

Interlocutory Appeal # 0021723-02.2025.8.19.0000

Appellant: SAMSUNG ELETRÔNICA DA AMAZÔNIA LTDA

Appellee: ZTE CORPORATION

Reporting Appellate Judge: Hon. Justice Adolpho Andrade Mello

CORPORATE AND CIVIL PROCEDURAL LAW. INTERLOCUTORY APPEAL. INDUSTRIAL PROPERTY. PATENT INFRINGEMENT. 5G TECHNOLOGY. INJUNCTIVE RELIEF. ESSENTIAL PATENT (SEP). PROBABILITY OF RIGHT. DANGER OF DAMAGE. INADEQUACY OF SECURITY AS A SUBSTITUTE FOR SPECIFIC INJUNCTION. ABSENCE OF REVERSE DAMAGE. REDUCTION OF PENALTY. APPEAL PARTIALLY GRANTED.

I. CASE UNDER REVIEW

1. Interlocutory appeal filed by Samsung Eletrônica da Amazônia Ltda. against the decision handed down by the 5th Business Court of the Capital District, which, in an injunction filed by ZTE Corporation, granted urgent relief to determine that the defendant refrain from infringing patent BR112015017291-1, relating to a digital modulation method applicable to 5G technology, under penalty of a daily fine.

II. ISSUE UNDER DISCUSSION

- (i) There are four issues under discussion: determine whether the requirements for granting preliminary injunction relief in cases of alleged patent infringement are met;
- (ii) determine whether the technical controversy surrounding the use of patented technology prevents the granting of relief in summary proceedings;
- (iii) determine whether the provision of security by the alleged infringer can replace the specific injunction; and
- (iv) verify the existence of danger of reverse damage to the Appellant.

III. REASONS FOR THE DECISION

3. The ownership of the patent by the appellee and the evidence contained in the case file, although controversial, demonstrate the likelihood of the right in summary proceedings, with the doubt being interpreted in favor of the holder of the exclusive right.

4. The allegation of technical complexity and the need for extensive evidentiary delay does not prevent the granting of injunctive relief, provided that there is reasonable evidence of infringement and risk of damage, pursuant to Article 300 of the Code of Civil Procedure and Article 209, paragraph 1, of the BR IP Statute.

5. Unauthorized exploitation of a patent causes damage that is difficult to repair, especially when the owner's business model is based on technology licensing, compromising revenues, fair competition, and incentives for innovation.

6. Injunctions are preventive in nature and cannot be replaced by a bond or a guarantee a surety bond, under penalty of

emptying of the right of exclusivity guaranteed to the patent holder and of the *ius prohibendi* that is part of the protective system.

7. The absence of unjustified refusal to license under FRAND conditions dismisses the allegation of abuse by the holder of a patent essential to the technological standard.

8. There is no danger of reverse damage, especially in view of the Appellant's own statement that it does not use the patented technology, and there is no concrete damage resulting from the order of abstention.

9. The amount of the punitive fine must comply with the principles of reasonableness and proportionality, and its reduction is appropriate to ensure effectiveness without excess.

IV. DECISION AND THESIS

5. Appeal partially granted.

Judgment thesis:

1. Injunctive relief in patent matters may be granted preliminarily when there is sufficient evidence of infringement and risk of damage, even if the controversy involves high technical complexity.

2. The provision of security does not replace specific relief intended to prevent the infringement of industrial property rights.

3. The declaration of the essentiality of a patent to the technological standard does not remove the holder's right of exclusivity or prevent the granting of injunctive relief, as there is no abusive refusal to license.

4. There is no reverse damage when the court order only imposes abstention from using technology that the party itself claims not to use.

Relevant provisions cited: Federal Constitution, article 5, XXIX; Code of Civil Procedure, articles 300, 497, sole paragraph, 932, III; BR IP Statute, articles 42 and 209, §1.

This is an interlocutory appeal filed by Samsung against the decision that granted the preliminary injunction ordering the defendant to refrain from infringing ZTE's patent BR112015017291-1, under penalty of a daily fine, handed down by the 5th Business Court of the Capital District, in the original lawsuit # 0804050-57.2025.8.19.0001.

