



Local division Munich
UPC_CFI_58/2025
ACT_3832/2025

Order
of the Court of First Instance of the Unified Patent Court,
Munich Local Division
issued on 19 May 2025

GUIDING PRINCIPLES

If the obligation to bear costs in the context of a decision under Rule 360 RoP depends on whether the defendant gave rise to the filing of the action, the objective view of a person in the Claimant's position at the time the action was filed must be taken into account. The question is whether the Claimant could assume at that time that she would not be able to obtain her rights without judicial assistance.

A warning is not a prerequisite for the admissibility or merits of an application for interim measures. Its absence does not automatically mean that the request is no longer urgent. However, its absence may result in the applicant having to bear the costs if the defendant submits a declaration of discontinuance and undertaking immediately at the beginning of the proceedings (continuation of CoA, Order of 24 October 2024, CoA_2-2024, APL_83-2024 - Edwards/Meril).

Even without a prior warning and despite a cease-and-desist declaration and declaration of obligation issued immediately after the initiation of proceedings for interim measures, the defendant must be ordered to pay the costs if a prior warning was unnecessary because it did not promise success from the outset or because there would have been a risk that the asserted right would have been definitively frustrated as a result of the warning before a court decision.

If the defendant has already initiated court proceedings for an anti-suit injunction or anti-enforcement injunction, a warning by the applicant prior to an application for an anti-suit injunction or anti-enforcement injunction is generally dispensable because it can be assumed that the defendant will not comply with it, unless there are concrete indications of other behaviour.

APPLICANT

Dolby International AB, represented by its EMEA Finance Director Susan Way, 77 Sir John Rogerson's Quay, Block C, Grand Canal Docklands, Dublin, D02 VK60, Ireland,

represented by: Rechtsanwalte Dr Muller, Dr Henke, Mamine, Bardehle Pagenberg PartmbB, Prinzregentenplatz 7, 81675 Munich, Germany.

DEFENDANT

Roku, Inc. represented by its directors, 1173 Coleman Avenue, San Jose, CA 95110 USA,

represented by: Dr Kramer, Vossius & Partner Patentanwalte Rechtsanwalte mbB, Georg-Glock- Strae 3, 40474 Dusseldorf, Germany.

PATENT AT ISSUE

European Patent No. EP 3 490 258

PANEL/CHAMBER

Panel 2 of the Munich local division

PARTICIPATING JUDGES

This Order was issued by presiding judge Ulrike Vo, legally qualified judge Dr Daniel Vo (judge-rapporteur) and legally qualified judge Edger Brinkman.

LANGUAGE OF THE PROCEEDINGS

German

SUBJECT MATTER

Application for examination of an Order for interim measures - Rule 212(3) RoP

FACTS OF THE CASE

- 1 Based on the European patent EP 3 490 258 B1 (patent at issue), the applicant filed an infringement action against the defendant before the Munich local division (case reference: UPC_CFI_235/2024 / ACT_27821/2024; hereinafter: infringement proceedings).
- 2 On 15 November 2024, the defendant filed a statement of defence and a counterclaim for revocation of the patent at issue in the infringement proceedings.
- 3 On 31 December 2024, the defendant filed a lawsuit in the USA before the United States District Court for the District of Massachusetts (Case No. 1:24-cv-13217-RGS) directed against the applicant, among others (hereinafter "US lawsuit", submitted as Annex BP 3). With the "Prayers for Relief" contained therein, it announced under lit. f) the application to prohibit the petitioner from enforcing injunctive relief obtained against the respondent during the duration of the US action in the infringement proceedings before the Unified Patent Court and under lit. g) the application to prohibit the applicant from asserting or enforcing injunctive relief against the defendant under its worldwide patents essential to the HEVC standard (so-called anti-suit injunction or anti-enforcement injunction; hereinafter: ASI or AEI).
- 4 The petitioner became aware of the US action as a result of the service of process on Dolby Inc. on 7 January 2025.
- 5 In the infringement proceedings, the applicant mentioned the US action in its Reply of 20 January 2025 and expressed its opinion on the application under lit. f) in the "Prayers for Relief", [REDACTED]
[REDACTED]
[REDACTED].
- 6 By document dated 22 January 2025, filed with the Unified Patent Court via CMS on 23 January 2025, the petitioner requested that interim measures be issued without hearing the respondent, including prohibiting the respondent from seeking or pursuing anti-suit injunctions and anti-enforcement injunctions as in the US action and ordering it to withdraw the applications for anti-suit injunctions and anti-enforcement injunctions already pending before the US court. anti-enforcement injunction (so-called Anti-Anti-Suit Injunction or Anti-Anti-Enforcement Injunction; hereinafter: AASI or AA EI).
- 7 By Order dated 28 January 2025 (ORD_4525/2025), the court largely granted the application without hearing the defendant and issued interim measures. A decision on costs was not made. The period for initiating the main proceedings was to begin from the date of service on the defendant.

8 Correspondence between the defendant's US attorneys and Sullivan & Cromwell, the law firm mandated by the claimant in the USA, had already begun on 22 January 2025 on the occasion of the US lawsuit, without the "Prayers for Relief" being discussed. On the occasion of the applicant's statements in her Reply in the infringement proceedings, the respondent's US attorneys contacted the applicant's US attorneys by email dated 27 January 2025. In it, they stated, among other things (see Annex VP 1),

[REDACTED]

9 In an email dated 4 February 2025, the US attorneys of the petitioner replied, inter alia inter alia, [REDACTED]
[REDACTED]
(see Annex VP 2).

