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Dear Reader

Our third UPDATE of the year 2011 mainly focuses under Patent Law on some guidelines dictated by recent jurisdiction in connection with preliminary injunctions based on German patents as well as the question of equivalent infringement. These decisions are also important seen from the point of view that the majority of patent infringements based on European patents are pled before German infringement courts, in particular before the courts of Düsseldorf.

So the Higher Regional Court Düsseldorf, well-known for infringement proceedings, has put very tough bars on preliminary injunctions based on German patents and has therewith even tightened the restrictions from the Olanzapin-Decision issued two years ago.



This should also have respective effects particularly also on fairs in Germany and in connection with the Decision "Pralinenform II" of the German Federal Court of Justice, which we already reported about in our first UPDATE this year. In short, discovering exhibited infringing products during a stroll around a fair is in future not sufficient anymore for a preliminary injunction and special aspects have to be considered for injunctions just to have even the chance for issuance of a preliminary injunction.

Preliminary injunctions based on a German patent are basically due to the current jurisdiction only promising, if there is already a positive decision in an opposition or invalidity proceeding. The very exhibition of a product on a fair is by the way not sufficient anymore to claim to cease and desist.

Moreover, we report about the decision "Okklusionsvorrichtung" which brings an overdue clarification regarding the scope of protection in terms of equivalence and is very helpful for the determination of the scope of protection of a claim. Furthermore, we also address interesting decisions in Trademark and Competition Law.

We hope that these topics appeal to you and that the one or the other topic also finds your interest for your decision making. In case you wish any additional information to the individual articles, then of course we are at your disposal. That is why we have also mentioned under each report the respective author of each article from our office.

We hope you enjoy reading our information.

Best regards

Josef Bockhorni
(Patent Attorney)

PATENT LAW

Small chances of success for preliminary injunctions based on German patents in the future?

Even though preliminary injunctions based on infringed German patents were hardly or only possible in specific exceptional cases in the past, fortunately this has changed in the last 10 years. However, the German courts, by name the Higher Regional Court Düsseldorf, has now put the screws on again so that preliminary injunctions based on German patents are hardly possible against infringers anymore or only very difficult to obtain and that at the most only in specific exceptional cases.

Decisive therefore is the jurisdiction of the Higher Regional Court Düsseldorf, whereby this negative development was already foreshadowed in the so-called Olanzapin-Decision of the Higher Regional Court Düsseldorf from 2008 (Not.2008, 327) and has now been supported and confirmed by the Decision "Harnkatheterset" of the Higher Regional Court Düsseldorf dated April 29, 2010.

In regard of preliminary injunctions in patent matters the Olanzapin-Decision has pointed out that a preliminary injunction is only then considered, if the answer to the question of patent infringement as well as the validity of the respective patent is as a result so clearly in favour of the petitioner that seriously no other decision in possible subsequent proceedings on the merits could be issued.

This jurisdiction has now been defined in so far that according to the "Harnkatheterset"-Decision the very grant of the patent by the German Patent and Trademark Office or the European Patent Office alone is not sufficient for the assumption of legal validity of the patent, rather the opposed patent must have already successfully overcome a first instance opposition or invalidity proceedings. Moreover, a positive decision of the therefore responsible opposition or invalidity instances with technical knowledge is required. According to the Higher Regional Court Düsseldorf these require-

ments shall only be disregarded in distinct exceptional cases.

For the record, probably the fewest patents - no matter whether national German patent or German patent based on a European patent – have already successfully passed an opposition or invalidity proceeding at the time of the request for a preliminary injunction. Insofar in practice it depends on the fact what exceptions for a preliminary injunction may still be considered.

Such cases were also mentioned by the Higher Regional Court Düsseldorf in the "Harnkatheterset"-Decision. An exception e.g. is when the defendant already participated in the granting procedure of the opposed patent with own objections, so that the grant of the patent so to speak objectively puts the decision in a bilateral opposition proceeding on par.

Therefrom it can again be taken that such objections based on submission of a third party have to be avoided in future as far as possible, since one is not the participating party and in particular risks that preliminary injunctions may be obtained even without a positive decision in an opposition proceeding.



According to the Higher Regional Court Düsseldorf further exceptions are that the opposed patent is already licensed by well-known licensees. This is then indirectly a good reason for the legal validity of the opposed patent.

A further exception could be that there are extraordinary circumstances considering the market situation or the disadvantages looming from protective right infringements making it exceptionally impossible for the petitioner to wait for the outcome of an opposition or invalidity proceedings.

All these, however, are “exceptions” that hardly apply in practice. There will only be well-known licensees when there are essential patents, e.g. patents for industrial standards. Also the reference to extraordinary circumstances can in practice normally not intervene.

