Day 1, Panel 7: Injunctive Relief

Key Terms: Global Litigation Campaign, Multi-Jurisdictional Strategy, Simultaneous Enforcement, Sequential Filing Strategy, Begin with End in Mind, Off-Ramp Planning, Jurisdictional Chess, Settlement Pressure, Inflection Point Strategy, Follow the Money, Follow the Business, Forum Selection Strategy, Venue Triage, Market Value Analysis, Supply Chain Enforcement, Preliminary Injunction (PI), Permanent Injunction, Ex Parte Injunction, Injunction Gap, Property Right Presumption, eBay Factors, Irreparable Harm, Monetary Damages Adequacy, Proportionality Defense, Rebuttable Presumption, Anti-Suit Injunction (ASI), Anti-Anti-Suit Injunction, Interim License, ITC Exclusion Order, Cease and Desist Order, eBay v. MercExchange, eBay Factor Analysis, RESTORE Act, Non-Practicing Entity Injunction Bar, Life Sciences PI Exception, Amazon Takedown Notice, ITC Exclusion Order, Competitive Litigation Injunction, Section 301 Report, US Trade Representative, Monetary Damages Preference, US Injunction Unavailability, NPE Injunction Difficulty, UPC Preliminary Injunction, UPC 60% PI Grant Rate, UPC 12-15 Month Timeline, UPC Permanent Injunction, UPC Proportionality Defense, Anti-Anti-Suit Injunction UPC, UPC Cross-Border Injunction, BSH Electrolux Decision, UPC Property Right Framework, Trade Fair Ex Parte PI, UPC First Instance Hearing, German Bifurcated System, German Injunction Gap, German National Court PI, German Proportionality Defense, Vossius & Partner, Munich Regional Court, German Nullity Action, German Infringement Court, Injunction Gap Risk, Damages Payback Risk, Volkswagen BMW Mercedes Lobbying, German Patent Property Right, Brazil PI Speed, One Week to Two Month PI, Brazil Patent Filings, 40 Cases Per Day, Brazilian Market Size, Brazil Delay Tactics, Brazil Ex Parte PI, Brazil Streaming Companies, Brazil Comparable License Review, Brazil Patent Backlog, Five Year Pendency Brazil, Brazil NPE Strategy, Brazil Portfolio Building, UK Litigation, India Patent Enforcement, China Patent Enforcement, Japan Patent Enforcement, Colombia Preliminary Injunction, Nigeria Patent Filing, Canada Patent Filing, South America Market, Latin America Growth, Ericsson v. Lenovo Colombia, Nokia v. Amazon Campaign, InterDigital v. Amazon Campaign, Standard Essential Patent (SEP), FRAND Defense, FRAND Rate Setting, FRAND Injunction Compatibility, Non-SEP Portfolio, SEP Non-SEP Combination, SEP Injunction Grant, Implementer Defense, Anti-Suit Injunction FRAND, FRAND Willing Licensee, FRAND Unwilling Licensee, SEP Licensing History, SEP Monetization Strategy, Geographic Patent Portfolio, Injunction-Friendly Jurisdictions, Market Importance Triage, Predictable Enforcement Regime, Portfolio Valuation, Injunctive Threat Value, Patent Acquisition Strategy, NPE Portfolio Strategy, Broad Claim Scope, Manufacturing Claim vs. End Product Claim, Supply Chain Claims, Portfolio Diversification, Private Equity Portfolio, Company Life Cycle Portfolio, Local Counsel Expertise, Lead Coordination Firm, Cross-Border Coordination, Inconsistent Position Risk, Client Hand-in-Hand, Business Outcome Focus, Judge-Specific Knowledge, Procedural Local Knowledge, International Counsel Role, Non-Patent Law Tools, State Court Remedies, Arbitration Stay Equivalence, Customer Suit Exception, Nullity Action Response, IPR Filing Response, Design Around Approach, Delay Tactics, Anti-Suit Injunction Defense, Nulity Counter-Action, Improvident Injunction Risk, Injunction Reversal Risk, Damages Payback Exposure, Implementer Forum Shopping, Rate Setting Jurisdiction, FRAND Rate Defense,

Nokia v. Amazon, InterDigital v. Amazon, Ericsson v. Lenovo, Nesta v. BMW, BSH v. Electrolux, Radion Case, UK Interim License Cases, German Injunction Gap Cases

Moderator
Saina Shamilov, Fenwick

Speakers
Rob Rodrigues, RNA Law
Ellisen Turner, Kirkland & Ellis
Philipp Widera, Vossius

[MARK LEMLEY]
Okay, welcome, everybody. Uh, our next panel is gonna talk about injunctions and our moderator is Saina Shamilov, who is a patent litigator at Fenwick and the co-head of their litigation, patent litigation group.

I'm gonna turn it over to her, and she can introduce the panel and tell us how we're gonna proceed.

[SAINA SHAMILOV]
Thank you, Mark. We kind of look, looks like our topic lost half of the room. But it's okay. So we're gonna talk about global litigation campaigns with injunction being sort of an important aspect of it. Recently, we've seen, I think, popularity of those campaigns rise.

And different considerations go into that, because you don't just now take the value of the patent versus value of defense, for example, as you decide to, how to resolve this dispute. You now take into consideration the value of the market you are in, right? And what's the value of the market you are in if you have a threat of the injunction?

We're lucky today because half of this panel is jet-lagged which means that we have really great global perspective. The other half is just sleep-deprived, like everybody else in this room.

So I'll let the panelists introduce themselves, because I think it's important for you to understand their context. And we'll start with Ellisen at the end, please.

[ELLISEN SHELTON TURNER]
So I am Ellisen Turner. I am a IP strategist in trial over at, over at Kirkland & Ellis. I'm here on the panel, aha, standing in for my partner, Nicola Dagg, who runs our London IP office. So you're gonna lose an accent, which I understand is more convincing and honest and makes you feel very comfortable.