10 In response, the respondent, via its US attorneys, stated by email dated 28 February 2025 with [REDACTED]
[REDACTED] (cf. Annex VP 3).

11 On 4 March 2025, the Order of 28 January 2025 was served on the Respondent in the USA.

12 By email dated 5 March 2025, the petitioner's US attorneys submitted procedural declarations regarding the amendment of the US complaint (see Exhibit VP 4), which was filed by the respondent on the same day. In it, the "Prayers for Relief" under lit. f) was deleted and the claim under lit. g) was amended accordingly, [REDACTED]
[REDACTED]
[REDACTED] (see Annex VP 5). The defendant stated in the amended complaint expressly clear, [REDACTED]
[REDACTED].

13 Finally, on 31 March 2025, the defendant issued a legally binding declaration of discontinuance and undertaking to the claimant, without acknowledging any legal obligation and without any obligation to bear costs, in which it undertook to

the applicant undertook to refrain from the acts specified in Section I. of the Order of 28 January 2025 (see Annex VP 6). On 2 April 2025, the defendant submitted a further, modified cease-and-desist declaration with penalty clause (cf. Annex BP 7).

APPLICATIONS OF THE PARTIES

14 The defendant applies for

1. to review Order ORD_4525/2025 relating to case number ACT_3832/2025 of 28 January 2025 and 28 January 2025 and to amend it to the effect that it is
 - it is determined that the application for interim measures has become irrelevant as a result of the Respondent's email of 27 January 2025, alternatively as a result of the filing of the amended US statement of claim on 5 March 2025, but in any event as a result of the Respondent's submission of the cease-and-desist declaration and undertaking on 31 March 2025, and that the proceedings have thus been terminated;
 - the proceedings concerning the application for interim measures are dismissed;
2. Ordered that the applicant bear the costs of the proceedings and the other costs incurred by the defendant.

15 The applicant opposes the application under 1. only to the extent that, in its view, the proceedings were terminated on 2 April 2025. For the rest, it declares the proceedings UPC_CFI_58/2025, ACT_3832/2025 closed and requests that

order the defendant to pay the costs of the proceedings UPC_CFI_58/2025, ACT_3832/2025.

POINTS IN DISPUTE BETWEEN THE PARTIES

Applicant

16 The applicant is of the opinion that the proceedings were in any case settled with the declaration of discontinuance and undertaking issued by the defendant on 2 April 2025. On the other hand, neither the defendant's declaration in the email of 27 January 2025 nor the amendment to the US lawsuit on 5 March 2025 removed the risk of repetition and thus the injunctive relief. Therefore, the

Therefore, the defendant must also bear the costs of the proceedings for an order for interim measures. As a result of the submission of the declaration of discontinuance and undertaking by the defendant, the defendant is deemed to be the unsuccessful party according to the general rules. No further examination of the admissibility and merits of the application was required.

- 17 There are also no grounds of equity to oppose this. It - the applicant - had not caused any unnecessary costs; on the contrary, the defendant's behaviour had given rise to the application for interim measures without a prior hearing. The US action with the "Prayers for Relief" under lit. f) and g) was already sufficient for this.

[REDACTED]

- 18 A warning prior to the application for interim measures was not necessary. The defendant had [REDACTED] had [REDACTED] become sufficiently [REDACTED] [REDACTED]. In any event, an explicit warning prior to an application for interim measures regarding an ASI or AEI would be contrary to the purpose of an AASI or AA EI. The defendant could have asserted its US claims for interim relief immediately after receiving a warning letter, while the applicant would have waited for the reaction to the warning letter. It would have been left to chance or even depended on the behaviour of the defendant which Order - ASI/AEI or AASI/AA EI - could have been obtained first. Since the US action had already been filed, the defendant was not in need of protection, whereas the applicant did not know how the defendant would react to a warning. She had to expect that the latter would anticipate her AASI or AA EI. There would have been a risk that the applicant would have lost her right to justice permanently, or at least for an unreasonable period of time.

- 19 The defendant's email of 27 January 2025 did not change any of this. Firstly, the application for interim measures was already pending at the time. Furthermore, the content of the email was contradictory, [REDACTED] [REDACTED]. Finally the declaration lacked any legally binding force.

- 20 The applicant's application for interim measures was also not manifestly inadmissible or unfounded. Until the defendant issued the declaration to cease and desist with a penalty clause, the applicant had a claim for injunctive relief. This had not lapsed as a result of the email of 27 January 2025. The urgency of the matter arose from the applications in the US lawsuit and the risk that these could have been pursued by way of summary proceedings. The applicant was unable to specify the period within which the defendant could have obtained an ASI or AEI. In any case

the risk that the present Order would have come too late - even if this was even if this was due to the duration of service.

For the aforementioned reasons, an ex parte decision was also justified in the present case. Otherwise, there would have been a risk of irreparable damage.

Defendant

- 21 The defendant is of the opinion that the Order of 28 January 2025 was wrongly issued. The applicant was not entitled to an injunction, nor was the matter urgent. Above all, there was a lack of particular urgency to decide without hearing her - the defendant.

