



# Newsletter Edition 12/2021

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Germany deposits the certificate of ratification for the UPC Protocol

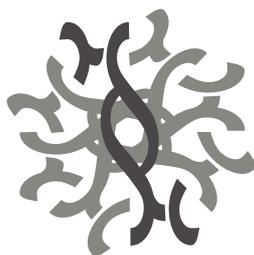
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FCJ presents reasons for decision in „Goldhase III“ ruling

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The FCJ decision „Bewässerungsspritze II“ (at the same time ECJ C-607/19 - Husqvarna) on the question of the time limit in trademark revocation proceedings

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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

## Germany deposits the certificate of ratification for the UPC Protocol

After Germany has already adopted the ratification law on the Unified Patent Court<sup>1</sup>, it can now be announced that it has also deposited the certificate of ratification of the Protocol to the Convention with the EU<sup>2</sup>.

This protocol<sup>3</sup> will allow the court to recruit judges and to make the necessary preparations for the Unified Patent Court to be operational when the Agreement enters into force. During the so-called “protocol phase”, it will also be possible to register so-called “opt-outs”,<sup>4</sup> i. e. declarations by a patent proprietor that national courts should have jurisdiction over his patent(s) as before. These would then be valid on the date of entry into force, so that third parties would be prevented from stopping the “opt-out” by filing a nullity action.

It should also be possible for European Patent Representatives to already register the EPLC, which is necessary according to Art. 48 for obtaining sole power of representation, during the protocol phase; here there are transitional provisions which recognize numerous courses already in existence.

For the protocol to enter into force, however, the deposit of two further states is still necessary. Fortunately, it can be reported that Slovenia<sup>5</sup> is about to ratify the protocol. Austria is being discussed as a candidate for the last ratification. Although it was assumed that the deposit would take place in September, things<sup>6</sup> seem to be delayed. Currently, the ratification is still hanging in the National Council and was recently referred to the Research Committee.<sup>7</sup>

Deposition is not expected before November, which means that the Protocol cannot enter into force until then. Nevertheless, entry into force of the unitary patent system in 2022 or early 2023 is not unrealistic.



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<sup>1</sup> s. our [newsletter 11/2021](#)

<sup>2</sup> s. here <https://www.consilium.europa.eu/en/documents-publications/treaties-agreements/agreement/?id=2015056>

<sup>3</sup> Exact title: „Protocol to the Agreement on a Unified Patent Court on provisional application“, see also our [newsletters 9/2021](#) and [11/2021](#).

<sup>4</sup> For more information, see here: <https://www.mhpatent.net/de/einheitspatent-und-einheitliches-patentgericht/opt-out/>

<sup>5</sup> See here: <https://www.juve-patent.com/news-and-stories/people-and-business/latest-news-and-updates-on-the-unified-patent-court/> (updated September 27, 2021).

<sup>6</sup> Pg. <https://www.juve-patent.com/news-and-stories/people-and-business/latest-news-and-updates-on-the-unified-patent-court/> (updated September 14, 2021)

<sup>7</sup> S. here: [https://www.parlament.gv.at/PAKT/VHG/XXVII/I/I\\_01027/index.shtml](https://www.parlament.gv.at/PAKT/VHG/XXVII/I/I_01027/index.shtml)

## FCJ presents reasons for decision in “Goldhase III” ruling

After the result of the [decision](#) of the Federal Court of Justice to grant a color trademark for the “Lindt Goldhase” (Lindt Gold Hare) had already become known in July, the <sup>9</sup>reasons for the decision are now available<sup>9</sup>.

The basis of the decision was a trademark infringement action by Lindt-Sprüngli on the basis of an abstract color trademark for “chocolate bunnies” acquired through use against a gold-colored bunny of a competitor.

As anyone practicing in trademark law knows, it is possible to obtain a trademark not on the basis of a trademark application and registration, but purely through use, by proving a so-called “Verkehrsgeltung” (public recognition), i. e. a reputation in the market. However, the hurdles are quite high in practice, so that such a plan is usually doomed to failure and in the literature as well as in daily advisory practice it is always advised to apply for a trademark instead of relying on the use trademark.



If this were not difficult enough for everyone, a color mark has now also been made subject of protection, for which it is often impossible to obtain trade mark protection even in normal trade mark registration procedures. For this purpose, so-called “Verkehrsdurchsetzung” (public reputation) must be proven, i. e. proof that the relevant public - usually all consumers - perceive a substantial part of a certain sign as an indication of origin.

Nevertheless, Lindt was successful in the end, after the Munich Higher Regional Court had allowed an appeal but rejected trademark protection in the end. The judgment is very extensive and concerns a large number of aspects important under trademark law, so that it cannot be discussed in full. However, important points include:

- One of the defendant’s arguments that there was no trade mark protection related to the amendment of the Trade Marks Act in 14 January 2019. Since then, under section 3 of the Trade Marks Act, signs have been excluded from trade mark protection which “*consist exclusively of a shape or other characteristic features which are due to the nature of the goods themselves*”.

