



# Newsletter March

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## Lack of intention to use in trademark law – the FCJ decision „Da Vinci“ (I ZR 46/19) and the ECJ decision „Sky/SkyKick“ (C-371/18)



**In its decision „Da Vinci“ of 23 October 2019 (I ZR 46/19), the First Civil Senate of the German Federal Court of Justice (FCJ), which is responsible for trademark disputes, held that it could be contrary to the principles of good faith if a trademark owner claims only a formal legal position when asserting claims for contractual penalties. The FCJ continues and clarifies with that decision its case law on so-called „speculative trademarks“ (FCJ, judgment of 23 November 2000, I ZR 93/98, e.g. GRUR 2001, 242 - Classe E). Furthermore, in the eagerly awaited decision in the case „Sky/SkyKick“ (C-371/18), the ECJ decided on 29 January 2020 that a lack of intention to use a trademark could also constitute bad faith within the meaning of Art. 59 (1) (b) EUTMR.**

1. In the „Da Vinci“ case, the FCJ had to decide on the question of a claim for contractual penalties asserted by the owner of the EUTM 005631304 („Da Vinci“). The plaintiff was the proprietor of altogether 12 registered German and EU trademarks, each bearing the name of famous artists. The trademarks were registered for a wide range of different goods and services. The plaintiff warned the defendant based on EUTM 005631304 („Da Vinci“), because the defendant offered a salt lamp under the designation „Davinci“ on the internet trading platform eBay. The defendant terminated all offers and auctions immediately after receipt of the warning letter and signed a cease and desist declaration subject to a penalty clause. Shortly thereafter, the plaintiff determined two offers by the defendant for one of the Da Vinci lamps in dispute, which had already ended. The

offers could still be viewed on eBay by searching for the article numbers. Following the plaintiff's request, the defendant had deleted these offers. Subsequently, the plaintiff requested the defendant to pay a contractual penalty, the payment of which the defendant refused. Each the Regional Court and the Higher Regional Court of Dusseldorf rejected the plaintiff's claim. The FCJ also dismissed the appeal on points of law against the judgment on appeal in its decision of 23 October 2019.

2. In its decision, the First Civil Senate stated first that the question whether the assertion of a contractual penalty pursuant Sec. 339 sentence 2 German Civil Code (BGB) in conjunction with an agreement to cease and desist was abusive of the law, was governed by the general principles of good faith pursuant to Sec. 242 BGB.

Furthermore, it was to be examined in the context of an overall assessment whether the behavior of the person issuing the warning before, during and after the warning justified the conclusion that the assertion of the contractual penalty claim was contrary to good faith (para. 6).

3. According to the First Civil Senate, it could be contrary to the principles of good faith if the owner of a trademark claimed only a formal legal position. In continuation of the „Classe E“ decision (e.g. GRUR 2001, 242) and the „Goldbaer“ decision (e.g. GRUR 2015, 1214), the First Civil Senate held that an abusive exploitation of a formal legal position must be assumed if a trademark owner cumulatively

- applied for a large number of trade marks for different goods and services;
- had no genuine intention to use the trademarks in question, in particular to use in its own business or for third parties on the basis of an existing or potential or specific consultancy concept, and
- the trademarks are essentially hoarded for the purpose to seek injunctive relief and damages from third parties who use identical or similar designations (para. 7).

4. The First Civil Senate considered these requirements to be fulfilled in the present case. In addition to the applicant's trademark, the plaintiff has applied for further 11 trademarks covering a wide range of goods and services in various sectors. No concept of use of the marks was apparent (para. 9 et seq.).

In the „Classe E“ decision (e.g. GRUR 2001, 242, 244), the First Civil Senate already stated that a general intention to use the trademark was a general requirement for protection of a trademark, which resulted from the nature of a trademark as a distinctive sign. The intention to use the mark must exist independently of the five-year grace period for use under Sec. 25 (1) German Trade Mark Act (MarkenG) or Art. 18 (1) EUTMR. The grace period for use was merely a rebuttable presumption of such an intention. What was required from the outset

was a general willingness on the part of the trademark owner to use the trademark as a sign in the course of business by himself or to allow a third party to use it, either by way of a licensing or following an assignment. Thus, a general intention to use was also given, for example, by advertising agencies or brand designers who created brands in the context of an existing or potential consultancy service in order to make them available to their customers for their specific marketing needs.

In its decision of 23 October 2019 (para. 9), the First Civil Senate now specified that in such a case the trademark owner had an increased secondary burden of proof. He must describe the considerations behind the trademark application and must disclose the marketing efforts made and the successes achieved in each case within the bounds of reasonableness.

5. The plaintiff did not comply with this obligation. It was only in the appellate instance that the plaintiff submitted license agreements, which the Higher Regional Court of Düsseldorf rejected as inadmissible new submissions within the meaning of Sec. 531 (2) German Code of civil Procedure (ZPO). Contrary to the plaintiff's arguments, the Court of First Instance was not obliged to make a reference in that regard. A judicial reference, the First Civil Senate continued, was regularly unnecessary if the party had already received the required information directly from the other party (para. 14). In its statement of defense, the defendant had already submitted substantiated arguments on the plaintiff's lack of intention to use the trademark and its abuse of rights.

6. The FCJ also refused to refer the legal question to the ECJ under Art. 267 (3) TFEU, because the subject matter of the dispute was not claims arising from a EU trademark, but solely claims based on a cease and desist agreement between the parties within the meaning of Sec. 339 sentence 2 BGB. Such an agreement constituted an independent ground of guilt, even if it was concluded in response to a warning letter concerning an alleged infringement of an EU trademark (para. 15).

7. In this context, the ECJ also decided in the „Sky/Sky-Kick“ case (C-371/18) on 29 January 2020 that a trade-



mark application made without any intention to use the trademark in relation to the goods and services covered by the registration constituted bad faith within the meaning of Art. 59 (1) (b) EUTMR if, alternatively

- the applicant for registration of the trademark had the intention of undermining, in a manner inconsistent with honest practices, the interest of third parties, or

- the applicant for registration of the trademark had the intention of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trademark.

8. The ECJ decision provides a wide scope for a wide range of applications. The reference for a preliminary ruling from the UK High Court of Justice was based on a dispute between the pay-tv provider Sky and the software service provider SkyKick. SkyKick defended itself against the alleged infringement of several of trademarks of Sky which were still in the grace period for use by means of a counterclaim for invalidity, arguing that Sky generally lacked the intention to use the its trademarks for the goods and services partially claimed by these trademarks, in particular for „computer software“ and for various „internet services“.

9. There is no exact definition of the term „bad faith“ in the context of Sec. 8 (2) No. 14 MarkenG or Art. 59 (1) (b) EUTMR. In the decision „Lindt & Sprüngli/Franz Hauswirth“ (e.g. GRUR 2009, 763), the ECJ stated that in order to determine whether the applicant of trademark is acting in bad faith it must be taken into consideration all the relevant factors specific to the particular case which pertained at the time of filing the application for registration of the sign as a trade mark, in particular:

- the fact that the applicant knows or must know that a third party is using, in at least one Member State, an identical or similar sign for an identical or similar product capable of being confused with the sign for which registration is sought;

- the applicant's intention to prevent that third party from continuing to use such a sign; and

- the degree of legal protection enjoyed by the third party's sign and by the sign for which registration is sought.

10. However, the list of circumstantial evidence established by the ECJ is not exhaustive. As a further example of a trademark application in bad faith the European General Court also regarded the filing strategy of filing national trademark applications in succession without paying a filing fee and with the purpose of obtaining a blocking position in order to oppose EU trademark applications of identical or similar signs by third parties on the basis of the priority of the national trademark application (cf. EGC, judgment of 07 July 2016, T-82/14 - Copernicus-Trademarks Ltd/EUIPO, e.g. GRUR-Prax 2016, 373).

Thus, the catalogue of circumstantial evidence now established by the ECJ in the „Sky/SkyKick“ decision (C-371/18) extends the application for a declaration of invalidity due to the applicant acting in bad faith in the event that the applicant of the trademark has no intention to use it.



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## „Duty of the court to give information“



**In the case of „Pizzaschmelz“, the Federal Court of Justice (Bundesgerichtshof) made an order on 14.11.2019, file number: I ZR 89/19, commenting on the extent of the court’s duty to inform the parties. Pursuant to § 139 (1) sentence 2 of the German Code of Civil Procedure (ZPO), the Court of First Instance must ensure that the parties declare in good time and in full all relevant facts, in particular that they provide sufficient information on the facts relied upon, describe the evidence and make the relevant applications. Failure to do so constitutes an infringement of the duty of the Court of First Instance to provide information and thus a procedural error leading to the setting aside of the judgment.**

The appellant in the present case lodges claims based on a Union trade mark ‚Pizzaschmelz‘, filed on 19 February 2014 and entered in the register for, inter alia, the following goods: ‚Cheese; vegan cheese; cheese based on vegetable fats‘.

The defendant uses the designation „Pizzaschmelz“ for vegan pizzas. At first instance before the Düsseldorf Regional Court, the defendant filed a counterclaim for a declaration of invalidity of the Union trade mark „Pizzaschmelz“ pursuant to Article 128 UMV on the ground that the trade mark was devoid of any distinctive character for the above-mentioned goods in the German-speaking area (Article 7 (1) b) UMV). The Regional Court followed this argumentation, declared the Union trademark „Pizzaschmelz“ invalid for the goods: „cheese; vegan cheese; cheese based on vegetable fats“ and dismissed the action.