This new orientation of German jurisdiction is also important regarding international fairs in Germany. As we already pointed out in our first UPDATE this year, the Decision “Pralinenform II” of the German Federal Court of Justice makes obtaining preliminary injunctions against products that are exposed on a fair in Germany more difficult. According to this jurisdiction the very exhibition of a product is no assumption yet that this product shall be offered or used in Germany. Although this decision of the FCJ was taken in a trademark matter, it may also be applied to patents, as it is shown by a recently issued decision of the District Court Mannheim dated October 29, 2010 (Not. 2011, 245 - Official file 7 O 214/10). The District Court Mannheim has hereby referred to the jurisdiction of the German Federal Court of Justice and also applied it now to patents.

Altogether in future it will be very difficult in Germany to obtain preliminary injunctions in patent litigation proceedings. Nevertheless, if this is still tried, then the request for a preliminary injunction has to be formulated respectively strong and convincing with focus on the presentation of the legal validity of the corresponding patent. Since – as it is well-known – preliminary injunctions have to be applied for preferably within four weeks from knowledge of the infringement due to the requirement of urgency, this procedure is naturally made more difficult. Therefore it is important to already explain the legal validity of the opposed patent in such a way with filing the petition, so that the court concludes that the expected objections of the defendant are so to speak “unfounded”.

Altogether this jurisdiction prohibits issuance of a preliminary injunction based on a utility model unless the utility model had already successfully passed first instance cancellation proceedings, which again may rarely be the case.

We highly regret this recent development in German jurisdiction regarding preliminary injunctions based on technical protective rights, since we regard this development as counterproductive to the basic idea of Article 50, paragraph 1 a of the TRIPS Agreement as well as the Directive 2004/48/EC on the Enforcement of Intellectual Property Rights with the aim to secure effective implementation of protective rights also by way of preliminary legal protection.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

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[Equivalent infringement and scope of protection of patents](#)

The Decision “Okklusionsvorrichtung” of the German Federal Court of Justice (FCJ) has further concretized the requirements for an equivalent patent infringement. When the description features several alternative possibilities and the patent owner decides that only one of these possibilities is to be included in the claim, then the

other remaining possibilities do also not justify an equivalent infringement.

In detail, the patent in suit covers a device featuring clamps for clamping wire ends on **opposite** ends of the device. The description of the patent in suit features both a description of an

embodiment with wires rotated by 180° and of alternative connections like soldering, hard-soldering and welding. The wires in the attacked infringing embodiment are rotated by 180° so that they end **on the same end** of the device. The wire ends are welded or melted with one another on this one end. The subject matter of infringement therefore differs from claim 1 by the fact that the wires end on the same end of the device and not on the opposite end and that they are not clamped there but welded or melted with one another.

An infringement in the literal sense is not given, since this would lead to a claim version that is too broad. For example, then the requirement of the opposing wire ends would not be fulfilled anymore. Moreover, the requirement of the clamps on the wire ends would not be fulfilled. Therefore, a narrow claim shall not be interpreted according to a broader composed description.

An equivalent infringement is also not given, since in the present case the patent owner has decided on one possibility (here: clamping) from a series of possibilities mentioned in the patent (as e.g. soldering, hard-soldering and welding).

This leads to the exclusion of an embodiment from the patent's scope of protection which is disclosed. The FCJ justifies this with the fact that the reader of the patent specification has to assume that this embodiment shall not be put under protection, since it is not reflected in the claim (FCJ, Decision dated May 10, 2011, official file: X ZR 16/09 - Okklusionsvorrichtung).

In practice it is therefore important to choose carefully when selecting one possibility from a series of possibilities mentioned in the patent application. Criteria therefore are here on the one hand economic usability by the patent owner as well as on the other hand blocking workarounds for competitors. If the use of the preamble is not possible in the course of the granting procedure anymore, then as many alternatives as possible should be included in the claim. If several alternative possible solutions cannot be prosecuted further in one and the same patent application, then it is recommended to prosecute them further by way of a divisional application.

Dipl.-Ing. Nils Winthuis (Patent Attorney)

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Loss of urgency in preliminary injunction proceedings

An essential requirement for obtaining a preliminary injunction is its urgency. The petitioner of a preliminary injunction has to substantiate it and therefore has to file the request without any culpable hesitation because otherwise the opponent can refer to lack of urgency.

The Higher Regional Court Hamm had to decide in a present case whether urgency may be lost again also after filing the request (Decision dated March 15, 2011, official file: I-4 U 200/10). In the case at hand the petitioner had filed an appeal

against the decision to reject the preliminary injunction and requested an extension of the deadline of the substantiation of appeal by three days. Moreover, it was requested to reschedule the oral proceedings dated February 18 to March 03, 2011 due to a traditional event ('Weiberfastnacht' – Thursday before Shrove Tuesday).

The court of appeal saw the assumption of urgency in regard of the preliminary injunction as disproved because the petitioner has to do anything possible to speed up the proceedings. The

petitioner therefore had to suggest to schedule the date of the oral proceedings earlier or to send a replacement representative. Therefore it did not depend on an evaluation of the original grounds for the rejection of the preliminary injunction

anymore, since the request lacked urgency at least in the stage of appeal.

