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Dear Reader,

Right on time this year we present our first UPDATE dealing under the headword Patents mainly with the new EPC Rules effective on April 01, 2010 implicating tightening and acceleration of the European examination procedure but unfortunately also setting stringent deadlines to be observed for divisional applications. Since the European, the Japanese and the US Patent and Trademark Office are obliged within the scope of a pilot project to also apply the Patent Prosecution Highway program (PPH) to PCT applications, an acceleration of granting a European patent should in principle be achieved if the possibilities are used effectively.

Next to further topics concerning Patent Law we also have composed a collection of reports and decisions from other fields of Intellectual Property, namely Trademark Law, Biotech as well as Copyright and Media Law and hope that one or the other topic finds your interest.

With the integration of Ms. Dr. jur. Annemarie Blum von Ann as a partner we have strengthened our Legal Department. Dr. Blum von Ann is an approved expert in the field of Intellectual Property and used to be the Head of the Legal and Patent Department of a major company for many years. Moreover, she has also gained experience in law firms. With Dr. Blum von Ann we have broadened our consultancy spectrum of our Legal Department.

Furthermore our next UPDATE issue will be in about 4 months in mid-summer.

If you need further information about the topics reported by us, please do not hesitate to contact us or the respective author of the report.

I hope you enjoy reading our UPDATE!

Best regards

Josef Bockhorni

PATEN LAW

New EPC-Rules effective from April 01, 2010 with important changes for filing divisional application

The Administrative Council decided important changes to EPC Rules which are effective with April 01, 2010. These changes have a major impact on preparation and prosecution of European patent applications and should streamline the examination proceedings and improve the quality of incoming applications.

These changes concern:

- new and restrictive time limits for filing divisional applications
- multiple independent claims
- mandatory response to the search opinion
- amendments during examination.

I. Divisional applications (Rule 36 EPC)

Under current practice, a divisional application can be filed as long as the European patent application is pending or that is till grant of patent. This was a reasonable regulation but allowed the possibility of filing a sequence of divisional applications. In view of the EPO this practice was misused by filing more and more divisionals at a late stage of the examination proceedings so that it was decided to introduce time limits for divisionals.

With the new rules, divisional applications have to be filed within a time limit of 24 months from the first communication in the examination proceedings (though not the written opinion issued with the search report), or within a term of 24 months from any communication in which the Examining Division objected non-unity of invention under Article 82 EPC.

Voluntary divisional applications maybe filed within 24 months from the first examina-

tion report which means that the decision for filing divisional applications has to be made at a very early stage of the examination proceedings.

Mandatory divisional applications are applications which are filed due to a non-unity objection of the EPO examiner and such a mandatory divisional application has to be filed within 24 months from the first communication in which the Examining Division raised the non-unity objection.

This difference in timing between a voluntary divisional application and a mandatory divisional application has to be regarded because there is no extension of the 24-month time limit for filing any divisional applications starting from the first examination communication of the Examining Division. Only in case the Examining Division objects lack of unity of invention in a later stage of proceedings, then an additional 24-month time limit starting from this communication is opened.

Consequently, you have to check at a very early stage of the proceedings whether it may be appropriate to file divisional applications. Particularly in view of pending European patent applications it is worthwhile to check whether filing of a divisional application is appropriate because transitional provisions shall apply for pending applications. If the 24-month time limits have expired before April 01, 2010 a divisional application may still be filed within 6 months of April 01, 2010 and if the time limits are still running on April 01, 2010, the time limits will continue to do so for not less than 6 months. Please regard that a request for further processing under Article 121 EPC is not applicable on these time limits.

Our recommendation is to accelerate the search and/or examination proceeding under the PACE program and try to bring the application to grant within the 24-month time limit so that voluntary filing of divisional applications is still possible within the new time limits and therefore depending on the outcome of the examination proceedings.

II. Multiple independent claims (Rules 62a)

Under European practice generally only one independent claim per category (device method, product-by-use claim) is allowed in view of Rule 43 (2) EPC.

Now the EPO is checking the Rule 43 (2) issue at a very early stage of the proceeding, namely before the search is performed. In case there are several independent claims in each category, the EPO gives a 2-month time limit to indicate which claims the applicant wishes to be searched, otherwise the search shall be carried out by the Office on the basis of the first claim in each category.

Therefore it is no longer advisable to stay with claims in accordance with US patent practice, i.e. with several independent claims in each category, rather we recommend revising the claims of a European patent application to have only one independent claim in each category, in case this is possible. This is also advisable in view of the excessive claim fees.

This change has also a strong impact on the examination proceedings because in case of several independent claims in each category, the Examining Division shall demand restricting the claims to the subject matter which was searched during the examination proceedings, unless the Division finds that the category objection raised by the Office before start of the search was not justified.

III. Incomplete search (Rule 63)

Currently, in case the Search Department comes to the conclusion that it is not possible

to carry out a meaningful search report, the Search Department issues a reasoned decision that a search was not possible or draws up a partial search report.

