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**BOCKHORN & KOLLEGEN**

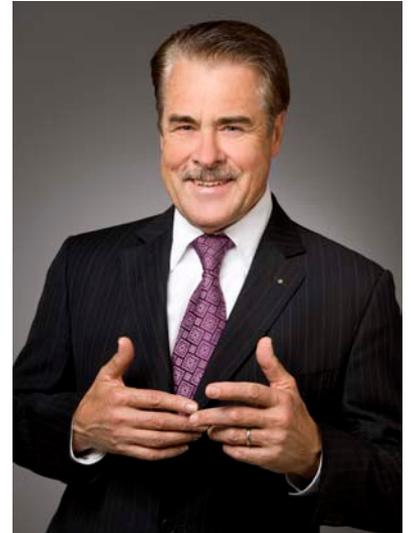
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Dear Reader,

For midsummer please find attached our second UPDATE edition this year with topics focusing on patent and trademark as well as domain law.

Not least because of cost pressure we will deal in this and our next circular letters with proposals focusing on cost-saving protection of own developments by respective protective rights. We learnt from conversations with our clients and colleagues that this is a more and more urging topic. In this UPDATE edition we address the value of a utility model and draw a comparison between utility model and patent. The German utility model grants just like the patent a claim to cease and desist and a claim for damages. The utility model has the advantage that it is a sheer registration right and therefore cost-saving. Examination does in principle only take place in case of an actual infringement, however, how often do infringements occur (we think mostly not) in regard of a protective right? Moreover, the utility model's duration of protection may be extended in a simple way to practically 11 years. For more details please see our UPDATE.



We hope our articles find your interest. In case you wish additional information to one or the other article, then, of course, we will provide you with further details.

We would be very pleased about your reaction and possible suggestions for improvement, also in regard of the topic selection and the design of our UPDATE.

Best regards

A handwritten signature in black ink, appearing to read 'J. Bockhorni', written in a cursive style.

J. Bockhorni  
(Patent Attorney)

# PATENT LAW

## IP-strategy for Germany: Utility model in comparison to the patent, sometimes still the better alternative?

Normally inventions are covered by way of filing a patent application and, not more than flanking, a utility model is used. In times of possible cost pressure, however, the question arises whether the way of patent filing is indeed the better alternative compared to utility model protection. We disagree and that for several reasons, since thought of in more detail the utility model offers many advantages so that it should be considered more closely which way is the more appropriate in each individual case.

An advantage often not considered is that a utility model is registered already after 1 to 2 months from the date of application. Then the whole set of claims is available, while, when filing a patent, this is only the case with grant of the patent taking, however, normally about 4 to 6 years after the date of application.

Insofar, in case of an infringement, the utility model practically offers quasi already with the date of application a claim for damages and a claim to cease and desist. In case of a patent application claims may be lodged against infringers not until years after, namely with the grant of the patent.

A patent application indeed gives a claim for adequate compensation with the application's publication - which is 18 months after the date of application - this, however, leads only to an appropriate license. On the other hand, with the claim for damages infringement, profits can be demanded that are normally many times higher than an appropriate royalty. The early claim for damages alone may bring in significant profits when winning an infringement matter in contrast to a patent which is granted not until many years from the date of application.



Picture@tohenchai

What counts in particular is the cost advantage considered that the utility model is only registered and not examined. In contrast thereto the patent application includes first of all the examination fee and then costs normally caused by a long lasting examination proceeding with multiple correspondence to the Patent Office. In addition, after grant of the patent there are often further costs caused by an opposition proceeding passing with the Patent Office and the Federal Patent Court two instances and again taking another several years. Moreover yearly increasing official annuity fees have to be paid for a patent application, whereas utility model renewals have to be paid at larger intervals.

The question is whether the effort for an examination proceeding and a possible opposition proceeding over several years is worth it. We don't think so in any case. Normally a patent is only used when there is an infringement. But this is actually only the case in regard of a very small percentage of all patents. But the actual examination proceeding of a utility model normally incurs at the Patent Office in case of an infringement action, when the

defendant requests cancellation at the Patent Office. This means that the costs for “examination” only incur when there is an actual infringement at all. The costs for the first instance of a cancellation proceeding are moreover calculable and comparable to an opposition proceeding.

Considering that in case of a patent infringement the defendant normally also files an invalidity action against the patent at the Patent Office, then, of course, there is a clearly significant cost advantage of the utility model.