Dipl.-Phys. Dr. Jan-David Hecht (Patent Attorney)

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Result:

If a petitioner of a preliminary injunction is not yet secured by such, then anything possible has to be done to speed up the proceedings also after filing the request at the court; otherwise loss of urgency poses a threat.

A request to reschedule oral proceedings may only not be harmful to urgency, when it is explicitly stated to schedule it earlier. Otherwise it must not be filed.

Therefore our recommendation to our clients in preliminary injunction proceedings is to always transmit all necessary information immediately after our request so that no petitions for extensions of time have to be filed.

Interesting changes in US Patent Law

On September 8, 2011 the US Congress has decided on decisive changes of the US Patent Law which has been in force since 1952. President Obama signed them into law on September 16, 2011. A part of the changes will be implemented on March 16, 2013, a part of the changes on September 16, 2012 and a part of changes has already been implemented by President Obama signing them into law on September 16, 2011. In the following we may inform you about the decisive changes:

1. Changes effective with March 16, 2013:

- The current so-called first-to-invent system is replaced by the first-inventor-to-file system. Therefore the Patent Law changes leaning onto worldwide practice, according to which the person who filed the patent application first is entitled to the right of the patent independent from the date of the invention.



However, there is a one-year grace period for inventors. Once an inventor has disclosed his invention to the public, the inventor enjoys a one year grace period during which third parties are barred from filing applications on this invention. In accordance therewith the current so-called interference proceedings are replaced by the so-called derivation proceedings, where an inventor may challenge a patent application of a third party, when that application is derived from the invention of

the actual inventor. This shall encourage inventors to file their invention as a patent as fast as possible. At the same time long-lasting and cost-intensive interference proceedings determining who was the first inventor are eliminated.

- Not the date of the invention is decisive for the prior art anymore but the date of filing. This also applies for the prior art that is relevant for the assessment of inventive step.
- The fact that up to now prior public use in the USA could only be held against a patent when the sale or use was in the United States has now changed insofar that also foreign sale or use is decisive for prior public use.
- For US patent applications claiming priority of a foreign patent application the date of filing of the foreign application, therefore of the priority application is decisive for the determination of the relevant prior art instead of the date of filing of the US application, as it was up to now.
- For biotech inventions it is decisive that now each claim that is directed to a human organism or encompassing it is not patentable anymore. Of course, this leaves room for judgement evaluation so that the scope will probably be determined by US courts.

2. Changes effective with September 16, 2012:

- Introduction of a nine-month opposition deadline starting with the date of grant of the patent. An opposition, however, requires that the opponent demonstrates that it is more likely that at least one of the patent claims is not allowable.
- Each third party may request an inter pares review after the nine-month opposition deadline independent from the opposition. Hereby the threshold of the current inter pares re-examination of the patent is increased since there has to be a reasonable likelihood that at least one of the claims is not allowable.

3. Changes effective with September 16, 2011:

- A patent does not necessarily lack legal validity anymore when the patent specification lacks the description of a best mode, even though the description of a best mode is still required.
- Now the Patent Law provides a fast track system for patent applications.
- Moreover, there are cost reductions for small companies and the US Patent and Trademark Office is allowed to set their own fees in future.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

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My comment:

All in all, the decided changes are to be welcomed in terms of a worldwide harmonization of patent laws. We doubt, however, whether current opposition regulation can be maintained in the long run, since it should be more likely than not that a patent claim is invalid and, moreover, in the USA individual oppositions are examined separately so that this regulation surely leads to a respective back log due to the individual cases. Therefore we are sure that this regulation will be revised in a couple of years.

TRADEMARK LAW

Internet advertisement: competitive trademark as the key word for displaying an advertisement

Most various sales levels relocate from the real business world with personal contact, phone, fax and email to the virtual sector of the world wide web. Because of the world wide web, larger business fields may be accessed faster, most various customer groups addressed in a parallel way and business deals or at least business start ups made possible faster. Correspondingly, also advertising relocates from classic media to the world wide web. A form of this advertising is key word advertising, e.g. by Google-AdWords. Put in a term to be searched in Google and next to the hit lists automatically appear advertisements on

Is this an infringement of the competitor's trademark rights?

The German Federal Court of Justice (FCJ) and the European Court of Justice (ECJ) have decided that the use of a competitor's trademark as a key word for displaying an advertisement of own products is not to be seen as a trademark infringement (*Banana Bay II*, FCJ IZR 125/07). In a particular case, for example, a user searches in Google for a "soccer ball of the trademark X", whereupon – indicated by the trademark name "X" - flashes up the advertisement for "soccer



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the image border next to it that are linked to the searched term. For this purpose so-called key words are placed for the advertisement. For example, an advertiser puts in the trademark of a competitor as a key word. Thus, by customers clicking on the newly slot-in advertisement, the advertiser tries to lure them to his own website via the search term of the competitor's trademark.

balls of the trademark Y" on the image border and catches the user's eye. The FCJ and the ECJ do not see this kind of advertising and particularly the link between search term and indication/display of the advertisement as a trademark infringement, since no function of the trademark used as a key word is infringed. Provided that the trademark used as a key word does neither appear in the text nor in the internet link of the advertisement. Namely, the function of origin of the

competitor's trademark is not spoiled because the link of the competitor's trademark with the advertiser's product does neither take place automatically nor in the advertisement displayed. Moreover, the advertisement appears on the right of the Google hit list in the advertising part – therefore apart from the hit list. This creates a clear cut off between the products of the searched competitor's trademark and the hit list on the one side as well as the advertisement that is, however, next to it but placed apart from the searched trademark name on the other side. The advertising function of the searched trademark is not affected by key word advertising either. The advertising function unfolds due to the combination of the searched trademark in the search box and the products appearing in the hit list and belonging to the searched trademark.

