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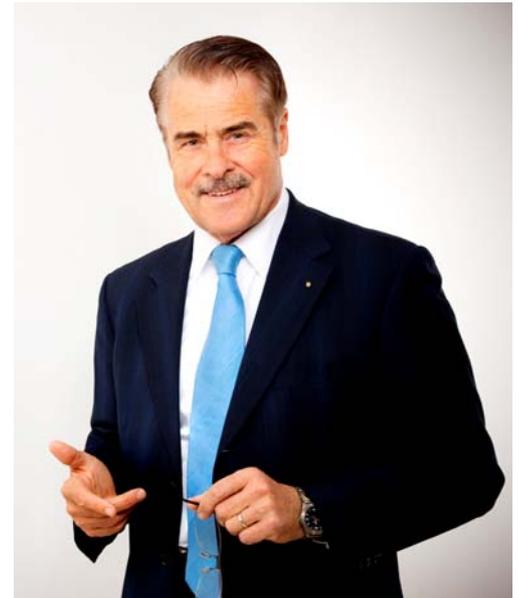
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Dear readers of our Update,

with our second Update this year, we continue our “strategy debate”. This time, we deal with the question as to what the better way towards patents in Europe is, the national way by filing national direct applications or the “European way” through the European Patent Office. Here, we compare the advantages and disadvantages of both possibilities.

At the end of the day, this question cannot be answered in general terms, it rather depends on the respective individual case. However, a rule of thumb is here, that the European way through the European Patent Office is the better way when more than five countries are concerned. With three to five countries, the selection of the countries is important, as depending on the country selection, one and the same translation can be used for certain countries. With applications with overlong texts and more than 40 pages, the European way bears more advantages when more than 4 countries are selected. With applications with normal lengths and a maximum of 30 pages, the national way should bring advantages in many respects and also when taking the costs into account. I hope that our considerations offer you some assistance, in the end, however, it depends on individual counselling for a decision in the particular case.

Further topics deal with the community patent and the trademark law. Here, we would like to point to two interesting decisions, i.e. “Desertfuel” for fuels (petrol) and “Momo against Memo”, where we represented our clients successfully.

Our picture at the end of our Update gives an impression of the Munich Beer Festival, i.e. the Oktoberfest in Munich and shall invite you to visit Munich.

I wish you happy reading of our articles. For any questions, our team will certainly be glad to help.

Best regards



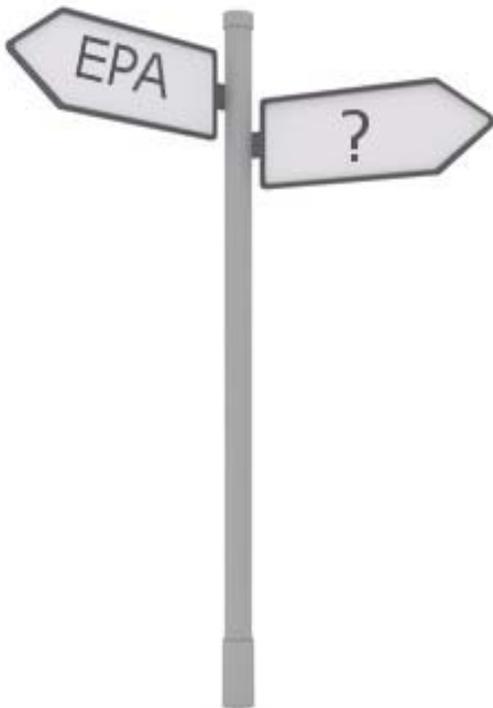
Josef Bockhorni
(Patentanwalt)

PATENT LAW

Patent strategy: The better way towards patents in Europe via EPO or nationally?

The usual way towards a patent protection in Europe is in most cases carried out via a European patent application, be it as a direct application or in the way of a PCT application. The question however is, whether this is really the best way for every single case. It is not only us who think that this is indeed not always the case, as can be seen from the following comparison of advantages and disadvantages of both alternatives.

1. The way via a European patent application



a) Advantages

Filing at one Office in one language, single examination procedure with only one attorney and subsequently a patent which is examined and quasi sealed by an approved authority.

b) Disadvantages

Automatism of the procedure, i.e. as soon as the EP application has been filed, the examination procedure is automatically initiated upon performance of a search.

Upon grant, the patent splits into a bundle of national patents and requires a separate initiation of national phases in the requested countries. Depending on the country, it may be necessary to file a complete translation of the patent or of the claims in the official national language, which is expensive. Furthermore, the same scope of protection in all countries does not necessarily have to be advantageous as in many countries, the judge in an infringement suit also decides on the legal validity of the patent. Here, opinions vary from country to country, in particular with regards to the inventive step, i.e. a less restrictive opinion than at the European Patent Office and therefore claims with a broader scope of protection in comparison with the European patent would be possible in different countries.

The biggest disadvantage, however, is the possibility of a **central attack** of the patent by means of an opposition, which could result in cancellation of the patent with automatic effect on all national phases of the European patent.

Cease and desist claims only arise late, namely only after the grant of the patent, i.e. after about three to five years, often even later in case of a rejection of the application and subsequent appeal proceedings.

Opposition proceedings in two instances can be very expensive and long-lasting, in particular for the case that more oppositions are filed.

2. The national way through filing of national applications

a) Advantages

In many countries, the patent can be obtained relatively quickly by sole registration, in most cases after a previous search with the result that a claim to cease and desist arises at a relatively early stage.

The national patents are independent from each other and can have a different scope of protection, which, with registered patents, is principally determined by the applicant in the knowledge of a search result. Only in an infringement litigation can it become necessary to make restrictions depending on the state of art.