At the appeal instance before the Düsseldorf Higher Re-

gional Court, the plaintiff stated for the first time that the Union trademark „Pizzaschmelz“ had acquired distinctiveness through use (Art. 7 (3) UMV). In this respect, the applicant stated that it was represented throughout Europe with the product „Pizzaschmelz“ and supplied food retailers, industrial processors and the catering trade in 22 countries. The product „Pizzaschmelz“ was the first product of its kind in 2011. The plaintiff was able to establish it in the German food trade throughout the country in a very short time. From there, the „Pizzaschmelz“ quickly reached large parts of Europe. Many consumers are familiar with the brand „Pizzaschmelz“. The prominent television chef S. W. held the plaintiff’s „Pizzaschmelz“ in her camera, and the Grimme Prize winner J. B. shared a photo of the branded product „Pizzaschmelz“ on Twitter. The defendant did not contest this presentation.

The Düsseldorf Higher Regional Court dismissed the plaintiff’s appeal, stating in particular that the plaintiff’s

trademark had not acquired distinctive character through use. The applicant had not submitted sufficiently substantiated arguments concerning the acquisition of distinctiveness through use. It failed to provide concrete information on the duration and scope of use, market shares and advertising expenses. There was also no information on the extent to which the designation „Pizzaschmelz“ had been used as a trademark and not merely descriptively. The Düsseldorf Higher Regional Court had not informed the applicant that, in its view, its submissions on the alleged acceptance by the public were not sufficiently substantiated.

The Federal Court of Justice considered this to be a violation of the court's duty to provide information under § 139 (2) ZPO. In the absence of any indication from the court, the applicant did not have to reckon with the fact that its submission on the acceptance of the claimed trademark by the public would not be considered sufficiently substantiated by the Court of Appeal. The applicant's argument concerning distinctiveness acquired through use was not a priori unsuitable to demonstrate that the applicant's mark had acquired distinctiveness through use. For this reason, the Düsseldorf Higher Regional Court had to point out that, in its view, the submission was not substantiated. Since this had not been done, the judgment on appeal had to be set aside and the case had to be referred back to the Court of Appeal for a new hearing and decision.

If the applicant's submissions had been unsuitable from the outset to show that the trademark had acquired acquired distinctive character through use, the Court of Appeal would obviously not have had to give any indication. The question whether or not the court must give an indication may not always be easy to answer. The author understands the decision to mean that in case of doubt it is more likely that the court should give an indication, which is to be welcomed in the interests of fair proceedings.



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in the category „Patents“ in Germany

## Curing of a formally ineffective enforcement in foreign countries

**The EU-foreign defendant has to bear the costs of the injunction proceedings even if he submits a cease-and-desist declaration with penalty clause before the preliminary injunction is served and the service is ultimately not effected. This was decided by the Düsseldorf Higher Regional Court in its order of 16.07.2019, file number I-20 W 59/19, printed e.g. in GRUR-RR 2020, p. 45 et seq.**

The decision was based on the following facts:

The defendant, which is domiciled in Great Britain, was warned by the applicant for an infringement of competition law. Thereupon, the applicant obtained a preliminary injunction based on para. 4 No. 3 of the German Unfair Competition Act on 9 June 2017. After receiving the injunction on 13.06.2017, the applicant applied within a few days for service in Great Britain. On 07.08.2017, the court registry sent the translated order to the defendant by registered letter with acknowledgement of receipt, whereby the application for preliminary injunction had not been translated.

The defendant submitted a cease-and-desist declaration with penalty clause through its representatives by letter on 09.08.2017. On 10.10.2017, the defendant filed an objection against the preliminary injunction. The objection was based on the fact that the injunction had not been effectively served because the form pursuant to Annex II to the Brussels I Regulation and a translation of the application were missing. In addition, there had been no return receipt and the application had been signed illegibly.

After both parties mutually declared the proceedings to be settled, the Regional Court ordered the defendant to bear the procedural costs in accordance with para. 91 a ZPO. The respondent filed an immediate appeal against this decision.

According to the Higher Regional Court of Düsseldorf, it is not relevant for the consequence of costs whether the service was actually effected, but whether it was still required to be executed at the time of execution.

First, however, the Higher Regional Court found that the notification in the present case was in fact ineffective because of the lack of a form pursuant to Annex II to the Brussels I Regulation. But according to the case law of the European Court of Justice, this lack of service can be remedied by submitting the form subsequently.

In this respect, the Higher Regional Court also clarified that a lack of acknowledgement of receipt does not result in the ineffectiveness of the service, as this only serves as proof of service and does not constitute a requirement for effectiveness. Furthermore, it was not necessary to enclose the translated application in order to grant the right to be heard or to establish equality of arms, since the court had given detailed reasons for the injunction.

Crucial was, however, that - regardless the possibility of curing - the enforcement of the injunction was no longer necessary. According to the prevailing opinion, enforcement is dispensable in particular if the claim to injunctive relief has been settled by a sufficient declaration of cease-and-desist. This requires that either the declaration of cease-and-desist is made within the time period for enforcement or that the applicant has at least undertaken the necessary steps for enforcement within the time period for enforcement.

In the relevant case, the applicant had taken all the necessary steps within the enforcement period by requesting service abroad from the competent Regional Court. In case of international service, it is generally acknowledged that the service itself does not have to be effected within the deadline for enforcement, it is sufficient if the applicant requests the court in due time to serve the preliminary injunction abroad.

Furthermore, the Higher Regional Court did not consider it to be detrimental to the urgency of the case that the applicant had not served the injunction on the extra-judicial counsel and that the application had not been translated. None of these actions had been necessary. From this, it cannot be concluded that the applicant was not intending to effectively enforce its claims. In particular, the missing translation could have been made up for without any significant delay.

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## World Trademark Review TOP TM Professionals:

„Preu Bohligh & Partner is resolutely committed to ensuring that its patrons enjoy maximum commercial success out of their intangible assets – and has been doing so since 1959. It deploys 21 seasoned IP professionals out of three bases in Berlin, Dusseldorf and Munich, as well as a branch in Paris, to defend brands from every angle. Alexander Harguth is a key contact for the address book.“



## On the international competence of courts and the targeting on a domestic market by exhibition on a trade fair; OLG Frankfurt a. M. - World's lightest



**In its decision of 14.02.2019, the Higher Regional Court (OLG) Frankfurt a. M. ruled that German courts possess international competence in competition matters for advertising statements at an international trade fair (held in Germany), even if the advertised product is not offered and distributed in Germany by the manufacturer. The advertising statement is, nonetheless, targeted on the German market. The decision of the OLG Frankfurt a.M. is published in GRUR-RR 2020, 74 - World's Lightest.**

In competition law, one often has to raise the question, whether actions / events at international trade fairs are directed at the German market or at least evoke the risk of an imminent infringement in Germany. These questions may also be relevant for the international competence of German courts.

The decision of the OLG Frankfurt a. M. was based on the following facts:

The plaintiff and the defendant both manufacture and distribute bags and trolleys. The defendant has its registered office outside of Germany. At its booth at an international trade fair held in Germany, the defendant advertised a cabin trolley as being the „world's lightest“. However, undisputedly there are lighter competing products on the market. The defendant does not offer the cabin trolley in dispute in Germany.

The plaintiff requested that the defendant be prohibited from advertising the cabin trolley as „world's lightest“ in Germany.

The Higher Regional Court of Frankfurt a. M. affirmed the international competence of German courts in accordance with Art. 7 No. 2 Bruxelles I-Directive. In the opinion of the court, an exhibition at a trade fair, as a rule, shall, have an intended effect at least on the respective country in which the fair is held; irrespective of whether it is a consumer fair or an international trade fair. Whether an infringement actually occurred in Germany is a so called double relevant fact and thus has to be assumed in the context of the jurisdictional test (paras. 21 and 22 of the decision).

Since the plaintiff only attacked the defendant's „advertising“ in Germany (and not other subsequent acts such as „offering“ or „selling“) and since there was indisputably such advertising by the exhibition at the fair, the court argued that there was a risk of repetition of the infringing advertisement in Germany.

Further, there was also a sufficient connection of the challenged act to the German market, even though the

defendant did not offer the advertised products in Germany. In the eyes of the court, there remains a possibility that third-party traders may offer the defendant's products in Germany to retailers in Germany who have previously seen the defendant's trade fair stand. In those circumstances, misleading advertising at the trade fair could also influence a domestic purchase decision (of the retailers in Germany) (paragraph 39).

The decision of the OLG Frankfurt a.M. shows that the wording of an injunction request is decisive for the successful enforcement of a claim in competition law. In the prior judgements „Pralinenform II“ (GRUR 2010, 1103), „Keksstangen“ (GRUR 2015, 603) and „Mart-Stam-Stuhl“ (GRUR 2017, 793), the German Federal Court of Justice (BGH) ruled that exhibiting a product at an international trade fair (held in Germany) would not automatically constitute (the risk of) an „offering“ to consumers in Germany.