- 22 There had never been a claim for injunctive relief. Even before the date of the Order for interim measures on 28 January 2025, the defendant had given binding notification in an email dated 27 January 2025, [REDACTED]. The applicant had not brought this to the court's attention. In any case, the claim for injunctive relief had expired since the amendment of the US lawsuit on 5 March 2025, but at the latest since the submission of the precautionary declaration of discontinuance. Therefore, the application for interim measures is unfounded, at least at the present time. However, this point in time should be taken into account because it - the defendant - now has the first opportunity to comment on the application.

- 23 The matter was also in no way urgent. The applicant had neither substantiated nor made credible its allegation in the application that it - the defendant - could have switched its applications in the US action to preliminary injunction proceedings at any time and that there was therefore a risk that corresponding ASIs or AElis would be issued within a very short time and that applications such as those in the present proceedings would be prohibited. In fact, the US court would not have decided on the "Prayers for Relief" at issue without further ado as long as the defendant had not filed a separate application ("motion") directed to this. In addition, the defendant would have been obliged to discuss an amicable settlement with the applicant beforehand. Finally, the applicant would have had the opportunity to comment on any application by the defendant within 14 days before the US court would have issued a decision. It follows from all of the above that it would have been possible for the applicant to issue a warning to the defendant at short notice prior to the application for interim measures. Moreover, the applicant had not shown that the US court could have pre-empted an Order by the Unified Patent Court.

- 24 However, it is essential that, in any event, since the applicant's Reply of 20 January 2025, it has been aware that the applicant is of the opinion that the US action

applications for an ASI or AEI also related to the Unified Patent Court and considered this to be problematic. If the respondent had seriously intended to use lit. f) and g) of the "Prayers for Relief" as the subject of an expedited decision by the US court, there would already have been cause and opportunity at that time. Instead, it - the respondent - took the Reply as an opportunity,

[REDACTED]. By the time the Order of 28 January 2025 was issued, more than a week had already passed without it having filed the feared motion to expedite. Instead, it had submitted a declaration of commitment. The particular urgency with which the Order of 28 January 2025 was issued without her being heard was therefore clearly lacking. All of these circumstances could have been taken into account in the case of the hearing.

- 25 The Order of 28 January 2025 should therefore be set aside and the application for interim measures dismissed. The applicant should be ordered to pay the costs. Despite submitting the declaration to cease and desist, it - the defendant - was not the unsuccessful party, as the application for interim measures was manifestly unfounded in the absence of a claim for injunctive relief and, in particular, should not have been decided without hearing the defendant. In any event, the applicant should be ordered to pay the costs for reasons of equity. This was because it - the defendant - had given no reason for the proceedings to be initiated. It had not been warned beforehand and had only been able to recognise indirectly that the applicant was taking offence at the "Prayers for Relief" under f) and g). Nevertheless, she had submitted the declaration of 27 January 2025.
- 26 On the basis of this declaration, it would no longer have been possible for the defendant to use the "Prayers for Relief" pursuant to lit. f) and lit. g) in the US proceedings, thereby depriving the proceedings here of their basis and thus also eliminating any alleged claim to an injunction.

[REDACTED]
[REDACTED]
[REDACTED] 27 January 2025. A risk of first occurrence could already be ended by making an "unqualified and unambiguous declaration that the act complained of will not be carried out in the future". The applicant would have been obliged procedurally and in good faith to submit the declaration of 27 January 2025 directly to the court so that it could make its decision in full knowledge of the facts. Even when the Order was still being served, the applicant could have withdrawn her application, declared it closed and/or withdrawn the order for service.

REASONS FOR THE ORDER

27 Now that the parties have agreed that there is no longer any need to adjudicate the proceedings, it is only necessary to decide in accordance with Rule 360 RoP and, pursuant to Rule 118.5 RoP, to make a decision on the costs, which in this case are to be ordered against the respondent.

I.

28 Pursuant to Rule 360 RoP, it is only necessary to determine that the application for interim measures has become devoid of purpose, that there is no longer any need to adjudicate and that the application for interim measures is therefore dismissed.

1.

29 The German version of Rule 360 RoP provides for the dismissal of an application by a party if the court finds that the application has become devoid of purpose and that there is no longer any need to adjudicate on the merits of the case. In the case in dispute, the panel is called upon to decide, the rule is applicable and its requirements are met.

2.

30 The decision pursuant to Rule 360 RoP is issued in accordance with Rule 363.1 RoP by order of the panel on the proposal of the judge-rapporteur. According to Rule 363.2 RoP, it is a final decision.

3.

31 Even though Rule 360 RoP only refers to an action, the provision also applies to applications for interim measures (Munich local division, Order of 19 December 2023, ACT_550921/2023, UPC_CFI_249/2023 - Edwards/Meril).

4.

32 In the case in dispute, the application for interim measures has become devoid of purpose and the main proceedings have been disposed of. This is undisputed between the parties. The risk of further infringements and thus the injunctive relief pursued with the application for interim measures ceased to exist at the latest when the defendant submitted the declaration of discontinuance and undertaking to pay penalties on 2 April 2025.

5.