The FCJ shows with its decision a clear difference between key word advertising and placing the trademark of a competitor as a meta tag on a website of the advertiser. Such meta tags cause that an indication to the advertiser's website appears within the hit list for the competitor's trademark. The user, however, expects offers of the trademark owner or of his linked companies in the hit list so that the advertiser's meta tag link to his own products via the competitor's trademark spoils the function of origin as well as the advertising function of the competitor's trademark.

Dipl.-Phys. Dr. Volker Heyer (Patent Attorney)

Impuls, FCJ I ZR 183/03

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Legally valid use in case of using a Community trademark in only one contracting Member state of the European Union?

For some time it has been disputed in the European jurisdiction what is to be understood under use of a Community trademark "within the Community". In the past use of a Community trademark in only one Member state of the European Union was acknowledged in jurisdiction. Thereby particularly the question arises whether use in only one small Member state e.g. Cyprus may be sufficient, since the European Union is relatively large and today comprises 27 Member states.

In the case ONEL./OMEL, the Benelux Trademark Office has recently considered the proof of the legally valid use of the opposing trademark in only one Member state as not being sufficient. Therewith the Benelux Office draws even with the Hungarian Trademark Office, which recently decided the same way in the case CITY INN./CITY HOTEL, whereby the proof of legally valid use in here only one Member state was not acknowledged as being sufficient.

After substantial criticism now the Court of Justice in the Hague has suspended the legal proceedings in the case ONEL./OMEL and presented

three questions regarding the topic to the European Court of Justice. The European Court of Justice now has to decide about the question whether Article 15 paragraph 1 of the Directive about the Community trademark shall be interpreted in such a way that it is sufficient for genuine use of a trademark when the trademark is used within the borders of just one Member state provided that said use would be valid as genuine



use in said Member state if a national trademark is concerned?

The answer to this question is of importance for the trademark owner's decision whether to file a Community trademark or, however, a national trademark due to the use in only one Member

state. We will keep you informed about any further process regarding the question put forward.

BBiotech (Hons) Vanessa Bockhorni

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Slogan "Wir machen morgen möglich" (We make tomorrow possible) distinctive

The Slogan "Wir machen morgen möglich" (We make tomorrow possible) was filed by the applicant at the German Patent and Trademark Office with a comprehensive list of goods and services, among others goods and services such as "electronic safety and supervisory devices; computerized telecommunication and network systems; organization of seminars; design and development of programs for access control". The Trademark Division for class 9 of the German Patent and Trademark Office had rejected the application due to lack of any distinctiveness according to § 8 (2) No. 1 German Trademark Law. Reasons given were that the word sequence 'We make tomorrow possible' is an ordinarily formed advertising statement of general type pointing to the future, future development or life in the future and therefore to a business offering its services to progress.

The applicant's appeal was directed against this decision. The German Federal Patent Court has thereupon decided that no describing and emphasising meaning is to be seen in the advertising slogan in regard of the claimed goods. The component 'tomorrow' of the trademark, refers to the next day or also the future, whereby 'possible' stands for "achievable, imaginable". Although the trademark gives the impression that goods and services lean on progress and future developments, however, this describing core of the

statement is not in the filed trademark's focus but presented to the public rather subliminally. Moreover, a certain interpretation effort is necessary (cp. "Vorsprung durch Technik" –'lead through technology') and the trademark gains a certain originality and conciseness by using the same initials when lining-up the words 'make tomorrow possible'.

Generally applies that advertising statements of general type, promotions, established phrases and word sequences, that have entered the vocabulary as firmly established phrases basically are of the competitors' interest so that such word sequences must remain freely available. Whereas distinctiveness of an advertising slogan cannot be denied when it contains originality and conciseness. So distinctiveness can then not be denied to an individual rather simple statement, when it cannot be determined whether the statement is required in its exact form for free use by the related business fields. (cp. German Federal Patent Court GRUR 2004, 333, 334 – ZEIG DER WELT DEIN SCHÖNSTES LÄCHELN-'show the world your most beautiful smile').

BBiotech (Hons) Vanessa Bockhorni

**German Federal Patent Court, Decision dated
May 19, 2011, 30 W (pat) 501/11**

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Graphical illustration of 3-dimensional trademarks

The constitutional principle of legal certainty requires that the subject matter of protection has to be clearly determined and defined in its precise embodiment when registering a trademark.