In the „Pralinenform II“ decision, the BGH, however, also stated that exhibiting a product at a trade fair could, generally constitute an „advertising“ of the product (in Germany). However, in that case the plaintiff had not requested that the „advertising“ be omitted. Rather, the request was aimed at prohibiting the defendant from „offering“ the product. Since the BGH held that there was no „offe-

ring“, the claim had to be dismissed.

In the decision „Industrienähmaschinen“ (GRUR 2019, 196), the BGH affirmed an „offering“ when exhibiting a product because an employee of the defendant had, upon request, declared at the trade fair that the product could also be delivered to Germany. If, however, there is no proof for an „offering“ in Germany, the injunction request should be limited - as in the OLG Frankfurt a.M. case - to refrain from „advertising“, only.



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## Who's Who Legal Germany Patents 2020

**Andreas Haberl** of Preu Bohlig & Partner is recognised as a significant figure in the German patents arena and is highly experienced when it comes to infringement litigation and parallel validity proceedings.

**Axel Oldekop** is a well-regarded patents lawyer who gains recognition in this year's research for his excellence in infringement litigation and validity cases.

## „Electrical and Electronic Equipment Act as market conduct regulation?“

**In its ruling of July 25, 2019, the Higher Regional Court of Frankfurt am Main, reprinted e.g. in GRUR-RR 2020, p. 25 et seq., in interim injunction proceedings considered the provision of § 9 (2) ElektroG to be a market conduct provision within the meaning of § 3a UWG. As a result, companies that violate this provision can be sued under the UWG (Act against unfair competition).**

According to § 9 (2) ElektroG, electrical appliances must be permanently marked with the symbol of a crossed-out wheeled bin shown below:



The defendant in the proceedings put a lamp, i.e. an electrical appliance, on the market which did not bear this symbol on the product itself. In doing so, the defendant had violated the provision of § 9 (2) ElektroG.

The applicant was a competitor of the defendant. It applied for a temporary injunction prohibiting the defendant from marketing lamps which did not display the symbol in question. Whether or not that application could be granted depended on whether or not the provision of Paragraph 9(2) of the ElektroG constituted a market conduct provision within the meaning of Paragraph 3a of the UWG.

This is disputed in case law. First of all, it must be taken into account that regulations that serve to protect the environment are generally not market conduct regulations (BGH, GRUR 2015, 1021, marginal no. 15 - headphone labelling). In a judgment of 20 February 2015, the Higher Regional Court of Cologne took the view that the Elektrogesetz pursues primarily waste management objectives in accordance with its legislative purpose, so that a market conduct regulation within the meaning of § 3a UWG would accordingly not exist. The fact that the environmentally sound use of natural resources would ultimately also avoid health risks for the consumer is not sufficient for the affirmation of a market conduct regulation. This connection applies to all regulations serving environmental protection (GRUR-RS 2015, 07009).

The Frankfurt am Main Higher Regional Court came to a different conclusion. The provision of § 9 (2) ElektroG indirectly serves consumer protection. The consumer could already recognize at the time of purchase from the symbol that he could not dispose of the product in household waste. In this information it has quite interest, because it is made clear to him that he must select another, usually more complex supply way. In addition, the legislator added the following sentence 3 to § 1 ElektroG with effect from 20 October 2015: „In order to achieve these waste management goals, the law should regulate the market behaviour of the obligated parties.“

With this reasoning, the Higher Regional Court of Frankfurt am Main assumed that the provision of § 9 (2) ElektroG would be a market conduct provision within the meaning of § 3a UWG. Accordingly, the Higher Regional Court of Frankfurt am Main - unlike the first instance - granted the application for a temporary injunction.

Anyone who thus wishes to make claims against a competitor under the UWG for a violation of § 9 (2) ElektroG should initiate such proceedings in Frankfurt. However, it does not follow from the decision that the other provisions of the ElektroG can also be regarded as market conduct regulations within the meaning of § 3a UWG. This must be examined separately in each individual case.



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## Protection of secrecy in civil proceedings

### Dealing with business secrets before German courts and in court proceedings is a difficult topic.

This already begins with the fact that in the protection of industrial property rights extensive claims for information are granted by the holder of the right against the infringer. However, there is no regulation on how the rightholder has to deal with the information once granted. There is therefore no limitation on the use of the information provided. The obligation to provide information is intended solely for the purpose of calculating damages. In fact, the recipient of the information may also use (misuse) this information about customers, production costs, supply chains, etc. of his competitor for any other purpose, for example to offer the competitor competition with this information or to entice away his customers. So far, the legislator has seen no reason to limit the possible uses. While data protection is written in capital letters everywhere, and there are restrictions on use and deletion obligations, the legislator is opening up a large data leakage at this sensitive point.

No less difficult is the handling of technical or commercial secrets during legal proceedings. It is true that there are rudimentary regulations in § 172 GVG, which regulate the exclusion of the public during the oral proceedings as well as the restriction of the inspection of files by third parties. Nevertheless, these provisions are not suitable to enable the protection of secrets and restrictions of use, especially vis-à-vis the opposing party.

In the GeschGehG, the legislator, based on the Directive, for the first time gave the courts the possibility to order reasonable and efficient secrecy measures. Thus, information can be classified as confidential and this information may not be used outside the proceedings or disclosed to third parties. The court may also restrict the access of litigants to such secrets.

Regrettably, the legislator has (without necessity) limited the scope of these standards to proceedings under the GeschGehG. Especially in patent litigation (and certainly in many other cases as well) these provisions are

therefore (for the time being) not directly applicable. It is true that the discussion draft of the 2nd Patent Law Modernisation Act (new § 145 a) provides that §§ 16 et seq. of the GeschGehG shall be applied accordingly in patent litigation. However, until its entry into force there are still no adequate legal rules on the handling of information requiring secrecy.

In practice, litigants have in recent years often proceeded in such a way that confidentiality agreements have been concluded between the parties during the proceedings. The obvious disadvantage of such a solution is that it is only possible voluntarily and does not work in practice if one party demands unreasonable conditions or the other party does not wish to submit to reasonable confidentiality conditions.

In some cases, it has happened that in the absence of such an in-process confidentiality agreement, one party has handed over documents requiring confidentiality to the court, while the other party has only been handed over blackened versions. It is obvious that this approach is not compatible with the right to a fair trial and the right to be heard.

This has now been confirmed in a recently announced decision of the Federal Court of Justice (BGH) of 14 January 2020 - X ZR 33/19 - Inspection of Files XXIV. The decision was based on facts in which one party had handed over complete documents to the court, but only blackened versions to the other party. The BGH considered this procedure to be inadmissible. The submission of documents is a procedural act which is in principle unconditional. Thus, the submission of annexes could not take place in such a way that the opposing party was granted access to a copy only on condition that a specific confidentiality agreement was concluded. The BGH stated that such conditionally submitted documents do not become part of the file and therefore the court cannot base its decision on them.

The decision did not further discuss the obvious question of whether the court may not take note of these documents either and must return/destroy them immediately. After all, the fair procedure and the right to be heard do not only require that these documents are not/do not formally become part of the file. The other party is of little help in claiming a fair trial if these documents are nevertheless read by the court and are physically present in a special booklet alongside the court file and, if necessary, are the subject of consultation.

This constellation thus demonstrates the urgent need for sensible legal regulations for dealing with secrets in civil proceedings so that such questions do not arise in the first place.



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## iam Patent 1000

Offering fantastic geographical reach, tremendous energy and a laser focus on finding the right arguments for any technical brief, Preu Bohligh & Partner is a firm whose reputation is flying high at the moment. With more than 50 years' experience, it enjoys tremendous name recognition in Germany for all the right reasons and continues to prosper despite the loss of some high-profile partners in recent years. Network technologies authority Alexander Harguth spends much of his time putting together outstanding case strategies that are much appreciated by clients. "He literally wrote the book on German patent litigation, which I happen to consult fairly regularly. He has a wonderful ability to explain the nuances of the German system in a way that makes legal sense to a non-German; just a truly outstanding attorney all round." Christian Donle's advocacy is just as prized – his classic, barrister-style pleading always hits the mark in court.

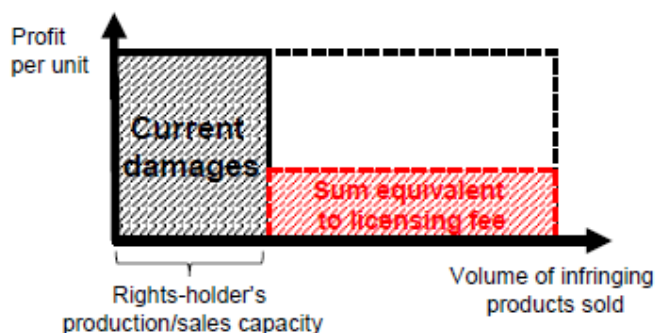
## Upcoming revision of the Patent Act and the Design Act (guest article by Sonderhoff & Einsele)

Due to the partial revision of the Patent Act and Design Act which passed the Diet in 2019, and as we reported on our website (<https://se1910.com/news/201905-patent-law-news/>), the following changes will be implemented on and after April 1, 2020.

### I. Revision of the Patent Act

#### 1. Calculation of damages caused by a patent infringement

Currently, it is not possible for a patentee to claim as damages a portion of the patent infringer's profits which exceeds the patentee's production capacity. According to the revised Patent Act, it will be assumed that the infringer had a license for said portion, and the patentee can claim damages corresponding to the license fee (Art. 102, Par. 1(2) of Patent Act).