33 Furthermore, Rule 360 RoP provides for the action to be dismissed. In order to avoid giving the impression that the plaintiff is the losing party, some argue that the proceedings should be dismissed in accordance with the English and French language versions of Rule 360 RoP (Munich local division, Order of 19 December 2023, ACT_550921/2023, UPC_CFI_249/2023 - Edwards/Meril; Central Chamber Paris, Order of 16 May 2024, ACT_580824/2023, UPC_CFI_372/2023 - Stäubli). The court also considers the wording of the provision in the German version to be unfortunate; in this respect, terminating or concluding the proceedings would be more appropriate. Nevertheless, the wording of the German version of Rule 360

of the German version of Rule 360 RoP should be respected at this point, without prejudice to the fact that the applicant is also the unsuccessful party (see Munich local division, decision of 11 October 2024, UPC_CFI_300/2023, CC_597425/2023 - MSG/EJP). However, as this is not an action, but an application for interim measures, it is not the action that must be dismissed, but the application that must be rejected. Insofar as it is also established that the application is devoid of purpose and that the main action has been disposed of, these are declaratory findings.

II.

34 The defendant is to be ordered to pay the costs of the proceedings.

1.

35 As a final decision, an Order within the meaning of Rule 360 RoP also contains a decision on costs (CoA, Order of 18 January 2024, UPC_CoA_2/2024, APL_83/2024 - Edwards/Meril; see also on the analogous application of Rule 118.5 sentence 1 RoP: Munich local division, Order of 19 December 2023, ACT_550921/2023, UPC_CFI_249/2023 - Edwards/Meril).

36 In general, the unsuccessful party must bear the appropriate and reasonable costs of the legal dispute and other costs of the successful party (Art. 69 para. 1 UPCA). Exceptions apply if reasons of equity require a different allocation of costs, in particular if a party prevails only partially or in exceptional circumstances (Art. 69 para. 2 UPCA) or if a party has caused unnecessary costs to the court or another party (Art. 69 para. 3 UPCA). However, termination of the proceedings pursuant to Rule 360 RoP does not necessarily exclude the application of the general rule in Art. 69 para. 1 UPCA.

37 If the proceedings are terminated pursuant to Rule 360 RoP, the concept of dismissal in Rule 360 RoP does not mean that the defendant is regularly the successful party within the meaning of Art. 69(1) UPCA (CoA, Order of 4 October 2024, UPC_CoA_2/2024, APL_83/2024 - Edwards/Meril; Munich local division, Order of 11 October 2024, UPC_CFI_300/2023, ACT_569315/2023 - MSP/EJP). This follows from the correctly understood terminology of the German language version of Rule 360 RoP, taking into account the English and French versions (see above).

38 Which party is the successful party within the meaning of Art. 69 para. UPCA if the proceedings have been terminated pursuant to Rule 360 RoP must be determined on the basis of the particularities of the proceedings and, in particular, the applications of the parties and the reason for the termination of the proceedings.

39 If the proceedings are terminated on the basis of the defendant's submission of a declaration to cease and desist with a penalty clause, the content of the declaration is also decisive.

is also decisive. If the defendant undertakes to comply with the plaintiff's applications after the proceedings have been initiated, it is generally not necessary to examine the admissibility and merits of the case at the time the declaration to cease and desist is issued in order to determine which party is the prevailing party. The declaration itself implies that the plaintiff's applications have been fulfilled. This means that, as a rule, the plaintiff is to be regarded as the prevailing party (CoA, Order of 4 October 2024, UPC_CoA_2/2024, APL_83/2024 - Edwards/Meril).

40 An exception to the general rule of Art. 69(1) UPCA may apply if a plaintiff initiates proceedings without first sending a warning letter and the defendant issues a cease-and-desist declaration immediately at the beginning of the proceedings. In such a situation, it may be justified to award costs to the defendant on equitable grounds, in particular because the plaintiff has caused unnecessary costs to the defendant and the court by bringing proceedings against a defendant who has not given rise to the action (CoA, Order of 4 October 2024, UPC_CoA_2/2024, APL_83/2024 - Edwards/Meril).

41 Similarly, the defendant in an action for revocation regularly puts itself in the position of the losing party if it comprehensively waives the patent. However, the plaintiff may nevertheless be ordered to pay the costs of the proceedings for reasons of equity if the parties to the nullity action had corresponded before the court about patentability, the plaintiff presents new prior art for the first time with the nullity action and the defendant renounces the patent on this basis (Central Chamber Paris, Order of 16 May 2024, ACT_580824/2023, UPC_CFI_372/2023 - Stäubli).

2.

42 In accordance with these principles, the defendant must be ordered to pay the costs.

43 The defendant has placed itself in the losing position by submitting the cease-and-desist declarations and undertakings subject to penalty, so that it must be ordered to pay the costs of the proceedings. The application for interim measures was also not manifestly inadmissible or manifestly unfounded at the time the proceedings were concluded, so that the applicant should be ordered to pay the costs of the proceedings. Equitable grounds also do not lead to a different result.

a)

44 On 30 March and 2 April 2025, the defendant issued a cease-and-desist declaration with penalty clause to the applicant, the content of which corresponded to the cease-and-desist order of 28 January 2025. The defendant thus placed itself in the position of the unsuccessful party with the consequence that it must be ordered to pay the costs of the proceedings. Whether the declaration of 30 March 2025 or only that of 2 April 2025 was sufficient in this respect can be left open. In any case, the second declaration was also accepted by the applicant.

b)

45 The applicant's application for interim measures was also not manifestly unfounded or manifestly inadmissible, so that an exception to the principle would be required according to which the applicant is to be regarded as the successful party in the event that the defendant submits a cease-and-desist declaration with a penalty clause.

