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Danish Court finds that the Danish Patent and Trademark Office is not obligated to consider ex officio the risk of double patenting for utility models

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On 6 January 2023, the Danish Maritime and Commercial High Court dismissed an application for remission to the Board of Appeal of the registration of a utility model. The court considered whether the Danish Patent and Trademark Office ought to have considered a prior registration when examining ex officio a utility model application.

On 14 May 2020, Fresenius Kabi applied for the registration of a utility model BM 038, which was published on 10 July 2020. Prior to the application, Fresenius Kabi had applied for the registration of utility model BM 030, which was published on 26 May 2020. The Patent and Trademark Office conducted an ex officio technical inspection of the registrations under the Danish Utility Models Act and the two utility models were registered without assessment of the requirements of novelty or creative step (akin to inventive step for patents).

On 10 June 2020, Fresenius Kabi filed an application for a preliminary injunction against Biogen based on the utility model registrations. Consequently, Biogen appealed the above-mentioned registrations to the Board of Appeal for Patents and Trademarks.

Fresenius Kabi decided to withdraw its earlier registration BR 030 following the appeal to the Board of Appeal.

It was undisputed that the two registrations had an identical claim. The Board of Appeal ruled against the appellant, which brought the question before the Maritime and Commercial High Court.

The plaintiffs, FUJIFILM, BIOGEN and Samsung Bioepis argued that a legal doctrine against double protection should prevent the registration of the latter utility model. Thus, the Patent and Trademark Office should have considered the earlier registration when assessing the subsequent application for BM 038 to prevent double protection of the same rights.

The plaintiffs held that the Board of Appeal should have revoked the registration and that the Danish Maritime and Commercial High Court, therefore, should grant remission of the case to the Board of Appeal.

With reference to the explanatory notes to the Danish Utility Models Act, the defendant, the Board of Appeal for Patents and Trademarks, argued that the technical inspection only regards the formal

requirements stated explicitly in section 19. The explanatory notes elaborate on the purposes of the section which include the interest in a fast and cheap registration of utility models. Thus, the Board of Appeal argued that the decision of the Patents and Trademarks Office should not include an ex officio assessment of the earlier registration of BM 030 when assessing the application for BM 038.

The Court ruled in favour of the Board of Appeal and found that the ex officio assessment made by the Patent and Trademark Office is limited to the conditions explicitly stated in section 19 of the Danish Utility Model Act. In accordance with the arguments made by the Board of Appeal, the Court based its decision on the explanatory notes to section 19 and the possibility of having a fast and cheap registration of utility models. An assessment of the compliance with the Danish Utility Model Act would have required a request and a fee paid by the applicant.

Consequently, the Court found that the Patent and Trademark Office is only obligated to ensure that an application concerns a creation which, by its nature, is eligible for protection, that protection of several independent creations is not sought in the same application, and that the application is not subsequently changed.

Based on the above, the Patent and Trademark Office was thus not obliged to examine the question of double protection ex officio.

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