Source: [https://www.jpo.go.jp/e/system/laws/rule/hokaisei/document/tokkyohoutou\\_kaiei\\_2\\_0190517/outline.pdf](https://www.jpo.go.jp/e/system/laws/rule/hokaisei/document/tokkyohoutou_kaiei_2_0190517/outline.pdf): „Outline of the Act“ by the JPO

For the calculation of the damages corresponding to the license fee, the court will consider a license fee which would have been negotiated on the presumption that there had been an infringement (i.e., possibly a higher license fee than that of a normal license agreement) (Art. 102, Par. 4 of Patent Act).

The same changes will also be made to the Utility Model Act, the Design Act and the Trademark Act.

### II. Revision of the Design Act

#### 1. Expansion of the scope of protection

Designs for graphical user interface (GUI) that are not stored or indicated on objects; e.g., images stored in a cloud and made available via a network or images projected on areas other than objects will be protected by the design right.

Also, designs for buildings such as museums or hotels, as well as interior designs will be protected as designs in order to encourage design investments which constitute a source of the company's competitive advantage (Art. 2 and 8bis of Design Act).



Source: „Revision of the Design Act in Japan - Contributing to innovation and branding - Revised in 2019“ by the JPO

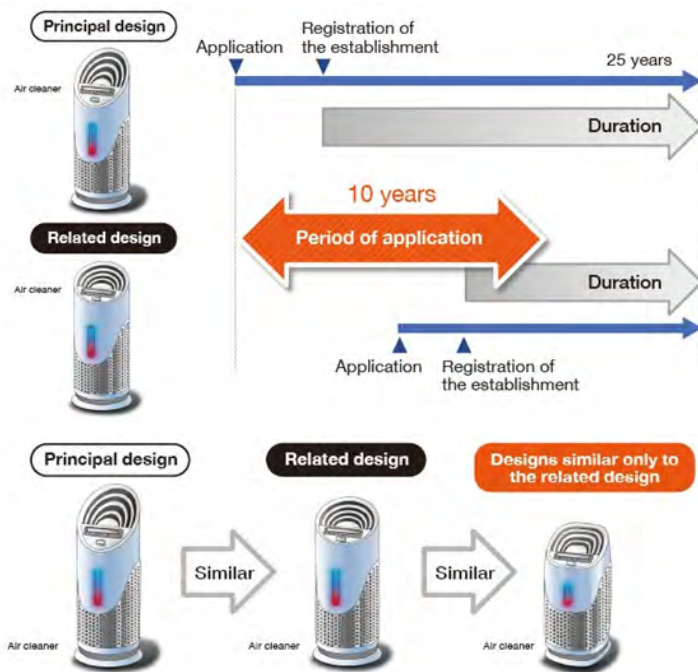
2. Enhancement of the related design system (system that allows the registration of designs that are similar to a design (principal design) in one's own design application or registered design) (Art. 10 of Design Act)

It will be possible to register multiple designs deve-

loped under a consistent concept. The new changes include the following:

a) The time limit for filing related designs will be extended to 10 years from the filing date of the principal design (currently, it is only until disclosure of the registered principal design; i.e., about 8 months from the filing date of the principle design); and

b) Registration of designs which are similar to related designs only will be possible.



Source: „Revision of the Design Act in Japan - Contributing to innovation and branding - Revised in 2019“ by the JPO

### 3. Change in the duration of design rights

The term is extended from “20 years from the date of registration” to “25 years from the filing date” (Art. 21 of Design Act).

### 4. Clarification of the level of creativity

Shapes, patterns, etc., or images published or made available through the internet will be considered in the determination of the creativity of a design (Art. 3 of Design Act).

### 5. Introduction of a partial design for a set of articles

Registration of a partial design for a set of articles such as the handle of a knife, fork and spoon in a cutlery set will be allowed (Art. 2 and 8 of Design Act).

### 6. Expansion of indirect infringement acts

By defining subjective factors such as “the knowledge that an object can be used for the working of a registered design”, actions such as the manufacture and import of disassembled individual parts which may constitute infringing products can be controlled as an “indirect infringement” (Art. 38 of Design Act).

Please also take a look at the pamphlet issued by the JPO regarding the revision of the Design Act:

[https://www.jpo.go.jp/e/resources/report/sonota-info/document/pamphlet/isho\\_kaisei\\_en.pdf](https://www.jpo.go.jp/e/resources/report/sonota-info/document/pamphlet/isho_kaisei_en.pdf)

We will keep you updated regarding the abovementioned revisions. If you have any questions, please do not hesitate to contact us.

### About us

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## Entry into force of further amendments to the Trade Mark Act on 1 May 2020

**As is known, on 14 January 2019 the German Trade Mark Act Modernisation Act (MaMoG) came into force in large part. The Act serves to implement the Directive (EU) 2015/2436 of 16 December 2015 to approximate the laws of the Member States relating to trade marks.**

On 14 January 2019, amendments regarding, inter alia, the unambiguous determinability of signs (sec. 3 Trade Mark Act), the new wording of sec. 3 (2) Trade Mark Act on shape-related trade marks, the introduction of further absolute grounds for refusal in sec. 8 (2) nos. 9 - 12 Trade Mark Act, the extension of the grounds for opposition in sec. 42 (2) no. 5 Trade Mark Act, the new regulation of the non-use objection and the calculation of the ten-year term of protection entered into force.

On 1 May 2020, the amended provisions on invalidity and revocation proceedings will enter into force. In implementation of the Trade Mark Act Directive, sections 53 and 54 Trade Mark Act provide for patent office proceedings with regard to the revocation proceedings and invalidity proceedings due to earlier rights.

### Invalidity proceedings due to absolute grounds for refusal

The invalidity procedure provided for in sec. 53 Trade Mark Act based on absolute grounds for refusal of protection has essentially been retained. However, the facts and evidence serving as substantiation must be filed together with the application, otherwise the application is inadmissible. With regard to the subject matter of the invalidity proceedings, the precise indication of the absolute grounds for refusal of protection (sec. 53 (1), fourth and fifth sentence, Trade Mark Act) must be observed. Any natural or legal person and any association of manufacturers, producers, service providers, traders or consumers which may be party to the proceedings is entitled to file an application (sec. 53 (2) Trade Mark Act).

The application for a declaration of invalidity based on absolute grounds for refusal will be served by the

German Patent and Trade Mark Office (GPTO) on the proprietor of the registered trade mark, together with a request to submit observations on the application within two months of service. If the proprietor does not object to the application for a declaration of invalidity within the aforementioned period, the invalidity of the trade mark will be declared and the registration will be cancelled. If, on the other hand, the request for invalidity is objected to within the time limit, the GPTO will forward the objection to the applicant (sec. 53 (5) Trade Mark Act). Exchange of observations will follow; the procedure ends with a decision; it is possible to file an appeal against this decision.

### Invalidity proceedings due to relative grounds for refusal

The introduction of invalidity procedures due to relative grounds for refusal of protection is new to proceedings before the GPTO (sec. 53, 51 Trade Mark Act). Here, too, the facts and evidence serving as substantiation have to be filed with the application (sec. 53 (1) sentence 2 Trade Mark Act). The earlier rights must be specified in detail with regard to the further provision according to which the application is inadmissible if an unappealable decision or final judgment has already been rendered on the same subject matter between the parties, or if an action under sec. 55 Trade Mark Act is pending between the parties on the same subject matter of the dispute (sec. 53 (1), fourth and fifth sentence, Trade Mark Act). The eligibility to file an application is governed by sec. 53 (3) Trade Mark Act.

In invalidity proceedings based on earlier rights the GPTO shall forward the application for a declaration of invalidity to the proprietor of the registered trade mark with the request to submit a declaration within two

months after service (sec. 53 (4) Trade Mark Act). If the proprietor does not object to the request within the aforementioned period, the invalidity of the trade mark will be declared and the registration will be cancelled. If the request for invalidity is objected to within the time limit, the GPTO will notify the applicant of the objection and the normal procedure at the GPTO will follow. Against the decision of the Trade Mark Division only an appeal may be filed.

The request for declaration of invalidity based on absolute grounds or on earlier rights is subject to a fee of EUR 400. If the request for a declaration of invalidity is based on several earlier rights, an additional fee of EUR 100 will be charged per right.

Opposition proceedings and invalidity proceedings based on relative grounds for refusal are both possible. There are differences in the decision-making authority: a Trade Mark Section decides the opposition (sec. 56 (2) Trade Mark Act), whereas the revocation request is decided by the Trade Mark Division with at least three members of the GPTO (sec. 56 (3) Trade Mark Act). Furthermore, all relative grounds for refusal under sec. 9 through sec. 13 Trade Mark Act may be invoked in invalidity proceedings; this is not possible in opposition proceedings. The opposition may only be filed within a period of three months after publication of the registration of the trade mark (sec. 42 (1) Trade Mark Act). The opposition proceedings postpone the beginning of the grace period for use of the challenged trade mark; the „changing period of use“ only exists in invalidity proceedings, sec. 53 (6) Trade Mark Act.

## Revocation proceedings

The application for revocation within the meaning of sec. 49 Trade Mark Act must be filed in writing pursuant to sec. 53 Trade Mark Act and must be accompanied by the grounds for the application. The application for revocation is subject to an initial fee of EUR 100.