The appealed decision is transcribed below:

"This is a lawsuit filed by ZTE Corporation against Samsung claiming the infringement of its BR112015017291-1 patent by producing, using, offering for sale, commercializing and importing, without its consent, cellular devices (such as smartphones and tablets) that implement the invention claimed by said patent.

It also states that if the defendant is allowed to continue infringing its patent, all its competitors will be discouraged from maintaining their licenses. Thus, according to the plaintiff, failure to prosecute the infringement puts its entire patent licensing business at risk, which is its biggest source of revenue, characterizing a risk of irreparable harm.

Based on article 5, XXIX of the Federal Constitution; articles 41, 42, 44, 183 to 186 and 207 to 210 of the IP Statute; articles 300 to 319 et seq. of the Code of Civil Procedure, and articles 186 and 92 of the Civil Code, the plaintiff requests the granting of a preliminary injunction to prevent the defendant from continuing to infringe patent BR112015017291-1 by using the patented technology in its products.

The defendant already filed a brief at id 16727785, stating, in summary, that the plaintiff uses a shallow thesis without any technical basis, that ZTE presumes the infringement of the BR291 patent held by it due to the fact that it would have self-declared its technology as essential to the 5G technological standard.

It adds that the 5G standard has more than 60,000 (sixty thousand) patents declared as essential. Among these, Samsung is a licensee of thousands of patents from third-party companies, because it recognizes that it makes effective use of them in its devices - but the BR291 patent is definitely not one of the technologies used by Samsung.

Therefore, it reiterates that defendant Samsung believes that it does not use patent BR291. 8. This means that ZTE's request is vertically incompatible with the provisions of article 300 of the Code of Civil Procedure. This is because, (i) the investigation into the use (or not) of the BR291 patent is technically complex and will require in-depth production of expert evidence; (ii) self-declared essential patents do not support injunctions regarding the use of the technology, of compulsory licensing, in FRAND terms 4 ; and (iii) ZTE's injunction request will cause manifest reverse risk of irreparable harm to Samsung, in line with precedents of this Court.

Thus, considering the exegesis of the legal provisions and the restricted scope of their application - for cases of LOW technical complexity - there is no way to carry out simplified expert evidence in this lawsuit, and it should be awaited for the issuance of a case management decision for a broad and robust production of expert evidence, so that the rights of both parties can be ensured in the proper manner

Therefore, it requests the rejection of the injunction requested and, in the alternative, Samsung offers to provide bond, by means of guarantee insurance to be issued by a first-rate financial institution, in the amount of BRL 10,000,000.00 (ten million reais).

This is the report. I will decide:

The complaint was accompanied by evidence of the use of the patented technology in products operating on 5G cellular network. This evidence includes: a patent letter issued by the BRPTO proving that ZTE is the holder of patent BR112015017291-1, which is valid until 2033, technical opinions from the Federal University of Rio de Janeiro (UFRJ) and the Université de Toulouse confirming that the use of 5G network requires the implementation of the patented technology, as well as tests carried out by the TIM Labs laboratory proving the use of the technology patented by BR112015017291-1 in a Samsung product.

It should be clarified that, even if the documents and technical opinions attached to the dockets have not been submitted to Samsung to manifest itself, I can see that they demonstrate the likelihood of the plaintiff's rights. The evidence of infringement is further corroborated by the existence of a previous license between the parties and negotiations to obtain a new license.

Both the specific injunction of the IP Statute (article 209 §1º) and the preliminary injunction provided for in article 300 of the Code of Civil Procedure are only authorized when there is evidence of the likelihood of the right, the risk of irreparable harm and to the useful outcome of the process as long as the effects of the decision are reversible.

Based on summary cognition, supported by the plaintiff's narrative and the various pieces of the evidence attached by the plaintiff, the legal requirements are deemed to have been met.

In fact, the Federal Constitution, in item XXIX of article 5, and the IP Statute, in its article 42, assure the patent holder the right to prevent third parties, without their

consent, from producing, using, offering for sale, commercializing or importing a process or product obtained directly by a patented process.

A patent is used to protect an invention or creation from competitors and through it, inventors reserve the right to commercially exploit their intellectual property, protecting it from possible copying. The purpose of legal patent protection is to prevent unfair competition, avoiding the possibility of misuse and profiteering from the efforts of others.