There is **no central attack** of the national patents, rather, each patent must be attacked separately. Of course, this is quite disadvantageous, time-consuming and cost-intensive for an infringer. The cancellation or restriction of a national patent does by no means necessarily have the consequence that this must be the case for the other parallel national patents as the criteria (with the exception of the novelty criterion) are handled quite differently from country to country. An early claim to cease and desist arises with the grant of a registered, national patent.

b) Disadvantages

Already when filing, the national patent applications have to be translated already into the respective national languages, which means early costs for translations. The patent filing can gener-

ally be made in the foreign language, the translation into the national language can be filed subsequently. Furthermore, the involvement of a patent attorney with national accreditation is in most cases necessary.

3. Summary and recommendation

The general rule is that the European way via the European Patent Office is the better way when, according to the choice of countries, patent protection is necessary in more than four to five countries. Four to five countries for the reason that this certainly also depends on the necessary translation costs. Depending on the choice of countries, one translation may also be sufficient for several countries, e.g. a German translation for Germany, Austria and Switzerland or a French translation for the countries France, Belgium and Switzerland.

Experience shows that usually, clients request for patent protection in only some selected countries and that it is rather rarely the case that patent protection is required in more than five countries.

If for example a patent protection is considered in the five countries Germany, France, Great Britain, Austria and Switzerland and the foreign initial application outside of Europe has been made in English, a translation into only two languages is necessary, i.e. translations into the German and French language.

If one considers that with the grant of the European patent, the patent claims have to be translated into three official languages, then the difference in the translation costs is not so decisive. In the end, this is of course dependent on the lengths of the patent application.

If the further countries Italy and Spain are included into this consideration, the translation costs are in the end comparable in both alternatives, as after grant of the European patent for the nationalization in Italy and in Spain, translations into the Italian and Spanish language are necessary.

The main advantage of the national way is that in the majority of these countries, patents are solely registered without examination as to novelty and inventive step, and therefore, the grant of patent is effected very quickly. In this case, the advantage is quite obvious. One can get national patents and thus an early claim to cease and desist and for compensation of damages at a very early stage. For example, no substantial examination is carried out in the countries France, Switzerland, Italy and Spain, so that a quick grant of patent can be expected in these countries. In some countries, a petition to accelerated registration can also be filed, here.

In Germany, the patent and thus a claim to cease and desist can only be obtained after grant of the patent and thus only after examination as to novelty and inventive step by the Office. However, there is the possibility of delaying the filing of the examination request as here, a seven-year term exists starting on the day of application. That means that the costs of the examination procedure incur with delay, too, and the applicant can decide freely on the beginning of the examination procedure.

On the other hand, it is at any time possible to branch off a utility model from the German patent application, the registration of which is generally effected within three to four weeks. Therefore,

one can very quickly obtain a registered protective right with a claim to cease and desist.

At the same time, a central attack of these patents is not possible. If one further takes into account that generally, even with an extensive patent portfolio of a client, patent litigations at best occur with a small number of patents, the question definitely arises whether the expenditure of the European procedure with search, request for examination, opposition proceedings, appeal proceedings and subsequent nationalisation is worthwhile.

A definite answer as to the better way cannot be given in general terms. It is rather dependent on the individual case. However, it can generally be said that the national way often brings significant advantages compared with the European way.

Therefore, it definitely has to be considered that there are two options for patent protection in Europe and that strategic considerations have to be made in order to find out which way is the better one. We have got experience with regard to both ways and are happy to help you when it comes to a corresponding consultancy.

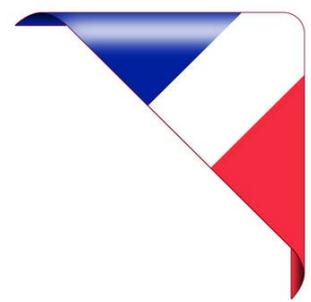
Dipl.-Ing. Josef Bockhorni (Patent Attorney)

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Disappointment in the German patent world – the new EU Patent Court goes to Paris

At the end of June 2012, the heads of state and government of the European Union decided that the unitary Patent Court for the planned community patent should get its head quarter in Paris and unfortunately not in Munich. Munich seemed to be the more suitable solution precisely because with the Federal Patent Court, the German Patent and Trademark Office and the European Patent Office, a concentration of "IP intelligence" is located there, which can only be helpful for a uni-

tary Patent Court. Unfortunately, only branches of the new Patent Court were assigned to Munich as well as to London. Accordingly, the office of the president of the EU Patent Court will be in Paris. Furthermore, complaints regarding textile and electricity patents will be treated in Paris. In Munich, patent lawyers will be concerned with the topics engineering and sustainability of resources, whereas



Picture: button france flax @ ferkeiraeae-Fotolia.com

the branch of the EU Patent Court in London will deal with chemical and pharmaceutical patents. Moreover, the administration of the EU Patent Court is supposed to have its office in Munich.

The unitary EU Patent Court is responsible for both complaints against the validity of a granted EU patent or a community patent – i.e. invalidity suits – and for complaints regarding the infringement of the EU patent and the community patent, respectively. Particularly in comparison with the existing European patent, a harmonization after granting of a patent is meant to be achieved, as it is from now on no longer different national courts which decide on the validity and the infringement of the protection scope of a European patent. (Please also see our report regarding this topic in Update 1/2012)

The official name of the EU patent and community patent, respectively, is “European patent with unitary effect”. It is supposed to have unitary validity in the whole European Union and to lead to a significant relief for applicants especially by the reduction of translation costs compared with the existing European patent.

For the granting of the EU patent and community patent, respectively, no new authority is planned

to be created, but rather the European Patent Office should be responsible. In this way, existing competences and resources are used whereby additionally, search reports of national patent courts should be taken into account, too.

