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M I C H A L S K I



H Ü T T E R M A N N

P A T E N T A N W Ä L T E

Bundestag passes the Unitary Patent (re)ratification law

On 26 November 2020, the German¹Bundestag dealt with the (Re-)Ratification Act in second and third reading and then passed it with the necessary two-thirds majority of all members of the German Bundestag, exactly 571 of 709 representatives.

The final vote in the Bundesrat is scheduled for the last session of the year on 18 December. The (re)ratification law would enter into force after it had been issued by the Federal President.

Scenarios have already been discussed according to which a new constitutional complaint would again stop the ratification process,² but this should be considered:

- The first-instance judgement³ was issued with 5:3 votes, the decisive vote coming from the former presiding judge Prof. Dr. Voßkuhle. However, he has left the Federal Constitutional Court in the meantime.
- His successor as chairperson of the second senate is Prof. Dr. König, who was the minority vote at the time.⁴
- His successor in the judgeship is Prof. Dr. Wallrabenstein, who - at least as far as her publications and interviews are concerned⁵ - is much more friendly than Voßkuhle of the transfer of sovereign rights.
- Prof. Dr. Huber, who was then judge-rapporteur, will leave the court in 2022. If a second trial should take place, it can be assumed that he would not be judge-rapporteur again.

Thus, the conditions for a successful constitutional complaint, be it with regard to a suspension of the ratification process or the prospects of success in general, are now different.

However, even if ratification proceeds without problems, the introduction of the unitary patent system is not immediately to be expected. The reason for this is that the Unitary Patent Court must be fully operational on the first day and a preparation time is necessary for this.

For this purpose, the so-called "Protocol"⁶ to the Unitary Patent Court was adopted at that time, which allows the provisional applicability of individual articles and, in particular, makes it possible for the necessary bodies and committees to be constituted and subsequently appoint the judges of the Unitary Patent Court.

It is assumed that the so-called "protocol phase" lasts about eight months.⁷ At best, it can therefore be expected to be introduced next autumn, almost nine years after the adoption of the EU regulations and the Agreement.

¹ See the agenda: <https://www.bundestag.de/resource/blob/473450/ad9836b2695c-f011e527e52a1feffe76/Tagesordnung-komplett-kommende-Woche-data.pdf>

² See for example here: <https://www.juve-patent.com/news-and-stories/legal-commentary/dark-day-for-upc-european-reacts-to-surprise-judgment/>

³ See our newsletter [Newsletter 3/2020](#)

⁴ See here: https://www.bundesverfassungsgericht.de/DE/Richter/Zweiter-Senat/zweiter-senat_node.html

⁵ See for example here: <https://www.reuters.com/article/uk-germany-court-ecb-analysis-idUKKBN23S0NI>

⁶ exact wording: Protocol to the Agreement on a Unitary Patent Court on provisional application

⁷ See our [newsletter 8/2019](#)



The Federal Supreme Court on the question of court costs in nullity proceedings involving several plaintiffs

The question whether one or more fees are necessary in the case of an application by several parties pursuing a common concern has been occupying German jurisdiction for a longer time.⁸

If several opponents jointly file an opposition, the DPMA will nevertheless charge an opposition fee for each of them, to name just a few examples.⁹ Also, in appeal proceedings, all patent owners of a patent must pay an appeal fee individually.¹⁰

The Federal Supreme Court now had to examine the question as to whether the 4.5 fee according to the Patent Costs Act also had to be paid twice in nullity proceedings if two plaintiffs jointly file a nullity action.¹¹

However, this was denied with great determination, at the same time the Federal Supreme Court emphasized the differences to the appeal procedure:

"The schedule of fees under Sec. 2 (1) Patent Costs Law provides for the separate charging of fees for each individual applicant in the preliminary remarks to Part A for a series of requests to the German Patent and Trade Mark Office and in the preliminary remarks to Part B for the fees 400 000 to 401 300 relating to the appeal proceedings. For the fees 402 100 and 402 110 relevant in proceedings concerning an action for revocation, however, there is no comparable regulation.

It can be concluded from this that the general principle for invalidity proceedings remains the same as mentioned above. If several plaintiffs jointly bring an action with the same subject-matter in dispute, the fee 402 100 is therefore only payable once. "

In view of the fact that the fees before the Federal Patent Court are calculated in accordance with the general law on court fees, the "GKG" based on the value of the dispute and can easily amount to tens of thousands of Euros with correspondingly high amounts in dispute, this of course means a significant improvement in the position of the parties - not only of the plaintiffs, but if the plaintiffs are successful, possibly also of the patent owner, since she then only has to bear the court costs once in accordance with § 91 Civil Procedure Code "ZPO" if the patent is revoked.