This Court has abundant case law for injunctions to stop the infringement of patented technologies.

"INTERLOCUTOY APPEAL. PATENT INFRINGEMENT LAWSUIT. PRELIMINARY INJUNCTION. [...] 2. As for the substantive argument, the appellant seeks the revocation of the decision that granted the preliminary injunction, consisting of the determination that the defendants refrain from infringing the indicated patent and from implementing the described technology, as well as presenting the court official accounting documents on a monthly basis, official accounting documents detailing current information on all imported devices sold and sold in Brazil, both current and future models, which use the aforementioned standard, as well as a sales projection for the next six months, so as to enable compliance with the injunction. [...] 6. In this scenario, the likelihood of the right alleged by the appellee regarding the alleged patent infringement is deemed to exist. 7. Furthermore, there is undeniable urgency, given that (i) the patent-in-suit has a certain and defined expiry date; (ii) it is inserted in the field of telecommunications, whose characteristic the quick and constant evolution. [...] 10. In view of this, it can be concluded that the trial decision is not teratological, against to the law or to the clear evidence in the case file, and should be upheld, under the terms of Precedent 59 of this Rio de Janeiro State Court" (Interlocutory Appeal # 0012886-26.2023.8.19.0000, Reporting Appellate Judge Fernando Cerqueira Chagas, 20th Chamber of Private Law, 6/29/2023).

"INTERLOCUTORY APPEAL. LAWSUIT. ALLEGATION OF PATENT INFRINGEMENT IN CELL PHONES COMMERCIALIZED BY THE DEFENDANT, NOW THE APPELLANT. THE REQUIREMENTS FOR THE GRATING OF THE PRELIMINARY INJUNCTION ARE PRESENT. PRECEDENTS OF THIS COURT. 1) The appellee is the holder of patent BR112012019729-0, granted by the BRPTO with validity until 17/12/2030; [...] 3) Significant evidence of the unauthorized use of the patent by the appellant, which can be seen from the three technical opinions (Unicamp, PUC-Rio and UFRJ) attached, as well as of the filing of an invalidity lawsuit claiming that this lawsuit must be stayed until the other is ruled, indicating the aim of legitimizing the use, dismissing the appellee's claim. 4) The appellant's argument that it is not using the patent in question, also attaching technical opinions to this effect, which rule out the potential of the appealed decision to harm its commercial activity, and that it is enough for it not to use it in order to not have to proceed with the payment of the fine; 5) Evidence sought, especially expert evidence which would not be able to demonstrate any damage caused by the appealed decision; 6) The stay of the decision would undoubtedly cause damage to the appellee, which would be powerless to watch the irregular use of its patent, with the appellant practicing a truly lucrative illicit act; 7) Damage that is not only shown in the context of the collection of royalties, making it possible to make timely compensation. The owner of the patent is entitled to seek the immediate protection if the requirements for a preliminary injunction are present, as is the case here; 8) There is no proof of the appellee's refusal to negotiate the acquisition of the patent license. Rejection of the appeal" (Interlocutory appeal # 0031565-11.2022.8.19.0000, 22nd Civil Chamber, Reporting Appellate Judge Maria da Gloria Oliveira Bandeira de Mello, 9/13/2022).

Likewise, when analyzing the request for an injunction to stop the infringement of technology patents related to 5G cell phone networks, this Court held that:

"In view of what is stated in the aforementioned provision, a preliminary injunction should be granted whenever there is a possibility of a violation of intellectual property rights, with a fine being a suitable and legitimate instrument to prevent infringement, and the claim by the appellants that the adoption of a bond or fiduciary guarantee should serve as a substitute for the fine is unfounded, not least because the latter is indicated in the legal system as a safeguard to be provided by the beneficiary of the preliminary injunction and not the other way around. The scope defined in the Law was to protect the legal asset under protection, which is intellectual property, in an effective preventive action, so that in the case of an obligation not to do something, consisting of refraining from using the patented technology, the coercive means must be sufficiently rigid to force compliance with the precept, and the fine is the appropriate instrument for this purpose. [...] In view of the above, I vote that the internal appeal should be DISMISSED and rendered MOOT, under the terms of article 932, III, of the Code of Civil Procedure, and that the interlocutory appeal should BE HEARD, and, on the merits, it should BE REJECTED, maintaining the appealed decision that determined the stay of the proceedings." (Interlocutory Appeal # 0101529-57.2023.8.19.0000, Appellate Judge André Luiz Cidra, 20th Chamber of Private Law, 08/08/2024).