With the new practice, the applicant is given the opportunity to file a statement within a time limit of 2 months indicating the subject matter to be searched.

New Rule 63 relating to incomplete search is only applicable to European search reports or supplemental European search reports which will be issued with April 01, 2010.

IV. Response to written opinion of extended European search report (Rule 70a)

Up to now, most of the European search reports were accompanied with the so-called written statement of the Search Department which is similar to a substantial communication in examination proceedings. Up to now there was no need to file a reply to the written opinion. But this was changed and now it is mandatory to file a response to the written opinion otherwise the application is deemed to be withdrawn (Rule 70a (3)).

There are 3 different situations for appliance of Rule 70a:

- (a) In case of EURO-DIRECT applications:
The applicant gets a 6-month time limit starting with publication of the search report for filing a response to the written opinion, otherwise the application is deemed to be withdrawn.
- (b) In case of EURO-PCT applications, where the EPO acted as ISA and the IPEA in the international phase, a communication is issued shortly after initiating the regional phase of the European patent application with a time limit of only one month within which it is mandatory to file a response to the written opinion of the Search Department, otherwise, the application is deemed to be

withdrawn. The one-month time limit is in accordance with changed Rule 161 (1).

- (c) In case of EURO-PCT applications, the existing practice remains unchanged. The EPO will issue a supplementary European search report and gives the applicant the opportunity to communicate to the extended European search report within the period specified for indicating whether he wishes to proceed further with the application (new Rule 70a (2)).

The consequences are that the European search report together with the written opinion should be regarded as a first official action in the examination proceedings so that a substantive response should be filed.

This is particularly of importance for PCT applications where the EPO acted as the ISA and the IPEA because the very short time limit of one month for filing a response should be regarded given by a communication of the EPO

shortly after entering the regional phase of the EURO-PCT application.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)



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Result

- It has to be decided at an early stage whether a divisional application makes sense and then the divisional application has to be filed very early.
- A European patent application, whether it resulted directly or within the scope of the regional phase out of a PCT application, should only be filed with respectively one independent claim in one category (in most cases device and method claim).
- The search report of the European Patent Office should be immediately regarded as the first examination report.

Due to the tightening in regard of filing of divisional applications it should however be considered to not necessarily initiate the European application based on a PCT application, rather to file a national German application and if applicable national applications in some major countries like Great Britain and France. Out of experience European applications are mostly nationalized in only two or three designated countries after grant of the patent. Therefore filing of two or three national applications instead of a European application becomes more and more interesting, since national examination proceedings are mostly exempt from the restrictions of the European proceeding.

Why filing a German national first application if foreign applications are planned anyway?

Due to the financial crisis more and more companies are forced to have an eye on the costs. In this respect it is our concern giving comprehensive advice to our clients and at the same time taking care of a cost-saving and efficient procedure when filing and prosecuting protective rights is concerned.

The different possibilities when filing the first application are often the focus of this consideration. In particular clients often have to face the question whether it is advisable to file a German first application (so to speak as a "test shot") in advance when foreign applications are planned anyway and then continue with filing of any foreign applications by claiming priority of said first application. Basically it would also be possible to file foreign applications without the German "test version" and e.g. to directly file the planned European or PCT application.

One of the advantages of a German first application lies for example in doubling the chances of receiving protection in Germany. This is indeed of advantage, since with a German first application and a European subsequent application two patents may be achieved effective for Germany. If both examination proceedings are coordinated, then two patents with a different scope of protection may be achieved and infringements may be faced better prepared.

Decisive, however, is the fact that the German first application may be used as a test version to see in how far improvements may be made in the presentation of the invention, that may be seen within the scope of the search report of the German Patent and Trademark Office (low search fees!!) and if so on the basis of a first examination report. Exactly the revision of the application by a third party (here by the examiner) shows possibilities on how to optimize the application text for foreign applications within the priority deadline and to receive a protective right that, in case of grant, has a strong basis. In addition, relevant prior art may

be considered in the subsequent application by introducing it during the search or examination procedure. The examination procedure may therefore be accelerated by respective limitation and specification of the claims. Moreover, considering the prior art, formulations may be chosen more accurately and precisely, further essential facts may be included and any unclarity may be eliminated (often only seen when cited prior art opposes the subject matter according to invention). This has also a very favourable effect for the patent's scope of protection.



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Under no circumstances this point shall not remain unconsidered since with a German first application a simple tool is given to revise the application together with its text version once again reflected and assessed by a third party.

Finally it has to be considered that any further developments of the subject matter according to invention may be taken up easily into a foreign application within the priority year. Here it also has to be noted that only by examination of the prior art it may be seen what exactly is one's own objective and how it may be presented better.

If it turns out that due to the German search report or the first examination report there is no virtue in prosecuting the application further because the prior art already found during the German proceeding is oppressive, then the costs for foreign applications may be saved completely. Even though an assessment thereto has to be seen critical (since an assessment of the prior art in other countries may lead to different results), at least a “dev-

astating” prior art is an indication to refrain from filing foreign applications.