46 Whether such an exception to the general rule is possible at all (leaving open: CoA, Order of 4 October 2024, UPC_CoA_2/2024, APL_83/2024 - Edwards/Meril) does not need to be decided. This is because the defendant has not demonstrated and it is not otherwise apparent that the applicant's application for interim measures was manifestly inadmissible or unfounded.

aa)

47 The relevant time for the assessment of the admissibility and merits of an application for interim measures to be made in the context of the decision on costs is the time of the event that brings the matter to a close.

When examining whether a deviation from the general rule, according to which the party who has voluntarily taken the losing position must bear the costs, is justified by the circumstances of the individual case, it must be borne in mind that, due to the termination of the proceedings before a decision on the merits is issued, it is generally not clear at the time of settlement of the main action whether and, if so, to what extent, the action would have been successful. For the decision on costs after the main action has been settled in accordance with Rule 360 RoP, only a summary examination of the prospects of success of the action at the time of the event giving rise to settlement can therefore be made. The decision on costs is an equitable decision. Questions of doubt do not require a final clarification and/or decision (Munich local division, decision of 11 October 2024, UPC_CFI_300/2023, CC_597425/2023 - MSG/EJP). However, the event that leads to the inadmissibility or unfoundedness of the application cannot in itself be the reason to consider the applicant, who has consented to the settlement, as the unsuccessful party and to order him to pay the costs of the proceedings due to the then unsuccessful application. Rather, it depends on whether the circumstances preceding the event leading to settlement justify a different decision on costs.

bb)

48 By the time of the final event, the applicant's claim for injunctive relief had not lapsed and the application for interim measures was not manifestly unfounded.

(1)

49 As already stated in the Order of 28 January 2025, an infringement had not yet occurred, but there was a threat of infringement of the applicant's property rights with regard to the patent at issue and other patents due to the "Prayers for Relief" in the US application (risk of first infringement). Since an ASI or AEI had not yet been issued, the applicant's property rights had not yet been infringed at the time of the decision on its application for interim measures. However, there was a claim for injunctive relief due to the risk of first infringement, which was established by the US lawsuit with the "Prayers for Relief". The US lawsuit with lit. f) and g) of the "Prayers for Relief" were also to be understood as initiating proceedings for the issuance of an ASI or AEI, even if this required a further application.

[REDACTED]

(2)

50 The applicant's claim for injunctive relief did not already lapse as a result of the defendant's email of 27 January 2025. This declaration did not definitively eliminate the risk of an imminent infringement. In this respect, it is irrelevant whether a declaration to cease and desist with a penalty clause is required to eliminate an infringement that is only imminent and has not yet occurred, or whether it is sufficient to clearly and unambiguously abandon the act giving rise to the initial risk of infringement. Even if the latter should be sufficient to eliminate an imminent infringement of rights and to allow the applicant's claim for injunctive relief to lapse, this must be denied on summary examination of the facts for the declaration in the email of 27 January 2025.

51 The risk of first offence was established by lit. f) and g) of the "Prayers for Relief" contained in the US complaint.

"Prayers for Relief" contained in the US complaint. This request was still pending after 27 January 2025. Contrary to the opinion of the defendant, the submission of an "unqualified and unambiguous declaration that the act complained of will not be carried out in the future" is not sufficient in the case in dispute to eliminate the risk of first infringement. This may be different if the risk of first occurrence is established by a mere claim. However, the case is different here because the defendant had already initiated legal proceedings that contradict the allegedly different declaration.

52 It cannot be successfully objected that the statement in the email of 27 January 2025 even legally bound the defendant and has the effect of an "express/implied waiver" or an "equitable estoppel". The legal effects of the declaration in the email of 27 January 2025 can ultimately be left open. The decisive factor is that the declaration does not clearly and unambiguously indicate that the

applicant had abandoned her request. The introductory reference [REDACTED] in the email of 27 January 2025, the impression arises that the defendant only attaches declaratory character to its declaration and does not wish to be legally bound. In any case, the declaration did not prevent it from pursuing its request further, and ultimately it would have been up to the US courts to decide what legal effects the declaration would have. Even if the US courts had ultimately rejected an application for an ASI or AEI, the declaration had not yet eliminated the risk of first offence. In any event, the applicant did not have to be satisfied with such an uncertain procedure.

53 The applicant also pointed this out to the respondent by informing her, [REDACTED] .
[REDACTED] .
Even at this point in time [REDACTED] e part of the defendant to abandon the behaviour that gave rise to the risk of first infringement.

(3)

54 This only changed with the filing of the amended US statement of claim on 5 March 2025. This conduct constitutes the actus contrarius to the act giving rise to the threat of infringement. If the threatened infringement manifested itself in lit. f) and g) of the "Prayers for Relief" of the original US complaint, this circumstance was completely eliminated by the amendment to the complaint of 5 March 2025.