*From all this, it can be seen that there is a strong indication that the defendant is infringing the plaintiff's patent, evidencing the existence of *fumus boni iuris*.*

*As for the *periculum in mora*, the plaintiff is right when it claims that the violation of its industrial property causes risk of irreparable harm, since the continuity of its business activity depends on the revenue obtained from licenses to use its technology, and it is certain that if these technologies can be used independently of a license, its source of revenue would be exhausted, imposing a risk to its own subsistence.*

The impact of allowing the use of technology without authorization should not be overlooked. After all, customers who pay to use the technology will suffer from unfair competition from those who have lower costs to operate in the market. On the other hand, the inventor who earns income from licensing patented inventions suffers truly irreparable damage through the depreciation of his assets if they are exploited without a license. Patent infringement causes an imbalance and distortion in the market, which can and should be remedied by curbing the infringement.

It should not be forgotten that this lawsuit combines a preliminary injunction and a reparation requests, but the two are not to be confused. A preliminary injunction is aimed at the future, precisely to prevent the damage caused from worsening and, more than that, to stop the illegal act. The reparation, on the other hand, relates to acts that have already taken place, which, because they cannot be resolved through specific protection, are converted, due to this exceptional and unavoidable circumstance, into damages.

Finally, there is no need to talk about the reverse risk of irreparable harm to the defendant, since the measure sought by the plaintiff is limited to disabling a specific non-mandatory technology in Samsung's mobile devices. There is no need to confuse the fact that the patent is always used in the operation of a particular technology with the need to implement the technology itself. Thus, none of its devices will stop working or be prevented from being commercialized but only stop implementing the patented method.

Furthermore, it is important to note that the defendant itself denies that it is infringing the patent held by the plaintiff, as follows: "...but the BR291 patent is definitely not one of the technologies used by Samsung" (item 6, in fine).

Now, if the Defendant itself states that it does not infringe patent BR112015017291-1 by using the patented technology, the granting of the measure will not cause it any harm, nor should the allegation of reverse damage with the granting of the injunction be accepted.

It should be emphasized once again that the measure does not make it impossible to commercialize the specific and identified products but merely orders the company to refrain from using the technology that infringes patent BR112015017291-1, which, as stated above, is not even harmful since the defendant denies using it.

It should also be noted that the Superior Court of Justice has already held, precisely in cases such as the present one, that injunctions aimed at preventing the use of specific technology do not, a priori, cause damage to the defendant, to the extent that nothing would prevent the technology from being implemented again in the event that the claim was dismissed:

"There is no question that, on the other hand, the analysis of the preliminary injunction must take into account the risk of irreparable harm to both parties, especially with regard to the irreversibility of the measure (article 300, §§ 1 and 3 of the Code of Civil Procedure). However, in the case under examination, it is not clear, at least from the factual analysis made by the trial courts, that the cessation of the use of the patented technology would lead to the complete impossibility that, in the event of the proposed lawsuit being dismissed, it would be used again." (Special Appeal # 2074392/RJ, Reporting Justice Ricardo Villas Bôas Cueva, 3rd Panel, 11/16/2023)

The behavior of a party who, after the end of a technology licensing contract, decides not to renew it, at the same time, continues to exploit the inventions of others, cannot be ignored. Even if negotiations are underway, no one is allowed to use third-party property until the terms for its licensing have been arranged.

The patented technology can only be used by the defendant through authorization, which, in view of the plaintiff's narrative, does not exist.

However, regarding the claim that there is no way to carry out simplified technical expert evidence in this case, and that the issuance of a case management decision should be waited for a broad and robust production of expert evidence, so that the rights of both parties can be properly guaranteed, the defendant is right. The complexity of the matter is undeniable and the expert evidence, if granted, should be carried out in a broad and comprehensive manner.

