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Dear Reader,

Our new UPDATE Edition 2/10 includes a selection of IP topics as well as of essential decisions to give you an overview of the current tendencies in European jurisdiction. Please take a journey with our UPDATE through German and European IP Law and to the most various fields. As usual we tried to prepare short and brief articles. Therefore please feel free to contact us in case you need any additional information.

I am very pleased to inform you that we have merged with the patent attorneys and lawyers of BPSH in Dusseldorf for a cooperation. We herewith strengthen our presence in North Rhine-Westphalia, as to say the region of our office origin, and also broaden our personal and professional orientation. At the same time we moved our office in Dusseldorf from Prinz-Georg-Straße 91 to Mörsenbroicher Weg

191 and therefore into new, modern and representative office rooms.

Under the heading Economic Forum we are proud to introduce today one of our clients: The company Schoeller Arca Systems GmbH which is a global player in the field of plastic packaging systems for transport and handling of materials. We are very pleased that Mr. Kellerer, Head of the Patent Department of Schoeller Arca Systems GmbH, was so kind for an informative interview. We will introduce more of our clients under said heading from time to time.

Have fun leafing through our UPDATE and please feel free to contact us in case of any remarks.

Best regards

Josef Bockhorni
Patent Attorney

PATENT LAW

European Community patent - a long time discussion: About to come or not yet again

Since 1975 there has been the ambition to convert the European patent for the Member states of the European Union into a European Community patent. The implementation, however, has failed up to now due to various reasons, in particular due to the question of language regulation and translation requirements but also due to the regulation of the respective courts.

Now the Council of Ministers of the European Union has decided in a new attempt in December 2009 on a compromise for the implementation of a Community patent as well as a European Patent Court.

According thereto a uniform European Patent Court shall be created that is divided into local and central chambers under the roof of a joint appellation court. Hereby, the national courts are the receiving instance and then a central European Patent Court is the appeal instance.

The new European and EU Patents Court, so-called EEUPC, will hereby decide about both the infringement and the legal validity of a Community patent, whereby the competence is also extended to the fact that it is also decided about infringements and legal validity of European patents.

The receiving courts of first instance are structured in local respectively regional chambers and a central chamber. A local chamber may only be created by a Member state of

the European Union, if the Member state has more than 50 infringement cases a year. The amount of local chambers, however, is also limited to a maximum of three chambers per Member state. This regulation is of disadvantage for Germany because about 50% of European infringement litigation cases are pending in Germany which is about 1000 a year compared to about 2000 all over Europe.

Regional chambers may be created as receiving instances by several Member states so that these states alone do not have the required 50 infringement cases a year. A regional chamber e.g. will be created for the Benelux.

The central chamber as receiving instance is responsible for cases, where Member states have no local chamber and do not share a regional chamber.

At the moment three locations are discussed for Germany: Dusseldorf, Munich and Mannheim.

The local respectively regional chambers are responsible for proceedings regarding patent infringement, interlocutory injunctions or suits for damages as well as invalidity actions against the litigious patent.

The central chamber is responsible for invalidity actions, declaratory actions to establish the non-existence of a right and compulsory licences.

It is new for the chambers of first instance, each having three judges, that only two judges may be appointed from the state that has a local chamber. For regional chambers respec-



tively two judges from the Member states would be appointed. The third judge of the chamber, however, is appointed from a pool of judges that includes judges with legal or technical skill in the field of patent infringement.

In case of a pending invalidity action before the receiving courts respectively an additional technical judge has to be consulted from the pool of judges.

The central chamber itself is formed by two legal judges and a further judge who has technical skill in the respective technical field. Said judges are appointed from the pool of judges.

Interesting and in our view very important is the fact that also patent attorneys with an additional qualification are authorized to solely represent before said European court so that there is no need to involve an additional lawyer.

Currently, a transition period of 5 years after implementation of the agreement is scheduled in the draft. During this transition period patent litigation proceedings based on Community patents or European patents may be claimed both before the present national courts and the newly created European court.

However, one cannot count on a fast implementation of the Community patent as well as of a European court, since at first an expert's opinion of the European Court of Justice has to clarify the compatibility with EU Law. However, the introduction of the Community patent would be very welcome since obtaining patent protection e.g. in 13 EU Member states is already eleven times more expensive than a US patent and running parallel infringement proceedings in transnational infringement litigation cases currently in different countries is therefore very expensive.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

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

RESULT

Since the Community patent was about to come at short notice for several times now due to political decisions, here again one has to be careful, since the conversion into a Community patent also depends on the expert's opinion of the European Court of Justice. As a matter of principle the Community patent would be very welcome because of the question of cost. In our view, however, it will take another couple of years until the Community patent will be implemented.

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What's the point of filing the request for international examination in the PCT proceeding?