You're gonna lose that. You're gonna lose the boots on the ground London experience, but what you'll gain is the perspective of someone who's been quarterbacking and linebackering global campaigns from here in the U.S., as well as somebody who's 20% of their practice is IP strategy

in a transactional context, either through due diligence or talking with people about investing in patent portfolios. So that has an international perspective as well, and that's what I'll bring.

[PHILIPP WIDERA]
Yeah, thank you. My name is Philipp Widera. I'm a partner with Vossius & Partner, a German IP law firm in, sorry, neither U.S. nor British accent, so hope it still works out. I'm a patent litigator for 12 years now, doing increasingly UPC work, of course. And yeah, happy to be on this panel.

[ROB RODRIGUES]
Thank you. So I'm Rob, a patent litigator in Brazil, and I think today I have the easy task to try to explain PIs in Brazil, so excited.

[SAINA SHAMILOV]
Great. So we've seen some of really large campaigns that span UPC, Brazil, ITC, district courts, Colombia, all in one, some of them including multiple complaints in the same jurisdiction. Why do you guys, and this is a question for the entire panel, Ellisen, we can start with you.

But why do you think we have a rise of these global wars with simultaneous enforcements and multiple complaints in the same jurisdiction? I mean, these are really hard to pull off in terms of coordination.

[ELLISEN SHELTON TURNER]
Yeah. Well, I mean, it's primarily because as IP lawyers, we follow the business, right? And so it's a global economy. Things become more efficient to do things cross border. There's global supply chains, so you want to be able to do what the business needs to protect its revenue and protect its moat.

And as IP lawyers, that's what we're about, exclusion or monetization of intellectual assets. And so we do that wherever it's necessary to do it. So that's one primary reason, but the other is something, it's really two things that are somewhat at odds.

It's global harmonization that's come about over the last few decades in terms of how IP is enforced, right? We all kind of think about claims and descriptions and invalidity and infringement in largely the same way across these venues, but at odds with that is the procedural differences and the differences in remedies across the venues.

You can get special treatment depending on what you want, depending on the venue you're in, right? So yeah, I can go to the US for my big damages, and I can go somewhere else for my injunction. And since I can do that, I'm gonna take advantage of that now that it's more efficient to do so, because we have a lot of overlap in how we think about IP.

[SAINA SHAMILOV]
Mm-hmm. What about you, Philipp? Why do you think we see the rise of these injunction campaigns?

[PHILIPP WIDERA]
Yeah, I can absolutely second what Ellisen said, but I would also add that I think both sides have been, become more aggressive, particularly in the SEP front area, which we heard just before, right after lunch. So the SEP holder obviously tries to get a forum where they get an injunction, whereas the defendant, the implementer tries to get a forum, maybe get an interim injunction, maybe get a rate-setting jurisdiction with favorable rates. So I think this is also plays out that both sides really try to play the jurisdictional game to get the most favorable outcome for their goal.

[ROB RODRIGUES]
Yeah, I believe is follow the money rule, where if you understand you're in the middle of a war and you have a place where you have availability of a relevant tool like a preliminary injunction or even damages or anything that will be helpful, you use that tool. Uh, and and particularly about Brazil, there is a difference in how the economy grow in the last few years. And if you look back in 10 years ago, there's maybe, like, handful number of cases. And nowadays, we have at least, like, 40 patent infringement cases filed on a daily basis.

And that, it's because, mostly because of the size of the market, harder than just determining the PIs, the strategy or something. And I guess the idea behind having a strong jurisdiction, but also where you have a big economy, it's a driving factor for this.

[SAINA SHAMILOV]
Mm-hmm. I mean, traditionally, injunction's been a tool to kinda prevent your competitor, protect your business from your competitors, from the, gain a little competitive advantage that way. But in these campaigns that we see right now, do you guys think that the injunctions or, as a tool, shifted maybe from preserving your business from competitors, to maybe just a settlement leverage for a dispute?

And, Ellisen, you're nodding, you wanna start there?

[ELLISEN SHELTON TURNER]
Well, yeah. It's a little bit of both.

I mean, different strokes for different folks, right? So when you're in a competitor litigation, a competitive scenario, which lots of, you know, my clients are, you know, it's huge corporation versus huge corporation, we're talking about, you know, not necessarily trying to keep each other's products off the market per se, but having some other sort of business resolution that will allow us to operate globally in a particular way that we want.

And so, the injunctive relief is a piece of pressure that you can use, not necessarily to get money or to get products off the market, but to get some business outcome that you want. But if you're a non-practicing entity, yeah, It's still the tool that you need to cause people to actually come to the negotiating table sometimes.

[SAINA SHAMILOV]
Mm-hmm. Interesting. What about you Philipp and Rob, anything to add there? Do you share the same view?

[PHILIPP WIDERA]
Yes. And in principle, I absolutely share that. So in Europe or Germany, we see both types of litigation. So we see still a lot of competitor litigation but also NPE litigation.

Obviously, both have reasons why they want injunctive relief. One is for settlement purposes, the other one is to drive the other one out of the market.

So there's still room for both.

[ROB RODRIGUES]
Yeah. It's hard to say like if you've see how companies behave in thinking on a PI as a leverage perspective, of course you're in a middle, again, in the middle of the war, so you try to have and, but at least from my client's perspective, I don't see them understanding as a PI as a peer resource to get a settlement, right? It's needed just maybe to be able to get a leverage but not perceived as a way to settle something.

[SAINA SHAMILOV]
Before we get into differences between sort of US injunction sort of state of affairs versus Europe and Latin America, do you think injunctions force faster financial resolutions or do the opposite and sort of protract the war because there's so much more at stake?

[ROB RODRIGUES]
I guess, yes. Yeah, I think that it's if you don't have a PI in the system, I believe the system gets more expensive. Because it's-- you can delay things and any delay will be more expensive. So in general, I feel that it's if you have a PI, it's cheaper.