The



three-dimensional mark filed in class 30 for products made of cocoa and chocolate does not fulfil this requirement because it is limited to an image of a wavy chocolate stick with crumbs and it cannot be taken from the image in how far protection regarding the third dimension is claimed. The three-dimensional design and expansion are in particular not to be seen in the illustration. It lacks any perspective element and it is just as little to be seen whether the illustrated chocolate stick is round in diameter or oval and whether the wavy stick goes in a dimension up and down or is

twisted and therefore has a further dimension in depth. The illustration filed would cover a multitude of various three-dimensional designs.

Since the graphical illustration does not define the subject matter of protection precisely and within legal certainty, a registration as a three-dimensional mark cannot be made. There could be a different outcome when the applicant had only filed for registration as a figurative mark and not a three-dimensional mark. The subject matter of protection of a figurative mark is the image itself. The subject matter of a three-dimensional mark, however, is not the image but the image is only a representation of the design to be protected three-dimensionally.

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

German Federal Patent Court, Decision dated July 21, 2011 – 25 W (pat) 8/09

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Confusion between NORMA and YORMA'S

The trademark



was filed as a Community trademark in class 35 for retail services with diverse foodstuffs and in class 42 for the service board and lodging of guests. Due to the mark



older in priority, registered among others for foodstuffs in classes 29 and 30 as well as for beverages in classes 32 and 33 and been used for decades for retail services of a supermarket chain, an opposition was raised leading to the rejection of the application of the mark YORMA'S in the last instance before the Court of the European Union.

The Court confirmed danger of confusion between the two opposing marks. The retail services claimed by the mark YORMA'S are similar to the good foodstuffs, since they are to be seen as supplemental due to their close connection. The same applies to the service board of guests and the good foodstuffs. Services rendered within the scope of retail are in particular the selection of the line of goods as well as further actions that shall provoke the customer to buy the goods. The retail service would be useless without the goods covered by the earlier mark. There is a close connection between said goods and the retail services as well as between the goods and the service board and lodging of guests.

Moreover, the Court considers the opposing marks as being similar in image and sound. The overall picture of the mark YORMA´S is formed by the word component, while the graphical component is only of subordinate importance, since it is only seen as a decorative element and not as an element indicating the business origin of the goods. The character sequence "ORMA" is identi-

cal in both marks. The differing initials "N" respectively "Y" as well as the apostrophe with the following character "S" are not that conspicuous as to neutralize the similarities. In the light of the existent danger of confusion the application of YORMA´S was therefore rejected.

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

**Court of the European Union, Decision dated
February 15, 2011, T-213/09**

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Identity in sound of two word/figurative marks but with distinct different image components

The plaintiff is the owner of the trademark



registered at the German Patent and Trademark Office for class 18 in particular for leather, leather goods, suitcases and umbrellas. The defendant had registered the later mark



for identical goods. The plaintiff filed a request for cancellation of the later trademark.

The German Federal Court of Justice approved danger of confusion. There is identity in goods

and of the respective word components. Although the image components differ distinctively from one another, the clear differences of the image component could only neutralize identity in sound regarding goods that are regularly bought only "by sight" and not by demand. Only if the customer of the goods notices the goods optically, visual differences may neutralize the concordance in sound of the respective word component and exclude danger of confusion. The present case concerns leather goods that are bought by demand without visual inspection. Therefore there is a danger of confusion.

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

**German Federal Court of Justice, Decision dated
January 20, 2011 – I ZR 31/09**

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Confusion between trademarks with the same figurative motive but different word components

The trademark



was registered at the German Patent and Trademark Office (GPTO) for milk and milk products as well as coffee, tea, cocoa and ice cream. The owner of the CTM-mark



elder in priority, however, filed an opposition. The opposing mark was registered in particular for the products eggs, egg powder and food on egg basis. After rejection of the opposition the owner of the mark elder in priority filed an appeal at the German Federal Patent Court.

According to the German Federal Patent Court there is neither identity nor a high similarity of the opposing goods. There is only a close common ground between the goods "ice cream" and "food on egg basis", while there is only a medium similarity between the goods "eggs" and "milk, milk products".

Although these are respectively agricultural products, the products have a different business origin, since milk and milk products are normally produced and processed in dairies. The question of trademark similarity is evaluated according to the overall impression of both marks compared. Generally the respective related fields of business orientate themselves more on the word than on the figurative component provided that not by way of exception the word component is only of subordinate importance. This however is in the light of the size of the word component here not the case. The opposing word components formative for the overall impression "DON GELATI" and "Lion Quality" are entirely different from one another. Moreover, both lion images have distinct differences. The lion image of the opposing trademark features the additional element of a crown above the head; the lion of the attacked trademark has in contrast to the opposing mark an open mouth and a tongue sticking out. Both lion images have a different style. Furthermore, the lion is seen as the "king of animals" and insofar comprises a promoting proposition in terms of high quality of the products advertised. The motive of a lion does therefore normally not deliver a statement about the business origin of the goods. Therefore there is no danger of confusion between the opposing trademarks.