With respect to the PCT proceeding our clients often ask us what's the point of filing the request for international (preliminary) examination.

Of course, this question has become even more important since the deadline for entering the national phases was extended from 20 (21) months to 30 (31) months. In the past this could only be achieved by filing the request for international preliminary examination. The can-

cellation of this regulation naturally led to a corresponding cutback of examination requests.

To answer the above-mentioned question it has to be considered that the international examination proceeding is in a sense only a cursory proceeding, which is also dictated by a short time period between the international search request and entering the national phase. Of course, in an examination proceeding with such

a short time frame, delicate evaluations regarding the inventive step often requiring longer discussions between the examiner and the attorney can hardly be satisfying. Therefore the international examination proceeding is principally suitable for such cases, where it can already be seen from the search report that due to the detected prior art a certain limitation of claim 1 is obligatorily required and that then, however, a positive action is to be expected in the international examination proceeding. Then however it definitely makes sense to file the request for international examination after a corresponding search result. If a final positive action is then issued affirming the patentability of the limited set of claims, then the examination proceedings can be respectively shortened in the individual national phases of a PCT application leading to not insignificant cost reductions.

Also in regard of the so-called Patent Prosecution Highway (PPH) between different foreign patent offices, in particular the European Pat-

ent Office, the Japanese and the US Patent Office, a positive international examination report may lead to a corresponding acceleration of national examination proceedings, since the European, the Japanese as well as the US Patent Office consider written office actions respectively statements for international preliminary examination.

*Dipl.-Ing. Josef Bockhorni (Patent Attorney),
Dipl.-Phys. Dr. Jan-David Hecht (Patent Attorney)*

RESULT

The request for international examination makes sense when it can be seen from the international search report that an allowable set of claims can be reached with a limitation, which is obligatory in respect of the detected prior art and which does not leave the central idea of the subject matter of the application. Otherwise a revision of the set of claims should be taken to the national examination proceeding and the request for international (preliminary) examination is not necessary.

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Filing of divisionals from German patent applications still possible within a one-month appeal period after decision of grant

Despite the cancellation of the possibility of filing divisional applications of a patent in the opposition proceeding (§ 60 PatG old version), divisional applications may, according to the German Patent Court, still be filed within the appeal period after receipt of the decision of grant. This is possible due to the principles of the FCJ's decision "Graustufenbild" ("grey-scale-picture") (GRUR 2000, 688).

This topic brought major uncertainty when the law amendment was published, since it was not clear until when exactly divisional applications had to be filed. It was questionable whether the way of filing divisionals was excluded "with the legal existence of the decision of grant starting with the issue to the mail dispatch office and which is in particular also

binding for the GPTO". This question has now been clarified with the above-mentioned decision.

According to § 39 para. 1 sentence 1 PatG the patent applicant can file divisional applications at any time. This means that filing of a divisional is still possible as long as the application does not gain strength as a full right, meaning also after the issue and after the receipt of the decision of grant, as long as this decision of grant is not final by expiration of the appeal period or by a waiver to file an appeal respectively – when the appeal has been filed – as long as the pending appeal proceeding is not terminated, e.g. by withdrawal of the applica-



tion or appeal (cp. also Schulte, PatG, 8th Edition., § 39 marginal number 29 et seq.).
Dipl.-Ing., Dipl.-Berufspäd. Dr. Susanne Schollweck (Patent Attorney)

BPatG, Decision of August 6, 2009 – 10 W (pat) 10/07, PatG § 39 (eye radiation)

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May damages be claimed from each single member of an infringer chain (producer, retailer, customer) in patent and design infringement proceedings in future?

This question arises due to an interesting decision of the German Federal Court of Justice, the so-called “Tripp-Trapp-Stuhl-decision” (Trip-Trap-chair-decision) concerning the account of infringer profits due to copyright infringement.

Hereby the plaintiff claimed damages from a distributor, even though the plaintiff already successfully demanded the account of infringer profits of the supplier in a different infringement proceeding against the supplier of the defendant (distributor). The distributor defended himself against the suit mainly with the argument that no account of their profits is owed to the plaintiff just because the plaintiff has already sued the supplier of the defendant, claimed the account of infringer profits and also received it. Therefore the plaintiff is stopped from claiming the profits earned several times from the sale of the same product on different distribution levels. According to the defendant subsequent distribution levels are exempt therefrom, when the distributor of the infringing subject matter is already obliged for account of profits.

The German Federal Court of Justice opposed this opinion and decided that, when the right holder receives the profits from an infringer within an infringer chain, then his claims for damages from further infringers of an infringer chain basically not expire. In view of the compensation and prevention function the right holder may rather claim the profits earned of each infringer within the infringer chain.