[SAINA SHAMILOV]
Ellisen, what's your view?

[ELLISEN SHELTON TURNER]
It depends on how well you've begun with the end in mind, right? That this is now a multi-dimensional game of chess. And if you have proceeded based on the simple fact that you can get an early injunction in a venue without thinking it through more deeply, you could end up with more protracted litigation than you've got.

Because it may turn out that, yes, people can get injunctions quickly in that venue, but not you. Or not without substantial cost or substantial risk, because if your injunction was improvidently granted in many venues and it turns out that you shouldn't have gotten it, that can actually cost you a lot of money as someone who might not have the resources to deal with it. You know, you

have to have a very clear understanding of what risks you are trying to impose on someone and what risks you're taking on yourself. But a well-planned strategic litigation that's designed to get an early injunction, a preliminary injunction, or a relatively fast permanent injunction can you know, accelerate the resolution.

Because obviously, what we're always looking for as, if you're on the plaintiff's side but even on the defense side in many cases is, where are the off-ramps? And obviously, the plaintiffs, if they're looking at time to money, want as early an off-ramp as possible, an inflection point where somebody has to come to the table and make a decision because the risk is so high on the other side of that decision. And preliminary and permanent injunctions are very high risk points, you know. And, you know, here in the US, we're thinking about Markman hearings and summary judgment and the venue motion, and you've got those sort of similar points a-- across the world, but the injunction is such a high risk point that the earlier you can bring that for bear, the more this -- you've done it right and thought it through correctly, you could have that negotiation earlier in the litigation.

[GEMA SHIMIZU]
Well, let's talk a little bit about the difference, those timing differences about where you can get it faster, where you can get it later. And I think, Alison, maybe we start with you and do a qu-- quick introduction of sort of what types of injunctions and how fast we can get them here and there now is because probably most of the people in the room are familiar with. And we'll spend a little more time on the differences from that in Europe and Latin America.

[ELLISEN SHELTON TURNER]
Yeah. So most of the people in the room, many of the people in the room are probably, like me, used to litigating the kind of fairly big ticket cases that we heard talked in the earlier about litigation funding, you kind of want $100 million at stake. And if you don't have $100 million at stake, then forget it, we're not gonna fund it. I mean, that's, you know, that's the kind of numbers that a lot of us at kind of the larger firms are talking about. But that is not the average US patent litigation or a patent matter.

There are many matters where it is consumer products, it is cosmetics they are design patents at issue, where actually you can get injunctions. You can go to a district court and get an injunction.

You can get something that's in the form of an injunction by doing an, a take-down notice on something like Amazon, where it's incredibly detrimental to the implementer to have their products taken down off Amazon and not be able to complete those sales for a period until something is resolved in court. So there are lots of ways to get the equivalent of an injunction in the US outside of certain types of matters.

Life sciences matters, of course, completely different animal. You can get preliminary injunctions here, you can get permanent injunctions here, competitive litigation, you at least have the opportunity to get permanent injunctions here.

And of course, have the International Trade Commission, the cease and desist, and exclusion order is the equivalent of an injunction in many ways, you can go to and get products excluded. So we do have avenues here, but of course, because of the eBay factors that we're all familiar with it's very difficult in a normal litigation, especially for a non-practicing entity, and you're sort of run-of-the-mill, you know, consumer electronics or non-practicing any related litigation, to get an injunction because amongst the other factors, this concept that there has to be a situation where monetary damages would not be adequate to satisfy you and the relief you need.

As long as that's a factor, it's gonna be very difficult in the U.S. to get an injunction and in many other countries that we'll talk about, that is not a significant factor. They talk about irreparable harm, but this concept that, "Well, would money be enough?" is less of an issue and not a dispositive issue, as much of a dispositive issue as it is here.

[SAINA SHAMILOV]
Rob, I wanna start with Brazil because it seems like in Brazil, you can get a preliminary injunction as fast as you can get a cup of coffee. Um, so tell us a little bit what the reality and if I'm right.

(laughing)

[ROB RODRIGUES]
Uh, maybe I'm uh, slightly misconception, so well, it's can be quick, but at the same time, there's I believe, like the companies when they apply for a PI in Brazil, they understand also that uh, the judges, "We need to do something." So you are in a jurisdiction where you have active magistrate is better than jurisdictions where judges are not doing anything, right? So it's a better off jurisdictions and, but it's not because they've, "Okay, we're gonna issue a fast decision."

It's a lot because what's the right thing to do in this case, right? And years ago, we did have ex parte PIs but then some judges realized that, "Okay, but maybe a ex parte PI is not the right way to solve these type of disputes."

And then we start to see the introductions of hearings to be able to issue a PI. So it's a system where I see at least a judge trying to find it right, and-- But yes, then you have companies like streaming companies where they play delay tactics. You have to be mindful that there's also companies the other side of say, "Okay, I will do everything I can to delay the grant of a PI, and because I can pay for that, I can afford that, and I will never settle." So the only way for a settlement to happens then is to issue a fast PI, right?

So I guess there's a balance and the judges are mindful to try to do that as well.

[SAINA SHAMILOV]
So I'll push you a little bit. On average, how fast can you get a PI in Brazil?

[ROB RODRIGUES]
Can take like something one week to a month or two.

[SAINA SHAMILOV]
That's a cup of coffee.

(laughs)

Philipp about Europe, I mean, with the UPC Court introducing a really great type of tool for getting faster injunctions, PIs, and obviously, sort of just mandatory injunctions after, can you talk a little bit about the landscape of this in Europe and also how fast you can get those?

[PHILIPP WIDERA]
Yeah, of course. Maybe as a starting point in general, in continental Europe, at least, we got patents as a property right. So for us, the eBay concept and factors always sound a bit weird to us.