Any natural or legal person as well as any association of manufacturers, producers, service providers, traders or consumers who may be parties to the proceedings is entitled to file an application (sec. 53 (2) Trade Mark Act). If the proprietor of the challenged trade mark does not object within a period of two months after service of the application for revocation, the trade mark shall be declared revoked and cancelled.

Otherwise, if the proprietor of the challenged trade mark objects, the GPTO will notify the applicant of such objection. If the applicant wishes to continue the revocation proceedings, a further fee of EUR 300 must be paid within one month after notification of the objection (sec. 53 (5), fourth sentence, Trade Mark Act).

The application for cancellation on grounds of revocation is inadmissible if a final judgment has been rendered on the same subject matter of the dispute between the parties or if an action under sec. 55 Trade Mark Act is pending (sec. 53 (1), fourth and fifth sentence, Trade Mark Act). Conversely, an action for revocation under sec. 55 (1), second sentence, Trade Mark Act is inadmissible if a decision has already been taken on the

same subject matter of the dispute between the parties or if an application for revocation has been filed with the GPTO. Each of the grounds for revocation mentioned in sec. 49 Trade Mark Act constitutes a separate subject matter of the dispute.

Third parties may join revocation and invalidity proceedings at any time, sec. 54 Trade Mark Act. A prerequisite is that the third party can show that proceedings for infringement of the same registered trade mark are pending against that party or that it has been requested to refrain from an alleged infringement of the registered trade mark.

When applying the new provisions that entered into force on 14 January 2019 and will enter on 1 May 2020, the transitional provisions in sec. 158 et seq. Trade Mark Act must be observed.



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## Who's Who Legal Germany Life Sciences 2020

Peter von Czettritz is listed in following categories:

„Who's Who Legal Germany: Life Sciences 2020 – Patent Litigation“,  
„Regulatory“ and „Life Sciences 2020“

**Peter von Czettritz** stands out for the effective compliance advice he provides related to drug approvals and is highlighted by peers for his „strong and reliable practice“.

**Peter von Czettritz** at Preu Bohlig & Partner is a specialist in healthcare advertising and marketing issues. He regularly advises domestic and international companies on a range of patent and regulatory matters.

## Discussion on an Amendment to German Patent Law

**On 14 January 2020, the Federal Ministry of Justice and Consumer Protection published a draft act to simplify and modernise patent law. About ten years have passed since the last major reform of German patent law, and the Ministry of Justice now identified a need for „selective“ amendments to further ensure „effective and balanced protection of industrial property rights“.**

It is an open secret that one of the main requests for an amendment in the patent law came from the automotive industry. German automobile manufacturers are increasingly exposed to attacks by NPEs in the field of telecommunication patents due to connected car applications. This is why the car industry quickly made a demand to the politics to soften the 'hard' legal provision on injunctive relief by adding an explicit proportionality test.

The draft act proposes the following main amendments to the German Patent Act:

### 1. Streamlining Nullity Proceedings

During nullity proceedings, the Federal Patent Court ("BPatG") issues a preliminary opinion on its view of the validity of a patent in a so-called 'skilled note' ("qualifizierter Hinweis"). Under the current law, the Federal Patent Court should give such preliminary opinion 'as early as possible' in the proceedings. The draft act now suggests adding a soft deadline for the skilled note, which is six months after service of the nullity action. This additional deadline is an attempt to reduce the long duration of patent nullity proceedings in Germany and therefore avoid the resulting injunction gap. The injunction gap is caused by the time gap between a first instance decision in patent infringement proceedings and in nullity proceedings because of the German bifurcated system. While the German infringement courts regularly need about 9 to 15 months – depending on the individual case and the workload of the court – for a first instance decision, the senates in the Federal Patent Court render their decision only after more than two years (currently approx. 26 months). Therefore, if a plaintiff is successful in the litigation part and obtains a quick judgment on infringement, the plaintiff can put the defendant under considerable pressure, because the defendant will have a reliable statement of the Federal Patent Court on the

validity of the relevant patent only during the appeal infringement proceedings. Then, it may already be too late if the plaintiff forced the defendant into an unfavourable out-of-court settlement.

Therefore, by introducing the six-month deadline, it is the intention of the Ministry of Justice to ensure that at least one technical judge at the Federal Patent Court reviewed the legal status of the patent in dispute before the oral hearing in the first instance infringement proceedings takes place. Thus, the preliminary opinion of the Federal Patent Court would play a major role in a discussion about a stay of the infringement proceedings. It remains to be seen whether the Federal Patent Court can meet such six-month deadline at all – since it is only a soft deadline, because the draft act reads that the preliminary opinion "should" be given within six months after service of the nullity action. It further remains to be seen what will be the quality of these opinions that were probably quickly cobbled together.

### 2. Explicit Proportionality Test for Injunctive Relief

As mentioned above, the injunctive relief under Sec. 139 (1) of the German Patent Act shall be put under an additional proportionality test. The draft act therefore proposes the following wording:

„The [injunctive relief] claim is excluded to the extent that the enforcement of the injunctive relief is disproportionate because, due to special circumstances and taking into account the patentee's interest towards the infringer and the requirements of good faith, it constitutes a hardship not justified by the exclusive right.“

In a number of presentations, German judges already pointed out that even without this additional provision, there are possibilities to deal with cases of hardship. First, the principle of proportionality as a general prin-



ciple of law applies to all claims in civil law anyway. Second, e.g. a high security deposit can create a higher threshold for the provisional enforcement of a first instance judgment. Third, in case of hardship, there is also the possibility that the court orders a temporary suspension of enforcement.

Nevertheless, the Ministry of Justice still identified the need for „legislative clarification“, as mentioned in the reasoning of the draft act, because in its eyes, the infringement courts are too strict in granting an injunction. A few years ago, the Federal Court of Justice (“BGH”) pointed out that the plaintiff’s right to injunctive relief can be limited due to good faith in cases of hardship (judgement of 10 May 2016, docket no. X ZR 114/13 – “Wärmetauscher”). The federal Court of Justice specifically discussed the option to grant a period of permitted use. However, the courts of first instance have so far been very reluctant to take such considerations of proportionality into account.

In the reasoning of the draft act, the Ministry of Justice emphasized that a limitation of the right to injunctive relief on the grounds of disproportionality may be considered in very few cases only. Such potential cases could be complex products (e.g. a patent-infringing telecommunication chip in a vehicle), a claim for injunctive relief brought forward by an NPE, or cases of particular economic hardship for the defendant. It is already foreseeable that such an explicit proportionality test will open up a whole new field of discussion in the parties’ pleadings. At the same time, it is surprising that an according “legislative clarification” is not inserted in the Utility Model Act.

### 3. Protection of Secrecy in Patent Litigation

The new German Act on the Protection of Trade Secrets provides for different possibilities of the courts to take procedural measures in order to preserve secrets in according infringement cases (please do also see the article „German Act on the Protection of Trade Secrets – Part III“ in the December 2019 issue of our newsletter). Such measures shall also be adopted in patent litigation by means of a cross-reference to according pro-

visions in the Act on the Protection of Trade Secrets. In this way, the patent courts would be able to i.a. restrict the access to files, to exclude the public from court hearings or to restrict access to specific documents to a certain number of reliable persons.

With these measures, the Ministry of Justice responds to the practical need for better protection of information disclosed in patent litigation cases (for example a special manufacturing process that must be discussed with the court). In the past, the courts dealing with patent cases have already been creative when it comes to the protection of information, see for example the so-called “Düsseldorf proceedings” regarding the inspection e.g. of a defendant’s production site or the (non-)disclosure of existing license agreements in FRAND proceedings. Legal practice will nevertheless welcome this amendment in the Patent Act. Here, too, a corresponding provision should be provided for in utility model cases, even though many provisions of the Patent Act are applicable in utility model law anyway.

### Current Status of the Legislative Procedure

When publishing the draft act, the Ministry of Justice asked the associations and institutions interested in industrial property rights to submit their comments by 10 March 2020. So far, 27 statements were given by the industry, associations and other stakeholders (e.g. the Patent Attorneys’ Association and the German Federal Bar). These statements were published on the website of the Ministry of Justice. It will be interesting to see how the discussion about the draft act evolves. We will report which amendments to the German patent law will eventually be accepted.



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## Brexit and IP: state of play and potential opportunities (guest article by John Hornby, Lambert Hornby IP Law)

### Key legislative sources

- Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community, 19 October 2019 (Withdrawal Agreement).
- European Union (Withdrawal) Act 2018 (2018 Act).
- European Union (Withdrawal Agreement) Act 2020 (2020 Act), which makes amendments to the 2018 Act.
- Political Declaration setting out the framework for the future relationship between the European Union and the United Kingdom, 19 October 2019 (Political Declaration).
- Statutory Instruments (secondary legislation) introduced by the UK Government in 2019 to cover the situation in which there was no deal between the EU and the UK (EU exit SIs). Subject to amendment beforehand, they will come into effect at the end of the transition period.

### Subject

We all know that the UK has left the European Union. And, we all know that there is a transition period (also called the implementation period) during which divergence between the laws of the UK and those of the EU ought not to occur<sup>1</sup>. After the transition period, there is a spectrum of certainty/uncertainty regarding the impact of Brexit on intellectual property rights (as in other areas).