However, the successful claim of several infringers (both of a purchaser and his supplier or distributor) is then excluded, when the distributor pays the damages for the purchaser due to his claim. Liability of the distributor in case of account of infringer profits is on the one hand justified by the profits earned; however, on the other side it is also limited.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

FCJ Decision I ZR 98/06

RESULT

This decision was passed in a copyright case, but may also be used in future infringement cases, e.g. in patent and design infringement cases. This opens an interesting perspective which may be quite uncomfortable for infringers.



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TRADEMARK LAW

Colour marks or black-white marks?

Basically a trademark filed in colour is actually determined by the respective colour design defining and limiting the subject matter of protection. Other colours are not significant for the determination of the subject matter of protection of a colour mark and can only be considered when assessing the scope of protection. In respect of danger of confusion it therefore depends on the similarity of the colour design of the registered mark to the infringing mark. Therefore colour marks only make sense, when a company uses a certain colour design for the entire outfit, therefore for writing paper, brochures, packaging, product design, etc.

According to latest jurisdiction it can be assumed that the black-white registration of a trademark takes an exceptional position, since a certain colour design is not determined but all colour combinations shall be included that seem to have a similar contrast impression.

Now the European Court of Justice has confirmed once again that the scope of protection of a registered mark without claiming certain colours (therefore of a mark registered in black-white) also extends to coloured repre-

sentations of the mark, in particular also to colour combinations.



Picture © artcalin - Fotolia.com

However the scope of protection is limited to such colour designs that do not provoke a different overall impression because e.g. certain details stand out in particular that only play a subordinate role in the black-white design.

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

***European Court of Justice,
Decision dated June 18, 2009 – T418/07***

Result

When it does not depend on certain colours or colour combinations, then the trademark registration should always be considered in black-white respectively in grey levels to secure a preferably broad scope of protection of the trademark. Only if a different overall impression compared to the black-white design arises by the preferred colouring, then a registration in colour is recommended. If in regard of a colour mark different colour combinations are used, then they would have to be registered additionally.

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Audi enforces the slogan „Vorsprung durch Technik“ (lead through technology) as Community trademark

After a long lasting route through the instances the company **Audi** could now finally enforce trademark protection for its slogan “Vorsprung durch Technik” (lead through technology) before the European Court of Justice. Among others this was also accomplished due to the publicity of the slogan that the public combines with the car builder in the meantime. Like this also a strapline can refer to the business origin of a product.

Audi filed the word mark “Vorsprung durch Technik” (lead through technology) in the year 2003 at **OHIM (Office for Harmonization in the Internal Market)** in Alicante. OHIM and the board of appeal rejected the registration. The slogan was a direct factual statement that may be seen as an advertising description by the respective customer. The filed mark therefore lacked distinctiveness.

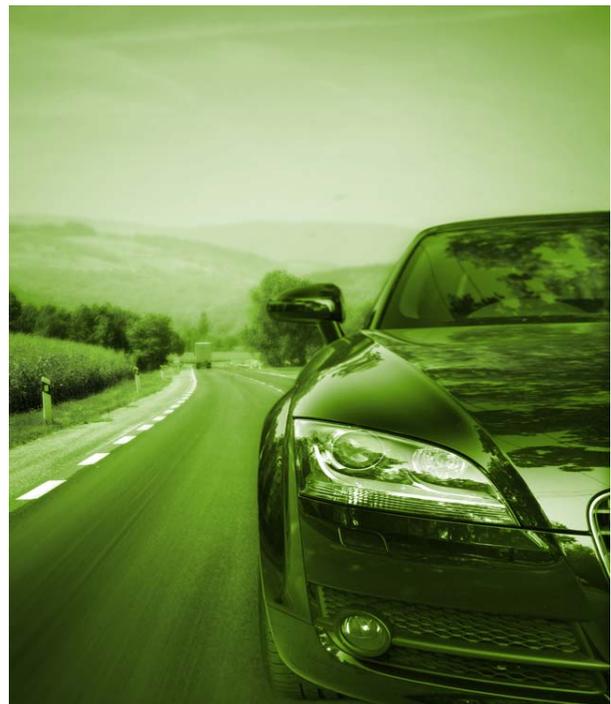
The court of first instance of the **European Communities (official file T-70/06)** also rejected Audi’s suit. According to the court, the trademark “Vorsprung durch Technik” (lead through technology) did also not accomplish distinctiveness by being a play of words or being creative, surprising and unexpected and may therefore stay in one’s memory. The trademark was only made distinctive through these various elements, if the related business fields see the goods and services labeled with it directly as an indication of the business origin. In the present case, however, the related business fields recognized said trademark mainly as a strapline.

The **European Court of Justice** has now reached a different opinion. All trademarks consisting of signs or indications that are normally used as straplines, quality indications or purchase requests of goods and services labeled with said marks naturally contained a factual statement to a more or less large ex-

tent. Just because of that such marks did not lack distinctiveness.