Just imagine you have a house with two bathrooms, an intruder sitting in one of those. I mean, a judge would never say, 'Well, you still have another bathroom.' So since it's a property right, you can't exclude others.

That's the, it's starting and end point in continental Europe in principle. So yes, you can get PIs and you can get permanent injunctions as the usual remedy. And with PIs you can also get them ex parte pretty quickly, particularly in trade fair cases. So if someone exhibits certain products on a trade fair, you can get a PI within hours if necessary.

In context of generics, for example, even, yeah, sometimes weeks, maybe months, but yeah, fairly quickly, and for permanent injunctions, depends a little bit on the forum you're in. About a year to a year and a half is probably fair to say.

[SAINA SHAMILOV]
Mm-hmm. So we have these several venues available for an injunctive relief, some with very drastic sort of temporal aspects to them differences as well as substantive ones.

So for someone who's trying to devise a campaign, right? That will hit all those points and some of them we've seen, right? Nokia v. Amazon had all the US available courts plus Germany, UK, India, Brazil, and UPC, for example, right? Where do you go first?

Does it matter? Do you hit multiple at the same time? Is there some order that's better than others? What have you seen from your experience and what's better?

Ellisen, you wanna start there?

[ELLISEN SHELTON TURNER]

Yeah. You know, actually I, so I'm gonna make a comment 'cause Andre asked me to bring this up. And so he used to be my boss, so I'm gonna bring it up. The RESTORE Act is pending.

He can talk more about what the status of it is, but of course it would eliminate the sort of eBay factor analysis in the way that it's been done and we would have more ability to get injunctive relief here in the US more like it used to be before eBay. Well, can I ask, many people know what the Section 301 report is from the US trade representative? All right, so I've got one.

I know Andre didn't raise his hand, he knows what it is. All right, so this is a report that is put out by the US trade representative that says basically, "Hey, here are a bunch of countries that are on our watch list because they don't enforce IP rights in the way that we would like."

And if you look in this report, historically, even today, in the one that came out in 2025, it'll say, "and China, for example, is on our watch list because they don't issue preliminary injunctions in the way that we would like." Now, that's kind of Kafkaesque, right?

Because we don't issue preliminary injunctions here in the US, generally, for patent matters except for in life sciences cases and some other unique circumstances. So, it is a little odd that you have these sort of, we think as a sort of matter of protecting economic, US economic interests, that preliminary injunctions and permanent injunctions are important but yet, we don't really do them in the same way that other countries are willing to do them. Now, when we're thinking about where to go first and what matters in terms of that choice, again, it goes back to that point of beginning with the end in mind because you have to think of the risk of going in that venue and losing, and losing fast. And how does that impact the place you're going next?

So if you start in the US and if you were to seek a preliminary injunction here and immediately lose, how much attention is the UK court gonna pay to that loss given the overlap between whatever you're gonna assert in the UK, and what you're gonna assert in the US. So you have to think about the overlap between the patent claims you're gonna assert in each venue, which one is going to get the decision first, which one's gonna give greater weight to things like the public interest, what public interest arguments you're gonna have to make in one venue, and how they might affect another.

In effect, you have to map out all of the timing, all of the patents you wanna use, the exact claims you wanna use, and what the responses are gonna be and what your off-ramp is if you lose in that venue to make that choice. There's no one-size-fits-all. I can't say, 'Go to Brazil first because they're super fast,' although, in many instances, I might say that for consumer electronics-related patents 'cause they're super fast, super good, and you'll get your result and have your pressure. And it's less likely that the US court that follows or the German court that follows is gonna say, 'Well, here's what they did in Brazil though,' right?

They just don't do that. And so, that, yeah, there may be circumstances where I'd say that place for sure first if you have the same patent in multiple venues. For the most part, it's gonna be a lot of those factors that you have to think about.

[SAINA SHAMILOV]
Rob, what do you think? Brazil first?

[ROB RODRIGUES]
Call me ass. But I would say, like interestingly, this you see less and less filings in the US, and why is that, right? Like from the previous panels, I understand the patent system in the US is not the best at least for patent owners.

[SAINA SHAMILOV]
Oh, we can argue about that.

[ROB RODRIGUES]
Well, I heard a lot about that before but happy to hear about it. But I would say that starting, My experience is that UPC and Brazil getting the first wave usually because of availability of PIs but also other jurisdictions like China play a role yeah.

[SAINA SHAMILOV]
Philipp, do you agree? Sort of UPC and Brazil, does that make sense to go there first?

[PHILIPP WIDERA]
In general, yes, and but in, it depends on the background. So in some cases, yeah, probably makes sense. For example, if you look at the InterDigital Amazon case, which we heard right after lunch, where eventually, infringement cases were filed, I think before the US District Court, Brazil, the UPC, and Germany more or less all at once. So just to exert as much pressure on Amazon as possible to get a settlement, so this was definitely a strategic reason.

In other circumstances, it might make sense to, like, increase the pressure over time if the patentee thinks, 'Well, maybe one step further will get the implementer to a settlement.' Yeah, it all depends on the strategy. And, but maybe just one comment on on what Ellisen said regarding, you know, what happens if an injunction is later found to be revoked. We've seen that in traditionally in Germany where we have the bifurcated system so we get the injunction after a year or one and a half and the parallel patent court decision deciding on validity maybe after two and a half or three years.

So you have this injunction gap I'm sure most of you have heard about. And yes, there is a theoretical risk that, you know, once maybe the patent court revokes the patent, injunction is revoked, that you have to pay damages.

But in reality, I've never seen cases where that played out because that, in that year and a half or maybe two years, defendants settled usually. So that is also a factor that you have to take in, so how realistic is it that you have to pay damages if a PI or if an injunction is later revoked?

[ELLISEN SHELTON TURNER]

And the defense considerations are also interesting as well. It's a good point because where you go first also dictates what the defendant's gonna do first.