Comparing the costs of a utility model over a period of 10 years with the ones of a patent shows a tremendous cost advantage of the utility model also considering the official annuity and official renewal fees, since neither an examination proceeding nor an opposition proceeding takes place.

Considering an infringement and assuming that the defendant files a request for cancellation against the utility model, which has two instances, in case of a patent, however, also files an invalidity action at the Federal Patent Court, then the utility model still has a quite tremendous cost advantage, since the costs of a patent invalidity proceeding are higher than the ones of a utility model cancellation proceeding.

The utility model is often objected because it is no examined protective right. This is correct. However, a cost-effective official search may be conducted at the German Patent and Trademark Office without any further ado leading to a very reli-

able search report that allows a reliable evaluation of legally valid utility model claims for an infringement.

The further objection of the limited protection duration of 10 years compared to a maximum of 20 years of a patent is also not always substantive. Experience shows that inventions are mostly used for an average period of about 7 years and are then replaced by a more developed solution.

In addition, parallel to filing a utility model a patent application may also be filed, whereby the official filing fees only amount to 60 €. Since the same application text is filed as when filing the utility model, there are no great additional expenses. By the way, we also offer a reduced fee for filing both applications so that this way is well worth it. This way, however, offers the advantage of filing the request for examination of the patent within a period of up to 7 years starting with the date of application. This means the examination proceeding may then be initiated when it can be seen within the seven years that the invention is a great hit on the market. Then the costs for the examination proceeding with the option of a 20-year period of protection should also be worth it.

In case of a first application the utility model may be replaced within the priority deadline by a new application and the duration of protection may therefore be extended so to speak to 11 years.

*Dipl.-Ing. Josef Bockhorni (Patent Attorney)*

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**RESULT:** All in all, filing a utility model has a great advantage compared to a patent application and also the way of filing a utility model application with a parallel patent application provided that filing of the examination request is initiated up to 7 years later, brings significant cost advantages compared to the regular way with a patent application and the examination proceeding.

We don't want to condemn the patent but would like to draw your attention to strategic alternatives that should be considered. If there is only a low budget for an invention available, then a utility model application is ideal and a utility model application in Germany can be directly derived from each PCT-application when nationalized.

## Community patent and European Court failed once again – a never-ending story?

For decades the Council of the European Union tries to implement the Community patent as well as a respective central European Court for litigation matters for European patents.

Up to now the procedure for grant of a European patent has been unitary, however, with the grant the European patent splits into a bundle of national patents. Litigation proceedings then have to be decided by the respective national civil courts.

The purpose of the Community patent would be to grant a European patent for the entire Euro-

pean Union with the same scope that can only be transferred or declared invalid or cancelled for the entire Union.

The most recent draft comprises a court for European patents and Community patents consisting in the first instance of a central chamber, local and regional chambers as well as a central court of appeal. The requested expert's opinion of the European Court of Justice, however, declared said recent draft for a Community patent with a court for European patents as being inconsistent with Union law.

*Dipl.-Ing. Josef Bockhorni (Patent Attorney)*

**RESULT:** The Community patent with a central court is surely about to come, the question still is **when** and **how**, in particular in regard of the courts. The current local court system is quite reasonable and has also proven successful up to now. In Europe for example, more than two thirds of all patent litigation proceedings are decided before the courts in Germany, most by far in Düsseldorf. Having succeeded there is often seen as an indication for legal actions in other countries so that the parties then normally come to an arrangement. The latest planned creation of a patent court in Europe would have caused significantly higher legal expenses than the current status.

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## European Council of Ministers decides about an intensified collaboration of 25 Member states regarding the European patent

A broad majority of 25 Member states with the exception of Spain and Italy have decided about an intensified collaboration to create unitary patent protection. The objective is to make future patent protection in Europe more cost-saving, effective and legally compliant. Hereby it is intended to grant the EU patent in German, English or French and to largely avoid time consuming and expensive translations in future. This process of intensified collaboration will then take effect, in case a part of the Member states wants to proceed alone and doesn't want to be stopped by other Member states, as here from Italy and Spain.

Now it is the task of the EU Commission to make proposals to create a EU patent and an appropriate language regime yet in 2011. Hereby the EU patent shall be granted in German, English or French by the European Patent Office according to the unitary standard of the European Patent Convention.