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

**German Federal Patent Court, Decision dated
June 27, 2011 – 25 W (pat) 40/10**

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Using the name of a famous music band for merchandise articles



The mark was filed as a trademark among others for goods in class 25 for protective clothing for practising Asian martial arts (Budo). The owner of the word mark SCORPIONS, elder in

priority and registered among others for clothing and headgear, in particular T-shirts in class 25, filed an opposition against the application. Hereby the owner is the famous German Rock band SCORPIONS. So the applicant raised the objection of lack of use and was of the opinion that the

word mark Scorpions has not been relevantly used as a trademark, since it was only printed on T-shirts for advertising purposes for the band with the same name and does not contain any indication of business origin relating to a certain company.

The German Federal Patent Court has decided that proper use of the opposing trademark was definitely given. The print of the mark SCORPIONS on T-shirts is also an indication for the origin of the goods to create respectively to maintain a market for these products. The fact that next to the function indicating the origin there is also advertisement for the band is hereby not opposing. Here also a majority of the related business fields tends to transfer the positive image of the band to clothing marked with the sign "SCORPIONS". Although the print of the mark on the T-shirts has mainly even been combined with indications to concert tours and albums of the

band, the related business fields do not only see an advertising message for the band in the use of the mark SCORPIONS, but also the indication to the producer of the goods. Therefore the objection of lack of use raised by the applicant of the word/figurative mark SCORPION BUDO'S FINEST was rejected.

The Court saw the opposing marks as similar above average, since the filed word/figurative mark was, given the overall impression, formed by the component SCORPION and the element "BUDO'S FINEST" was only an addition in smaller and thinner writing. Moreover, the Court confirmed a "minor" similarity of goods. Therefore the Court confirmed danger of confusion and allowed the opposition.

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

German Federal Patent Court, Decision dated August 23, 2011 – 33 W (pat) 526/10

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"PowerTeacher" not allowable

"PowerTeacher" was filed as a trademark for the goods and services "printing products; photographs; teaching aids and material (except devices); education, namely driving license education; services of a driving school". After rejection of the application by the German Patent and Trademark Office (GPTO) an appeal was raised at the German Federal Patent Court, which was not successful due to the following reasons.

The German Federal Patent Court ruled that the term "PowerTeacher" is not registrable due to lack of distinctiveness. The term "PowerTeacher" is not suited to refer to the business origin of the goods respectively services. The mark "PowerTeacher" has been formed by the components "Power" and "Teacher", which is visible in particular by the capital letter "T" in the middle of the

word. The English word "Power" has already been known for a long period of time in German language in terms of "force, strength, performance, impact" and developed to a general intensifying indication appearing in numerous different compositions. It is practically used as universal indication for high performance. Also the word "Teacher" has been known in German language in terms of "schoolteacher/instructor". The composition of both components does only give a describing indication to a particularly high-performance service of a teaching person and is only a sequence of describing indications.

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

German Federal Patent Court, Decision dated December 14, 2010 – 27 W (pat) 276/09

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City name with a preceding “Absolute” not allowable

An applicant registered the term “Absolut Berlin” (‘Absolute Berlin’) as a trademark for the services “telecommunication (operation of a website), transport, travel organisation; services for board and lodging of guests”. The German Patent and Trademark Office has rejected the application on the grounds that the combination “Absolut Berlin” refers to specific characteristics of the services; the services are indicated as being provided exclusively and completely in Berlin. The word combination “Absolut Berlin”, however, does not suit as indication of origin to specific business operations.

The applicant’s appeal at the German Federal Patent Court was not successful. The Court was

also of the opinion that the term “Absolut Berlin” was not registrable due to lack of distinctiveness. The preceding component “absolute” however seen individually has several meanings like “sovereign, complete, well and truly”, however, it does not justify ambiguity in combination with the city name because the average consumer understands the word combination as a key word in terms of “completely Berlin-like” and not as an indication of a specific business operation.

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

**German Federal Patent Court, Decision dated
September 28, 2010 – 27 W (pat) 524/10**

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Cancellation of the trademark “Micropayment”

In the year 2001 the term “Micropayment” has been registered at the German Patent and Trademark Office (GPTO) for the goods/services “software” (class 9), “finance” (class 36) and “creating programs for data processing” (class 42). A third party filed a request for cancellation due to absolute grounds of refusal. The trademark owner objected the request for cancellation, the GPTO, however, ordered the cancellation of the trademark. The trademark owner’s appeal against the decision of the GPTO remained unsuccessful. The German Federal Patent Court took the view that the word “Micropayment” had already been a known technical term at the time of the trademark registration in the year 2001 to be kept free for non-cash payment of smaller amounts in particular with the help of telecommunication devices and services. “Micropayment” is also explained in these terms in the reference

book Duden “Dictionary of the New Economy”. “Micropayment” is not suited as a mere describing term to give an indication to the business origin of a good/service. Since the request for cancellation had been filed within the 10-year deadline since registration (§ 50 German Trademark Law), the trademark was cancelled due to lack of distinctiveness and due to direct description of the intended use of the goods/services (§ 8 paragraph 2 numeral 1 and 2 German Trademark Law).