Right, are they going to immediately go to a nulity action? Are they immediately going to go in the US, file an IPR? They're going to look at the venue where they can apply the most pressure on you and disrupt this potential injunction that might be coming their way. It's also gonna dictate whether they go immediately to a design around approach or just go to a fight it or negotiate approach.

[SAINA SHAMILOV]
What are the best tactics for coordination of this sort of cross-border campaign that has the injunctive relief at its core? Do you, as a patentee, want firm that has presence everywhere, is that the better way?

Or do you hire experts separately and then hope that they coordinate and talk to each other and don't take inconsistent positions? What's your view on that?

[ELLISEN SHELTON TURNER]
Yeah, well, so we're big But we're still not so big at Kirkland that we can cover all these venues by ourselves But I would say local expertise is extremely important and the best local expertise you can get, the better. There's very often, when I, when I was a young lawyer, and we were always in Texas, I would be in Marshall, Texas still with six different local counsel because they all had different perspectives and value to add to the way we were gonna litigate in that case, and so I do want in any venue I go to, you have to have local counsel to coordinate with to give you the perspective of not just procedurally, this is what the rules are, but this is what this judge thinks, this thing just happen yesterday that's gonna impact it. This judge is on vacation. You need all of that, but you also need, at the client side, someone who's invested in this process.

It is whether you're on the defense side or the plaintiff's side, the client working with you hand-in-hand. So you understand how this is impacting their business, what decisions that, how the decisions you're making and the timing of them will impact their business, and how you can adjust things in order to put them in the best position possible to have the business outcome being good is important. And the international lawyers will bring a lot of expertise on that too.

They can say, "Well, in this country, if we make this adjustment, then you can have this, you know, kind of silver lining to the bad outcome."

[ROB RODRIGUES]
I feel relieved that Kirkland's not coming for my job.

[ELLISEN SHELTON TURNER]
Not yet.

[ROB RODRIGUES]

Yeah. But I do feel that the local expertise is again very important and it's getting more with the time. So I see a lot of work together, cooperation, and I think that's a key strategy for winning team nowadays.

[SAINA SHAMILOV]
You agree, Philipp?

[PHILIPP WIDERA]
Yes. I mean, it's always good if there's one law firm that has the lead on all of it, who coordinates all the other law firms, but, yeah, in general, it's good to have local, obviously, local counsel everywhere you litigate.

[SAINA SHAMILOV]
Yeah. We've heard a little bit about anti-suit injunctions earlier today. How effective are those for defendants to disrupt a campaign with a injunctive threat? Philipp?

[PHILIPP WIDERA]
Well, so and so because, I mean, at least talking from a UPC, European, or German perspective, our courts are ready to grant anti-anti-suit injunctions against those. So in that regard, I would say the effect is limited and it can even have a quite detrimental effect, particularly in fraud cases where judges have said, "Well, if you filed an anti-suit injunction elsewhere, you are unwilling as an implementer."

So, which means your fraud defense fails. Um, so that is something you have to be very uh, very cautious about when, when, when, when, when filing those, those ASIs, at least in relation to European courts.

[SAINA SHAMILOV]
Yeah. And that makes me wanna ask a question about kinda lessons learned, what you've seen from these kinda large cases, the global matters. What parties did well, what parties, you know, didn't do so well, or the practical considerations that one party missed. Kinda, what have we learned from the campaigns that already took place in the last five years?

[ELLISEN SHELTON TURNER]
A few things. Um, well, one thing I'll say about the anti-suit injunctions, just as patent lawyers, we tend to think we've invented everything.

And the anti-suit injunctions, I mean, that's not a patent law thing. You know, anti-suit injunctions existed in the law, there's U.S. equivalents, right?

There's a motion to stay pending arbitration, is effectively an anti-suit injunction. And so or a customer suit exception, right?

Where you say, "Hey, look, wait a minute. You're suing my customer, and you should've sued me," as an anti-suit injunction.

And in, in Europe, this always existed where you could be contractual or non-contractual, that you, you, you sought an injunction. And so there's lots of-- One of the mistakes that I see often is, we, as patent lawyers, get so focused on the patent regime and the Like here in the U.S., if I have an associate And I say, "Research something," they go straight to Docket Navigator, which is a great tool. And then they go straight to the Federal Circuit cases, and I say, "Well, what about all the other district court cases?

What about the state court cases?" Like, tell me procedurally how we can get the answer we need to get. It's not always in the patent law or the patent procedures, and that goes internationally as well. And that's another reason why you need this great local counsel because they're not just focused on the patent regime, right?

They're gonna know the local laws that can benefit you, and that's-- So that's the number one mistake, is not just thinking more broadly. The other is, I think, the same thing I said before is just jumping the gun and thinking because injunctions and preliminary injunctions and ex parte injunctions are available, immediately go there because you can, and you have a patent in that venue. It needs to be much more thoughtful about that, looking at your whole portfolio, the timing, and where your off-ramps are if you lose.

[SAINA SHAMILOV]
Philipp, what lessons do you think we should learn from campaigns we've already seen?

[PHILIPP WIDERA]
Well, one thing's definitely w-- what Ellisen said, so thinking outside the box. So I think the UK invented the, sort of invented the interim license, which was, which was when it came up, a pretty, pretty disruptive tool where at least at first, the German and UPC courts didn't know how to deal with them.

And on the other hand, of course, you have the B-SIH Electrolux decision in for Europe, so you can now uh get cross-border injunctions, and even we've heard about the BMW case this morning, where a U.S. patent is, is litigated before, before the Munich Regional Court. Don't know how that plays out, and there are a lot of questions that have to be answered, how they deal with eBay and so forth.

But I think being creative and thinking outside the box is definitely one thing that you should always keep in mind. And yeah, that's and Yeah. And, and as Eileen said, don't, don't jump the gun. Really think through the your strategy and then decide how and where to best litigate.