- At one end of the spectrum, it is clear that those holding registered EU trade marks, Community designs and Community plant variety rights will automatically

become holders of comparable rights in the UK<sup>2</sup>. And, Brexit does not of itself affect the UK's participation in the European Patent system under the EPC (it not being an EU instrument).

- At the other end, there is speculation. How will the UK will exercise its freedoms to diverge after the transition period? What might happen during further negotiations between the EU, the UK and the EFTA countries?

This article addresses some important aspects about: how things currently stand for the post-transition period; efforts made to alleviate uncertainty; and opportunities for the UK that may arise by being able to diverge from EU law.

### The transition period – any uncertainty?

First though, is there any uncertainty about the duration of the transition period? The starting position is that it ends on 31 December 2020<sup>3</sup>. However, the "Joint Committee" of representatives of the Union and of the United Kingdom "may, before 1 July 2020, adopt a single decision extending the transition period for up to 1 or 2 years."<sup>4</sup> Once that deadline has passed, there is no mechanism for an extension<sup>5</sup>.

The UK Government has laid down a marker about such an extension by legislating that a government minister cannot agree to extend the transition period<sup>6</sup>. Of course, that legislative provision could itself be repealed by further legislation and, in that regard, Covid-19 is now upon us. Will that force the Government to change its mind? So far, it appears not. Michael Gove (a Government minister and on the Joint Committee) has been reported as having flatly ruled out any extension on 11 March 2020<sup>7</sup> and a similar statement was attributed a few days later to a "source close to the Prime Minister".

<sup>1</sup> Withdrawal Agreement, Article 127(1): "Unless otherwise provided in this Agreement, Union law shall be applicable to and in the United Kingdom during the transition period." Union law is defined in Article 2(a).

<sup>2</sup> Withdrawal Agreement, Article 54(1) and some corresponding domestic secondary legislation contained in "EU exit SIs".

<sup>3</sup> Withdrawal Agreement, Article 126.

<sup>4</sup> Withdrawal Agreement, Article 132(1).

<sup>5</sup> The House of Lords European Union Committee has concluded: "Should that deadline pass without an extension being granted, we can see no other legal mechanism, under the terms of the Withdrawal Agreement, whereby an extension could be achieved, even if the two sides so desired."

<sup>6</sup> Section 33 of the 2020 Act introduced Section 15A to the 2018 Act: "A Minister of the Crown may not agree in the Joint Committee to an extension of the implementation period."

<sup>7</sup> During questioning by the House of Commons' Future Relationship with the European Union Committee.

## Being bound by the case law of the CJEU

The basic principle is that existing EU law will still be in force in the UK after the transition period and Section 6 of the 2018 Act provides for the retention of existing case law of the CJEU (the relevant cut-off date now being the end of the transition period). In relation to IP (as with other areas), the UK Supreme Court has been given the power to depart from existing EU case law in the same circumstances as when it could depart from its own previous decisions.

As to when that power of the UKSC is currently exercised, in *Actavis v Eli Lilly* [2017] UKSC 48 (pemetrexed litigation), Lord Neuberger, in introducing equivalents into UK patent infringement<sup>8</sup>, said: “In these circumstances, given the weight that has been given by courts in this jurisdiction (and indeed in some other jurisdictions) to the three “Improver questions”, I think it must be right for this court to express in our own words our reformulated version of those questions.” (Paragraph 66.) And, in relation to modifying what had been said in the previous leading case about prosecution history estoppel: “In the absence of good reason to the contrary, it would be wrong to depart from what was said by the House of Lords.” (Lord Neuberger at paragraph 83.) Whilst the test might seem a bit nebulous, the power is exercised sparingly by the UKSC.

Further, of course, not many cases come before the UKSC and it takes time and money for the cases that do come before it to be heard. Probably reflecting a more Brexiteer-oriented UK government, Section 26 of the 2020 Act introduces powers for it to pass regulations setting out circumstances in which retained case law can be departed from by other (junior) courts and the relevant test for the court to apply. No doubt with concerns in mind about the government instructing the judiciary how to interpret the law, such regulations can only be made after consultation with leading judges and the power to set the relevant test can be delegated to one or more of those judges.

On the one hand, it might be said that the exercise of these powers to depart from retained case law will in-

troduce uncertainty. On the other hand, it provides an opportunity for UK courts to adopt interpretations of retained EU legislation that will themselves provide greater clarity and certainty than those sometimes provided by the CJEU.

## An opportunity: Supplementary Protection Certificates

An illustration in the IP field of that potential opportunity is provided by the number of references to the CJEU on essentially the same points about interpreting the SPC Regulation and the resulting guidance given. It is not the purpose of this article to give a critique of all those CJEU decisions and, for present purposes, the following extracts from the A-G's Opinion of 23 January 2020 in *Santen* (Case C-673/18) probably suffice to make the point.

- “...the Court is once again invited to clarify the scope of its judgment of 19 July 2012, *Neurim Pharmaceuticals* (1991), in which, by means of a teleological interpretation of Article 3 (d) of Regulation (EC) No 469/2009, it paved the way for the possibility of obtaining a supplementary protection certificate for ... new applications of old active ingredients.” (Paragraph 1.)
- “Because of the impossibility of reconciling the strict interpretation of the concept of ‘product’ within the meaning of Article 1 b) of Regulation No 469/2009 with the reading of Article 3 d), of this regulation adopted in the *Neurim* judgment, the case-law of the Court currently contains a contradiction which undermines the systemic coherence of the said regulation and the effects of which are likely to spread far beyond application of the condition referred to in this last provision.” (Paragraph 38.)

And, consider too the number of references made concerning the interpretation of “the product is protected by a basic patent in force” in Article 3(a)<sup>9</sup>. A move away from the teleological approach of the CJEU could introduce greater certainty in the UK in an area of IP protection of such importance.

It is not just freedom to depart from CJEU case law that

<sup>8</sup> Thereby effectively overruling the House of Lords, the forerunner of the UKSC, in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] RPC 9.

<sup>9</sup> See paragraph 1 of the A-G's Opinion of 11 September 2019 in *Joined Cases C650/17 and C114/18*.

may be relevant here. After the transition period, it will be open to the UK to pass legislation that diverges from that of the EU. SPCs may be an area in which the UK wishes to follow that path in order to provide a clearer legislative framework for the availability of SPCs in relation to, amongst other things, inventions concerning second medical uses, formulations and dosage regimes.

### Exhaustion of rights

This area of law is often highly contentious and it provides illustrations of where there is certainty and what has been done to alleviate uncertainty.

- If rights are exhausted under EU law, both in the EU and the UK, before the end of the transition period, they remain so<sup>10</sup>.
- The position afterwards is less clear. Article 44 of the Political Declaration provides: “The Parties should maintain the freedom to establish their own regimes for the exhaustion of intellectual property rights.”

EEA exhaustion. The effects of the relevant EU exit SI<sup>11</sup>, are that the UK has provided that rights in goods put on the UK or EEA markets after the transition period will be exhausted in the UK.

So, domestic provisions corresponding to EU Directives on exhaustion (e.g., Section 12 of the Trade Marks Act 1994, corresponding to Article 7 of the Trade Mark Directive) are proposed to be amended under the relevant EU exit SI. In the case of Section 12, the proposed amendment is the underlined text below:

“A registered trade mark is not infringed by the use of the trade mark in relation to goods which have been put on the market in the United Kingdom or the European Economic Area under that trade mark by the proprietor or with his consent.”

There is no relevant EU Directive in relation to patents and the post-transition period situation is dealt with by paragraph 2 of the relevant EU exit SI (which covers all IP rights). Sub-paragraph (1) provides:

„Anything which -

(a) was, immediately before [the end of the transition period], an enforceable EU right relating to the exhaustion of rights of the owner of an intellectual property right under Articles 34 to 36 [of the TFEU<sup>12</sup>] or Articles 11 to 13 [of the EEA Agreement<sup>13</sup>]; and

(b) is retained EU law by virtue of section 4 of [the 2018 Act], has the same effect on and after [the end of the transition period], despite the United Kingdom not being a member state, as it had immediately before [the end of the transition period].“

The effect of this provision is that, again, patent rights in goods put on the market in the EEA will be exhausted in the UK.

However, the EU has not (at least yet) provided for exhaustion the other way around. No doubt for that reason, the UK government website contains a warning to parallel exporters of IP-protected goods to the EEA<sup>14</sup>.

International exhaustion (not including patents). In *Silhouette v Hartlauer* (Case C-355/96) and *Laserdisken v Kulturministeriet* (Case C-497/04), the CJEU held that it was not open to Member States to provide for international exhaustion in relation to trade marks and distribution rights (Directive 2001/29, Article 4). And the same reasoning in those cases would appear to apply to other EU harmonised rights (which do not include patents). Whilst UK domestic provisions corresponding to relevant articles in EU Directives are proposed to be amended (see above), they are otherwise to remain in force. Accordingly, under Section 6 of the 2018 Act, *Silhouette* and *Laserdisken* seem to qualify as “retained EU case

<sup>10</sup> Article 61 of the Withdrawal Agreement: “Intellectual property rights which were exhausted both in the Union and in the United Kingdom before the end of the transition period under the conditions provided for by Union law shall remain exhausted both in the Union and in the United Kingdom.”