⁸ See in detail Dike foot. GRUR 2015, 1170

⁹ S. here: <https://www.dpma.de/docs/formulare/patent/p2797.pdf> - exactly opposite to the practice of the European patent office, see the [G 3/99](#)

¹⁰ BGH X ZB 3/14, GRUR 2015, 1255 - Wall insert

¹¹ BGH X ZR 147/18, judgment of September 17, 2020 - [Signal conversion](#)

The Federal Court of Justice on the question of the burden of proof in the case of complex sales contracts and the plea of exhaustion

In the recent decision “Querlieferungen (Cross-deliveries)”, the Federal Supreme Court had to¹² assess the question of who, if necessary, bears the burden of proof of the alleged exhaustion in the case of complex sales contracts.

The case is very complex and is only presented to the extent that it is important for the points that are relevant to the decision.

The plaintiff was Coty, a company known from many lawsuits that produces luxury perfumes. Coty distributes its perfumes through distributors, who are bound by sales agreements that include sales targets, and this has already been the subject of several decisions.¹³

In the present case, the selling partners were forbidden to sell luxury perfumes outside of the European Union/EEA (European economic area, i.e. additionally Liechtenstein, Norway and Iceland) to commercial customers, cross-deliveries within the European Union and/or the EEA were however permitted.

Coty now made a test purchase from a seller on Amazon and sued both this seller - who was no longer involved in the present case - and Amazon for trademark infringement.

Coty argued that the goods sold were perfumes that the seller had purchased in Dubai, so the principle of exhaustion did not apply. Amazon, however, claimed that the seller had purchased the perfume from one of the contractors in the EEA, i.e., exhaustion existed, but did not want to provide any further information on the identity of this contractor.

The question was now, whom the burden of proof regarding exhaustion meets here, Coty or Amazon.

The Federal Supreme Court has now determined the following:

- In principle, when a defendant invokes exhaustion, the burden of proof that exhaustion has occurred rests with him.
- There may, however, be exceptions to this rule, in particular if the trademark owner places his goods on the market only via an exclusive distribution system and there is a risk of market foreclosure - and in particular if it can be assumed that the respective distribution partner is threatened with severe penalties or reactions by the trademark owner if he sells his goods contrary to the distribution system.
- However, the requirements for such market foreclosure are very high, as the Federal Court of Justice states:

“It cannot generally be assumed that national markets are closed off if sales to outsiders are prohibited in a selective distribution system. The risk of foreclosure of national markets can be excluded if sales to outsiders are prohibited but cross-supplies between distributors in different Member States are allowed.”¹⁴

¹² BGH, judgement of 15 October 2020, I ZR 147/18 - [cross deliveries](#)

¹³ See for example our [Newsletter 6/2017](#)

¹⁴ Paragraph 43 of the decision



- However, if cross-deliveries are allowed in principle, the matter is not over for the trademark owner. Only, if these actually take place, it can be assumed that no market foreclosure will occur. An indication that this is not the case, however, can be very different prices in different EU countries:

"The existence of price differentials and the selective distribution system operated by [Coty] [...] give rise to a real presumption that the cross-deliveries between depositors located in different Member States, which are possible under the standard Deposit Agreement, cannot take place in reality or cannot take place to any significant extent as a result of the contractual restrictions. Should [Amazon] prove that the considerable price differences it claims to have exist, the existence of an actual risk of foreclosure of national markets cannot therefore be denied."

All this has eminent effects on the burden of proof. If there is a market foreclosure, the plaintiff, i.e. Coty, must prove that there was no exhaustion, otherwise the defendant, i.e. Amazon, must prove exhaustion.

In this case, the affair was referred back to the previous instance (Upper Regional Court "OLG Munich") to examine with the condition which conditions apply and if now thus the burden of proof meets.

This judgement shows very clearly which questions arise if both parties exhaust their respective possibilities strongly (too strongly?). Coty, a luxury perfume manufacturer, which is interested of exclusivity, on the one hand, Amazon, which wants to sell (or let sell) unhindered any goods on the other hand.

In Our Own Affairs

We wish your relatives, employees, colleagues and of course yourself all the best for the current difficult time and - as far as possible - happy holidays and only the best for 2021.

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