



Newsletter 4/2017 Edition

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News of ratification of the Unitary Patent System

There is good news regarding the ratification of the Unitary Patent System from Great Britain. The last bill required for final ratification regarding the privileges and immunities of judges of the Unitary Patent Act has been submitted to parliament in Westminster (see [here](#)).

However, for a final ratification, this order must be available in parliament for 40 days, - and as the parliamentary recess begins in Great Britain on 20 July 2017, this period of availability will be suspended again. In addition, the bill must also be available in the Scottish Parliament. Thus, no final ratification is expected before late Autumn.

The introduction of the bill to parliament shortly after the new parliament was opened, however, indicates that the British Government is clearly taking the ratification seriously.

While the ratification is going ahead in Great Britain, it is being unexpectedly delayed in Germany.

As the Frankfurter Allgemeine Zeitung reported on 12 June 2017, (see [here](#)), at the beginning of April the German Federal Constitutional Court (Bundesverfassungsgericht) had already asked the German President not to sign the bills already passed for ratification due to a constitutional complaint submitted on 31 March.

The reason for this was that the specified constitutional complaint submitted by an individual "was not totally unfounded", and thus the Court required more time to review it.

Unfortunately, the information available for these proceedings is very unclear, as neither the identity of the constitutional claimant nor the argumentation are known. However, this is not uncommon: the action will only be published if the Federal Constitutional Court serves the action on those involved in the proceedings (i.e. the German Bun-

Product recall obligation for overseas firms too (?) – BGH "Abdichtsystem"

The recent decision X ZR 120/15 "Abdichtsystem" (available [here](#)) of the Federal Supreme Court (BGH, Bundesgerichtshof) includes the obligations to recall and remove the infringing items in the event of patent infringement.

The case in question is very complex, thus not all aspects can be considered within the context of this newsletter.

The matter concerns a patent infringement action against a company based overseas as a result of deliveries to Germany – part of the contested delivery did not go to Germany, but (indisputably) to a company also based overseas. However, the patent holder assumed that this company then delivered to Germany and thus infringed its patent.

The points to be clarified included:

I. Can the right to recall according to § 140a, Section 3 of the German Patent's Act, on the one hand, and final removal from the distribution channels, on the other hand, be enforced in parallel?

This was affirmed by the Federal Supreme Court. Moreover, it made it clear that there is also a recall obligation if the patent-infringing items are no longer under the control of the defendant. The defendant must take all reasonable measures here to ensure that its purchasers also return the items.¹

II. Is the right to recall from distribution channels excluded, as the obligated party is based overseas?

Here, too, the Federal Supreme Court ruled on behalf of the patent holder. The duty of recall generally also applies to obligated parties based

And in our own affairs...

For the tenth year, our practice is offering two free two-day preparatory courses for Parts C and D of the European Qualifying Examination (EQE).

The courses will take place on Monday/Tuesday 27/28 November and also Saturday/Sunday 9/10 December. The course leaders are Dr. Torsten Exner, Dipl.-Ing. Andreas Gröschel, Dr. Aloys Hüttermann and Dr. Ulrich Storz.

You can enroll immediately at eqe@mhpatent.de. (Please provide your full name, your employer's name and also your requested date)

Michalski Hüttermann & Partner has been included in IAM magazine's World's Leading Professionals 2017. Our [EURIPTA](#) network was specifically mentioned as a highlight in the relevant entry. Dr. Aloys Hüttermann was also listed in IAM 1000.

Proposals and Questions

destag and Bundesrat, §94 Section 1 of the Federal Constitutional Court Act.

However, it should be noted that according to the current state of play, the Federal Constitutional Court does not consider the Unified Patent System as unconstitutional in any way - it merely requires time for a more thorough review. Due to the special significance of the Unified Patent Court as the first real European court whose Rules of Procedure could also serve as a blueprint in other areas, this does not seem surprising.¹

It remains to be seen whether proceedings will, in fact, be opened. As the ratification in Great Britain will be somewhat drawn out, as reported above, it may even be the case that the Unitary Patent System comes into effect without any delay at all, even if the Federal Constitutional Court takes several months to review the complaint.

¹ See *Hilty et al*, Max Planck Institute for Intellectual Property & Competition Law Research Paper 13-16, available [here](#)

overseas.

III. What is the situation for deliveries from one overseas company to another overseas company?

Here, the Federal Supreme Court made it clear that a supplier is not obliged to monitor further use of its goods. The supplier is only obliged to take action if there are specific indications that a delivery from a purchaser is being made to Germany.

The Federal Supreme Court also made it clear in this respect that if such an infringement of duty exists, the supplier must then provide detailed information about all its deliveries to this purchaser.

However, whether all this was, in fact, relevant in this case (e.g. whether the existence of operating instructions in German is adequate evidence), was ultimately not decided by the Federal Supreme Court. It referred the action back to the Karlsruhe Higher Regional Court.

Consequently, the Federal Supreme Court has strengthened the rights of patent holders. Overseas companies themselves have a duty of due diligence, even if they themselves do not operate in Germany, but their purchasers do operate there.

¹ With regard to competition law, it has been referred to the Federal Supreme Court decisions "Hot Sox" and "RESCUE-Products", see *Sakowski*, GRUR 2017, 355. As a result, the ruling was that even injunctive relief includes a duty of recall.

If you have any proposals or questions, please don't hesitate to contact us [here](#).

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