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Misleading by arrogation of a patent despite reinstatement in the status quo ante

Thomas Musmann (Rospatt Osten Pross) · Friday, February 3rd, 2012

by Stephan Lieck

The Düsseldorf Regional Court had to decide whether it is misleading under competition law that the former proprietor of a patent advertises with the fact that there is patent protection for a product (wrongful representation of an article as patent-ed/arrogation of patent), although the patent had expired at the time of arrogation on account of his failure to pay the annual fee, but the patent proprietor was granted a reinstatement in the status quo ante because of the failure to observe the payment date later. Such a reinstatement is possible under German law according to Sec. 123 German Patent Act under certain conditions, if someone was prevented from observing a deadline through no fault of his own, and the failure to observe this deadline results in a legal prejudice according to the statutory provisions.

In the decision dated 5th July 2011 (file no. 4b O 177/10) the Düsseldorf Regional Court initially affirmed a relevant misleading act. Although Sec. 123 of the German Patent Act did not specify how wrongful acts have to be assessed which took place in the period before the reinstatement, the court held that, for reasons of equity, it was justified to assume a misleading act in the present case, because the expiration of the patent was due to an event that took place in the patent proprietor's sphere of influence, and it was therefore more appropriate and more in keeping with the interests at stake to prejudice the patent proprietor than to retroactively assess the act of use as being lawful. This was because the competitor observing the advertising and the products of its rivals had to rely on the fact that an unlawful state in the sphere of the patent proprietor which was given notice of in a warning letter following a search would not be subsequently eliminated, because the competitor had no influence on it and it was therefore not justified to place the (cost) risk on the competitor.

In addition to that, the Court also confirmed a damages claim on this basis, because the patent proprietor was liable, although the German Patent and Trademark Office had denied a liability on account of the late payment of the annual fee in the context of the reinstatement proceedings. The Regional Court did not assume a binding effect in this respect, on the grounds that the finding that the patent proprietor did not culpably miss the period for making subsequent payment of the annual fee, had no influence on the assessment as to whether the patent proprietor can be held liable with respect to the advertisement of a product with a non-existent patent. Seeing that the defendant was a company specialised in the art, the Court affirmed negligence and in addition to that also intent as of receipt of the warning letter, because the defendant had not taken any measures to stop the unlawful advertising.

The proceedings are not final. The proceedings before the Düsseldorf Higher Regional Court bear the file number I-2 U 92/11.

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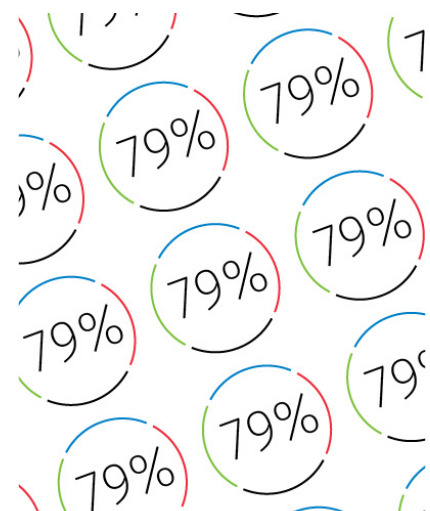
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