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

**German Federal Patent Court, Decision dated
July 27, 2011 – 33 W (pat) 101/09**

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Confusion between Enzymax und Enzymix

The plaintiff is the owner of the trademark Enzymax registered at the German Patent and Trademark Office (GPTO) for dietary supplements. The defendant sold a dietary supplement under the term Enzymix and was sued by the plaintiff to cease and desist, of rendering of accounts and for damages.

The German Federal Court of Justice (FCJ) has approved danger of confusion between the opposing marks. There is identity of goods as well a high similarity of both trademarks. Indeed the opposing mark Enzymax only has distinctiveness below average, since it approaches the describing terms Enzym and Maximum and enzymes are often contained in dietary supplements, however, despite said describing suggestions the trademark Enzymax is still “an imaginary and made-up word with its own creative content not existing in the German language”. For the mark Enzymax as a whole, however, there is no distinct meaning.

The marks Enzymax and Enzymix match 6 out of 7 letters and their sequence. The matching final letter “x” counts in particular striking due to its form and minor occurrence in the German language. There is also a similarity in sound, since the sound pattern of respectively the last syllable is defined by the sound-intensive “x”. The “m” only contained respectively once in both marks is in each case assigned twice by the customer since the “m” is seen as an element of “Enzym” as well as of the element “max” respectively “mix”. Due to direct danger of confusion of both marks the plaintiff as the owner of the mark elder in priority is entitled to the claims lodged.

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

**FCJ, Decision dated
February 24, 2011 – I ZR 154/09**

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COMPETITION LAW

Right of use for commercialization of a work protected by copyright on a storage medium (here DVD) comprises also commercialization on a technically improved storage medium (here Blu-ray Disc)

A movie maker (creator) had entrusted a movie distribution company with the utilization of a movie.

In the year 1985 the movie distribution company granted a movie provider an exclusive right of use for distributing the cinematographic work on VHS tapes. In an amended agreement from the year 1997 the exclusive right of use was expanded without additional payments to distribut-

ing the movie in DVD format, since the movie distribution company and the provider agreed that marketing on DVD “is the logical consequence and reasonable replacement to the VHS tape”.

When the provider also wanted to distribute the movie on Blue-ray Disc in the year 2010, he was sued by the movie distribution company to cease and desist due to copyright infringement according to § 94, 97 German Copyright Law.

The District Court Munich has rejected the request of the movie distribution company to grant a preliminary injunction. The appeal at the Higher Regional Court Munich had no success. Whether the movie distribution company already granted the right of use with the original contract from the year 1985 also with respect to the distribution on Blu-ray Disc, was explicitly left open by the Higher Regional Court because “in any case with the agreement from 1997” the right of use for the distribution on Blue-ray Disc was granted to the provider. In 1997 the scope of the granting of rights was not limited to the prior art back then, otherwise “the economic importance of the granted commercialization possibility diminished with each technical innovation”. Such a “petrification” would also not be as defined by the contracting partners, who both strived for an utmost

successful exploitation of the movie rights. By agreement of the year 1997 the rights of use were therefore transferred to all distributions on data mediums that “back then mainly corresponded to the known DVD system, even if they feature technical innovations in comparison”. The Blue-ray system is just like the DVD system characterized by the fact that a digital storage medium is optically read-out. That the Blue-ray Disc has more available data storage space does not pose a basic difference to the classic DVD, which had created a copyrighted different possibility of use.

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

**Higher Regional Court Munich, Decision dated
January 20 - 29U44 46-10**

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Blu-ray Disc

Unfair advertisement with the term “lightning shipping” and unallowable Opt-out-clause

An internet dealer offered cables and supplies for satellite antennas, highlighting the term “lightning shipping” as an eye-catcher. On a different position below the headline “duration of domestic shipping” it then said that the vendor will ship the good(s) “within two working days after receipt of payment”. In the article description it said further that there was immediate shipping for invoice amounts below EUR 300 for customers from Germany provided that the customer’s member profile had more than 20 positive ratings and no negative ratings regarding payments. All other German customers only receive immediate shipping when sending a payment confirmation (copy/screenshot of the transfer) by email or fax.

During the order procedure there is an option saying “subscribe newsletter”, where the order box is already ticked. If the customer does not want to subscribe, then the tick mark has to be removed again by the customer (opt-out-clause).

A competitor of the dealer made a test purchase on September 22, 2010 and paid by bank transfer on September 22, 2010. The purchaser received the goods not until September 29, 2010. The District Court Frankfurt on the Main considered the advertisement with the eye-catching term “lightning shipping” as misleading, since the good(s) were not immediately shipped after ordering, but did not reach the purchaser until one week later. An average informed and rational customer understands under lightning shipping “that the ordered goods – independent from the amount of the invoice – are sent immediately after ordering without any exceptions”. The explaining notes below the headline “immediate shipping” were not highlighted in the type face and were also not marked with an asterisk symbol referring to the indication “lightning shipping”. These explaining notes were therefore not included in the eye-catcher. This advertisement is therefore incorrect and misleading. There is a misleading indication about the type of shipping respectively terms of



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delivery that is anticompetitive according to § 5 paragraph 1, sentences 1 and 2 number 1 and 2.