With the current European patent, only the granting procedure is unitary and centralized at the European Patent Office. After conclusion of the granting procedure, the granted European patent splits into a bundle of national patents which are valid in those single states of the European Union

that have been designated by the applicant. As the individual states of the European Union demand different translation requirements for granted European patents, the so-called validations of the European patent in individual contractual states of the European Union are often connected with considerable translation costs. A relief in this matter has however already been brought about by the London Agreement of the year 2008.

Picture:Valerie Potadova - Fotolia.com



In contrast to that, the granting of one single patent, which unfolds its protection in the whole area of the European community, is planned for the EU patent and the community patent, respectively, after conclusion of a centralized granting procedure at the European Patent Office. By that, the patent would no longer split into individual national patents after granting so that a unitary language regime could be achieved.

Dr. Volker Heyer (Patent Attorney)

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Community patent – does it come, and if so, when does it come?

The question can be answered easily. The community patent will come, in particular as an agreement with regard to the patent court could be reached in political terms. When the community patent does come, is, however, an open question. This might still be written in the stars.

On the one hand, the countries Italy and Spain filed a suit against the EU Council because of the community patent (case C-274/11 and C-295/11). Both countries feel to be disadvantaged as the community patent is only granted in the three current official languages German, French and English. An oral proceeding took place before the European Court of Justice on September 25, 2012 during which the parties quite vehemently defended their arguments. Most observers, however, came to the conclusion that the suits by Italy and Spain will probably not be successful. It will be a few months until a decision can be expected.

Furthermore, there is still a number of open questions with regard to the system of the uniform EU patent. In particular, the influence of the EU community law on substantive (patent) and legal questions has again led to discussions, especially as far as articles 6-8 of the EU patent enactment are concerned. In its decision of March 2011, the European Court of Justice declared the draft for a community patent with a court for European patent inconsistent with the EU contracts. Subsequently, considerations by the commission, the Council and the European Parliament have now led to an inclusion of a considerable part of the substantive patent law into articles 6-8 of the EU patent enactment. This might in the end open the door for many preliminary rulings to the European Court of Justice. Many experts agree that the start of the community patent will thereby be set back by several years. Thus, an end cannot be foreseen.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

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BIOTECH

The Melon-Patent

Once more, Monsanto faces an opposition proceeding before the European Patent Office as two appeals have been lodged against its patent EP 1 962 578, which was granted in May 2011. Firstly, the company Nunhems, a vegetable seed producer of Bayer Crop Science, raises technical objections against the patent, and secondly, the organisation "No Patents on Seeds" puts some legal concerns against the patenting of conventionally bred plants on the table.

The "Melon Patent" relates to melon plants which are resistant against a virus, namely the *Cucurbit*



Picture: © Giuseppe Forzani – Fotolia.com

Yellow Stunting Disorder Virus-CYSDV. This virus leads to a yellowing of the plants and significantly reduces the crop yield. The resistance against the virus CYSDV was generated by introducing a gene of another melon plant by using a common breeding technique, whereby genetic markers (smart breeding) were used during the breeding process. The resistance gene itself was already discovered in an Indian melon plant some years ago and was also catalogued in the year 1961, since 1966, it is publicly available.

The opponents also cite previous decisions by the EPO, especially the decisions "Broccoli" and "Tomato" (G2/07 and G1/08) where it was decided that biological techniques for plant breeding are only patentable if they comprise steps which significantly change the breeding technique so that the resulting plants are not obtained by simple recombination of the parental genomes. That

means that there should not be any European patent on basic biological breeding techniques.

The jurisdiction derived from the bio patent directive of the EU says, that plants are generally patentable when the practicability of a technical innovation is not limited to a specific variety, i.e. the invention must be executable with various plants so that a patent on the plant as such is grantable. Thereby, it is not determined, that a plant must have been genetically modified in order to be patentable. Therefore, for some time, applications are handed in whose object is new breeding techniques, e.g. with marker genes. The clarification whether such techniques are patentable according to the EPC is currently a popular question in the legislative trend. The outcome of the proceeding is eagerly awaited.

Dipl.-Biotechnol. Vanessa Bockhorni (Patent Attorney)

Figures

Since the foundation of the European Patent Office (1978), over 1.6 Million patents have been granted, 43.000 of which in biotechnology. Out of 13.840 patent applications for plants so far, a total of only 1.690 has resulted in a patent, 88 of which relate to conventionally bred plants and the rest to genetically modified plants.

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TRADEMARK LAW

Clear specification of goods and services in a trademark application

A trademark unfolds its protection based on two main components. One component is the sign itself and the second component is the specification of the products for which the sign should unfold its characteristic effect. Both goods as well as services can count to these services, which are listed in the goods and services register of a trademark application. In order to guarantee a certain system of the registered trademarks, the goods and services are divided into 45 classes,

whereby each of these classes contains a number of goods or services. While the headlines of the individual classes only describe an approximate classification, a clear description or formulation of the goods and services register of a trademark is given in the classes directly with the specifications of goods and services.

When handling trademark applications, a different practice of the Office for Harmonisation in the

Internal Market and various national patent offices, e.g. the German Patent and Trademark Office (GPTO), can currently be observed. The GPTO, for example, interprets the goods and services register of a trademark and trademark application, respectively, rather literally. Compared to that, the Office for Harmonisation takes a different approach by listing a class headline and thereby obtaining protection for all possible products of this class. Consequently, on closer examination, an assessment of protectability, scope of protection and genuine use of one and the same trademark by, for example, the Office for Harmonisation in the Internal Market and the GPTO would vary.

