



Newsletter Issue 1/2016

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This is the first Newsletter of the Office of Michalski • Hüttermann & Partner mbB, with which we want to inform you about the latest developments both in the field of intellectual property law as well as our Office.

Repeal of the prohibition of double protection for unitary patents?

In the course of the ratification of the Agreement on the Unified Patent Court the German Ministry of Justice has [posted](#) the corresponding draft bill both for the ratification concept and the Accompanying Act in the Internet on 16 February 2016.

In particular, the Accompanying Act provides here a real surprise: Here it is provided that the prohibition of double protection of Art. II § 8 IntPatÜG for unitary patents is repealed. Initial demands herefor arised already in 2011¹, but that the legislature even complies with this, may well be regarded as surprising.

So far, in Germany a prohibition of double protection applies to national German and European patents under Art. II § 8 IntPatÜG. If an invention has been granted for the same inventor or his assignee both nationally before the German Patent and Trademark Office and european before the European Patent Office, the German Patent for the granted scope of protection has become ineffective by the European patent if it has been validated in Germany.

A continuation of the national patent was only worthwhile if in Germany the German patent was granted wider than the European, and then both patents had to be maintained.

In the draft bill is now scheduled to repeal this double protection for unitary patents. Thus, patent holders can go "double track" in the future, if they choose the protection for their granted European patents in Germany via the unitary patent.

Fees and eligible costs for the Unified Patent Court presented

On 26 February 2016 the final proposal for the fees and eligible costs of the Unified Patent Court was [presented](#) by the Preparatory Committee. However, these have yet to be confirmed by the management committee of the Unified Patent Court to be initiated, which is however generally expected.

For this purpose, in May 2015 a first draft was already published, along with an opportunity to submit entries. Then the now final schedule of fees has been changed in several points compared with the initial version:

- A fee for the "opt-out", unlike in the first draft, is no longer intended.
- As before, there are fixed and value in dispute based court fees, wherein for actions of annulment now no value in dispute based court fee accrues. For patent infringement suits the court fees are from € 11,000 for a value in dispute of up to € 500,000 to € 336,000 for a value in dispute of € 50 million or more.
- For the calculation of the value in dispute guidelines have been [published](#) that suggest the court to determine the value in dispute on the basis of a license analogy.
- Both for small and medium enterprises as well as for early termination of the lawsuit reductions of court fees are intended.
- The maximum eligible costs have been reduced both for the low and the highest values in dispute; they now are € 38,000 for a

On our own behalf

On 1 January 2016 Dr. Torsten Exner was appointed as partner of Michalski • Hüttermann & Partner mbB. We sincerely congratulate Dr. Exner!

On **10 March 2016** Dr. Ulrich Storz gives a lecture on the subject "Second Medical Indication" at the '15. Düsseldorfer Patenttage'.

The 2nd MH Patent Seminar takes place on **8 April 2016** at Industrieclub Düsseldorf,

guest speakers at the MH Patent Seminar are, among others, Volker Vanek (Dorma AG), Michael Gollwitzer (Siemens AG) and Wulf Höflich (formerly Airbus AG).

On **2 June 2016** the 'Rheinische Biopatentforum' is held for the 9th time already in our office premises. Here, Filip de Corte (Syngenta) and Dorian Immler (Bayer AG) are already fixed as speakers.

In this case they can enforce a parallel German Patent before the District Courts and file a lawsuit before the Unified Patent Court. Of course, an alleged patent infringer can be taken to court only once - it is provided that, if a proceeding before the Unified Patent Court has been legally decided a parallel German infringement action with respect to the same invention has to be dismissed as inadmissible if the respondent makes a corresponding objection. Even a stay of the German proceeding is possible.

A general repeal for all European patents, however, is not intended, which means that for conventionally validated patents the prohibition continues to hold.

The repeal of the prohibition of double protection in particular for patent holders which protect their patents first with German first applications offers novel strategic opportunities.

Now it is surely attractive not only to claim German first applications due to the favourable research but also to bring to grant in order to open the door to the District Courts in future when a unitary patent is chosen for a parallel European patent. This possibility ends - in contrast to the "opt-out" - not after seven years since the Unified Patent Court has come into force, but will also be available subsequently.

value in dispute of up to € 250,000 and are up to € 2 million for a value in dispute of € 50 million and more.

- However, in particularly difficult cases these maximum costs may still be raised at request, while in the event that one side will be economically ruined or severely restricted by the costs a reduction is possible.
- However, by means of an appropriate preamble it has been ensured that these maximum eligible costs are rather to be understood as safety net than to map the actual arising costs. The Court is free to impose only those costs on the opponent, which it considers actually as necessary and appropriate.

The court fees as already in the initial draft are within the range, which also arise according to GVG in actions before German courts; the maximum eligible costs just as in the initial draft, however, are significantly higher than the cost according to RVG.

However, whether these will actually be the costs actually payable in a dispute, or if the courts will apply a stricter standard here remains to be seen. The example of the Swiss Federal Patent Court shows that courts in some cases are not afraid to reduce the note of fees of each party here, if they should consider the costs as too excessive.¹

¹see e.g. decision of Swiss Federal Patent Court O2013_013 of 29 May 2013

¹s. Bardehle Mitt. d. dt. Patentanw. 2011, 452, later Nieder GRUR Int 2014, 1033 and Chudziak, GRUR Int 2015, 839. For a legal discussion McGuire GRUR 2011, 767, see also Köllner, Mitt. d. dt. Patentanw. 2013, 253 and Holzwarth-Rochford, GRUR Prax, 2013, 374

If you are interested in these seminars we ask for feedback to Ms Judith Felsner (seminare@mhpatent.de).

On 12 May 2016 the 5th European Conference of the Intellectual Property Owners Association (IPO) takes place - this year for the first time in Germany in Frankfurt a. Main. Dr. Aloys Hüttermann will moderate a session on the topic indemnity in Europe, in the USA and before the Unified Patent Court. Registration and information can be found at

www.ipo.org/Europe2016

Questions and suggestions

We will appreciate any questions and suggestions. - please contact us [here](#).

[Impressum](#): Michalski - Hüttermann & Partner Patentanwälte mbB

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