55 If the amendment of 5 March 2025 eliminated the applicant's claim for injunctive relief, it constitutes the event with which the present proceedings became irrelevant and the claim for injunctive relief was settled. The fact that the applicant takes a different view and refers to the cease-and-desist declaration of 2 April 2025 as the event that ended the proceedings 2 April 2025 is irrelevant. A concordant declaration of settlement is not required by Rule 360 RoP. The application of one party is sufficient. It is also possible to issue an order ex officio (Munich local division, decision of 11 October 2024, UPC_CFI_300/2023, CC_597425/2023 - MSG/EJP). As a result, the court determines the point in time at which the claim was settled, i.e. in the case in dispute with the amendment to the action of 5 March 2025. However, up to this point in time, the applicant's claim for injunctive relief was given and the application for interim measures was not manifestly unfounded in this respect. Rather, the opposite is the case, as shown in the Order of 28 January 2025 and in the preceding statements, the application was admissible and well-founded.

Even if one wanted to see it differently and wanted to take the defendant's declarations of discontinuance and commitment as the point in time of fulfilment,

this does not lead to a different decision on costs. This is because even with the amendment to the action of 5 March 2025, the defendant has put itself in the losing position by complying with the Order of 28 January 2025. It expressly stated in the amended US action,

[REDACTED]
[REDACTED] from an equity perspective.

cc)

- 56 There was also no obvious lack of the urgency of the matter required for the issuance of interim measures. Urgency is only one of several circumstances that are taken into account when weighing up the interests of the parties as to whether interim measures should be issued. Urgency is to be affirmed above all if the applicant has not behaved in a dilatory manner and cannot reasonably be expected to exercise his rights in proceedings on the merits and await their decision (see also local division Munich, UPC_CFI_443/2024, decision of 25 November 2024 - Häfele/Kunststoff KG Nehl; local division Düsseldorf, UPC_CFI_347/2024 - Valeo Electrification/Magna PT and others). The court affirmed this in the Order of 28 January 2025 with detailed reasons and the defendant does not object to this either.
- 57 Therefore, it ultimately does not apply if the "Prayers for Relief" could not have easily led to the issuance of an ASI or AEI. In this respect, based on the opinion of its expert [REDACTED] (Annex VP 7), the defendant has argued that before the US court would have ruled on the "Prayers for Relief", the defendant would have had to file an application directed at this; in addition, it would have been obliged to discuss an amicable settlement with the applicant beforehand; finally, the applicant would have had the opportunity to comment on the application within 14 days before the US court would have issued a decision. However, even if an ASI or AEI is only issued after such proceedings, a main proceedings aimed at issuing an AASI or AA EI would not have been concluded by then and the applicant could not reasonably be expected to be referred to such proceedings.
- 58 In essence, the respondent is of the opinion that, based on the extrajudicial correspondence between it and the applicant, the applicant could have been warned beforehand, or at least heard in court, instead of interim measures being issued without hearing the applicant. The timing of the procedure of the US courts for the issuance of an ASI or AEI just described would also have left room for a prior warning or court hearing. The defendant cannot prevail with this view.
- 59 The defendant's failure to issue a warning does not remove the urgency of the matter. A warning is not a prerequisite for the admissibility or justification of an application for interim measures. The same applies to the fact that the

Order of 28 January 2025 was issued without hearing the defendant. The decision on whether to issue an ex parte order is ultimately at the discretion of the court in accordance with Rule 209.1 and 2 (c) RoP and constitutes a procedural decision. Therefore, even if a hearing of the defendant would have been appropriate in the present case, its omission does not mean that the application for interim measures was manifestly inadmissible or unfounded.

- 60 Since a failure to be heard cannot in principle lead to the inadmissibility or unfoundedness of an application for interim measures, it is also irrelevant what the defendant would have submitted if it had been heard. Therefore, her argument that she would have submitted extrajudicial correspondence if she had been heard and could even have recognised the claim immediately does not apply. The defendant does not suffer any loss of rights as a result, as it can make up for its submissions in the context of examination proceedings. If the application for interim measures then proves to be inadmissible or unfounded, the costs of the proceedings must be decided in accordance with the general rules. These should be imposed on the applicant if the application was inadmissible or unfounded from the outset. If the application has only been disposed of in the course of the proceedings, the principles established by case law for a decision on costs in the context of a decision pursuant to Rule 360 RoP apply again. However, these legal consequences are independent of whether the defendant was - allegedly - not heard due to an error of judgement. Irrespective of this, it cannot be assumed from the summary examination required here that a different decision on costs would have been issued than in the current case constellation if the defendant had been heard. Insofar as the defendant argues that, if she had been heard, she would have provided additional information on her extrajudicial correspondence with the applicant, this would have no effect on the admissibility and merits of the application. In particular, as stated, the email of 27 January 2025 would not have led to the claim for injunctive relief ceasing to exist. The amendment of the US action following the application for interim measures or an immediate declaration to cease and desist, on the other hand, would only have led to the termination of the proceedings, even if the defendant had been heard, with the result that the defendant would have been considered the losing party and would have had to bear the costs, unless it had not given any reason to file the application (see below). It has not been shown what other facts the defendant would have wanted to present in the event of her hearing.
- 61 For this reason, it was also not in breach of trust that the applicant did not submit the defendant's email of 27 January 2025 before the interim injunction was issued on 28 January 2025, insofar as this was practically possible at all. The statement was only submitted by the defendant after the initiation of the present proceedings and less than 24 hours before the Order was issued and should have been discussed with the applicant herself and the UPC Agreement representatives here. Furthermore

the application would not have been manifestly unfounded on the basis of the email of 27 January. The declaration also had no effect on urgency.