Since Spain and Italy had prevented an amicable solution regarding the language question for the EU patent despite numerous compromise proposals, further approaches will be made in collaboration with the remaining 25 Member states of the European Union.

Thereby ways of a joint patent jurisdiction with unitary effect in litigation matters shall also be created. We are anxious about which way will be taken. Our prediction is that now the national courts as specific courts are included more in-

tensely. Three chambers in the Federal Republic of Germany are hereby under discussion, since about 70% of all litigation matters are currently conducted in Germany on the basis of European patents before specific courts.

*Dipl.-Ing. Josef Bockhorni (Patent Attorney)*

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## Overview and comparison of the number of IP protective rights in Germany, OHIM and WIPO

The German Patent and Trademark Office (GPTO) is next to the European Patent Office the largest examining patent office in Europe with altogether about 2.800 employees, therefrom about 830 examiners experiencing an upward trend.

About 60.000 patent applications were filed at the GPTO in the year 2010 and about 33.000 examination proceedings were completed, whereby about 42% were granted, about 26% rejected and the remaining abandoned due to lack of payment of fees or withdrawal. Almost 526.000 German patents were in force by the end of the year 2010.

The number of German national designs also increases and amounted to about 47.200 in the year 2010, a plus of 5.5% compared to 2009.

About 69.100 trademarks were filed at the GPTO in Germany, whereby an average of 195 trademarks was registered each working day.

Comparing this to the Community trademark with 940.000 Community trademark applications since the foundation of the Community Trademark Of-

fice 15 years ago, then the Community trademark reaches an average number of 62.600 new applications a year compared to 69.100 trademark applications in Germany in the year 2010 and about 39.600 international trademarks a year at WIPO.

This comparison shows the significance that German national protective rights still enjoy in Europe. We notice that many clients use a more and more split approach, meaning part of the protective rights is filed the European way and the other part with an upward trend, however, the sheer national way in Germany and in a few other selected European countries. Patent applications are normally not examined in said countries but only registered, which, of course, is very cost-effective. Grant of the patent in Germany after substantial examination is later on also seen as an indication for legal validity of parallel patents in other countries. This is also an interesting and cost-effective alternative which we will also address in detail in a separate circular letter.

*Dipl.-Ing. Josef Bockhorni (Patent Attorney)*

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# TRADEMARK LAW/DOMAIN LAW

## Legally relevant trademark use for highly similar trademark

A publishing house was the owner of the word marks "ILLU" and "SUPER ILLU" both registered for classes 16 and 41. A competitor filed an invalidity action against the trademark "ILLU" on the basis of forfeiture, since the trademark was neither used within the term of 5 years starting with the registration nor thereafter. The trademark owner, however, had published and sold a magazine with the title "SUPERillu" with high circulation for years. Moreover, the trademark owner had broadcasted a TV show called "SUPER ILLU TV".

The Higher Regional Court Karlsruhe has decided that the trademark "ILLU" is not vulnerable to cancellation on the basis of forfeiture. Forfeiture of the trademark "ILLU" had been avoided by using the mark "SUPERillu". This does not only concern a work title use but also a trademark use, since use of a mark as a title of a magazine cannot just be an indication for differentiation of the work from others but also an indication to business origin of the printed product. Due to the significant and long-lasting success of the magazine "SUPERillu" the related fields see an indication of business origin in the use of the mark.



The use of "SUPERillu" is a relevant use for the opposed mark "ILLU", since the component "SUPER" added for the use does not have its own decisive distinctiveness but only serves for advertising purposes. Only the component "illu" is of distinctive nature, which is also not describing for the claimed goods, since "illu" is neither a word of the German language nor a commonly used abbreviation for the German word "Illustrierte" (translation: 'the illustrated' which means 'magazine'). Since only the element "illu" is of distinctive character in "SUPERillu" and the advertisement "SUPER" is no indication of origin, "SUPERillu" is an unessential variation of the trademark "ILLU" not influencing its distinctiveness since its use has been reserved by using "SUPERillu". Cancellation on the basis of forfeiture is therefore not considered.

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

**Higher Regional Court Karlsruhe,  
Decision dated January 26, 2011 - 6 U 27/10**

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## No registrability of the number "1000" as a Community trademark

A Polish publisher of brochures and magazines with, among others, puzzles and games has filed the mark "1000" at OHIM as a Community trademark in the year 2005. OHIM rejected the application due to lack of distinctiveness.

