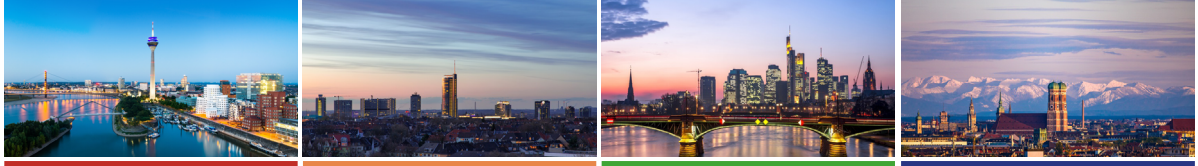

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News from G1/21

ECJ T-633/19 „Monopoly“ - on the question whether trademark applications can be in bad faith

MICHALSKI · HÜTTERMANN

PATENTANWÄLTE

News from G1/21

In the „videoconference" proceedings G1/21, there are some news to report, some of them spectacular.

These proceedings deal with the question whether the scheduling of oral proceedings by video conference is in accordance with Article 116 EPC even without the parties' consent[1].

For the Boards of Appeal, Rule 15a RPBA is decisive in this context, on the basis of which such a practice is permitted. The appellant in this case now argued - after there had also been corresponding discussions in interested groups - that at least concerning the President of the Boards of Appeal, Carl Josefsson, as well as two other members of the Board convened in G1/21[2], namely Andrea Ritzka and Gunnar Eliasson, there would be a concern of partiality, since they had participated in the development of the corresponding Rule.

The Enlarged Board of Appeal was subsequently restructured in terms of personnel in order to come to a decision on partiality. In parallel, another member of the original Board, Ingo Beckedorf, informed[3] the Board that he had been involved in the formulation of Rule 15a RPBA and requested that his partiality be examined.

In a decision dated May 17, 2021, the Enlarged Board of Appeal ruled that both Carl Josefsson and Ingo Beckedorf were at risk of partiality - only a few days before the oral proceedings, which had been scheduled for May 28, 2021. Andrea Ritzka and Gunnar Eliasson, on the other hand, were not considered to act partial.

The Enlarged Board of Appeal gave the following reasons for its decisions:

As far as Carl Josefsson was concerned, it was pointed out (in short) that he, as per his function, undoubtedly had been involved in the development of Rule 15a. This would suffice to assume partiality in this particular case[4].

In our own affairs

For the event „Innovativ Gründen" (Innovative Founding) as part of this year's Startup-Woche Düsseldorf on June 10 at our Düsseldorf premises, there is still the opportunity to participate, both in person and online.

European Inventor Award

Members of our law firm's clients have been nominated twice for this year's European Inventor Award, namely Prof. Dr. Karl Leo, one of the co-founders of our client Novaled GmbH, in the category „Lifetime Achievement" as well as Prof. Dr. Walter Leitner (RWTH Aachen) and Dr. Christoph Gürtler (Covestro Deutschland AG) in the category „Industry".

We congratulate very warmly already now and hope that all of them will also receive the European Inventor Award in the end.

1 see our newsletters 12/2020, 3/2021 and 6/2021

2 note: these individuals are not named personally in the decision, but they are apparent from the appellant's requests.

3 note: para. 7 of the decision, also this person is not named personally in the decision, but results from the procedure.

4 para. 17ff of the decision

In our own affairs

Dr. Christoph Volpers will present a paper on „Patenting antibodies: Lessons learned from recent court decisions“ at the 9th Antibody Industrial Symposium, June 22-25. ”

As a result, this was also concluded in the case of Ingo Beckedorf, who had been a member of a working group regarding the handling of videoconferences before the Boards of Appeal.

In contrast, the roles of Andrea Ritzka and Gunnar Eliasson in the development of Rule 15a were considered less decisive. They had been members of the Presidium of the Enlarged Board of Appeal at the time when the Enlarged Board of Appeal was asked for a statement on Rule 15a - when it had still been in the drafting stage. According to the decision, however, Rule 15a was (only) discussed and no vote took place. Thus, the Enlarged Board of Appeal could not see any danger of bias here.

This is the first time that a bias claim has been successful in an ongoing proceeding, and for this reason alone G1/21 - regardless of outcome - must be classified as exceptional.

Somewhat less historic, but nonetheless surprising, is the outcome of the oral hearing on May 28, 2021 - namely that the proceedings were adjourned.

The reason is that the appellant had submitted that it had been served with the submission of the President of the European Patent Office only two days before the oral proceedings and thus had not yet had time to react sufficiently to it.