The word sequence “Vorsprung durch Technik” (lead through technology) only signified a causal connection and required a certain interpretation effort. Moreover said slogan featured a certain originality and conciseness that easily stays in one’s memory. Finally, since it concerns a famous slogan used for many years by Audi, it shall not be excluded that the circumstance of the related business fields being accustomed to connect said slogan with cars produced by said company, makes it also easy for the public to recognize the business origin of the indicated goods and services.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)



Picture: © Olaru Radian - Fotolia.com

**European Court of Justice
Decision of January 21, 2010
Official file: C-398/08 P**

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Opel defeated in a toy car trademark infringement dispute

The German Federal Court of Justice has decided that the producer of a motor vehicle cannot ban the distribution of model toy cars that also have the mark of the original producer at the respective position by referring to his trademark rights.

The plaintiff, the company Adam Opel, is the owner of a figurative mark registered for motor vehicles and toys, representing the well-known Opel-lightning-mark, which is used on all vehicles of the Opel company. The plaintiff wanted to prevent the defendant from distributing a toy car which is a miniature copy of a Opel Astra V8 Coupé having the Opel-lightning-mark on the radiator grill.

The respective regional court has sought a pre-decision from the European Court of Justice to the question whether said miniature copy poses an inadmissible use of the trademark. The European Court of Justice has decided that this mainly depends on the ruling to be made by the presenting court whether the related business fields take the identical mark on model toy cars as an indication that these originate from the plaintiff or from a company economically connected to the plaintiff. The regional court has then dismissed the action among others for cease and desist as well as damages. The court assumed that the related fields only see the mark at the right position of a miniature copy of a big original motor vehicle as a part of the model vehicle and therefore assign it neither to the producer of the original motor vehicle nor assume economic relations, in particular licence contracts, between the producers of the original and the toy model. The court of appeal has confirmed this statement. The appeal of the plaintiff was not successful.

The Federal Court of Justice has denied an infringement of the plaintiff's trademark registered for toys. However, the requirements of a trademark infringement are insofar fulfilled because applying the Opel-lightning-mark on

the defendant's toy car signifies the use of a sign identical to the infringed mark for identical goods (toys). However, here neither the main function of the mark, which is pointing out the origin of the good (here: toy car) to the customer, nor other trademark functions are affected because the respective customers see the Opel –lightning-mark on the defendant's toy cars only as a representation of the mark – true to original – that is placed on the plaintiff's copied car at the respective position. The Opel-lightning-mark is only seen as a copy detail of reality. Therefore the customers do not see any indication to the origin of the model car.



Since the plaintiff's trademark is registered for motor vehicles there is no similarity of goods (toy cars and motor vehicles) so that also the assumption of a trademark infringement is eliminated on the grounds of danger of confusion. Trademark infringement is likewise to be denied under the aspect of protection of a well-known mark for vehicles. Therefore unfair impairment or taking advantage of the reputation of plaintiff's trademark registered for motor vehicles is missing.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

German Federal Court of Justice – I ZR 88/08 – Opel Blitz II (Opel lightning II)

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No trademark infringement of the former national emblems CCCP and DDR of the former Soviet Union and the German Democratic Republic

The German Federal Court of Justice has rejected two infringement actions of German trademark owners of CCCP and DDR in the final instance, where the use of symbols of said former Eastern Bloc States on clothing should have been prohibited.

The plaintiffs were the owners of the word marks DDR and CCCP that among others are registered for clothing. Moreover, the actions were based on a German figurative mark displaying the national coat of arms of the former German Democratic Republic.

The defendants sold T-shirts with the term DDR and its coat of arms respectively with the letter sequence CCCP together with the hammer and sickle symbol. The letter sequence CCCP (in Latin letters SSSR) hereby stands for the abbreviation of the Cyrillic spelling of the former USSR.

The Federal Court of Justice has rejected both actions in the final instance due to lack of trademark use. According to the Federal Court

of Justice placing the symbols of the former Eastern Bloc States on pieces of clothing by the defendants does not infringe the trademark rights of the plaintiffs. Trademark claims presume that related business fields see the logos placed on clothing as an indication of the origin of the products of a certain company and not only as a decorative element that may vary according to the motive type.

The Federal Court of Justice has assumed that customers consider the symbols of former Eastern Bloc States on the front of T-shirts, like CCCP or DDR respectively the hammer and sickle symbol, exclusively as a decorative element and therefore do not see a product label in these symbols. Therefore there is no use of the trademarks.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

FCJ Decisions I ZR82/08-CCCP and I ZR92/08-DDR

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RESULT

It is fully agreed to the decisions of the German Federal Court of Justice regarding the trademarks CCCP, DDR and Opel-Blitz, since the cases described lack use of a trademark as function of origin, therefore the indication to the business origin. Use of the marks is seen by the related fields as a decorative element respectively the use of the Opel-lightning-mark is seen as an obligatory toy car detail, which shall be displayed as an Opel vehicle.