[ROB RODRIGUES]
Yeah, I believe everyone is always trying to find a balance. And as representing a lot of patent owners, it's hard like to really identify something we, something better than filing for a PI and

getting a good result. Because it's the same time you see a lot of again, the delaying tactics played by implementers and finding the balance as to still like in the best interest of everyone.

So cooperation and that.

[SAINA SHAMILOV]
For standard essential patents, is injunctive relief incompatible with those? Or can you still devise a campaign with a threat of an injunctive relief with the standard essential patents being asserted?

[PHILIPP WIDERA]
Oh, can I go first?

[SAINA SHAMILOV]
Yeah, please.

[PHILIPP WIDERA]
Yes.

(laughs)

[ROB RODRIGUES]
Faster than I, yeah.

(laughter)

[SAINA SHAMILOV]
Do you want to elaborate? I Tell us a little more about it?

[PHILIPP WIDERA]
Oh, well, as I said from the beginning, patents are property rights, and courts have time and time again stressed that SEP patents are patents and should, in principle, not be dealt with in any other way. So even though implementers have always argued, "Well, there's an NPE, and why do they need injunctive relief?" I have done that but to be honest, to no avail.

And so injunctions are granted. Unless you can win on the front defense, which is quite difficult, as we heard on the panel after lunch. So yeah. As I said in the beginning, you have in Europe, in principle, injunctive relief with SEPs.

[ROB RODRIGUES]
Yeah, if you can claim non-essentiality as a defense, you have to abide by the possibility of having a PI against yourself.

[SAINA SHAMILOV]

Ellisen, do you think for a patent owner who has or owns standard essential patents that they should have non-standard essential patents as well in the portfolio to kind of broaden the net of injunctive relief for themselves?

[ELLISEN SHELTON TURNER]
Certainly, I think so in advising investors and people who are looking at the strength in value of portfolios that having, if you're, if you have SEPs, that's wonderful, great thing to have. Having non-SEPs is important. How you license those two things is also very important for just as an example, if you have a history of licensing your SEPs and non-SEPs together, then that can impact your ability to differentiate them later on when you're, for example, faced with an antitussive injunction, "Oh, well, these patents are not, these non-SEPs are not part of that sort of SEP portfolio that was, that's over there."

But if you've licensed them together, they can be taken up in that sort of, "Hey, I'm going to set the rates for all of this together because, and you're not gonna stop me before court from doing that." Because this has historically been the way that these package of patents have been licensed together. But it absolutely adds value to your ability to negotiate different rates to have sort of, again, different strokes for different folks in terms of your licensing paradigm.

[SAINA SHAMILOV]
Well, let's talk a little bit about building the portfolio. Because getting these injunctions, you can only do that if you have the portfolio that you can actually use. So getting patents is expensive through the patent office, buying them is expensive. Now, what do you guys think?

Do you need to get patents in all the possible jurisdictions that later you may want to enforce? Or is there a handful of jurisdictions you really should focus on? Because, let's say, of the injunction rules and how easy it is to get, kind of what are the view on overall portfolio building, and where you wanna go?

[ELLISEN SHELTON TURNER]
Who wants to start? You want me to start?

[SAINA SHAMILOV]
Sure.

[ELLISEN SHELTON TURNER]
I talk too much. So obviously, again, you know, most of us here are representing well-heeled inventors for the most part.

At least when they're coming to us, they're either funded or well-heeled, but that's not always the case. Obviously, with unlimited resources, you're gonna go in every country that has a worthwhile enforcement regime. You're going to get patents there, at least if you think that you're going to have revenue there or supply of competing products is going to come from there, then that's where you're gonna go.

But you really have to triage and think about what are the most important markets for this particular company now and in the future, and focus there. And, you know, this is really the debate we've all been having all day is, you know, how predictable is that venue?

Just because they have one legal regime and approach today, are they gonna have it tomorrow? And so you have to sort of take into account all of these factors. I think all the if you follow the crowd and follow the money, it still makes sense to, of course, file in the US.

People are not gonna not file in the US if they have important intellectual property. and I think given the way that the UPC is shaping up, and the way that the laws in Germany and the UK are relatively predictable, of course, you're going to be in Europe as well because those are important markets.

South America is becoming an increasingly, increasingly important market, and one that cannot be ignored in your consideration. One that people ignore right here is Canada. I don't understand why no one files, it's like it's right there, they give injunction. Like, why aren't you filing some patents in Canada?

It's not a huge market, but it's not nothing. And so but you have to think about the most important markets to your company's current and future business.

And that's easier said than done when you're a larger entity that's funded.

[SAINA SHAMILOV]
Philipp and Rob, any additional thoughts on this, kind of overall portfolio building and where to go?

[PHILIPP WIDERA]
Yeah, I've two answers to that. The first is kind of provocative because regardless of where you have your patents, can all litigate them in Europe now.

(laughs)

And get an injunction. The second one may be more differentiated, is that, of course, you have to look at your own market. You have to look at, where does it, I think I was in touch on it, like, where does it make sense to litigate? Like, we have an efficient, fair, impartial court system.

How much is cost of litigation, chances of winning, predictability, and so forth? So these factors all, you have to obviously have to consider when deciding where to get your patents.

I think there was a, a recent case where an, an NPE file, no, I think it was Ericsson filed that case in Nigeria. So there was quite a surprise. I don't know how that turns out.

Maybe it turns out that, that the Nigerian courts are efficient, predictable, and good on quality. But yeah, let's see about that.

[ROB RODRIGUES]
Yeah. And I believe not just patent rights, but everything. Like, any trademark design rights and anything you can have as a portfolio in general can be useful and.

[SAINA SHAMILOV]
For the non-practicing entity, are there different strategic considerations there? Do you just buy patents that are sort of Europe and Brazil-focused? Or do you still want as a non-practicing entity, to have a broader portfolio?

[ROB RODRIGUES]
If you are an NPE, and you find patents in Brazil, should definitely buy them and use them.