Despite the alternative request for the provision of a bond, following the case law of our Rio de Janeiro State Court, it cannot be accepted, since "there is no counter-right of the defendant to oppose the preliminary injunction by offering a bond - or to request its replacement, in substance, would mean precisely the undue attempt to neutralize the right to seek preliminary injunction, recognized by the trial court". Furthermore, there is no certainty that the bond offered is sufficient in the specific case, so to allow the use of the technology without due consideration would cause harm to the plaintiff.

By way of illustration, I bring you a ruling from our Court dealing with the matter under discussion:

Interlocutory appeal # 0101529-57.2023.8.19.0000 INTERLOCUTORY APPEAL AND INTERNAL APPEAL. PATENT INFRINGEMENT. PROHIBITION OF USE. POSSIBILITY. LIKELIHOOD OF THE RIGHT INSERTED IN THE CONTEXT OF THE SOUNDNESS OF THE PATENT AND THE RIGHT THAT RESULTS FROM INTELLECTUAL PROPERTY, OF WHICH NO OPPOSITION HAS BEEN REPORTED, AND WHICH THEREFORE ENJOYS A PRESUMPTION OF LEGALITY AND VALIDITY. SUBJECTIVE RIGHT OF THE PATENT HOLDER TO PREVENT THIRD PARTIES, WITHOUT HIS CONSENT, FROM USING THE PATENTED PRODUCT. INTELLIGENCE OF ARTICLE 42 OF IP STATUTE. PRELIMINARY INJUNCTION AUTHORIZED BY ARTICLE 209, § 1 OF THE SAME LAW. INJUNCTION THAT MUST BE GRANTED WHENEVER THERE IS A POSSIBILITY OF A VIOLATION OF INTELLECTUAL PROPERTY RIGHTS, WITH A FINE BEING A SUITABLE AND LEGITIMATE INSTRUMENT TO PREVENT INFRINGEMENT, AND THE CLAIM BY THE APPELLANTS THAT THE ADOPTION OF A BOND OR FIDUCIARY GUARANTEE SHOULD SERVE AS A SUBSTITUTE FOR THE FINE IS

UNFOUNDED, NOT LEAST BECAUSE THE LATTER IS INDICATED IN THE LEGAL SYSTEM AS A SAFEGUARD TO BE PROVIDED BY THE BENEFICIARY OF THE PRELIMINARY INJUNCTION AND NOT THE OTHER WAY AROUND. SYSTEM OF STANDARDIZATION OF DECISIONS WHICH IDENTIFIES THE PREVIOUS DECISION AS CASE LAW TO BE FOLLOWED, ENSURING THAT THE JUDICIAL PARAMETERS PROVIDE THE NECESSARY ISONOMY AND LEGAL CERTAINTY, ESPECIALLY WHEN THEY COME FROM THE SAME FRACTIONAL BODY, AND THERE IS A SIMILAR POSITION IN THIS 20TH CHAMBER OF PRIVATE LAW REGARDING THE PROTECTION THAT MUST BE GIVEN TO THE HOLDER OF INTELLECTUAL PROPERTY RIGHTS AND THE POSSIBILITY OF USING PRELIMINARY INJUNCTION FOR THIS PURPOSE. IT ALSO SHOULD BE HIGHLIGHTED THE UNDERSTANDING THAT THE RETURN EFFECT OF AN INTERLOCUTORY APPEAL MUST NOT GO BEYOND THE LIMITS OF THE APPEALED DECISION, SO THAT IN ADHERENCE TO THE DISPOSITIVE PRINCIPLE, THE FRACTIONAL APPELLATE BODY MUST LIMIT ITSELF TO THE DEPTH OF THE MAIN EFFECT, WITHIN THE FRAMEWORK OF THE PRELIMINARY INJUNCTION ISSUED BY THE TRIAL JUDGE, WITHOUT OVERRULING, ELONGATING OR EXPANDING BEYOND THE FRAMEWORK OF THE APPEAL. THE AUTHORIZING PRESUPPOSITIONS ARE PRESENT, THERE IS NO WAY TO RECOGNIZE ANY ILLEGALITY OR TERATOLOGY IN THE DECISION IMPUGNED WHICH, FOUNDED ON PREMISES WELL DELINEATED, RECOGNIZED THE EXISTENCE OF THE PRECONDITIONS FOR GRANTING THE PRELIMINARY INJUNCTION. INTERLOCUTORY APPEAL REJECTED. (Reporting appellate judge: ANDRÉ LUIZ CIDRA - ELEVENTH CIVIL CHAMBER).