62 Finally, the applicant's comments on the US proceedings in the Reply to the infringement proceedings do not play any role in the urgency. The fact that she commented on the "Prayers for Relief" in the Reply on 20 January 2025 does not allow the conclusion that the matter was not urgent for her. The submission in the Reply was due to the fact that the Reply period ended on 20 January 2025 and the introduction of further submissions in infringement proceedings after the expiry of the time limits for written submissions is associated with difficulties. The application for interim measures was filed by the applicant just three days later. Such a short period of time is to be granted to the applicant for the preparation and coordination of the application, but does not allow the assumption that she is not in a hurry to enforce her claim for injunctive relief.

c)

63 The costs of the proceedings are not to be imposed on the applicant on grounds of equity pursuant to Art. 69 (2) RoP.

64 An exception to the general rule of Art. 69 (1) UPCA is not required because the applicant has caused unnecessary costs by initiating the proceedings against the defendant without the latter having given cause for this. In particular, it was not necessary for the applicant to warn the defendant before initiating the proceedings for interim measures. This is because a warning was unnecessary in the present case.

aa)

65 In order to assess whether the defendant gave rise to the application for interim measures by the applicant, the objective view of a person in the applicant's position at the time the application was filed on 23 January 2025 must be taken into account. The question is whether the applicant could assume at that time that she would not be able to obtain her rights without judicial assistance. This is to be denied in particular if it was to be expected that the defendant would cease the behaviour giving rise to the risk of first offence in response to a pre-litigation warning or would otherwise submit. On the other hand, it must be affirmed if a warning was dispensable because it did not promise success from the outset or if, as a result of the warning, there would have been a risk that the asserted right would have been definitively frustrated before a court decision.

bb)

66 In the case in dispute, the defendant gave the applicant sufficient cause to file an application for interim measures on the basis of the sections under lit. f) and g) of the "Prayers for Relief" in the US complaint. A prior out-of-court warning was unnecessary because it did not promise any success.

(1)

67 In cases in which court proceedings for the issuance of an ASI or AEI have already been initiated, which threaten the applicant's property right in the form of a patent and claims derived therefrom, and the applicant requests the issuance of an AASI or AA EI, a warning is generally dispensable because it can be assumed that it does not promise success anyway. The present case constellation is typically characterised by the defendant applying to a court for an ASI or AEI, thereby jeopardising the applicant's ownership position. This action by the defendant is taken with the clear intention and in the concrete awareness of restricting the enforcement of the applicant's rights, in this case the enforcement of the applicant's patent rights in the jurisdiction of the Unified Patent Court. Without concrete evidence to the contrary, a defendant who has knowingly and willingly taken this step and has already appealed to the courts cannot in principle be expected to simply reverse this step in response to a mere out-of-court request for an injunction, i.e. a warning letter, by assuming the costs incurred up to that point. His request makes it clear that he is not prepared to tolerate the enforcement of the applicant's patent rights, at least not for the duration of the parallel proceedings - in this case in the USA. This is because the ASI or AEI sought is intended precisely to remove the review competence of the court solely responsible for clarifying the infringement issue here, or at least to limit it in terms of time. Especially if, as in the present case, an infringement action is already pending before the UPC Agreement, the request for an ASI or AEI indicates that the defendant is not prepared to defend himself in these proceedings before the competent infringement court. Against this background, it cannot in principle be assumed that a defendant will comply with an out-of-court warning intended to enforce precisely this jeopardised legal position of the applicant in order to submit to the jurisdiction of an infringement court, which he wishes to avoid. The contrary assumption would be in complete contradiction to the defendant's previous behaviour, so that the unsuccessfulness of a warning must be assumed in principle. If the defendant has therefore already resorted to the courts to enforce an unlawful encroachment on the applicant's legal position, it cannot be assumed that the applicant, for his part, will be able to achieve his goal in defence against this risk without judicial assistance.

68 In this respect, the present situation is different from cases in which a patent is used unlawfully by offering and selling a patent-infringing product (see, for example, CoA, Order of 4 October 2024, UPC_CoA_2/2024, APL_83/2024 - Edwards/Meril). These cases are regularly characterised by a certain degree of uncertainty in factual and legal terms, which can be eliminated by a warning. In this respect, it is possible that the patent infringer is not aware that the technical teaching is protected by a patent and is being used by him, especially as there can regularly be different opinions regarding the interpretation of a patent and the question of its use.

In addition, such an infringement case is on a purely factual level at the stage before recourse to the courts. In such cases, a warning letter is suitable for drawing the defendant's attention to the existence of the patent, pointing out the arguments in favour of an infringement of this patent and, by means of a clear request for an injunction, persuading the defendant to reconsider and, if necessary, to give in and submit a cease-and-desist declaration with a penalty clause before the case is brought before the courts and thus raised to another level. The cases in which the defendant seeks the issuance of an ASI or AEI are regularly distinguished from this by the defendant's knowing and wilful action and the fact that judicial assistance has already been sought.