This tendency induced Advocate General Bott, based on the trademark application "IP TRANSLATOR" for the in the headline of class 41 mentioned services education, apprenticeship, entertainment, sporty and cultural activities, to bring about a clarification of the present situation and the future procedure through the European Court of Justice (CJEU). Advocate General Bott argued that in European trademark law, a uniform interpretation of the registers of goods and services was necessary. In this regard, he joined the supporters of a literal interpretation of the goods and services register. Only a literal interpretation is specific enough to clearly determine the scope of protection of a trademark.

With its decision of June 19, 2012, the CJEU essentially joined Advocate General Bott's opin-

ion. In particular, the CJEU emphasizes in its decision, that the responsible authorities, must be able to clearly and ambiguously identify by means of the goods and services register, which goods or services are covered by the present trademark. Otherwise, the authorities would not be capable of meeting their obligations during the pre-examination of the trademark application as well as its publication. Furthermore, under different circumstances, it would not be possible to maintain an adequate and clear trademark register. With regard to third parties, the CJEU highlighted in its decision that the former has to be able to clearly and unambiguously find out which registration or application has been carried out by other legal or natural persons and which resulting rights have to be observed in future.

That means in practice, that a clear indication of goods or services of a certain class must be made in order to derive an effective protection from it in future. A wide and vague formulation of goods and services suggests a universally applicable scope of protection for the future, however, it has to be expected that offices in the frame of the registration procedure will already work towards a clarification of the very goods and services that have to be protected.

Decision by the European Court of Justice dated June 19, 2012, file no. C-307/10

Dr. Volker Heyer (Patent Attorney)

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[DESERTFUEL registrable for fuels \(petrol\)](#)

With regard to our client's community trademark application DESERTFUEL, we successfully appealed the decision of the first instance according to which the application for in particular the goods "fuel and luminescence substances" in class 04 was rejected.

The European Trademark Office rejected the application because the word elements "DESERT" and "FUEL" were perceived with a certain meaning by the English consumer, namely in the sense

of fuel from the desert or fuel suitable for the desert. The full expression "DESERTFUEL" would contain direct information for the purpose of the claimed fuel substances. Furthermore, extreme climate conditions in the desert could have an effect on the performance of petrol or motor fuel. The applied goods were therefore resistant against temperature differences in the desert and therefore highly efficient under extreme conditions. Consequently, according to the first examiner, the trademark had a descriptive meaning

with regards to the rejected goods and would lack distinctiveness.

With our appeal, we could achieve a decision in our client's favour. The Board of Appeal stated that the complete word DESERTFUEL was more than the sum of its both word elements DESERT and FUEL. The complete term was neither lexical nor by other means verifiable. The English speaking public could therefore not derive a clear meaning from the term DESERTFUEL.

The Board of Appeal supported our argumentation that a differentiation on particular fields of application of fuel is currently not common and also no technical development can be seen that renders such need obvious in the near future. The special climate conditions in desert areas are known at least as long as fuel is produced, with-

out a supply of desertfuel being known. The consumer of fuel or petrol is also not used to selecting fuel according to its field of application.

Although the desert could be interpreted as origin, the desert is too undetermined and the consumer would not have a clear geographical image with it.

Consequently, the complete term DESERTFUEL is not descriptive for the rejected goods. Thus, the Board of Appeal concluded that DESERTFUEL has sufficient distinctiveness and is eligible for registration.

Dipl.- Biotechnol. Vanessa Bockhorni (Patent Attorney)

**Decision of July 13, 2012 –
R 589-2012-4-DESERTFUEL**

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MOMO not confusable with MEMO



In the matter MOMO against MEMO, we successfully defended our client's interests, proprietor of the German wordmark MOMO, through all instances.

An opposition was lodged against the wordmark MOMO, which has been filed for the goods „wines“, by the proprietor of the wordmark MEMO, registered for both food stuff as well as for beers, mineral and carbonated waters and other alcohol-free drinks, fruit drinks and fruit juices and the like. The trademark department of

the German Patent and Trademark Office had rejected the opposition as there was no risk of confusion between both wordmarks. Subsequently, the opposing party lodged an appeal at the German Federal Patent Court (GFPC).

The GFPC solely saw a medium degree of similarity between the goods “wines” and “fruit juices” as far as grape juices are concerned, and between “wines” and “mineral waters”, as wines and fruit juices, especially grape juices, come from the same production site and therefore have a medium degree of similarity. Furthermore, wine and water are often mixed to spritzers and consumed parallel, so that there is therefore also a certain similarity between these goods.

The opposing party did not present any proof which would attribute a higher distinctive character to the opposition mark, so that the GFPC assumed an average distinctiveness of the older mark. The GFPC further noticed that the consumer shows a slightly increased attention regarding the goods “wines”. This is probably because wines are only occasionally bought by the average consumer and when buying a wine, more attention is paid to quality than when buying goods for everyday needs.

The Court shared our argumentation and further assessed, that because of the first emphasized syllables "O" and "E" of the marks, there was no phonetic similarity. In particular, MOMO and MEMO were spoken acronyms, with which one deviation of only one letter is sufficient to deny a danger of confusion. Phonetic differences could solely be seen in the vowel "E" of MEMO and the vowel "O" of MOMO, whereas the vowel "E" was a high-pitched sound which was pronounced long and the vowel "O" had a deep timbre and was pronounced particularly short. The opposing marks were visually significantly more similar than phonetically, however, the different conceptual character of the two marks led to the fact that the addressed relevant public was able to distinguish clearly between the two wordmarks. On the conceptual level, the average consumer

could relate the word MOMO to Michael Ende's novel "Momo", which has been filmed multiple times and of which there are several audio drama versions and one opera. In comparison, MEMO was related to a completely different understanding, namely "Memorandum", the short version of which is "Memo".