In the process, the phrase “or other characteristic features” had been added. If this had been the case for the gold tone, an assertion of the trade mark would not have opened up any trade mark protection either, as this cannot overcome the hurdle of §3.... The Federal Court of Justice now ruled that this

<sup>8</sup> S. here: <https://juris.bundesgerichtshof.de/cgi-bin/rechtsprechung/document.py?Gericht=bgh&Art=en&sid=52ad200c18a678d183f974ffc0c45dc2&nr=120760&linked=pm&Blank=1>

<sup>9</sup> BGH Judgment of 29 July 2021, I ZR 139/20 - Goldhase III

provision did not apply to trade marks that had been registered before 14 January 2019 or - as in this case - had acquired reputation and refrained from further examination.

- As regards both reputation and distinctiveness, the Federal Court of Justice referred to an expert's report of the plaintiff. According to this :

*"91.7% of all respondents were familiar with the color gold shown in connection with chocolate bunnies (awareness level). 75.8% of all respondents [were] of the opinion that the color indicates a very specific company in connection with chocolate bunnies (degree of identification). 72.3% of all respondents [spontaneously associated] the color gold shown in connection with chocolate bunnies with plaintiffs' company; 2.3% of all respondents [had named] other companies. <sup>10</sup>"*



For a distinctive character, which is necessary for the recognition of a sign ("Verkehrsdurchsetzung") that is not protectable per se as a trademark and which always has to be proven for color trademarks, the limit is 50%. The Federal Court of Justice now ruled that such a reputation, which is sufficient for "Verkehrsdurchsetzung", is "even more"<sup>11</sup> sufficient for a public recognition, i. e. the recognition of a trade mark purely on the basis of use.

In doing so, the Federal Court of Justice expressly acknowledged that in the aforementioned expert opinion the color was taken in isolation, i. e. without any other decorative elements, as the basis for the traffic survey.

- The Upper District Court had also assumed that the color mark was not being used as a trade mark because Lindt/Sprüngli was using the shade of gold in question virtually "across the board" for a large number of products. The Federal Court of Justice was unable to follow this:

*"The fact that a significant proportion of the relevant public associates 'Lindt-Gold' for chocolate bunnies with the applicants' company means that it can in principle be inferred that the color is also well known as an indication of origin."*

As a result, the case was remanded to the Superior Court for consideration of the violation.

Although the constellation of the case at hand is quite unusual - normally there is a registered trademark when proceeding from color trademarks - what is interesting above all is the aspect that a use mark was asserted here. If one follows the reasoning of the Federal Court of Justice, then in the case of "Verkehrsdurchsetzung", which must always be proven in the case of unconventional marks, there is almost automatically also a public recognition, i.e. a use mark. It remains to be seen to what extent this will play a role in subsequent disputes arising from unconventional trademarks.

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<sup>10</sup> Paragraph 38 of the decision

<sup>11</sup> S. Heading (b) of the decision

## The FCJ decision “Bewässerungsspritze II” (at the same time ECJ C-607/19 - Husqvarna) on the question of the time limit in trademark revocation proceedings

In the “Irrigation Injection II”<sup>12</sup> [decision](#) published a few days ago, the issue was how to calculate the five-year period in actions for forfeiture.

The dispute was based on trademark infringement proceedings in which the defendant had filed a counterclaim for cancellation due to non-use. What was now relevant for the decision was how the five-year period within which use of the trademark had to be proven was calculated.

The plaintiff as well as the District Court Düsseldorf were of the opinion that the period would be calculated on the basis of the filing of the (counter)action. This was 2015, so that the (indisputably last) use until May 2012 would render the action ineffective. However, the Düsseldorf Upper District Court assumed that the period was decisive on the basis of the latest oral hearing in the appeal proceedings. This was in October 2017, i.e. the trademark would then lapse - this was also the court's ruling, but it allowed the appeal.

The Federal Court of Justice now suspended the proceedings and referred the question to the ECJ. In its decision<sup>13</sup>, the ECJ now clarified that the time of filing the action was. As a result, the Federal Court of Justice dismissed the action for cancellation.

As a result of the Trade Mark Law Modernisation Act<sup>14</sup>, which will come into force in 2019, revocation proceedings will also be conducted before the DPMA instead of only before the courts as before and it can be assumed that, with the exception of counterclaims, as in the previous case, most revocation proceedings will

### 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). If the pandemic situation allows, these 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 primarily 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](mailto:eqe@mhpatent.de).

<sup>12</sup> BGH, Judgment of 22 July 2021 - I ZR 212/17 - Bewässerungsspritze II

<sup>13</sup> ECJ, Judgment of 17 December 2020 - C-607/19 - Husqvarna, cited in GRUR 2021, 613.

<sup>14</sup> S. our [newsletter 1/2019](#)

be office actions in the future. Even if the ECJ has not explicitly commented on this, it can be assumed that, by analogy, the time of filing the application will also determine the five-year period.

Applicants or counterclaimants must therefore, from a strategic point of view, determine well the date on which they will act, since they will thus irrevocably determine the period during which the trade mark proprietor must have used his trade mark.

## 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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