<sup>11</sup> The Intellectual Property (Exhaustion of Rights) (EU Exit) Regulations 2019.

<sup>12</sup> The Treaty on the Functioning of the European Union. Articles 34-36 deal with the Prohibition of Quantitative Restrictions between Member States.

<sup>13</sup> Agreement on the European Economic Area. Articles 11-13 again deal with quantitative restrictions.

<sup>14</sup> In part: “Check whether you currently export IP-protected goods to the EEA (for example, goods branded with a trade mark) that have already been placed on the UK market and where the rights holder’s permission to export those goods is not currently required.”



law” that will apply to “retained EU law”. In other words, UK exhaustion will not occur when goods are put on the market outside the EEA (subject to domestic judicial or legislative intervention, mentioned earlier).

International exhaustion (patents). The reasoning in *Silhouette* does not apply to patents, there being no relevant Directive or case law. So, UK law relating to an implied licence being granted to the purchaser of patented goods, dating back to *Betts v Willmott* [1871] 6 Ch App 239, ought to continue to apply. Such a licence will not be implied if there is an express contrary agreement; and it may be made subject to express conditions. Note that issues may arise about whether notice of such a contrary agreement, or express conditions, was drawn to the attention of third party recipients further down a supply chain<sup>15</sup>. (See earlier re imports from the EEA.)

## Jurisdiction and enforcement of judgments

Leaving the EU means that the re-cast Brussels Regulation<sup>16</sup> will no longer apply after the transition period. However, the UK intends to seek consent to accede to the Lugano Convention<sup>17</sup> and intends to accede to the Hague Convention<sup>18</sup>.

Lugano. Accession requires the agreement of the EU, Denmark, Iceland, Norway and Switzerland<sup>19</sup>. The UK has so far received statements of support from Norway, Iceland and Switzerland<sup>20</sup>.

An illustration of the significance of the UK obtaining the requisite agreement is that Articles 4(1), 7(2) and 24(4) of Brussels and Articles 2(1), 5(3) and 22(4) of Lugano are substantially the same. So, for example, the same jurisdiction over EEA companies, with the same restrictions<sup>21</sup>, to obtain declarations of non-infringement of foreign designations of European Patents ought to be

retained if the UK accedes to the Lugano Convention. Absent Lugano, different restrictions (concerning service out of the jurisdiction and *forum non conveniens*) may well arise in respect of proceedings against EEA companies, just as they currently do against non-EEA bodies<sup>22</sup>.

Hague. This Convention concerns “... exclusive choice of court agreements between parties to commercial transactions” and “governs the recognition and enforcement of judgments resulting from proceedings based on such agreements.” (Third preamble.) Excluded from its compass under Article 2 are:

“n) the validity of intellectual property rights other than copyright and related rights;

o) infringement of intellectual property rights other than copyright and related rights, except where infringement proceedings are brought for breach of a contract between the parties relating to such rights, or could have been brought for breach of that contract;

p) the validity of entries in public registers.”

The agreement of other contracting states is not required for accession.

On 31 January 2020, because of the Withdrawal Agreement and the consequent application of the Hague Convention to the UK during the transition period (due to the EU being a party), the UK withdrew its 2018 instrument of accession. However, it declared at that time:

“The United Kingdom attaches importance to the seamless continuity of the application of the Agreement to the United Kingdom. The United Kingdom therefore intends to deposit a new instrument of accession at the appropriate time<sup>23</sup> prior to the termination of the transition period.”

<sup>15</sup> See, for example, *Roussel Uclaf SA v Hockley International Ltd & Anor* (1996) RPC 441, referred to recently in *Parainen Pearl Shipping Ltd v KGJS* [2018] EWHC 2628 (Pat) at paragraph 198 onwards.

<sup>16</sup> Regulation 1215/2012.

<sup>17</sup> 2007 Lugano Convention on Jurisdiction and the Recognition and Enforcement of Judgments in Civil and Commercial Matters.

<sup>18</sup> 2005 Hague Convention on Choice of Court Agreements.

<sup>19</sup> Lugano Convention, Article 72(3): “Without prejudice to paragraph 4, the Depositary shall invite the State concerned to accede only if it has obtained the unanimous agreement of the Contracting Parties. The Contracting Parties shall endeavour to give their consent at the latest within one year after the invitation by the Depositary.” Paragraph 4 provides: “The Convention shall enter into force only in relations between the acceding State and the Contracting Parties which have not made any objections to the accession before the first day of the third month following the deposit of the instrument of accession.”

<sup>20</sup> Ministry of Justice statement published on 28 January 2020.

<sup>21</sup> Validity not being in issue is one. See too the difficulty in founding jurisdiction on the basis of Lugano 5(3) in *Parainen Shipping Ltd v KGJS* EWHC 2570 (Pat).

<sup>22</sup> Those issues were unsuccessfully raised by the Defendant in *Eli Lilly v Genentech* [2017] EWHC 3104 (Pat).

<sup>23</sup> Allowing for the three-month period of Article 31 of the Hague Convention and assuming no extension to the transition period (see earlier), “the appropriate time” is before the end of September.

On re-joining, relevant UK judgments should be enforceable in the EU under the Hague Convention<sup>24</sup>.

### The limits on the scope of this article

Many of the areas covered above would warrant one or more articles in their own right and there are other important IP issues raised by Brexit that have not been covered. Some examples of the latter are briefly described below.

The Digital Single Market Copyright Directive (2019/790). A UK government minister pointed out, in January of this year, that the Directive's implementation date comes after the transition period and stated that the UK has no plans to implement it. More generally, there is the question as to what agreement the UK and the EU will reach concerning broadcasting, e-commerce, data protection and so on.

The UPC. Although there has yet to be an "official" announcement, the UK government has let it be known that it will not be participating in the UPCA. That is consistent with the UK government's stance on there being no future jurisdiction of the CJEU<sup>25</sup>, which is to be contrasted with the UPCA's recognition of the primacy of Union law (Article 20). However, on 10 March 2020, the House of Lords EU Justice Sub-Committee heard evidence from Julia Florence (former President of CIPA) and Daniel Alexander QC, about (amongst other areas of discussion): "the impact on the UK and on the Court if the UK does not participate" (underlining added). Nonetheless, assuming that the UK does (as seems probable) officially announce that it will not participate, that is most likely the end of its proposed involvement. Any legal niceties about ratification withdrawal are unlikely to pose a practical impediment.

Cofemel-Sociedade de Vesturário SA v G-Star Raw CV (Case C-683/17). There is a live issue as to whether

Section 4(2) of the UK Copyright Designs and Patents Act 1988 complies with Article 2 of the Copyright Directive (2001/29), as interpreted most recently in Cofemel<sup>26</sup>, in relation to whether aesthetic appeal is needed for copyright subsistence. A UK Court might deal with this matter by applying the Marleasing principle<sup>27</sup> concerning interpretation of domestic legislation in conformity with the corresponding Directive; or the Government might legislate<sup>28</sup>.

Grace period and the EPC. A leaked 451-page dossier about UK/US negotiations does reveal that, as one would expect, the US would like to see the introduction of a 12 month grace period in the UK. Such a move by the UK would be incompatible with the EPC. However, to suggest that the UK would leave the EPC as a means of securing a trade deal with the US, is firmly in the realms of speculation. And, withdrawing from the centralised procedures available under the EPC would not seem to be in the interests of either the US or the UK.

### Final comments

Some IP issues relating to Brexit are reasonably clear now and others will become clearer as the transition period progresses. After the transition period, the UK legislature and courts will have new freedoms that will present opportunities for providing greater clarity and coherence. Here, the author borrows from Guy Verhofstadt: „Brexit is not a liability. I see it more as an opportunity.“<sup>29</sup> The author will keep his friends and colleagues at Preu Bohlig informed.

#### Guest article by John Hornby

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<sup>24</sup> Note that the Hague Convention only applies if there is an exclusive jurisdiction clause that has been entered into after the Convention came into force in the relevant state. After the UK joins in its own right, the Convention might not apply to a UK exclusive jurisdiction clause entered into whilst it was in force in the UK due to EU membership (from 1 October 2015).

<sup>25</sup> "Our overriding objective in the [Brexit] negotiations is by 1 January to have taken back control and we won't agree to anything that doesn't deliver that. Which means no rule-taking from the EU and no role for the European Court of Justice." (A senior government source quoted in the press on 24 February 2020).

<sup>26</sup> At paragraph 56: "Article 2(a) of Directive 2001/29 must be interpreted as precluding national legislation from conferring protection, under copyright, to designs such as the clothing designs at issue in the main proceedings, on the ground that, over and above their practical purpose, they generate a specific, aesthetically significant visual effect."

<sup>27</sup> Marleasing SA v La Comercial Internacional de Alimentación SA (1990) C-106/89.

<sup>28</sup> The issue was recently referred to in Response Clothing Limited v The Edinburgh Woollen Mill Limited [2020] EWHC 148(IPEC).

<sup>29</sup> Guy Verhofstadt, one of the European Parliament's Brexit Negotiators, 14 September 2016.