Due to the significant differences in conceptual and phonetic character, the GFPC was of the view that there is no danger of confusion between the wordmarks MOMO and MEMO.

Dipl.-Biotechnol. Vanessa Bockhorni (Patent Attorney)

**Decision by the GFPC dated December 14, 2011
(26 W (pat) 577/10)**

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„BIOFUN“ registrable

The German Patent and Trademark Office (GPTO) had rejected the application of the wordmark "BIOFUN" for goods of leather and leather imitations, textile materials, especially hand bags, shopping bags, purses as well as footwear in the classes 18 and 25. According to the GPTO, the word "BIOFUN" was solely a combination of the descriptive components "BIO" for the production of material out of naturally farmed goods without any harmful additives and of the term "FUN", which is customary used in the German language and which is a common buzzword in the fashion industry for a positive and carefree attitude towards life, e.g. in the combinations "FUNSHIRT" and "FUNFASHION". According to the GPTO, the wordmark "BIOFUN" lacks any distinctiveness.



able to translate the wordmark "BIOFUN" in the sense of "BIOSPAB", with regard to the claimed goods, it was however not possible to gather any descriptive indication from the word "BIOFUN" and "BIOSPAB" respectively. The decisive factor is the total evaluation of the wordmark "BIOFUN", not the individual assessment of the components "BIO" and "FUN". Therefore, the wordmark "BIOFUN" is registrable as it does not contain a descriptive character for the claimed goods and as it is definitely capable of serving as a means of identifying for the claimed goods of one company towards the goods of other companies.

Dr. jur. A. Blum von Ann (Attorney)

**German Federal Patent Court, decision dated
January 10, 2012, file no. 27 W (pat) 168/10**

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The applicant successfully lodged an appeal at the German Federal Patent Office against the decision of the GPTO. The German Federal Patent Office explained that the target group would easily be

„Surf.GREEN“ registrable

The German Patent and Trademark Office (GPTO) rejected the registration of the wordmark “Surf.GREEN” for the service “advertisement” (class 35). According to the GPTO, this is a sign the availability of which has to be preserved in the interest of the competitors and which lacks any distinctiveness. According to the GPTO, the wordmark consists of the components “Surf” in the sense of searching through the internet and “GREEN” in the sense of “green conscious, environmentally friendly” and is understood by the addressed target group as an environmentally friendly surfing in the internet, which stands in a closely descriptive relation to advertising services.

The applicant successfully submitted a complaint to the German Federal Patent Court against the decision of the GPTO. The German Federal Patent Court explained that to the average consumer and to domestic business clients, the English verb “to surf” as well as the Germanized word “surfen” are considered both as an aquatic sport as well as a term for searching through the internet. The word mark “Surf.GREEN” is no descriptive indica-

tion of the service “advertisement”. Although there are search engines on the internet, whose data centre is powered by eco-electricity, there are no advertising services which are particularly designed for such search engines or an environmentally friendly surfing and which by that distinguish themselves from other advertising services. Nor are there any advertising services which are particularly designed for an environmental exercise of the aquatic sport “surfing”. Therefore, it is not the case that the wordmark “Surf.GREEN” lacks any distinctiveness with regard to the service “advertisement”, but can rather serve as an indication of the provider of advertising services when the advertising services are marked with “Surf.GREEN” on the market. “Surf.GREEN” is not descriptive of advertising services and therefore the availability in the interest of any competitors does not have to be preserved. Therefore, the wordmark was registrable.

Dr. jur. A. Blum von Ann (Attorney)

German Federal Patent Court, decision dated February 6, 2012, file no. 26 W (pat) 522/11

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Picture: © anankml – Fotolia.com



„YoYo Foodworld“ and „YO“ not confusable

The applicant filed the wordmark YoYo Foodworld with the German Patent and Trademark Office (GPTO) in class 43 for gastronomy, namely services regarding the catering and hospitality of guests. The proprietor of the earlier wordmark Yo, registered in particular for fruit juices and mineral water as well as other non-alcoholic drinks in classes 05,

29, 30 and 32, filed an opposition. Upon rejection of the opposition by the GPTO, it lodged an appeal to the German Patent Court and pointed out, amongst other things, that its wordmark Yo had been used intensively and, as proved by a survey among consumers, had a degree of familiarity of 87 % in the sector of fruit syrups.

The German Patent Court agreed with the opinion of the GPTO and did not consider the two opposing wordmarks confusable.

The services of the younger wordmark “catering and hospitality of guests” only had a medium degree of similarity with the goods of the opposing mark non-“alcoholic drinks”. The opposing mark also only had a medium degree of distinctiveness. According to the GPTO, the opposing party did not demonstrate conclusively an increased wordmark recognition, as it did neither present anything regarding the

market share held by the wordmark nor anything regarding the intensity, the geographic dissemination and duration of the wordmark use and also did not specify the spent advertising material. In particular, however, the opposing party did not specify



Picture: © nasir1164 – Fotolia.com

the turnover achieved with the products in Germany. The survey among consumers, which had shown a degree of familiarity of 87 %, was leaving open whether it had been carried out in Germany or in another country. Furthermore, only 262 people had been asked, so that the survey was not representative.

The German Patent Court was of the view that the wordmarks Yo and YoYo were sufficiently distinctive in visual, phonetic and conceptual regard, so that a danger of confusion could be denied, whereas the component “Foodworld” as a solely descriptive term was disregarded in the evaluation. The wordmarks Yo and YoYo can therefore coexist.