Therefore, I GRANT the preliminary injunction to order the defendant, under a penalty of a daily fine of BRL 50,000.00 (fifty thousand reais), to refrain from infringing ZTE's BR112015017291-1 patent, within 5 days of being summoned, by means of any of the acts indicated in article 42 of the IP Statute.

In view of the defendant's spontaneous appearance, I consider that Samsung has already been served with the lawsuit, in accordance with article 239, paragraph 1 of the Code of Civil Procedure, and must present its answer to the complaint in accordance with article 335, III of the Code of Civil Procedure, and the deadline for which will be triggered once the defendant is summoned of this decision.

Summons the parties." (ID 167505741)

Motion for clarification filed by the defendant SAMSUNG, which was accepted to "grant the extension of the defense period requested by the defendant to 60 consecutive days" in the decision posted in electronic index 168658341.

The defendant SAMSUNG, now the appellant, argues in its appeal that the plaintiff requested the suspension of the infringement of patent BR112015017291-1 and the acts that give rise to it (use of 5G technology) based on a superficial thesis and without any technical basis, which was accepted in a teratological decision contrary to the evidence in the case file. It alleges that the reports submitted by the appellant are useless to prove the alleged infringement, as they were produced unilaterally and are apocryphal. Furthermore, it argues that it does not use the technology of Patent BR 291 and that it is not essential to the 5G standard, but that the decision, by granting the injunction stating that the patent is mandatory for the use of the technology, causes serious damage to the Appellant because it prevents it from using the 5G standard in its cell phones.

It claims that the decision should be overturned because: **a)** the original lawsuit involves highly controversial and complex technical issues, which would require extensive evidentiary proceedings; **b)** although ZTE's claim is exclusively financial, the damages to be borne by SAMSUNG are immeasurable, since the injunction, as granted, has a very broad scope, the practical repercussion of which is to prevent the use of 5G technology in its mobile devices, which would result in millions of dollars in monthly damages to the appellant; **c)** there is no damage to the appellee with the revocation of the injunction, since the claim is exclusively

financial in nature and the appellant is a large company fully capable of paying ZTE the fair compensation that may be due to it; and **d**) SAMSUNG, in good faith, offers, in a subsidiary manner, a suitable and sufficient bond of BRL 10,000,000.00 (ten million reais), which would eliminate any risk of damage to the appellee. It requests the granting of staying effect and, ultimately, the granting of the appeal.

Decision of electronic index 54, which partially granted the staying effect "*to suspend the effectiveness of the appealed decision, provisionally replacing it with the provision of security by the appellant in the amount of BRL 10,000,000.00 (ten million reais), to be provided within 30 (thirty) days in the original case file, under penalty of restoration of the effects of the appealed decision.*"

Brief by the appellee requesting reconsideration of the decision. (IE 62)

Answer by the appellee requesting that the appeal be dismissed on the grounds of untimeliness or, alternatively, that it be dismissed in its entirety. (IE 859)

Certificate regarding the timeliness of the appeal, in index 1011.

This is the factual report of the case, now I adjudicate.

Provided that the admissibility requirements are met, the appeal must be heard.

The Plaintiff Samsung claims that the defendant implemented, in cell phones commercialized in Brazil, the 256-QAM digital modulation method, which is the subject of patent BR112015017291-1, owned by it (Patent BR 291). It claims that this technology is essential to the implementation of the 5G standard, so that Samsung would only achieve this technology through the unlicensed use of the invention, which would constitute an infringement of industrial property rights.

Due to the alleged violation of its temporary exclusivity right, it requested the granting of an injunction to stop the misuse of the patented technology.

The Defendant ZTE, in turn, denies the use of patent BR 291 and maintains that the plaintiff's invention is not essential to the availability of 5G technology in the devices it produces and commercializes.