Scope of protection of a letter mark with the logo B

The applicant is the owner of a word-figurative mark registered for leather bags consisting of the capital letter "B" in a defined graphical design. The opponent sells a leather bag with a tag attached in form of a capital letter "B". The opponent was enjoined to refrain from offering and distributing said bag. Although the letter "B" had been designed differently in both marks, there is according to the court

similarity of the marks, since none of the marks has striking graphical characteristics. Since both marks are used for identical goods, the court realized of danger of confusion.

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

OLG Frankfurt, AZ: 6 U 240/09

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BULLENMEISTER ./ RED BULL

The German trademark BULLENMEISTER takes full advantage of the distinctiveness and valuation of the mark RED BULL according to § 14 para. 3 No. 3 German Trademark Law.



Taking such advantage of a mark is given, if a competitor has with the labelling of his goods approached the other mark to make use of the expected quality for him that is associated with the products distributed on the market under the other mark.

The above-mentioned decision has reached the conclusion that the mark BULLENMEISTER (class 32 and 33) registered since 2001 leans on the mark RED BULL, well-known for drinks, for reasons of selfish image transfer. Energy drinks in aluminium cans of 250ml and 350ml are offered under the mark RED BULL, which

has an outstanding market position. In Germany alone 210.2 million cans have been sold until the year of 2007. The product of the opponent, distributed under the mark BULLENMEISTER, does also include energy drinks, however being sold on the market in transparent 1l PET bottles.

Despite the completely different overall design of the products, the Hanseatic Higher Regional Court Hamburg has decided correctly according to our opinion that there is a danger of confusion between the notorious mark RED BULL and BULLENMEISTER.

BBiotech (Hons) Vanessa Bockhorn

OLG Hamburg, Decision of November 26, 2009 – 3 U 201/08

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No EU Trademark Protection for “Golden Toast”

The European Court has dismissed an action of the Dusseldorf consortium Golden Toast e.V. for the filing of the Community trademark “Golden Toast”. OHIM (the Office for Harmonization in the Internal Market) in Alicante, Spain had rejected the registration of the Community trademark for toasted bread on the grounds that the mark “Golden Toast” would be describing for the respective goods and had no distinctiveness.

The sixth chamber of the European Court now also agreed with the argumentation of the OHIM trademark examiners. From the view of the general public with English knowledge and an ordinary perception, the expression “Golden Toast” indicates a characteristic of the

goods in question, meaning that these are “right for toasting” and that the final product is golden, therefore “toasted just rightly brown”. The objection that the word mark “Golden Toast” is taken from the German public as indication to the company origin of the mentioned goods was not sufficient.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

Court of Justice of the European Union, Decision dated May 19, 2010, Official file: T-163/08

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FIFA's marks South Africa 2010 and Germany 2006 defeated by the German marks Südafrika 2010 as well as Deutschland 2006

In view of the World Cup 2010 FIFA filed an invalidity suit in Germany against, among others, the owner of the marks Südafrika 2010



as well as Deutschland 2006 registered for chocolate products, based on the FIFA marks South Africa 2010 and Germany 2006, which for everybody visible is just an English translation of the two German marks.

The German Federal Court of Justice (FCJ) has rejected both suits given the grounds to fact that the scope of protection of the registered



FIFA marks as well as of the attacked marks is very tight due to the describing content of the marks. Therefore the different language versions (English-German) are sufficient to make a clear difference between the marks. Moreover the FCJ noted that also common language terms of events, as it is the case here, belong to non-distinctive terms. Tables turned, this means that those marks should not even have been registered due to lack of distinctiveness according to German practice.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

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BIOTECH / MEDICAL TECHNOLOGY

Range and scope of protection of the European Directive on the legal protection of biotechnological inventions

The Directive 98/44/EC of the European Parliament and the Council for Legal Protection of Biotechnological Inventions has been implemented in the meantime in all Member States.

Up to now there has been no patent infringement case with respect to the Directive but now the ECJ has to take a decision in the legal

case Monsanto Technology ./. Cefetra among others. Hereby the company Monsanto (here: plaintiff) sees a patent infringement on Dutch territory in the import of several loads of soy flour from Argentina to the Netherlands. This infringement shall be prosecuted before a Dutch court.

The Patent of Monsanto:

Monsanto has a European patent on a genetically modified soy plant that is resistant against a herbicide, namely glyphosate. Due to the resistance of the soy plant other plants (e.g. weeds) can be killed by using the non-selective herbicide "Round-up" developed with the plant. Therefore only the soy plant resistant against glyphosate remains on the field.