Dr. jur. A. Blum von Ann (Attorney)

Federal Patent Court, decision of January 17, 2012, file no: 27 W (pat) 595/10

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„Coffea“ and „Caffeo“ not confusable

The wordmark “Coffea” was registered with the German Patent and Trademark Office (GPTO) for coffee machines in class 11. The proprietor of the earlier wordmark “Caffeo”, which was, among others, also registered for coffee machines, lodged an opposition against this registration. Upon rejection of the opposition by the DPMA, the opposing party lodged an appeal with the German Federal Patent Court. This appeal was not successful. The German Federal Patent Court denied a likelihood of confusion under trademark law between the opposed marks. There is a goods identity regarding the coffee machines claimed by both marks, however, both marks only contain a very low degree of distinctiveness. According to

the German Federal Patent Court, “Caffeo” and “Coffea” are both only a very minor modification of the smoothly descriptive German term “Kaffee” or its English equivalent “coffee”. Both marks are only slight modifications of the same non-protectable indication of goods, so that already slight varieties of the mark exclude the danger of confusion.

Dr. jur. A. Blum von Ann (Attorney)

German Federal Patent Court, decision dated February 14, 2012, file no. 24 W (pat) 126/10

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„Cutmetall“ not registrable

The word and figurative mark Cutmetall was filed for registration among others for machines and machine parts for the metal and wood working, plastic processing and paper industry, chopper knives, hammers, blades and knives of mowing machines. The German Patent and Trademark Office (GPTO) rejected the registration of these goods, as the Office is of the opinion that the word component of the mark was a descriptive product term, which was understood by the target group in connection with the mentioned

Picture: © Thomas Jansa – Fotolia.com



goods as a mere indication of state and purpose. The chosen graphic design of the mark, which is limited to underlinings and different size of the letters, was not suitable for awarding sufficient distinctiveness to the mark because of its habitualness in advertisements.

The applicant lodged an appeal to the German Patent Court which was rejected as unfounded. The German Patent Court also considered the word element “Cutmetall” a mere indication of the subject matter with the product related meaning “cutting, sawing, bevelling, milling of metal”. This did not only apply for metal working but also for the wood, plastic and paper industry, where a high abrasion resistance was also a requirement for good cutting results. The design of the lettering with underlinings of the mark was customary and did not provide the necessary graphic conciseness in order to convey distinctiveness to the mark, as the mark was not suitable for marking goods for the relevant public as coming from a certain producer.

Dr. jur. A. Blum von Ann (Attorney)

Federal Patent Court, decision of January 9, 2012, file no: 28 W (pat) 50/11

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Cosmobelleza not confusable similar to Cosmopolitan

The younger Community trademark COSMOBELLEZA (CTM 3494424) was registered on behalf of Vida Estética S.L. for “*organisation of exhibitions for commercial and advertising purposes*” in class 35 and for “*training, education ... of exhibitions...*” in class 41.

Based on earlier rights, namely national and international word marks and tradenames COSMOPOLITAN, COSMO, COSMOTEST, with effect in the UK, Spain, France, Germany, Austria and Italy, the company Hearst Communications,

Inc. filed an opposition against the younger CTM COSMOBELLEZA.

The opposition was not successful because OHIM and the General Court decided that, even if the earlier signs possess enhanced distinctiveness through reputation or extensive use, the older and younger signs markets and their respective consumers did not overlap. COSMOBELLEZA therefore is not perceived as forming part of a series of marks owned by Hearst Communications, Inc. Furthermore, the Office and the Court

compared the earlier rights and the applied trademark COSMOBELLEZA in different national jurisdictions based on their conceptual character. In Germany they could not find any obvious meaning because both signs are perceived as fanciful. However, in the UK, the trademark COSMOPOLITAN had a meaning, namely that of a person who "is worldly and familiar with other places and customs". When analysing the younger applied sign COSMOBELLEZA in Spain and France the Court came to the conclusion that the applied trademark would evoke the idea of "COSMIC BEAUTY", while the prior sign would

describe a person as it is understood in Great Britain. Due to the conceptual differences and the fact that the world element "COSMO" did not constitute the dominant element in the signs, the General Court found that the earlier signs, taken overall, and the mark applied for were dissimilar and there could be no likelihood of confusion.

Dipl.- Biotechnol. Vanessa Bockhorni (Patent Attorney)

**Decision of the European General Court,
Case T-344/09**

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[„ATOS“ and „Artus“ confusable](#)

The word mark ATOS was registered at the German Patent and Trademark Office (GPTO) in the class 32 for "non-alcoholic drinks; soda; bottled water; waters (drinks)". The proprietor of the earlier mark "Artus", protected for the goods "mineral waters, fizzy drinks, lemonades", filed an opposition against this registration.

The Federal Patent Court decided that the word-mark ATOS has to be cancelled as there is a danger of confusion between the opposed marks. There is a goods identity between the opponent's goods "fizzy drinks, lemonades" and the "non-alcoholic drinks" of the opposed mark. The latter's further goods "soda; bottled water; waters (drinks)" are very similar to the goods of the opposing mark "fizzy drinks, lemonades". With regard to the phonetic character and the typeface, the marks "ATOS" and "Artus" are confusingly

similar. With regard to the phonetic danger of confusion, the arrangement of the syllables and the order of vowels are in particular decisive, whereby the first compounds of the words are more closely observed. ATOS and Artus are virtually identical with regard to the letter string; the additional consonant "r" is of hardly any consequence in the phonetic pattern, nor is the vowel deviation in the last syllable "o" respectively "u". Due to an identical stress and identical arrangement of the syllables, both marks are very similar with regard to their overall appearance. Therefore, in order to avoid any danger of confusion, the younger mark had to be deleted.

