



# Newsletter Edition 2/2023

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starts on June 1, 2023

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The return of the BIG MAC

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estoppel period in the case of  
forfeiture? - BGH HEITEC III

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 T T O R N E Y S

# Germany ratifies the UPC - unitary patent system starts on June 1, 2023

In a [press release](#) dated February 17, 2023, the Ministry of Justice announced that Germany has ratified the UPC and that the unitary patent system will thus begin as planned<sup>1</sup> on June 1, 2023.

Germany's ratification was the last necessary step after all other requirements had already been fulfilled for some time. The deposit must be made with the EU, although there is still no entry on the official [site](#), but this will certainly be the case soon.

With the deposit of Germany, the so-called "sunrise period" begins on March 1 as planned,<sup>2</sup> during which some preparatory actions become possible, especially:

- Early application of "opt-outs" which, if applied for in due time (correctly), then become effective when the unitary patent system comes into force
- Registration as a representative (for both legal and patent attorneys); and
- For patent attorneys, request "grandfather" recognition of existing certificates as EPLCs.<sup>3</sup>

The forthcoming entry into force of the unitary patent system in Europe marks the beginning of a new era for patent law - regardless of one's opinion of the new system - and all those involved in patents, whether as applicants, inventors, patent attorneys or attorneys-at-law, or simply as industrial companies that have to observe third-party property rights, will have to adjust to the new situation. The impact of this goes far beyond Europe; in terms of importance, the unitary patent system is on a par with the "America Invents Act" of 2011 or the creation of the European Patent Office in 1973, exactly 50 years ago.

## The return of the BIG MAC

Author: Dr. Rolf Claessen

McDonalds International Property Company has recently won the appeal against the EUIPO's decision to cancel the EU trademark BIG MAC for revocation. The appellant had submitted 14 additional annexes in addition to the 5 annexes submitted in the first instance in response to the list of homework that the first instance had established in its decision. The main points can be summarized as follows:

- No sufficient evidence of use from third party publications
- Material that is at least partially outside the relevant time period and does not show the goods and services claimed or the mark
- Insufficient sales figures in the EU member states to support the figures from the affidavits
- Some evidence related only to the USA and could therefore not be included
- No visitor numbers for the website

In the grounds of appeal, McDonalds addressed all these points in detail and submitted additional evidence of use. It is surprising that this evidence was only

### In Our Own Affairs

For the 15th time, our office is offering two free two-day preparatory courses for the C and D parts of the European Qualifying Examination (EQE) in 2023. The courses will take place on Monday/Tuesday, November 20/21, and Saturday/Sunday, December 9/10, 2023. Both courses are identical in content, so attending 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 Kaistrasse 16A and are free of charge. Speakers of the course are Dr. Torsten Exner, Dipl.-Ing. Andreas Gröschel and Prof. Dr. Aloys Hüttermann.

Registration is now possible (please state your full name and employer) at [eqe@mhpattent.de](mailto:eqe@mhpattent.de).

Prof. Dr. Aloys Hüttermann is moderator of a panel on "Injunctions" at the 30th [Fordham IP Conference](#) on April 13-14 in New York.

<sup>1</sup> S. our newsletter [10/2022](#)

<sup>2</sup> See our newsletters [10/2022](#) and [4/2022](#)

<sup>3</sup> S. our newsletter [3/2022](#)

accepted at this late stage, as it could have been submitted in the first instance. The decision in appeal case R 543/2019-4 extends over 61 pages and provides readers with very detailed advice on which mistakes to avoid when filing proof of use for trademarks.

It remains to be seen whether the opposing Supermac's (Holding) Ltd, Ireland, will challenge this decision and whether it may also challenge the subsequent trademark application EUTM 017305079, as the repeated filing of an identical trademark to circumvent the obligation to use constitutes an act in bad faith (R 2108/2018-2).

## What is sufficient in Germany to interrupt the estoppel period in the case of forfeiture? - BGH HEITEC III

Author: Dr. Rolf Claessen

After the BGH (German Federal Court of Justice) had already laid down quite clear rules on forfeiture, inter alia in the HRD ROCK CAFE decision, as to which specific acts may be forfeited in the case of the use of another's trademark for goods and services, the BGH in this now recently issued decision sets out rules for interrupting the period of acquiescence in the case of forfeiture. An action which is served on the other party only more than 5 years after a cease & desist letter cannot interrupt the estoppel period.

The foreign plaintiff had initially not paid an advance on costs for the lawsuit that was initially filed some 3 years later and then, after payment of the advance on costs, had first filed claims in the original, but these did not correspond to the originally filed claims. It then took a total of more than one and a half years to remedy the deficiencies in the lawsuit, which was originally only submitted by fax, with the result that the lawsuit was served on the defendant more than five years after the cease & desist letter. Accordingly, the BGH was then also unable to find a basis for all subsequent and ancillary claims.

The BGH takes a hard line with the plaintiff in this decision. Even in the guiding principles, the lack of diligence on the part of the rights holder is addressed. In addition, the BGH states in this decision that an offer of settlement made by the defendant can only interrupt the period of acquiescence if the right holder indicates willingness to enter into negotiations, which was not the case here.

### In Our Own Affairs

Dr. Storz will give a lecture on "The Covid Patent Complex or: Experiencing History in Real Time Once in a Lifetime" on April 26, 18:00 in the House of the University of Düsseldorf as part of the Düsseldorf Workshop Talks.

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

### Impressum:

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