The applicant filed a suit against the rejection at the court of first instance. The court has confirmed OHIM's decision in its entirety and ex-



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plained that the mark “1000” refers to a quantity and is therefore immediately and without any further ado understood by the related public as a description of characteristics of the goods, in particular the quantity of pages and games or as a position in a ranking list. The applicant appealed against said decision of the year 2009 at the Court of Justice.

The Court of Justice at first referred to the fact that one of the public’s interests of Community Trademark Law is to guarantee that such marks describing the characteristics of goods or services may be freely used by everyone offering such goods or services.

Moreover, the Court argues that this is always the case, when an application refers in particular to a category of goods and its content is easily and typically described by a quantity of its components, as it can be assumed in the present case regarding magazines with, among others, crossword puzzles that a mark consisting of digits is seen in related fields as a description of the quantity and therefore is identified as a characteristic of said goods.

The appeal was therefore rejected.

*Dipl.-Ing. Josef Bockhorni (Patent Attorney)*

**European Court of Justice,  
Decision dated March 10, 2011 –C-51/10 P**

**RESULT:**

Of course, the decision is not just limited to the number “1000” but practically denies any registrability of mere numbers.

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## Registrability of the trademark “POLYMAIL”

The applicant had filed the term “POLYMAIL” for registration at the German Patent and Trademark Office (GPTO) for goods of class 16, in particular paper goods, book covers and boxes made of cardboard or paper, as well as for services of class 35, in particular for conducting internet auctions, online-advertising and business management for third parties.

The GPTO saw a sheer description in the combination of “POLY” and “MAIL” for multiple mailing and was of the opinion that “POLYMAIL” was only a descriptive indication in regard of type and intended use of the goods and services claimed.

The German Federal Patent Court held the view that “POLYMAIL” was not descriptive for the services claimed in class 35, since these are typically

not provided in form of mass mailings of advertising mail within direct marketing. The term “POLYMAIL” was also not descriptive for the goods of class 16, since the goods claimed in class 16 are neither made of polymer plastics nor sent through mass mailings. Nor a functional context of said goods with advertising mail is to be seen. The term “POLYMAIL” is seen as indication of origin in related fields and is registrable for the claimed goods and services.

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

**German Federal Patent Court, Decision dated  
March 23, 2011 - 29W (pat) 214/10**

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## Registrability of the trademark “Autopack” for sweets

The applicant had filed the trademark “Autopack” for registration at the German Patent and Trademark Office (GPTO) for goods of class 30, among others for sweets, bonbons, chewing gum, confectionary, licorice, and chocolate. The GPTO rejected the application given the reason that it is a combination of two descriptive words “Auto” and “Pack” that only indicate the goods being ideal for taking along and eating in the car.

The German Federal Patent Court considered the trademark “Autopack” registrable for the claimed goods of class 30, since it suits to be seen as indication of business origin in related fields, and is not descriptive for goods of class 30. The component “Auto” is also understood in terms of “automatic” so that “Autopack” may also be understood in terms of machines for automatic packag-

ing of goods. The characteristics of the sweets chocolate etc. are not described with the term “Autopack”. The consumer has to perform several mental steps until coming to the rather remote meaning of “Autopack” for sweets. The claimed sweets, bonbons, chewing gum etc. are also often consumed on travel without the suitability of the packaging for distinctive transportation means being indicated in the product description respectively in the generics of product characteristics.

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

**German Federal Patent Court, Decision dated February 10, 2011 - 25W (pat) 47/10**

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## Protection of the word mark “Schneeflöckchen” (‘little snowflake’) against the use of the term “Schneeflöckchen Tee” (‘snowflake tea’)

The plaintiff is the owner of the word mark “Schneeflöckchen” (‘little snowflake’) registered among others for non-alcoholic hot drinks on a fruit basis, glühwein (mulled wine) and non-alcoholic glühwein. The defendant, merchandiser of various gift articles, offered among others a tea named “Schneeflöckchen-Tee” (‘snowflake tea’) belonging to a product line and using the term “Schneeflocken sind kleine Geschenke des Himmels” (‘snowflakes are small gifts from heaven’).