Dr. jur. A. Blum von Ann (Attorney)

**Federal Patent Court, decision of March 6,
2012, file no. 24 W (pat) 104/10**

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[„ragstar“ registrable](#)

According to the Madrid Agreement, the word-mark "ragstar" had been registered internationally with Belgium as the country of origin in class 25 for clothes, shoes, headgear, and an extension of protection to Germany had been applied for.

The German Patent and Trademark Office (GPTO) rejected the extension of protection to Germany, and the wordmark proprietor successfully submitted a complaint to the German Federal Patent Court.

The German Federal Patent Court considered the wordmark “ragstar” to be capable of being protected. Although its individual components “rag” and “star” are descriptive of pieces of fabric or cloth respectively for a premium product, the combination of both components, which is decisive for the required overall evaluation, is vague and unclear in relation to the claimed goods. Even if the addressed consumers could translate

the wordmark in the sense of “fabricstar” or “clothstar”, the meaning of the word combination would still remain unclear. The wordmark “ragstar” therefore contains the necessary minimum of distinctiveness, and the decision to a refusal of protection by the GPTO had to be repealed.

Dr. jur. A. Blum von Ann (Attorney)

German Federal Patent Court, decision dated January 17, 2012, file no. 27 W (pat) 587/10

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Trademark use for cigarettes in Australia

The Australian government recently decided that cigarette products may no longer be marked with trademarks. For cigarette packages in trade, solely wordmarks are allowed, whereas the usage of logos, illustrations and the like will be prohibited. Further to this prohibition of using logos and the like on the cigarette package, the font, the font size and the font colour of the wordmark - the vestige which can still be used on cigarette packages - are preset. The rest of the package will be filled with written and graphic health warnings.

Philip Morris Asia Ltd., Hongkong, has now initiated an arbitration proceeding against the Australian government and the Ukraine, too, accuses Australia of breaching the TRIPPS Agreement, the General Agreement on Tariffs and Trade (GATT) and the WTO agreement on Technical Barriers to Trade (TBT agreement). Therefore, an adversary proceeding will take place before the World Trade Organisation, whereby a decision is expected in approximately two years.

Such a regulation of a market segment seems incon-



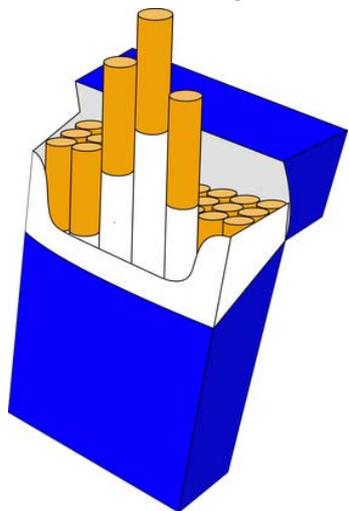
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ceivable in Europe. Nevertheless, the prospects of reducing the number of smokers in Australia might be promising. The tobacco industry will have to expect a significant slump, particularly because a few other countries are planning to preset the look of cigarette packages, e.g. completely white packages for tobacco products. Latest news: (now former) EU Health Commissioner John Dalli wanted to introduce strict measurements against smoking by implementing a new tobacco product directive.

This development is problematic for new companies which will very likely have difficulties gaining a market presence without any advertising efforts.

Dipl.- Biotechnol. Vanessa Bockhorni (Patent Attorney)

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COPYRIGHT / COMPETITION LAW

No copyright for the function of computer programmes (CJEU)

A little excursion into software and copyright



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In a recent decision of May 2, 2012 (file no. C-406/10), the European Court of Justice (CJEU) decided that the functionality as well as the coding language of a computer programme is not protected by copyright. Consequently, the owner of a programme license is always entitled to observe, examine or test the functioning of the computer programme in order to determine the underlying ideas and principles.

With its decision, the CJEU emphasizes various principles from the integration of software protection into copyright. In particular, with the present decision, it expresses that neither the functionality of a computer programme nor the coding language used in the frame of a computer pro-

gramme nor the data format represent an expression form in the sense of the copyright. By that, the elements functionality, coding language and data format – just to mention a few “mechanical” elements of a computer programme – do not enjoy any copyright protection. If, however, the functionality of a computer programme was accessible to copyright protection, one would monopolize ideas as well as a variety of software related approaches, and this would lead to a disturbance of technical progress and industrial development.

The present decision of the CJEU is based on the guideline of protection of computer programmes (RL91/250/EWG), with which the legal protection

of computer programmes was integrated into the already existing copyright. The implementation of this EC-guideline has, for example, led to sections 69a-69g in the German copyright act. The regulations relevant for software in the copyright act are special regulations, which treat software as literary work. By that, a protection for those software programmes is obtained, too, whose protectability so far failed due to threshold of originality required by the copyright act (cf. sec 2 subs 2, copyright act). In contrast to patent law, copyright demands individuality of the software. However, the presence of objective novelty of the work and software, respectively, is not required, as the copyright does not protect the new result but rather the individual producing.

Therefore, the copyright protection of the computer programme only refers to the expression form of ideas and principles of a computer programme. However, neither the functionality of the computer programme nor the coding language or the data format, which are used in the

frame of the computer programme, represent such an expression form.

Based on the shortly summarized legal situation above, the CJEU therefore highlights in its present decision that no infringement of copyright is present when the licensee examines, observes and tests the computer programme in order to reproduce its functionality in a new computer programme without access to the source code of the computer programme. In contrast to that, when reproducing certain elements of a manual of a computer programme protected by copyright, an infringement of copyright on the mentioned manual may, however, be present. This is particularly the case when this reproduction expresses the intellectual creation of the author of the manual.