## CJEU decides on access to clinical study reports and toxicity studies - no general assumption of confidentiality



In recent years, an increasing trend towards transparency has been observed among the European authorities, especially the European Medicines Agency (EMA). Many pharmaceutical companies observe this trend with conflicting feelings. On the one hand, transparency may jeopardize the confidentiality of their own sensitive information; on the other hand, it may give them the opportunity to obtain information about competitors that would otherwise not be publicly available. Not without reason, according to information provided by the EMA, 385 of a total of 812 access to documents requests from the pharmaceutical industry were made in 2018 on the basis of Policy 0043, 119 by consultants, 36 by healthcare professionals and only 100 by patient or consumer organisations (EMA, Annual Report 2018, pp. 88 and 89). The Court of Justice of the European Union (CJEU) has now strengthened the transparency movement and, in the proceedings *PTC Therapeutics International / EMA* (C-175/18 P) and *MSD Animal Health Innovation and Intervet International / EMA* (C-178/18 P), has confirmed the generous approach of the EMA.

### Background

Both proceedings were aimed at setting aside the judgments of the General Court of the European Union (GCEU) of 5 February 2018, by which the GCEU dismissed actions for annulment of two decisions of the EMA.

In both decisions, EMA decided to grant access to a document contained in the file of a marketing authorisation application for a medicinal product to a third party in accordance with Regulation (EC) No 1049/2001 of the European Parliament and of the Council of 30 May 2001 regarding public access to European Parliament, Council and Commission documents (OJ 2001 L 145, p. 43).

### Crucial points of the CJEU's reasoning

The applicants put forward several grounds in support of their appeals. None of the grounds of appeal was successful. The most important ones were the first and the second ground of appeal which were the same in both proceedings.

By the **first ground of appeal**, the appellants submit, first, that the GCEU erred in law in not finding that the reports at issue must be protected by a general presumption of confidentiality (C-175/18 P, paragraph 41; C-178/18 P, paragraph 38). Secondly, the appellants submit that in the judgment under appeal the GCEU misapplied the criteria governing recognition of a general presumption of confidentiality in the present case (C-175/18 P, paragraph 43; C-178/18 P, paragraph 40).

The CJEU points out that Article 1 of Regulation 1049/2001 provides that the regulation is to grant the public a right of the widest possible access to documents of the EU institutions (C-175/18 P, paragraph 54; C-178/18 P, paragraph 51). Since exceptions to the principle of the widest possible public access to documents deviate from the rule, they must be interpreted and applied strictly (C-175/18 P, paragraph 56; C-178/18 P, paragraph 53). An institution, body, office or agency of the Union is not obliged to base its decision on a general presumption of confidentiality of a document, but may at any time carry out a concrete examination of the documents covered by the application for access and give concrete reasons for its decision (C-175/18 P, paragraph 60; C-178/18 P, paragraph 57).

By the **second ground of appeal**, the appellants submit that, in the present case, the GCEU failed to have regard to the protection of commercial interests afforded by the first indent of Article 4(2) of Regulation No 1049/2001 (C-175/18 P, paragraph 69; C-178/18 P, paragraph 66).

With this respect, the CJEU states as follow: In so far as a company identifies a specific and reasonably foreseeable risk that a competitor of that company may use certain unpublished data contained in a report such as the one at issue, which are not generally available knowledge in the pharmaceutical industry, in one or several non-member countries in order to obtain a marketing authorisation and thus benefit unfairly from the work carried out by the company in question, this could be sufficient evidence of an adverse effect to be taken into account in the decision about access to the document (C-175/18 P, paragraph 81; C-178/18 P, paragraph 80). However, according to the CJEU, this requires a specific and precise identification of critical parts of the document in scope (C-175/18 P, paragraph 82; C-178/18 P, paragraph 81). Furthermore, a weighing of interests would only need to be carried out when one of the exceptions under Article 4 of Regulation 1049/2001 applies. Where it is apparent that documents need not be protected by one or more of these exceptions, there is no obligation to determine or evaluate the public interest in disclosure of the document, nor to weigh it

against the appellant's interest in preserving the confidentiality of the document (C-175/18 P, paragraph 86; C-178/18 P, paragraph 85).

The CJEU also emphasises that, where an institution, body, office or agency of the EU to which access to a document has been requested decides to refuse the request on the basis of one of the exceptions to the fundamental principle of transparency laid down in Article 4 of Regulation 1049/2001, it must explain in principle how access to that document could specifically and actually undermine the interest protected by that exception. The likelihood of such an impairment must be "reasonably foreseeable and not purely hypothetical" (C-175/18 P, paragraph 94; C-178/18 P, paragraph 93). Admittedly, the risk of misuse of data contained in a document to which access is requested may, in certain circumstances, harm the commercial interests of an undertaking. However, the existence of such a risk must be specifically demonstrated. The unproven reference to a general risk was not held to be sufficient (C-175/18 P, paragraph 96; C-178/18 P, paragraph 95).

Furthermore, the CJEU states that it is for the owner of the document to explain to the EMA, before a decision is taken, the nature, purpose and scope of the data, the disclosure of which would harm their business interests. Documents submitted subsequently after the decision was taken are irrelevant (C-175/18 P, paragraphs 109 and 117).

The CJEU also rejected incompatibility with Article 39 of the TRIPS Agreement in its PTC judgment: Article 39(3) of the TRIPS Agreement did not serve to define the concept of commercial interests (C-175/18 P, paragraph 114). Furthermore, the requirement to provide evidence for the application of an exception under Article 4 of Regulation 1049/2001 is compatible with Article 39(3) of the TRIPS Agreement.

### Impact of the CJEU decisions

Based on these decisions of the CJEU, the requirements to successfully claim that certain information are commercial confidential information in accordance with

Article 4(2) of Regulation 1049/2001 and by that should not be disclosed are high. It is necessary to lay down specifically how disclosure of (parts of) that document could actually undermine the commercial interests protected by that exception. Therefore, it is of utmost importance that companies submitting documents to European institutions or authorities have a solid review process in place prior to the actual submission in order to identify any potential commercial confidential information and take all necessary steps either to obtain protection as IP right or to claim protection upfront. Otherwise, when consulted by a European institution or authority dealing with a third party access to document requests, due to the tough and strict timelines to respond and to claim commercial confidential data protection, being prepared and having a line of argumentation ready is clearly advisable.



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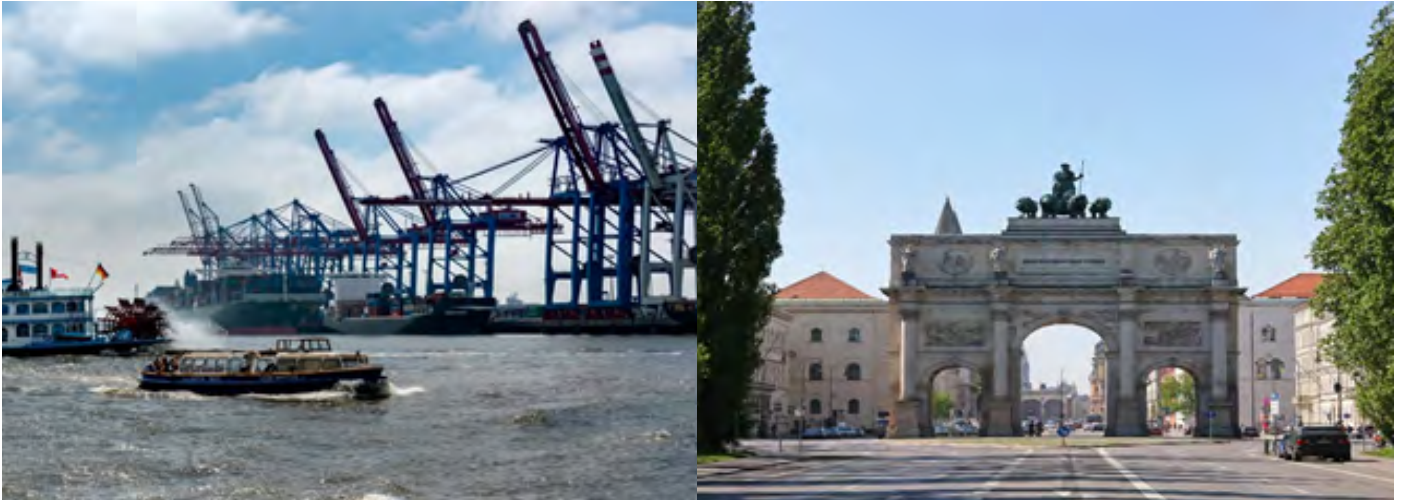
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## Preu Breakfast in Hamburg and Munich

**We had again our Preu Breakfast on 14 January in Hamburg and on 4 February in Munich to which we invited interested guests.**



In front of about 20 guests each time, attorney Dr. Alexander Meier from Preu Bohligh's Munich office talked about the protection of commercial confidential information in documents held by EU institutions. He explained the latest developments, the implications for industry and the existing legal protection options in particular in consideration of recent decisions of the European courts on access to documents held by European authorities, such as clinical study data of medicinal products held by the European Medicines Agency (EMA) and documents concerning fertilisers held by the European Food Safety Authority (EFSA).

After the presentation, the guests had the opportunity to talk to each other in person while enjoying the rich breakfast buffet.

**We thank you for the good discussions and the great interest.**



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## Current events, seminars and lectures

see website „News“

**MAY  
2020**

11. Mai 2020

Seminar in Munich

„Abgrenzungsvereinbarungen im Markenrecht“

**Current:** Video training „Abgrenzungsvereinbarungen kompakt“  
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