Even though the President's submission had already been published on the website of the European Patent Office at the end of April, the appellant argued that this was irrelevant. The appellant stated that it was not obliged to constantly monitor the website but could rely on the delivery.

EQE Preparatory Courses 2021

There are still places available on our preparatory courses for the C and D parts of the European Qualifying Examination (EQE). Provided the pandemic situation allows, the courses will take place on Monday/Tuesday, November 22/23, and Saturday/Sunday, December 4/5, 2021. Both courses are identical in content, so attendance at one course is sufficient.

The course content is mainly focused on appropriate exam techniques as well as strategies for avoiding mistakes in order to be able to successfully tackle the C and D parts of the EQE exam with these skills. It has been our experience that well-prepared exam materials significantly increase the chances of success. Therefore, we want to provide the participants with the necessary methodological knowledge in this course. In this respect, the course is to be understood as a supplement to the participants' own preparation of the legal fundamentals of the EPC. Instead, participants will learn how to convert their technical knowledge of the EPC into as many points as possible for passing the C and D parts of the EQE examination. The courses take place in Düsseldorf at our premises in Speditionstr. 21 and are free of charge. Speakers of the course are Dr. Torsten Exner, Dipl.-Ing. Andreas Gröschel and Dr. Aloys Hüttermann.

Registration is now possible (please state your full name and employer) at eqe@mhpatent.de.

After the new Chairman of the Board, Fritz Blumer, had asked the appellant how much time it needed and the appellant replied that it should be given at least one month, the request for adjournment was finally granted. A new oral hearing will thus take place at the end of June or - more likely - in July.

The Enlarged Board of Appeal is also breaking new ground in this regard; it is the first time that oral proceedings have been adjourned. However, it seems that the newly composed Board wants to play it safe here.

In our own affairs

We congratulate Dr. Deborah Meyer on passing the patent attorney bar examination. After her admission, she will strengthen our Düsseldorf office.

However, all this need not mean anything for the outcome of the proceedings, both in terms of timing and content. A decision can still be expected in the near future.

ECJ T-633/19 „Monopoly“ - on the question whether trademark applications can be in bad faith.

In the proceedings T-633/19, the Court of Justice of the European Union (ECJ) had to assess the question whether and to what extent trademark applications can be in bad faith.

Specifically, the case concerned a trademark application „MONOPOLY“ by Hasbro from 2010, in which - in addition to some new goods and services - several goods and services of older trademarks had been newly applied for.

A competitor now took action against this and filed an application for cancellation on the grounds of bad faith, arguing that this trademark had only been applied for, at least in part, in order to avoid the obligation to use it pursuant to Art 18 of the EU Trademark Regulation.

Just like the Board of Appeal of the EUIPO, the ECJ partially granted this cancellation request. Although there is no provision in EU trademark law prohibiting the re-filing of a trademark application[5], a practice of repeatedly re-filing trademarks in order to avoid the obligation to use them under Art. 18 is not permitted.

It is worth mentioning here that the trademark owner itself had argued that for administrative reasons as well as to save costs it could be appropriate to file a new trademark application, in particular because then the effort for the proof of use would be omitted in case of oppositions.

Europe‘s Leading Patent Law Firms Report

Our patent law firm is honored in this year‘s edition of the Financial Times Europe‘s Leading Patent Law Firms Report. In mid-June, the most recommended patent law firms in Europe will be published both online on the Financial Times website (www.ft.com) and in print in a Special Report.

The Europe‘s Leading Patent Law Firms Report is the result of a joint initiative of the Financial Times and Statista and is based on extensive research and a comprehensive survey in which thousands of our professional colleagues and clients throughout Europe participated.

In addition, more than 10,000 patent attorneys and experts from corporate R&D departments were invited to participate in a Europe-wide survey and contribute to the analysis with their expertise. Michalski - Hüttermann & Partner stood out here and is therefore publicly recognized in the Financial Times as one of the leading patent law firms in Europe.

We are delighted to receive this award and would like to thank our clients most sincerely for their trust.

[5] para. 71 of the decision

This was even considered an abuse of law by the ECJ[6] and thus the decision of the Board of Appeal was confirmed.

It should be noted that it was also apparently relevant to the decision that the only undisputed use of the mark „MONOPOLY" was for board games.

As a result, trademark owners are well advised, at least as long as there is no other decision of the ECJ, to proceed with caution when filing new trademark applications, if they do not want to expose themselves to the accusation of bad faith.

[6] para. 72 of the decision

In our own affairs

We wish your relatives, employees, colleagues and of course yourself all the best for the current, still difficult time.

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