(Further details can be gathered from the complete text of the press release of the CJEU on its websites. Source: CJEU, press release dated May 2, 2012).

Dr. Volker Heyer (Patent Attorney)

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CURRENT ISSUES & NEWS

Inconsistent development in application figures at the GPTO in 2011



Picture: © M.studio – Fotolia.com

The German Patent and Trademark Office recently published a statistic on application figures in the year 2011. In this statistic, the application figures for patents, utility models, design patents and trademarks are compared with the application figures of the previous year. While the number of patent applications is roughly still at the same level as in 2010, there is at the same time a decrease of application figures for trademarks and utility models by about 7 % and 9 %. In contrast, the number of design patent applications increased by 7 %, a number that emphasises the importance of the latter.

The briefly summarized application figures above make clear that despite increasing cyclical strategic deliberations and because of a change in cost awareness, Germany has not lost its significance as an industrial location and source of innovation. 78.6 % of patent applications come from German companies whereas 21.4 % of patent applications trace back to foreign companies, e.g. in the USA, Japan and Korea.

As in the previous years, companies of the sectors automotive and mechanical engineering count among the strongest applicants. In a national comparison of application figures, Baden-Württemberg is still ahead, closely followed by Bavaria and North Rhine Westphalia on the third place. According to the GPTO, the leading patent applicants are Robert-Bosch GmbH with 3602 applications, Daimler AG with 2014 applications as well as Siemens AG with 1910 applications.

A possible explanation for the decline in the number of trademark applications can be found by referring to the number of applications for community trademarks. In the years 2010 and 2011, the number of applications for community trademarks at the Office for Harmonization in the Internal Market increased by 11 % and 6 %. One might well suppose that there is an appreciation of applicants for the community trademark behind that, as with a community trademark, despite higher costs, one can get a trademark protection within the whole economic area of the European community. With the European integration and the constant expansion of the European

domestic market, a German trademark with its restricted scope of protection to the German market only, seems to slightly take a backseat. Whether this explanation is actually correct and whether the currently displaying trend in application figures will continue, future will yet have to show.

In contrast to trademark applications, the increased application figures for German design patents show a similar trend as the application figures of community design patents. In the years 2010 and 2011, the number of applications for community design patents increased by 4.5 % and 5 % when being compared to the respective previous years.

The reasons for the changing application behaviour with regard to design patents can unfortunately only be presumed, as reliable statistics and surveys among applicants are missing. However, a changed awareness of industry seems to become apparent, an awareness that for example technical devices do not only convince the consumer with their "inner" potential, but also and precisely with their outer design. Furthermore, besides the existing trademark, the design protection gains in importance, as it ensures the recognition value. By this, the protection of shapes creativity and design creativity through the design patent offers an additional protection against the access to extraordinary designs and products by copycats.

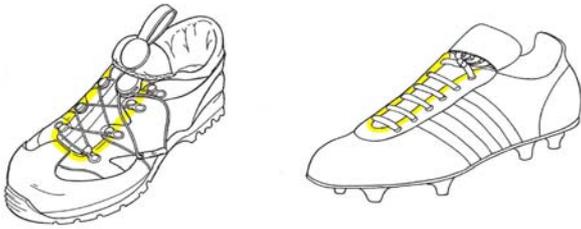
Dr. Volker Heyer (Patent Attorney)

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[Current followup to the strategy discussion „Way via EPO or national way“](#)

These days, we had an invalidity proceeding before the Federal Court of Justice between two renowned producers of sportswear. This proceeding concerned a sports shoe containing a receiving pocket for stowage of a closure device in the form of a blocker. As can be seen from the following comparison, which shows the sports shoe according to the patent on the left and the sports shoe according to the prior art on the right, the

sports shoe according to the prior art also already contains a corresponding receiving pocket for a conventional lacing with bows and shoelaces. The sports shoe according to the patent only distinguishes itself by the blocker, i.e. by the special kind of closure device, which was already clear prior art on its own. Despite this prior art, the patent was granted by the EPO.



In principle, the lack of legal validity was apparent, however, no opposition was filed against the European patents of the patent proprietor S, so that every competitor was faced with a bundle of national patents from the EP patent as it is the case with patents via a pure national way. S sent warning letters diligently and it was only B who took action against the patents. Both in the first instance as well as in the second instance, the patents were cancelled.

This leads to a settled situation in Germany, however, other infringers and the infringer B, represented by our office, are still confronted with the national patents in France, Italy, Spain etc., so that S as the patent proprietor still has a very competitive position towards comparable sport shoes and can also display this position.

This shows that national patents make life hard for the infringer and that an enormous effort is necessary to establish his position on the European market. As an aside it should be said that infringer B has not sold the sports shoe in Europe since the beginning of the infringement action. In this respect, despite the lack of legal validity, the patent proprietor S did win in the end due to his patent situation. This is also a proof which shows that the national way provides a good position against infringers without the danger of a central attack of all patents like in an EP-opposition proceeding.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

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Conclusion: A central attack by oppositions would have been successful here and would have led to a cancellation of the patents. As the competitors missed to do so, one is now confronted with a bundle of national patents as is the case with national applications; this results in a conceivable deterioration of the situation for the infringers.

Trip to the Oktoberfest

Our office's annual trip to the Oktoberfest was once again accompanied by bright sunshine. Even if the beer festival itself hardly had any influence on the application numbers of property right, a part of our office team could jovially and fully relaxed enjoy the flair at the Oktoberfest with a roast chicken and a glass of beer.



The enclosed picture of one of our tables at the Oktoberfest in the "Hofbräu" marquee reflects the atmosphere during the Oktoberfest in Munich. Perhaps this induces you to visit the Oktoberfest next year – we would be happy to accompany you.

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