The trial judge, in summary proceedings, granted the injunction, ordering Samsung to refrain from infringing patent BR112015017291-1 within five days, through any of the acts provided for in Article 42 of Law # 9,279/96.

The defendant, now the appellant, challenges this decision, which is why the appeal is being reviewed.

First, it is worth remembering that injunctive relief is eminently preventive in nature, intended to prevent the practice, repetition, or continuation of unlawful acts, projecting its effects into the future. It thus differs from compensatory relief, which is aimed at redressing past damages, as well as from precautionary relief, which is instrumental in nature.

Under the Code of Civil Procedure, injunctive relief is based on Article 497, sole paragraph, according to which it is irrelevant to demonstrate damage or fault in order to grant specific relief aimed at preventing the practice of unlawful acts:

Article 497. In an lawsuit whose purpose is to compel performance or refrainment, the judge, if the request is granted, shall grant specific relief or determine measures to ensure that relief is obtained through an equivalent practical result.

Sole paragraph. For the granting of specific relief intended to inhibit the practice, repetition, or continuation of an unlawful act, or its removal, it is irrelevant to demonstrate the occurrence of damage or the existence of fault or intent.

In the field of industrial property, protection derives directly from Article 42 of Law # 9,279/96, as well as from Article 209, paragraph 1, of the same law, which expressly authorizes the granting of preliminary injunctions to cease acts that violate industrial property rights, whenever the legal requirements are met:

Article 42. A patent confers on its owner the right to prevent third parties, without his consent, from producing, using, offering for sale, selling, or importing for these purposes:

I - a patented product;

II - process or product obtained directly by a patented process.

§ 1 The patent holder is also guaranteed the right to prevent third parties from contributing to others practicing the acts referred to in this article.

Article 209. The injured party shall retain the right to claim damages in compensation for losses caused by acts of infringement of industrial property rights and acts of unfair competition not provided for in this Law, which tend to damage the reputation or business of others, create confusion among commercial, industrial, or service establishments, or among products and services placed on the market.

§ 1 The judge may, in the case file itself, in order to avoid irreparable or difficult to repair damage, preliminarily determine the suspension of the violation or act that gives rise to it, before the defendant is summoned, by means of, if deemed necessary, a cash deposit or surety bond.

In urgent situations, the preliminary injunction may be granted, provided that the likelihood of the right and the risk of damage are demonstrated, pursuant to Article 300 of the Code of Civil Procedure.

It is precisely in the field of industrial property that preliminary injunctions take on special importance, since monetary compensation alone is insufficient to restore the legal balance violated by the improper exploitation of protected technological assets.

Patent rights are structured on the logic of exclusivity, translating into true *jus prohibendi*, imposing on third parties the legal duty not to use the invention without the owner's authorization. The effectiveness of this guarantee requires the possibility of prompt judicial intervention whenever there are indications of infringement.

In this specific case, the probability of the right arises from the plaintiff's ownership of the patent and the existence of circumstantial evidence that the defendant may be using the protected digital modulation method without the corresponding license.

In fact, there is no unequivocal probability or certainty of misuse of the technology patented by the appellant. There is doubt. This is because the parties disagree on the facts and evidence contained in the case file.

However, this circumstance does not argue in favor of the appellant. Samsung's statements presented on its appeal reveal inconsistent positions, sometimes categorically maintaining that it does not use the patent in question, sometimes defending the need for complex expert evidence precisely to assess the existence-or-not-of the alleged infringement.

Contributing to this scenario of uncertainty is the fact that the Samsung's appeal points to the existence of past or potential negotiations for the licensing of the patent, attributing to the appellee a failure to comply with "FRAND" standards, while at other times questioning the very essentiality of the invention.

In other words, Samsung sometimes claims that the patent is not essential and that it does not use it, while at other times it argues that, since it is essential, it should have been

offered by the Appellee appealed under "FRAND" conditions, claiming that the decision preventing the use of the technology would cause it serious damage.

These imprecise conclusions by Samsung reinforce the indication of a possible infringement. And, considering the industrial property protection system, the doubt, in this summary judgment, favors the patent holder, thus satisfying the requirement of probability of right.

