

Cancellation Proceedings in Germany

Overview and strategic questions

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Overview

- I. Introduction**
- II. Action for cancellation before ordinary courts**
- III. Cancellation proceedings before the office (GPTO)**
- IV. Strategic Issues**
- V. Summary**

II. Action for cancellation before the ordinary courts

- 1.) based on prior rights
- 2.) based on absolute grounds for refusal
- 3.) due to revocation (non-use)

II. Cancellation proceedings before the office

- 1.) Cancellation due to absolute grounds for refusal
- 2.) Cancellation based on Non-use (revocation)
- 3.) Cancellation based on Conflicting earlier rights

II. Cancellation proceedings before the office

- 1.) Cancellation due to absolute grounds for refusal
 - possible in Germany before the Office since decades
 - more than 80% of these cancellation proceedings are handled by the office and not the ordinary courts
 - numbers of proceedings before the GPTO:
 - In 2020: 240
 - In 2021: 159

II. Cancellation proceedings before the office

2.) Cancellation based on Non-use (revocation)

- possible in Germany since 2019
- due to the change: risk of obtaining revocation applications increased. It is easier and cheaper to initiate those proceedings for third parties.
- numbers of proceedings before the GPTO:
 - in 2020: 440 (persuing until the end: 111)
 - in 2021: 416 (persuing until the end: 227)

II. Cancellation proceedings before the office

- 3.) Cancellation based on Conflicting earlier rights
- possible in Germany since May 2020
 - proceedings are very similar to opposition proceedings
 - numbers of proceedings before the GPTO:
in 2020: 89
in 2021: 159

III. Strategic issues

1. costs
2. straw man application
3. right of representation

III. Strategic issues

1. Costs

- administrative proceedings are much cheaper
- no reimbursement of fees
- fees for attorney are nearly similar

III. Strategic issues

2. Strawman application

- more attractive to use a straw person in administrative proceedings
- normally no oral hearings face to face with opponent
- this option increases the number of revocation cases

III. Strategic issues

3. Right of representation

- important difference from strategic point of view
- patent attorney can represent until the end
- no attorney at law necessary
- for some clients very attractive

III. Summary

- office proceedings open up a large and wide playing field
- on first view less expensive
- can be handled by trademark attorney/patent attorney until the end
- attracts more applicants
- leads to more cancellation proceedings

THANK YOU !