[PHILIPP WIDERA]
Yep. Obviously, same for Europe, but.

[ELLISEN SHELTON TURNER]
Yeah, Rob, how is the backlog, by the way? I mean, it used to be like, that was one of the issues, was, you bought the patents because who knows when you're gonna get more? How is it these days in terms of the ability to get patents within a reasonable amount of time in Brazil?

[ROB RODRIGUES]
Sorry.

[ELLISEN SHELTON TURNER]
Just how easy is the backlog in Brazil--

[ROB RODRIGUES]
Oh, right, okay.

[ELLISEN SHELTON TURNER]
I mean, to get patents quickly?

[ROB RODRIGUES]
Not as a quick as a injunction. It takes a little bit of time. It's usually the tendency, it's like five years right now. But yeah. It's a set about.

[SAINA SHAMILOV]
So, Rob, you said that in your kind of from your research and what you see less companies file more overseas than in the U.S. Now, from the portfolio building kind of point of view, do you think the company should be then skewing more to have foreign, more foreign assets than, let's say, U.S. assets?

What do you think about that?

[ROB RODRIGUES]
I also think, like, you should have a lot of U.S. assets. But yeah, I guess if you have the budget, have more Brazilian assets for sure as a portfolio building. Yes.

[SAINA SHAMILOV]
Any other different views from Ellisen and Philipp about sort of skewing more towards foreign assets than US assets now that you can get easier injunctions than those other jurisdictions?

[PHILIPP WIDERA]
Well, I think as I said before, it depends on what your company is, where your markets are, and where yeah, where you're gonna sell your products eventually. So if, if you don't sell product in, in Germany, well, obviously, arguably, you don't need a patent there. And that's what I think.

[ELLISEN SHELTON TURNER]
Yeah. I mean, it also depends on the life cycle of your company. If you're not a public company, you're funded by private equity, you're looking for an exit in five years, gonna have different decision-making about what's the value of these patents and how I'm gonna use them, am I gonna use them, how are they gonna bring accomplish my goals than if you're a company who's in it for the long haul who's already public, already funded. And IP protecting the mode is the most important category as opposed to other sources of revenue.

[SAINA SHAMILOV]
There are some if we've talked about the Philippine bench in Nigeria. I think Ericsson went as far as Colombia, in for their campaign against Lenovo. And I think Colombia, if I'm not wrong, Rob, also you can get very fast preliminary injunctions. So are there favorable from injunctive perspective favorable jurisdictions or countries where historically folks have not been getting patent assets and now they should be reconsidering?

[ROB RODRIGUES]
Yeah. I don't see at least on the Colombia side, a lot of patents being granted there. So yeah. A jurisdiction maybe to pay attention.

[PHILIPP WIDERA]
Yeah. Yeah, in recent years, seen a lot of litigation in India. where you can get injunctions. China, of course. Japan is an important market. So I think these are maybe Korea, I'm not sure about but yeah. There's countries are definitely worth considering.

[SAINA SHAMILOV]
How about claim scope in a portfolio, right? Do you want to have sort of similar claim scope across all these jurisdictions or does it make sense to focus on one aspect, maybe on the supply chain in one part of the world, maybe on the end result of end product in the other part of

the world and kinda have this diversity of claim scope depending on where you are, where you sort of you're getting your asset in which geography? What do you guys think about that from the portfolio building aspect?

[ROB RODRIGUES]
I think you can get a lot of something broader, I think it's always better than narrow.

[PHILIPP WIDERA]
And in general, I agree. Of course, the broader, the better. And on the other hand, I would not, at least on top of my head, I would not consider, like, doing, like, some claims, like, sort of more on the manufacturing type of claims in one jurisdiction and end product claims on, in another jurisdiction because at the end of the day, you never know where your competitors manufacture, right?

I mean-- it could be that it's China, but it, it could also be, be somewhere else. So you rather wanna have broad claims as much as possible.

[SAINA SHAMILOV]
For the valuation of the patents and the assets in your portfolio, have you guys seen sort of patents valued greater or given greater value in transactions because of the injunctive threat they pose? Talk about that, Ellison.

[ELLISEN SHELTON TURNER]
Yeah. Absolutely. You know, the biggest issue with the intellectual property enforcement is predictability. And if you have predictably enforceable patents, then they have higher value. That's the way it works.

And so certainly when we are diligencing a portfolio or valuing a portfolio, if we can see that there are patents in a jurisdiction that will provide you with a competitive advantage or a monetization advantage, then it increases the value.

[SAINA SHAMILOV]
Mm-hmm. We've-- I don't think we're gonna see changes in the near future, maybe on the injunctive relief in the U.S. But Rob, in Brazil, being that it's so fast to get injunctive relief, and I know some of the, let's say, the streaming companies are now very actively involved in trying to maybe change that, what's, uh-- What are we looking at? Is there gonna be change?

Is there already a change in terms of how the judges are looking at these preliminary injunction requests and analyzing them?

[ROB RODRIGUES]
Yeah. For sure, there's some concern raised by some judges. Couple of weeks ago, one of the judges mentioned that he is going to take a look on the comparable license before issuing a decision. So, he will start to order plaintiffs to file, submit licensing agreements.

But still those judge understand that the matter in front of them is important to decide and that PI is key, right? So, that's the balance being tried, but PI is still there.

[SAINA SHAMILOV]
Philipp, what about the UPC Court? Is it there to stick around or what's gonna happen?

[PHILIPP WIDERA]
The UPC or injunctions?

[SAINA SHAMILOV]
Injunctions.

[PHILIPP WIDERA]
Yes, I would think so. So, when I just look back couple years ago, so before the UPC was there, there was a lot of talk about pressure from the holy car manufacturers in Germany advocating for a proportionality defense that deserves its name. And eventually, even Volkswagen, BMW, Mercedes, they all fail to implement that.