The risk of damage to the appellee is also present. This is a company whose core business is research, development, and licensing technologies, with royalties from patents being its main source of revenue. The unauthorized use of its assets compromises the sustainability of its business model and makes reinvestment in innovation unfeasible.

Furthermore, the offer of a bond in the amount of BRL 10,000,000.00 (ten million reais) is unacceptable. Such a measure would subvert the patent holder's rights by precluding the right to seek injunctive relief to cease infringement, effectively reducing the remedy to purely financial (compensatory) relief. This stands in direct violation of Article 497, sole paragraph, of the Code of Civil Procedure, and Article 42 of Law No. 9,279/96. An Order of Abstention cannot be replaced by financial compensation, as doing so would undermine the very protection conferred by the right of exclusivity

In this regard, the lesson of Luiz Guilherme Marinoni¹ is enlightening:

There is no possibility for a patent infringer to request the replacement of injunctive relief with the offer of royalties because such a possibility would violate the right to individual autonomy of the right holder, as well as subvert the normative preference for specific relief to the detriment of monetary compensation.

Samsung's allegation of a risk of reverse damage also fails to prosper. The Appealing Party itself categorically states that it does not use the technology patented by ZTE. In this case, the contested injunction—even if situated within a natural environment of doubt and uncertainty regarding the facts of the lawsuit—is projected as a legal indifference, incapable of causing concrete damage to Samsung's economic activity. If the invention is not used, there is no practical impact resulting from the imposition of the duty not to do, which also weakens the grounds for appeal on this specific basis.

Secondarily, Samsung argues that, since the patent is essential to the 5G standard, it would not be possible to grant injunctive relief, as this would render the use of several other patents not belonging to ZTE unfeasible, resulting, in practice, in the disabling of 5G technology on its devices. This argument does not hold water.

A Standard Essential Patent (SEP) is one whose technology is indispensable for the implementation of a given standard, with no viable technical alternatives. Usually, the declaration of essentiality is made through a self-declaration by the patent holder filed with a Standard Setting Organization (SSO). In the national legal system, the declaration of essentiality does not restrict the rights of the patent holder, nor does it prevent them from exercising the right of exclusivity provided for by law.

It is true that SEP status imposes a commitment on the holder to license the technology on fair, reasonable, and non-discriminatory (FRAND) terms, with a view to balancing the holder's interest in receiving royalties with the implementers' access to standardized technologies. However, from an analysis of the case files, there is no evidence that ZTE refused to license its

¹ MARINONI, Luiz Guilherme. Injunctive relief and industrial patents (Opinion). *Revista de Direito Civil Contemporâneo* [Contemporary Civil Law Magazine], [S. l.], v. 39, n. 11, p. 361–377, 2025. Available at: <https://ojs.direitocivilcontemporaneo.com/index.php/rdcc/article/view/1512>

patent under FRAND conditions or that there was a failed negotiation attributable to ZTE. On the contrary, Samsung does not demonstrate that it effectively sought to license Patent BR 291, limiting itself to alleging potential damages resulting from the maintenance of the injunction.

Thus, in the absence of evidence of abusive conduct or an unjustified refusal to license, ZTE's initiative to seek an injunction is not illegitimate, at least in a preliminary judgment. The overturn of the preliminary injunction, as intended by Samsung, would undermine the legal system for patent protection, allowing the continued exploitation of another's technological assets without authorization or compensation. This would disregard the patent holder's right to prevent unauthorized exploitation of the patented rights, even if certainty regarding the fact of infringement depends on extensive and complex evidentiary proceedings.

Finally, the decision includes a minor amendment regarding the amount of the daily fine set in the event of non-compliance with the obligation not to do something, showing that the amount of BRL 25,000.00 (twenty-five thousand reais) is sufficient and more appropriate to ensure the effectiveness of the decision, at least at this time [where technical examination by court appointed expert is pending].

In view of the above, I vote to partially grant the appeal only to reduce the daily fine to BRL 25,000.00 (twenty-five thousand reais). The decision of *index 54* is hereby revoked.

Rio de Janeiro, on the date of the trial session.

Hon. Justice **ADOLPHO ANDRADE MELLO**

NEW REPORTING JUDGE SUCCEEDING VIA DISSENTING MAJORITY