Being called to cease and desist the trademark use of “Schneeflöckchen” the defendant meant that he did not use “Schneeflöckchen” as a trademark but only as a description for the packaging design, since several snowflakes were dis-

played on the packaging and there it was said that snowflakes were small gifts from heaven. The Higher Regional Court Nuremburg was of the opinion that “Schneeflöckchen” was not describing for tea as a good but only describing for the packaging design. Therefore “Schneeflöckchen” was used as a trademark for tea as a good so that the defendant was banned from further use with regard to the earlier word mark of the plaintiff.

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

**Higher Regional Court Nuremburg, Decision dated March 15, 2011 - 3 U 1644/10**

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Picture @tbel

## No limitation of the scope of protection for the trademark “BUFFALO” for textiles, even though “BUFFALO” is the name of a US city



The plaintiff is the owner of the trademark “BUFFALO” registered for clothing, bed linen and textile towels. The defendant used the mark “BUFFALO jeans BEDDING” for bathrobes and bed linen and meant that the term “BUFFALO” as the name of a US city was a geographical indication of origin for which there was a necessity to keep it freely available, so that the defendant could not be banned from using his mark “BUFFALO jeans BEDDING”.

The Higher Regional Court Frankfurt had a different opinion. The related fields of business did not see any indication to the US city BUFFALO in the use of the mark “BUFFALO” for clothing, bed linen or textiles, since the city had neither reputation nor noto-

riety as a place of origin for textiles. Moreover, “BUFFALO” was also the English term for the animal buffalo. Neither the plaintiff nor the defendant therefore used the term “BUFFALO” as a geographical indication of origin. Since the other components “jeans” and “BEDDING” in the mark of the defendant were only of describing nature for the merchandised goods, they only have an insignificant meaning for the overall appearance. The trademarks of the plaintiff and the defendant are therefore almost identical and are used for very similar goods. The Higher Regional Court approved likelihood of confusion and banned the defendant from further use of the mark “BUFFALO jeans BEDDING” due to the earlier mark of the plaintiff.

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

**Higher Regional Court Frankfurt, Decision dated February 24, 2011 - 6 U 260/10**

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## No trademark registration for the word marks “BOTOLIST” and “BOTOCYL” due to unfair reputation exploitation of the earlier mark “BOTOX”

The marks “BOTOLIST” and “BOTOCYL” had been registered as Community trademarks in class 3 in particular for perfume, eau de toilette, bath and shower gels, soaps, deodorant and face and body cosmetics as well as hair-care products. The owner of the earlier mark “BOTOX” requested to declare the trademarks “BOTOLIST” and “BOTOCYL” with later priority as invalid. The trademark “BOTOX” is registered as Community and national trademark in the UK for class 5 among others for pharmaceutical compounds for facial wrinkle treatment.

The Court of the European Union has accepted both suits referring to Article 8 paragraph 5 of the EC regulation number 207/2009 about the Com-

munity trademark. According to this regulation a trademark registration is among others then impossible when in regard of similarity of both opposing marks the respectively claimed goods are not similar, however, the earlier Community trademark is a trademark known in the EC, respectively when the earlier national trademark is known in the respective Member State and the later mark would exploit or affect the valuation of the earlier mark in an unfair way. The mark “BOTOX” on the one hand and the marks “BOTOLIST” and “BOTOCYL” on the other are similar, since they all start with the element “BOTO” which is the main part of the trademark BOTOX. According to the Court the trademark “BOTOX” is known in all EC Member States as a

compound for wrinkle reduction. Although there is no direct advertisement to the consumer for "BOTOX" since it is a prescriptive product, it is still known due to media publications and, moreover, also included in various English dictionaries. It does not depend on danger of confusion between the opposing marks but only on the fact whether the related fields associate the marks with one another due to their similarity and due to the major reputation of the earlier mark. An average customer perceiving the marks "BOTOLIST" and "BOTOCYL" comes to the false assumption that the cosmetic compounds distrib-

uted under said marks contain the component Botox for wrinkle reduction, although this is not the case. Therefore the producers of the cosmetics would gain an unfair competitive advantage when using both marks. The trademarks "BOTOLIST" and "BOTOCYL" were therefore declared invalid.

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

**Court of the European Union, Decision dated December 16, 2010, GRUR Int 2011, 420**

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## Jurisdiction of German courts for actions against internet publications

With a decision the German Federal Court of Justice (FCJ) has negated the international jurisdiction of German courts for actions against internet publications, when there is no clearly visible domestic reference.