In the course of the infringement (import of soy flour from Argentina) a product consisting of constituents of the genetically modified soy plant was imported by the defendant companies. After Monsanto found traces of the genetically modified soy plant in the imported flour, the company sued for damages in the Netherlands. The Dutch court has hereby requested the ECJ for clarification of four submitted questions.

1. Does a product (DNA sequence) that is part of a material (soy flour) imported to the EU and does not fulfil its function at the time when the infringement is claimed, however, has fulfilled it (in the soy plant from Argentina) fall under the protection according to Art. 9 of the Biopatent Directive?
2. Can national patent law grant a broader patent protection beyond the Directive?
3. Does a patent with a broader patent protection that has been granted before issuance of the Directive maintain its patent protection or is it limited by the Directive?
4. What is the relation of the Directive to the regulations of the TRIPS Agreement?

The Advocate General of the ECJ Paolo Mengozzi has commented to the Directive as follows:

To 1

Patented DNA as a chemical substance is not absolutely protected, only within the scope of the function for which the patent has been granted. Therefore the patent for a biotechnological invention is purpose-bound. Hence the protection of the patent has to be limited to



Picture: © flariv - Fotolia.com

the function. This means in the above-mentioned case that the protection of the patent is limited to the soy resistance against glyphosate. Since said resistance is not present as a function in the soy flour anymore and only the DNA remains as a residue, Monsanto may not reach broader protection within the EU.

To 2

The Directive is not a final regulation of patent protection for a biotechnological invention and does therefore not give way for a national statutory regulation granting a broader protection. The regulation contained in the Directive had to be seen as exhaustive so that a national statutory regulation may not offer a higher level of protection.

To 3

That the patent has been granted to Monsanto in 1996 before the implementation of the Directive in 1998, is not of importance, since the Directive does not contain transitional provisions and the Member States are obliged to interpret national law in concordance with the law of the Union.

To 4

The TRIPS Agreement is not contradictory to the Directive. Art. 30 of the Agreement only demands that exceptions are limited by patent

protection and normal utilization of the invention shall not be hindered.

BBiotech (Hons) Vanessa Bockhorn

Requests for protection of the Advocate General Mengozzi dated March 9, 2010 in the legal case C-428/08

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Note

In this case the economic implications are high, since EU agriculture earns high profits from the imported soy flour and the resistant soy plant may not be cultivated in the EU at the moment. There is no protection with respect to the DNA sequence only its function is protected. Consequently there is also a timely limitation because protection is also given when the function is currently active, therefore also active at the point in time.

European Patent for „milk production method“ maintained

According to the European Patent Office the European patent granted in 2007 (EP 1 330 552) that refers to a method for increasing the milk production of genetically modified cows and belongs to a group of Belgian and New Zealand researchers is maintained in the granted version.

The organisation Greenpeace e.V. and the German Federal Association of German dairy cattle breeders had among others filed an opposition against the patent that relates to the use of a marker test for identifying the DGAT1-gene of cows and with which the genetic value of a cow with respect to the milk composition and volume can be determined. The opponents raised the objection that the grant of the patent infringes several regulations of the European Patent Convention (EPC).

After hearing the parties involved the opposition division has now rejected the opposition on the basis of the EPC. In particular the objection that the patented invention may cause animals to “suffer without any essential medical advantage neither for humans nor the animal” was not sufficiently proven for the opposition division.

In the meantime Greenpeace has lodged an appeal against this decision.

BBiotech (Hons) Vanessa Bockhorn

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Broader scope for European patents relating to medical methods

Background

The European Patent Convention (EPC) comprises several exceptions to patentability. Amongst those for example Article 53 (c) EPC, according to which European patents shall not be granted for “methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body”.

The ratio legis of Article 53 (c) EPC for excluding the defined methods from patentability lies in the provision of medical services to the public. Medical and veterinary practitioners should be free to use their skills and knowledge of the best treatments to achieve the maximum benefit for their patients without being susceptible to patent infringement.

Decision G1/07

With respect to the exception to patentability for methods for “treatment by surgery”, the Enlarged Board of Appeal (EBA) recently ruled in its decision G1/07 (Medi-Physics Inc.) that the exclusion should apply only to method claims with features that cover treatment with health risks that make it necessary to reserve the treatment for medical practitioners.

The patent application in question relates to a magnetic resonance imaging (MRI) method for imaging the pulmonary and/or cardiac vasculature and evaluating blood flow, and involves a step of administering a contrast agent (dissolved polarized ^{129}Xe) to a patient whereby the way of administration could be by injection into the heart or for example inhalation by the patient.