(2)

- 69 In the case in dispute, there are no concrete indications that speak against the assumption that the applicant could only enforce her rights with judicial assistance. As stated at the outset, the objective view of a person in the applicant's position at the time the application was filed on 23 January 2025 must be taken into account. At that time, however, the defendant had not yet commented on the "Prayers for Relief" submitted by it in the US lawsuit. It could not be assumed that the defendant would already drop its request under lit. f) and g) of the "Prayers for Relief" in response to an out-of-court injunction.
- 70 Nor does it follow otherwise from the fact that the applicant had already criticised this in her Reply of 20 January 2025 [REDACTED] criticised. As already stated with regard to urgency, this circumstance does not allow the conclusion that the applicant herself assumed that she would be able to deal with the defendant out of court about the "Prayers for Relief" in the expectation that the defendant would drop her request again.
- 71 This assumption is also not justified by the fact that the defendant did not request an acceleration of the US proceedings or an ASI or AEI by way of a preliminary injunction within the three days until the application for interim measures on 23 January 2025. The reasons why the respondent did not do so may be manifold and may be due, for example, to the fact that it had not yet decided how it wanted to proceed. In any case, up to the time of the application for interim measures by the applicant on 23 January 2025, there was no conduct on the part of the defendant that clearly and unambiguously indicated that it could drop its request on the basis of a pre-litigation warning.
- 72 Therefore, the behaviour of the defendant after 23 January 2025 - such as the statement in the email of 27 January 2025 - is also no indication that the applicant could (and had to) assume at the time of filing the application that she would be successful with a warning from the defendant. This is because before 23 January 2025, there was no indication that the defendant would behave in exactly the same way as it did afterwards - even if

without the enforcement pressure of the Order of 4 March 2025, which was only served on 28 January 2025 - did.

cc)

73 Furthermore, a warning was also unnecessary.

(1)

74 At the time the application was filed on 23 January 2025, the applicant could not assume that the defendant would remain inactive in response to a warning. It could not be ruled out that the defendant would request an acceleration of the proceedings before the US court or the issuance of an ASI or AEI by means of a preliminary injunction. This was even to be assumed in principle, because there is no reason to assume that a defendant who wishes to enforce its claim in court - here through lit. f) and g) of the "Prayers for Relief" - would abandon this path solely on the basis of an out-of-court request instead of continuing it with judicial assistance - then by way of urgent legal protection (see also Local Division Munich, Panel 2, Order of 19 February 2025, CFI_112/2025, ACT_7300/2025, para. 39 f. - Nokia/Sunmi).

75 However, the applicant did not have to accept the risk of an acceleration of the US proceedings or an application for the issuance of an ASI or AEI in summary proceedings. This is because the issuance of such an ASI or AEI prior to the issuance of the AASI/AAEI requested by the applicant or at least prior to the service of a corresponding Order on the respondent would have significantly jeopardised, if not rendered impossible, the enforcement of the applicant's rights.

(2)

76 On the other hand, the defendant cannot successfully argue that before issuing an ASI or AEI, it should have first filed a corresponding application on the basis of the "Prayers for Relief", which should have been preceded by out-of-court settlement efforts with the applicant, and that the applicant should have been heard by the US court within a two-week period, so that the issuance of an ASI or AEI would not have been possible at short notice. However, the respondent's private expert, ██████████ ██████████, stated in his opinion that the median time for the issuance of a preliminary injunction by the Massachusetts District Court has been 29 days in the last five years. Even if the private expert Rizzolo is not aware that any district court in the USA has ever issued an anti-anti-enforcement injunction (there is no mention of an ASI or AEI), it cannot be ruled out that a US court would have issued an ASI or AEI in response to the defendant's emergency motion provoked by a warning letter from the plaintiff, and in less than 29 days. In any event, there was a risk that such an ASI or AEI would be issued and served on the petitioner rather than, conversely, the respondent's AASI/AAEI order sought by the petitioner. In that case, however, there was a risk for the applicant that

applicant would not have been able to enforce her rights because she would have been forced to withdraw her application or would even have been fined. The applicant would not have had to accept these uncertainties, which makes a prior warning appear unnecessary.

ORDER

1. It is established that the application for interim measures is without merit and that the proceedings on the merits have been concluded.
2. The application for interim measures is dismissed.
3. The Order of 28 January 2025 has no effect.
4. The defendant shall bear the costs of the proceedings.
5. The value in dispute is set at EUR 1,000,000.00.
6. The decision is to be entered in the register.

DETAILS OF THE ORDER

Order no. ORD_16027/2025

UPC number:

UPC_CFI_58/2025

No. of the associated procedure Application no.: 3832/2025

Type of application:

Application for interim measures (Rule 206 Regulation)


Ulrike Voß (Presiding Judge)	
Dr Daniel Voß (legally qualified judge)	
Edger Brinkman (legally qualified judge)	

For the Deputy-Registrar	
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Note:

This document is the redacted version of the Order intended for the public. It is valid without the signatures of the judges involved and the Deputy-Registrar's representative.

**Daniel
Voss**

 Digitally signed by
Daniel Voß Date:
2025.05.16
17:51:05 +02'00'