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DIPARTIMENTO DI ENERGIA

New revocation and invalidity proceedings in Europe / Germany

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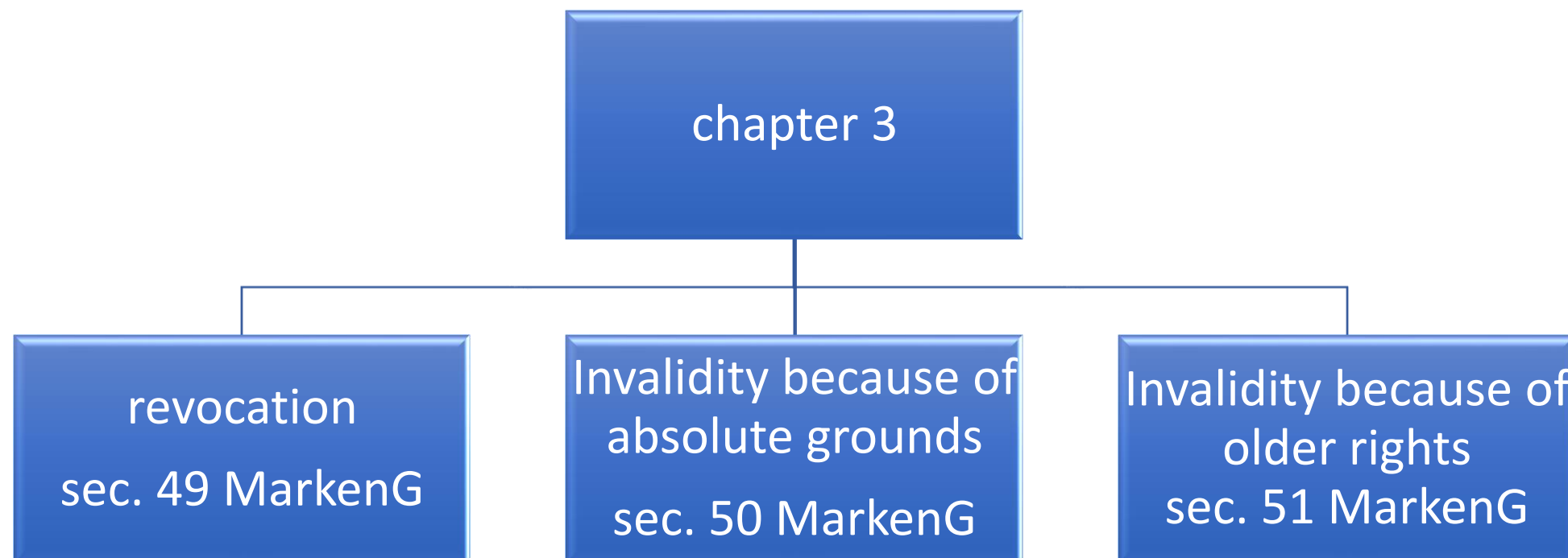
EU directive 2015/2435 is the basis

- 1) New proceedings in front of office
- 2) Observation by third parties during examination proceeding
- 3) Different other changes to scope of protection and exemptions (not of interest here)

Germany has splitted proceedings in many IP-laws

- 1) In former times (and in patent law) the proceeding for invalidity was separated from the infringement proceedings
- 2) Since 01.05.2020 new proceedings for invalidity and revocation in front of office
- 3) Sec. 55 MarkenG: However, action to a court is still possible, but not parallelly (however, switch of proceedings possible)

This structure is easy



The rules are easy – part. 1

- 1) Applicable for German trademarks but also of international registrations
- 2) Possibility for court action (not for collective and certification marks)
- 3) Or: office proceedings

The rules are easy – part. 2

- 4) Possibility to appeal decisions of the office Federal Patent Court (BPatG)

- 5) Invalidity proceeding because of absolute grounds more or less unchanged

here: No court proceedings possible

The rules are easy – part. 3

- 7) Possibility to include third parties (possibility to join dispute as a third party): Deadline: 3 month e.g. after cease-and-desist letter
- 8) Parties outside EU / EWR may have to provide security
- 9) Decision also has validity for successor in title regarding the trademark in question (sec. 325 German Civil Procedure Act)

Some details

- only if owner opposes **within 2 months** (from the date of notification of the invalidity application), proceedings start – otherwise declaration of invalidity ex tunc
- even if opposition proceedings are pending: invalidity proceedings are admissible
- Unlike in opposition proceedings, the 'moving use period' continues to exist in invalidity proceedings; if the grace period for use expires only during the invalidity proceedings, proof of use of the earlier mark within the five years preceding the decision must be provided upon objection by the proprietor of the challenged mark. This will lead to increased recourse of the invalidity (but also revocation) proceedings.

Increased need for advice - far-reaching strategic decisions

- lower cost threshold for Office proceedings, but no reimbursement of costs (e.g. official fee for invalidity application EUR 400,- as well as EUR 500,- for appeal to the BPatG)
- no obligation to appoint a lawyer before the Office
- However, in the case of successful legal action, reimbursement of court fees and essential attorney fees can be obtained.
- Eased burden of proof to prove right-preserving use in Office proceedings (sworn affidavit is sufficient). But beware: stricter burden of proof applies in court proceedings.

Further aspects ...

- provocation of official revocation proceedings in case of opposition
- (as known from EU trademarks): owner of earlier trademark(s) will have to weigh the filing of an opposition more carefully: trademark subject to compulsory use is not only exposed to the defense of non-use, but there is the threat of total loss via the low-cost counterattack of invalidity proceedings in front of Office



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Thanks for your attention!

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