In the proceeding the plaintiff sued against an unfavourable publication in Russian in the internet portal [www.womenineurope.com](http://www.womenineurope.com), having its domicile in Germany. Therefore the action was filed at a German court. According to the decision of the FCJ German courts are in charge of actions

against publications available in the internet internationally, however only, when the contents objected as being legally infringing objectively show a clear reference to the home country. This, however, was not seen by the FCJ in the decided case, in particular due to the publication in Russian language.

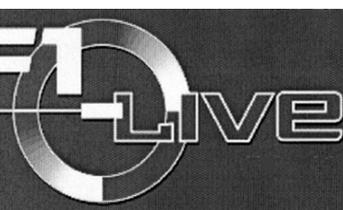
*Dipl.-Ing. Josef Bockhorni (Patent Attorney)*

**FCJ Decision dated March 29, 2011 - VI ZR 11/10**

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## Ecclestone underlies: "F1 Live" registered despite opposition of

### Formula One Licensing BV



The figurative mark F1-Live shown on the left was filed at the Office for Harmoniza-

tion by Racing-Live SAS for goods and services like "magazines, brochures, books, notifications about and distribution of books, organisation of competitions via internet, reservation of event tickets, online games and the like". In the list of goods and services it is also noted that all goods and services relate to Formula 1.

The internationally known Formula One Licensing BV filed an opposition against the registration of the application based on one international registered word mark "F1" and two registered national word marks "F1" as well as a figurative Community trademark "F1 Formula 1" used as a logo (see image below).



The opposition was rejected by the Office for Harmonisation. There was no danger of confusion to be seen between the later trademark F1-Live and the earlier trademarks of Formula One Licensing BV, since there are sufficient differences. The relevant public sees the connection of “F” and “1” as a generic term for a racing car category. Moreover, the F1 word mark only has a minor distinctiveness, since it is understood as the usual term for racings or special racing cars.

This was also confirmed by the Court of the European Union. The relevant public does, however, identify the F1-logo as a trademark, since said logo is extensively used when licences are granted or for advertising purposes. However, the opposing figurative marks F1-Live and F1-Formula are visually not similar and phonetically

and notionally only slightly similar so that there is no danger of confusion.

Furthermore, there is also a minor similarity between the word marks F1 and the filed mark, since the later figurative mark contains the component “-Live” and F1 - written out in standard letters – is generally a describing indication for the consumer. Therefore according to the Court there is only a minor similarity between the F1-word marks and the filed mark so that there is no risk of confusion.

*BBiotech (Hons) Vanessa Bockhorni*

#### **Decision in the legal case T-10/09 OHIM**

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### [Lindt-Golden Bunny not registrable as a 3D-mark](#)

The story of Lindt & Sprüngli AG, which is probably one of the most famous chocolate factories worldwide, began in the year 1945 in Zurich. Every year at Eastertime Lindt & Sprüngli AG sells the golden Easter bunny known worldwide with the red necklace and golden little bell.

In the year 2004 Lindt & Sprüngli AG filed said chocolate bunny as a three-dimensional mark (3D-mark) at the Office for Harmonization (OHIM) in Alicante for chocolates. OHIM, however, rejected the filed trademark due to lack of distinctiveness and also brought forward that the mark did not acquire distinctiveness by use. The chocolate factory filed an appeal against this decision, however remained unsuccessful.

The case was brought to the European Court of First Instance that, however, rejected the action and confirmed the decision of the Board of Appeal. According thereto, when deciding about a 3D mark the same aspects have to be applied as it is done by a word or figurative mark, however, when deciding about a 3D mark it also has to be considered whether the form of the packaging



essentially differs from the form of the subject matter of the good or whether – as in the present

case – it comes close to the form of the chocolate. The more similar the form of the packaging to the form of the good itself, the less applies the argument of distinctiveness. On the one hand the form of the sitting bunny is a typical form for chocolate bunnies, therefore lacking distinctiveness; on the other hand a golden foil is also used for other chocolate packaging so that these characteristics posing a possible distinctiveness are not unusual.

Currently, a German 3D mark for the well-known golden bunny is registered in Germany and was recited by Lindt & Sprüngli AG as an argument for trademark ability. According to the European Court of First Instance, this registration is, however, not binding. The plaintiff Lindt & Sprüngli AG then claimed that the mark had acquired distinctiveness due to use in three of the Member

states of the EU. The proof of the three Member states was, however not sufficient for the Court.

Therefore, most various European producers can now produce and distribute chocolate bunnies in golden foil.

