Prinz & Partner
PATENTANWÄLTE RECHTSANWÄLTE

Client Information | November 2016

UNITY OF COURT RULINGS REGARDING PATENT INFRINGEMENT EVEN WITHOUT A UNIFIED PATENT COURT?

MARKETPLACE OPERATORS HAVE A SHARED RESPONSIBILITY FOR IP RIGHTS INFRINGEMENTS ON THEIR PREMISES

A WORD IN A PERSONAL MATTER: OUR NEW INTERNET APPEARANCE

Jochen Sties and Dr. Alexander González

Europe-wide unity of court rulings regarding patent infringement even without a Unified Patent Court?

The Federal Court of Justice (BGH) continues to work on harmonizing court rulings in the field of patent infringement within the EU.

The judges of the courts within the EU who focus on or are exclusively concerned with the legal validity and the infringement of patents aim at reaching as uniform a decision on identical facts of cases as possible. This is put to practice in that, should a judgment of a higher instance already exist in regard to the same facts and circumstances, the judges will deal with this judgment and – insofar as is compatible with the national legal system – will rule similarly. If a similar decision is not possible, a detailed explanation is given in some cases as to why the court had to rule differently.

The Federal Court of Justice added a further building block to this trend in a recent decision (X ZR 29/15 of 14 June 2016; "Pemetrexed").

It is common practice in many countries – for example in the United Kingdom, in France and in the Netherlands – to make a very detailed analysis of the grant procedure when construing the claims.

In Germany, on the other hand, it has been basically assumed that a claim should be construed exclusively on the basis of the printed patent specification. Only if an opposition or nullity procedure had taken place and the patent owner had made statements there vis-à-vis the later defendant relating to the scope of protection has the patent owner to accept these statements against him under the aspect of good faith.

The Federal Court of Justice has now pointed out in the aforesaid decision (taking up a rather incidental statement made in a decision from the year 1997) that not only statements made by the applicant can be made use of for construing a claim, but also statements made by the examiner, more specifically as an indication of how the claims are to be understood.

Even if statements made by the applicant and/or the examiner are merely referred to as an indication of construing the claims, the trend is clear: In patent infringement proceedings a look into the grant file will become necessary in Germany as well – as has long been known from proceedings in, e.g., the United Kingdom, France and also the Netherlands.

QUESTIONS?

If you have any questions regarding this topic, please feel free to get in touch with your personal contact or Jochen Sties at (j.sties@prinz.eu).

The European Court of Justice decides that marketplace operators have a shared responsibility for intellectual property rights infringements on their premises

The European Court of Justice has decided in a precedent-setting judgment (legal matter C-494/15) that the lessors of market halls will in future be obligated to prevent the infringement of intellectual property, in particular of trademarks, designs and patents, by the stall operators.

The decision was based on a number of actions brought by the owners of the fashion brands "Tommy Hilfiger", "Lacoste" and "Burberry" against the operator of the "Prague market halls". Stallholders had regularly sold counterfeit goods in the market halls. The aim of the plaintiffs was to obtain a decision that Delta Center, which lets market stalls, is itself required to take steps against the repeated trade-mark infringements. The Czech Supreme Court presented the issue of liability of the market operator to the European Court of Justice for a decision.

In the decision that has now been issued, the European Court of Justice made it clear that the lessors of sales areas in which traders or stall operators renting such sales areas offer counterfeit goods have to be considered intermediaries within the mean-

ing of the EU Enforcement Directive 2004/48/EG and are therefore basically liable for such intellectual property rights infringements.

This liability of intermediaries had already been confirmed several times in the past by the European Court of Justice and the Federal Court of Justice for operators of online marketplaces such as eBay. What is new is the clarification that the lessors of physical market premises also must proceed against such intellectual property rights infringements. According to the principles established by the ECJ, the measures to be taken by the market hall operators have to be effective and dissuasive, but also proportionate and reasonable and must not result in any excessive barriers to legitimate trade. A general and continuous supervision of all tenants can not be demanded. But when a market operator becomes aware of infringements of a particular property right, he will in future be forced to take reasonable measures to prevent new parallel infringements.

The wording of the decision of the European Court of Justice relates to the liability of only one marketplace operator, namely the operator of the "Prague market halls". But since the European Court of Justice explicitly expands the general principles that apply to market operators in the online trade to include stationary sales platforms here as well, it should be assumed that the judgment also concerns trade fair organizers and lessors of other sales areas.

QUESTIONS?

If you have any questions regarding this topic, please feel free to get in touch with your personal contact or Dr. Alexander González at (a.gonzalez@prinz.eu).

A word in a personal matter: our new Internet appearance

Prinz & Partner has a new Internet appearance as of October of this year. Some six years after the latest relaunch we have given our website a complete makeover and now present ourselves with a new and modern design. We are looking forward to your visit to www.prinz.eu!

Prinz & Partner mbB
Rundfunkplatz 2
80335 München

Telephone: +49 (0) 89 / 59 98 87-0
Telefax: +49 (0) 89 / 59 98 87-211
Email: info@prinz.eu