The Examining Division of the EPO rejected this application arguing that such diagnostic methods, in particular when they involve the administration of a contrast agent, fall under the exclusion from patentability pursuant to Article 53 (c) EPC. The Division thereby referred to older decisions such as T655/92, in which it was decided that the parenteral administration of a contrast agent is a process or a diagnostic purpose which is to be implemented in its essential steps by medical staff or under the responsibility of a doctor and therefore exempted from patentability.

of Appeal (TBA) that referred three questions (s. left box) to the EBA because previous decisions by the Technical Boards of Appeal had produced divergent Case Law with respect to Article 53 (c) EPC.

The EBA ruled that a claimed imaging method that comprises an invasive step involving a physical intervention on the body is excluded from patentability as a method of treatment by surgery, when professional medical expertise is required and the method entails a substantial health risk. The EBA stressed that safe routine techniques are not excluded from patentability, even when of invasive nature. Further, the exclusion does not apply to methods which are directed to the operation of a device. In the case of the injection of a contrast agent, the health risk would need to be associated with the mode of administration, not only with the agent as such.

Further the EBA confirmed that a disclaimer can be used to avoid the exclusion from patent protection. The exclusion could also be avoided by amending the claims wording. However, the EBA reasoned that it was difficult to imagine how there could be a problem under Article 53 (c) if the claimed invention no longer contained excluded subject matter. In both instances, the disclaimer and the amendment must meet the other requirements of the EPC and Case Law and each case would have to be assessed on its merits.

Finally, a claimed imaging method is not to be considered as being a “treatment of the human or animal body by surgery” within the meaning of Article 53 (c) merely because during a surgical intervention the data obtained by the use of the method immediately allows a surgeon to decide on the course of action to be taken during a surgical intervention.

Conclusion

As the injection of the contrast agent into the heart is seen as a surgical step by the EBA, the claims could have been drafted with expressions like pre-delivered or pre-injected, or by a disclaimer, so as to avoid exclusion to patentability.

After the applicant filed an appeal against this decision, the case attained the Technical Board



In the future, claim features that cover bodily interventions that involve health risks which necessitate execution by a medical practitioner should be avoided. However, surgical methods with a non-therapeutic purpose that do not involve a health risk and not require medical expertise may be patentable, i.e. in connection with cosmetic procedures like tattooing or piercing.

This decision clearly outlines the importance of drafting your European patent application with utmost care, in particular regarding the formulation of the claims.

BBiotech (Hons) Vanessa Bockhorn

***Decision of the Enlarged Board of Appeal
(EPO), February 15, 2010***

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Questions referred to the EBA

1. Is a claimed imaging method for a diagnostic purpose, which comprises or encompasses a step consisting in a physical intervention practised on the human or animal body, to be excluded from patent protection as a “method for treatment of the human or animal body by surgery” pursuant to Art. 53 (c) EPC, if such a step does not per se aim at maintaining health and life?
2. If the answer to question 1 is in the affirmative, could the exclusion from patent protection be avoided by amending the wording of the claim so as to omit the step at issue, or disclaim it, or let the claim encompass it without being limited to it?
3. Is a claimed imaging method for diagnostic purpose to be considered as being a constitutive step of a “treatment of the human or animal body by surgery” pursuant to Art. 53 (c) EPC, if the data obtained by the method immediately allows a surgeon to decide on the cause of action to be taken during a surgical intervention?

COPYRIGHT LAW / MEDIA LAW

FIFA-World Cup Sweepstake and Unfair Competition

A company A, distributor of shaving devices, has announced a sweepstake on TV for advertisement with the following note:

“Win FIFA World Cup tickets now and a shaving gel for free. Tickets separately available in stores.”

An association V against fraud in trade and industry sent a warning letter to A since, according to the opinion of the association, the viewers were not correctly informed about the terms and conditions for participation. There V sees a competition violation. According to § 4 No. 5 UWG (Law against Unfair Competition) the terms and conditions for sweepstakes have to be indicated quite clearly. Therefore V sued for discontinuance of the objected advertisement.

The suit was rejected by the FCJ. The FCJ remarks that A has not acted unfair in terms of § 4 No. 5 of the Law against Unfair Competition, since it was referred in the TV spot to tickets available in stores, from which the terms and

conditions have resulted quite clearly. Under the circumstances given A was not obliged to already indicate the terms and conditions in the TV spot. TV as advertising media is not made to give detailed information about terms and conditions, since there is the danger on TV that information may not or only insufficiently be noticed. The information about the tickets, where the terms and conditions were printed quite clearly, was necessary and sufficient in the case at hand since the customer could not just participate in the sweepstake due to the TV spot but had to organize a ticket with printed terms and conditions in the stores at first. If, however, the terms and conditions contain unexpected limitations or other surprising clauses, then these have to be disclosed right in the TV spot.