*BBiotech (Hons) Vanessa Bockhorni*

**European Court of First Instance, Decision dated December 17, 2010, T336-08**

**Note:** The Court points out that the form of a 3D mark has to differ significantly from the customary goods or goods already introduced to the market to be registrable. However, it does hereby not determine how large the market share of the competitive products has to be to justify a customary trademark. The Court, however, does not find proof of use in three Member states to be sufficient and the applicant has a very hard time to provide proof of acquisition of distinctiveness in the entire EU. This strict jurisdiction regarding the good's trademark form and successful registration of the 3D mark in the German Register support the thought that it's better filing applications of this trademark form the national way.

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# BIOTECH

## Biological processes for the production of plants not patentable

Picture © ExQuisine



According to Article 53 (b) EPC European patents regarding "essentially biological processes for the production of plants or animals" are not granted. This exclusion from patentability acknowledges that usual crossing processes through conventional cultivation are not patentable. The present case concerned the clarification of the term "essentially biological processes" through the Enlarged Board of Appeal of the European Patent

Picture@Stei



Office in the so-called "broccoli" and "tomato" cases (G2/07 and G1/08).

According to that the Enlarged Board of Appeal rendered its decision that essentially biological

processes involving sexually crossing regarding the whole genome as well as the subsequent selection of plants by the growers resulting therefrom are not patentable. Thereby also technical process steps which serve to enable or assist processes of sexually crossing the genomes of plants and of subsequently selecting plants cannot override this exclusion from patentability. It is thereby emphasized that e.g. genetic markers as technical devices are patentable inventions, their use in an essentially biological process, however, does not make this process patentable. However, it is also emphasized that processes for modifying plants by inserting traits into the genome respectively its modification by using genetic engineering may be patentable. In such cases, however,

attention should be paid to the fact that crossing and selection processes are not claimed in the patent.

After this present decision of the Enlarged Board of Appeal the respective Technical Board of Appeal is now called to decide upon the individual cases. Therefore we have to wait and see how the first concrete application of the above explanations will turn out.

*BBiotech (Hons) Vanessa Bockhorni*

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# COPYRIGHT LAW/MEDIA LAW

## Advertising crossed-out prices at introductory offers

A merchant advertised his carpet collection in his brochure as a world's first and put significant higher crossed-out prices next to the introductory prices. As a producer he was of the opinion that he was able to grant attractive discounts for market introduction. A competitor, however, thought his advertisement as deceptive and anti-competitive.

Since the conditions for claiming the discounts were not indicated clearly and explicitly, and since in particular the end of the term for the introductory prices and the start of the regular (crossed-out) prices could not be seen, the German Federal Court of Justice (FCJ) approved of the infringement against the unfair competitive transparency imperative and against the decep-

tive ban (§ 4 No. 4, § 5 of the German Law against Unfair Competition). When advertising an introductory offer with favourable introductory prices and contrasting them with regular crossed-out prices, then the date has to be indicated when regular prices apply again. According to the FCJ clearance sales are different hereto, where a time limitation does not have to be indicated.

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

**FCJ, Decision dated March 17, 2011 - ZR 81/09**



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# CURRENT ISSUES & NEWS

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## [Patent Attorney Dipl.-Ing. Bockhorni elected Substitute epi Member in 2011](#)

We are happy to inform you that Patent Attorney Dipl.-Ing. J. Bockhorni has been elected as Substitute Member of the epi Council from among German Patent Attorneys in spring 2011. Epi, the European Patent Institute, is a professional body, representing registered European Patent Attorneys. All European Patent Attorneys are a member of this Institute, whereby it currently has a membership of about 10.000.

The governing body of the Institute is the Council which is elected by the members and comprises

registered European Patent Attorneys from all the states contracting to the European Patent Convention authorized as representatives before the European Patent Office.

The epi maintains close contacts with the European Patent Office (EPO) and the World Intellectual Property Organisation (WIPO) and therefore has respective influence on future decision making in the patent law field.

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## [Cancellation of fee payment receipts by the German Patent and Trademark Office](#)

Please note that with May 2, 2011 the German Patent and Trademark Office does not issue receipts anymore confirming receipt of payments. This is a consequence of the change to electronic file documentation of the German Patent and Trademark Office. Foreign attorneys often ask for a receipt confirming payment of annuities at the

Patent Office which is now, however, not possible anymore. Thank you for your understanding.

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