The already ticked box for the newsletter is an unallowable opt-out-clause. Consent clauses, where the customer has to delete an already pro-

vided tick mark if he does not want to receive newsletters are anticompetitive according to § 7 paragraph 2, numeral 3 UWG (German Law against Unfair Competition). There it says that it is an illegal unacceptable molestation, when there is advertisement by using an automatic calling or fax machine or electronic mail without having the addressee's consent. A pre-formulated consent declaration (opt-out-clause) with a pre-ticked box lacks the required specific consent declaration of the customer. "The required specific consent requires a separate declaration by marking a respective box individually by the customer (so-called opt-in-declaration)".

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

District Court Frankfurt on the Main, Decision dated May 11, 2011, 3-08 O 140/10

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Anti-competitive loss leaders due to lack of explanation of only little supply

A supermarket chain published an advertisement in a newspaper, where among others a discount of 23 % was granted for a distinct branded butter for the time from April 21 until April 26, 2008. Between 12 noon and 1 pm on April 21, 2008 the butter was already sold out in two chain stores that were located within the advertisement region.



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According to No. 5 of the attachment to § 3 paragraph 3 German Law against Unfair Competition it is an illegally deceptive advertisement when a company offers goods without explaining that the goods are not available in adequate quantities for the expected demand at the price offered. With a clearly for-

mulated and well visible indication that the goods may already be sold out on the first day of offering due to limited supply, the supermarket chain could have avoided the deception of the customers. Alternatively the deception could have also been prevented by a precise indication of the available good supply in the advertisement or by another appropriate indication. Since in the present case an appropriate indication of insufficient supply was not given, the German Federal Court of Justice approved of illegal deception and allowed the cease and desist action raised by a consumer advice center.

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

German Federal Court of Justice, Decision dated February 10, 2011, I ZR 183/09

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Anti-competitive price indication in a flight booking portal

After choosing a flight in a booking portal of a travel agency there appeared the flight dates and next to them an eye-catching highlighted price. Only after a further booking step after accepting the general terms and conditions the notice appeared that in addition to the before-mentioned price "further taxes and fees" have to be paid, whereby these primarily concerned an agency fee. The final price including the additional taxes and fees was not formed during the booking procedure.

According to the decision of the German Federal Court of Justice (FCJ) this is a violation of § 4 Numeral 11 UWG (German Law against Unfair Competition). According thereto one acts anti-

competitive who acts contrary to a statutory provision that controls the market behaviour in the interest of the market participants. According to Article 23 of the EU Air Services Regulation dated November 01, 2008 flight prices open to the public have to be final prices including all obligatory taxes, fees, surcharges and other fees. This European Regulation controls the market behaviour and is therefore a statutory provision in terms of the German § 4 Numeral 11 UWG.

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

**FCJ, Decision dated
August 17, 2011 – I ZR 168/10**

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CURRENT ISSUES & NEWS

Our candidate Dipl.-Ing. Nils Winthuis successfully passed the exam as German Patent Attorney

Our candidate Mr. Dipl.-Ing. Nils Winthuis has successfully passed the exam as a Patent Attorney and has been admitted to the Bar since October. Mr. Winthuis is a graduate engineer for technology and biotechnology of food and therefore breaches the gap between mechanical engineer

ing and food chemistry. Congratulations! Patent Attorney Winthuis works as a colleague in our office and is now preparing himself for the European exam coming up in spring.

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Attending the APAA-Congress

Patent Attorney Dipl.-Ing. Josef Bockhorni from our office will attend the APAA-Congress on the Philippines in mid-November. Fortunately, the APAA-Congress still mostly has a reasonable

number of participants and is always a very good opportunity for personal meetings with colleagues from all over the world.

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Historic trademarks

Due to the changeover of the German Patent and Trademark Office to electronic file documentation we also received some office actions regarding “historic” trademarks of our clients. This once again shows more the value of a trademark itself that can be renewed as often as liked. These “historic” trademarks are not noticed by the attorneys in the normal office routine, since renewals fall under a routine procedure and do therefore not pass the attorney’s table.

“Historic” trademarks are German trademarks that were filed from November 30, 1874 at the German Patent and Trademark Office and were registered at the German Imperial Patent Office.

Obviously, however, the files or documentation of the German Patent and Trademark Office do not

seem to be complete. Partially only the date of registration in the current register, but not the date of application, partially only the date of registration in the Register (circa 1894) and the date of the publication of the registration in the year 1955 is mentioned, thus after the Second World War and therewith more than 60 years after registration of the trademark.

Nevertheless it is quite nice running over the pages of such old files and so to speak dipping into the 19th century. However we also see this continuous long-lasting mark of confidence of our so to speak “historic” clients as appraisal of our office.

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