What we got was a very, very, very weak proportionality defense that doesn't deserve its name. So, yes, I would very much assume that injunctions are there to stay.

[SAINA SHAMILOV]
Well, thank you so much for your expertise. Really appreciate it. Thank you for your attention.

[ROB RODRIGUES]
Thank you.

(audience clapping)

Injunctive Relief

A Global Perspective for Those Enforcing Patents and Building Patent Portfolios

26th Annual Berkeley-Stanford Advanced Patent Law Institute at UC Berkeley Law

Saina Shamilov

Partner, Fenwick

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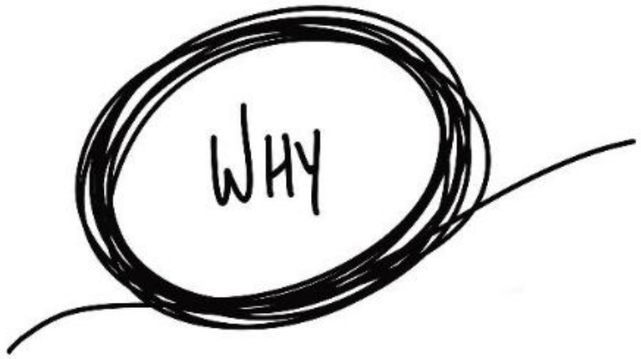
Rob Rodrigues

Partner, RNA Law

Rise of Global Injunctions

- ***IPCom v. Lenovo***
  - US, UK, and France
- ***Unwired Planet v. Huawei***
  - UK, Germany and China
- ***Nokia v. Amazon***
  - US (District Court and ITC), Germany, UK, India, Brazil, and EU UPC
- ***Ericsson v. Lenovo***
  - US (District Court and ITC), UK, Brazil, Colombia, UPC
- ***ZTE v Samsung***
  - US (District Court), UPC, Germany, UK, China, Brazil and ETSI
- ***Interdigital v Amazon***
  - US (District Court), UPC, Germany, UK, and Brazil
- ***Newron v Puren Pharma***
  - Germany and Netherlands



US District Court	ITC	Europe UPC	Germany	UK
eBay four factor sets a high bar; takes time	Exclusion Orders – faster than District Court but must meet requirements to seek	Automatic injunctions both permanent and preliminary and fast	Automatic injunctions both permanent and preliminary and fast	Injunctions are discretionary, but commonly ordered

France	China	Brazil	Colombia	India
Injunctions are a default remedy but UPC has changed the landscape	Injunctions are a default remedy	Default permanent and preliminary injunctions and fast	Preliminary and final injunctions are default remedies	Injunctions are a common remedy

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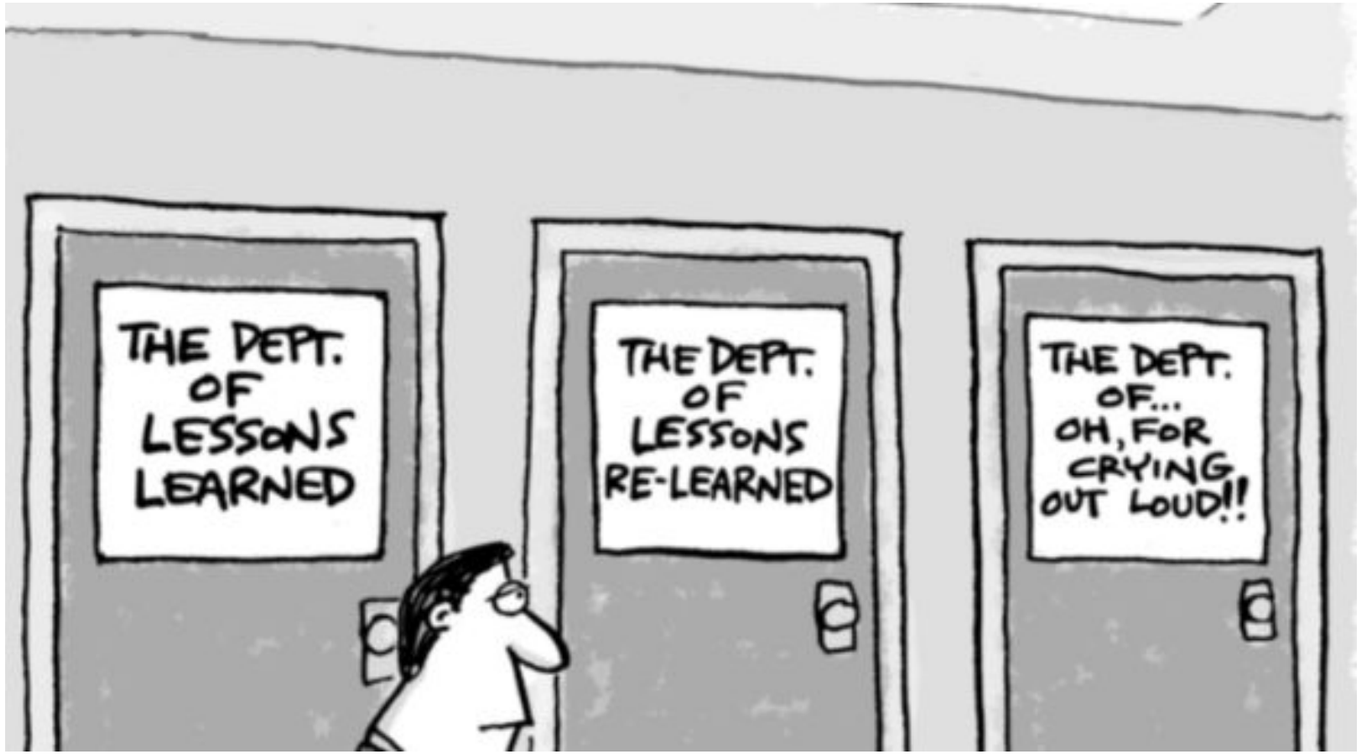
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