Dr. jur. A. Blum von Ann (Attorney)
FCJ-Decision– I ZR 64/07

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No screen mask copyright protection as long as the graphical design is not in the limelight

The plaintiff offers an online travel booking software AT having as a submodule T a booking mask with several input boxes. The defendant developed a travel booking software X with the booking mask X. The masks T and X have a number of conformities, in particular with respect to the design of the input boxes, the structure of the user interfaces and the design of the windows. The plaintiff claims that the defendant's X-booking mask is an inadmissible slavish imitation of the T-mask and lodges claims relating to copyright and competition

law. The action was not successful in the first and second instance.

According to the Higher Regional Court the T-mask is no protected computer program according to § 69 a German Copyright Law rather just the result of a computer program. The screen surface is created by the computer program, however, is no computer program itself.

Just as little does the T-mask enjoy copyright protection according to § 2 para. 1 No. 7 Ger-

man Copyright Law. According thereto, scientific or technical representations like drawings, plans, sketch maps, tables and plastic representations belong to the protected works. This basically also includes preprints and forms however the T-mask lacks the required level of creativity. What data is needed during travel booking (customer data, tour operator, travel dates as e.g. the type of accommodation) is indicated by the travel provider and is of sheer handicraft nature and therefore no creative performance.

The plaintiff is also not entitled to an injunctive relief from the defendant according to the Law against Unfair Competition. According to § 4 No. 9a of the Law against Unfair Competition one acts unfair when offering goods or services that are imitations of the goods and services of a competitor and creating an avoidable deception of the customers in regard of the business origin. However the court assumes that the T-mask has a certain competitive characteristic, amongst others because it has a customer awareness of 75 % in Germany. However it's

not suitable for origin deception. The related business fields, namely owners and professional employees of travel agencies are not deceived by the business origin of the X-mask. Since the T-mask and the X-mask are not distributed isolated but are both components of different comprehensive software packages, one who decides about purchasing the software is not deceived with respect to business origin due to similarities of both masks.

According to the Higher Regional Court a defendant's competitive infringement does also not result from § 4 No. 9 b Law against Unfair Competition, where one acts unfair who takes inadequate advantage of or influences the valuation of an imitated good or service. The required transmission of valuation for anti-competitive exploitation of reputation is not the case, since the defendant by the way clearly limits his software package from the plaintiff's.

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

Higher Regional Court Karlsruhe, Decision of April 14, 2010 (not yet effective)

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Indication of a telephone number in distance selling contracts may cause a breach of Unfair Competition Law

In distance selling contracts, in particular common in e-commerce and distance selling, the consumer has the right to withdraw his offer respectively acceptance of contract within two weeks in written form or by returning the good without explanations. The consumer has to be informed about his right of withdrawal quite clearly.

The OLG (Higher Regional Court) Hamm has seen an illegal action in the following text of the terms and conditions used by an entrepreneur: "The withdrawal has to be directed to the company X, owner X1, E-street ..., B-city, telephone number...." According to the court adding the phone number may give the false

impression to the customer that he may declare his withdrawal also by phone and not just in written form. Therefore the customer was not correctly informed about his right of withdrawal and the cancellation period is not running. The passage irritating because of adding the phone number in the terms and conditions is an infringement of § 4 No. 11 of the Law against Unfair Competition, so that competitors of the company may utilize it to sue for discontinuance and damages.

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

OLG Hamm, Az.: 4 U 43/09

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CURRENT ISSUES & NEWS

Trademark Law cooperation between China and Germany

In April 2010 the German Patent and Trademark Office and the State Administration for Industry and Commerce of the People's Republic of China (SAIC) agreed on a bilateral partnership of both offices in trademark matters.

Cooperation is hereby scheduled in the following fields:

- information exchange on current trademark law questions including protective right aspects of the Law against Unfair Competition as well as on administrative questions;

- joint activities regarding international IP issues as well as sensitizing the public for trademark law.

For the time being the agreement's duration is for two years with the option for a prolongation.

BBiotech (Hons) Vanessa Bockhorn

Press portal of the GPTO, April 19, 2010

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Israel joins the Protocol relating to the Madrid Agreement

Israel will implement the Protocol relating to the Madrid Agreement concerning the International Registration of marks, effective as of **September 1, 2010** so that International Madrid Protocol Registrations (IR's) may be extended to Israel (national registrations may

be transformed to International Registrations, and vice versa).

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

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Cooperation with BPSH Patent Attorneys and Attorneys at Law in Dusseldorf

With effect of June 2010 we have merged with the patent attorneys and attorneys at law BPSH in Dusseldorf for a cooperation aiming for broadening our professional orientation in the technical field and also strengthening the legal department of our firm. In this cooperation we work very closely together with Dipl.-Ing. Rolf Schrooten, who has a background in mechanical engineering, and Dr. Alvaro Re-

mus, with focus on Biotech, as well as with Jan Wilhelm Haber as a lawyer.

At the same time we moved with our Dusseldorf office to more modern and bigger office premises. Our Dusseldorf office is now at Mörsebroicher Weg 191.

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