Moreover, it has to be considered that the already prepared first application may be used for subsequent foreign applications and if need be only has to be adapted. Here the costs until then are fully considered.

*Dipl.-Ing., Dipl.-Berufspäd. Dr. Susanne Schollweck
(Patent Attorney)*

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Result

A German first application is definitely recommended if foreign applications are planned so that the subject matter and/or its presentation in the application text may still be developed within the priority year.

[Proof of publication of internet documents](#)

[Communication of the EPO, Official Journal 8-9, 2009, Year 32, p.456](#)

Never mind if in the examination or in the opposition proceeding and never mind who provides an internet document, the examiner or the opponent, giving proof of when an internet document has been made available to the public is always a delicate topic. It is at least such a hot topic that the European Patent Office has made the effort to give a statement to eliminate any uncertainty.

It is undeniable that internet disclosures belong to the prior art starting with the date when they were published online. But exactly that date cannot always be determined precisely, since manipulations may be made easily and can therefore not be excluded. Possibly it can also not be determined what the content of the website looked like before updating it (archives showing the temporal course of internet presentations do not exist very often). And finally the relevance of websites has to be considered that are only available to a certain number of users, e.g. by password assignment.

Now the EPO clearly states that an evaluation of a website has to be made in the same way as it is done, according to the principle of “free evaluation of evidence”, with “any other evi-

dence, including traditional printed publications”. This means that each piece of evidence is to be weighted according to its conclusive force, which is determined under consideration of special circumstances of the individual case. The circumstances are hereby assessed according to the principle of calculating the probability, as it is normally applied by the boards of appeal as a measurement for the evaluation of evidence. According to this it is not sufficient that the facts claimed (e.g. the date of publication) is only presumable; the Examination Division moreover has to be convinced about its correctness. However, this also means that the claim does not have to be proven completely free of doubt and in an unbroken chain.”



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Generally, data shown on websites is seen as reliable, proving the opposite has to be done by the applicant or if so the patent owner. Demonstration of the date of publication of special internet information put in particularly by private persons (Usenet-discussion groups, blogs, Wiki-pages etc.) is indeed more extensive. Reliability of such sources may differ a lot. "Computer generated timestamps ... can be considered as reliable publication dates. While such dates could have been generated by an imprecise computer clock this will be weighed against the fact that in general many internet services rely on accurate timing and will often stop functioning if time and date are incorrect".

For disclosures where no reliable date may be assigned, further proof needs to be found. Internet archive services (e.g. www.archive.org) may be of use that might offer further information as so-called way-back machines. Incompleteness of the information found there poses no obstacle for the EPO to use such services. If a corresponding publication date may however not be found, then the respective internet information may not be used as prior art.

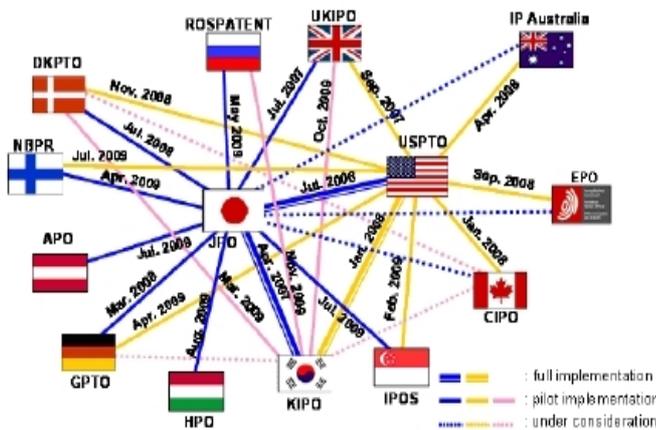
*Dipl.-Ing., Dipl.-Berufspäd. Dr. Susanne Schollweck
(Patent Attorney)*

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Result

Also information from the internet may be considered as prior art without any further ado. However, it has to be noted that a respective publication date has to be shown. And this is not more difficult than the proof of a "usual" written document.

Pilot of Patent Prosecution Highway Program to use PCT Work Products



On 13 November 2009, the Trilateral Offices (the European Patent Office, the Japan Patent Office and the United States Patent and Trademark Office) agreed to expand the existing set of bilateral Patent Prosecution Highway (PPH) work sharing arrangements by starting a PCT/PPH pilot program under which PCT work products established by one of the Trilateral Offices in its capacity as a PCT International Searching or Preliminary Examining Authority (namely, international search reports, written

opinions and international preliminary examination reports) may form the basis for PPH requests in each of the Trilateral Offices during national phase processing of the international application. The pilot program, which is scheduled to start on 29 January 2010, will greatly expand the potential of the PPH work sharing arrangements, which until now have been limited to work products established in respect of national patent applications.

Under the PPH, an applicant receiving a determination from an office of first filing that certain or all claims in an application are allowable may request that the corresponding application filed at a second office be advanced, out of turn, for examination in respect of those allowable claims.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

For further information on this development, see the Trilateral website at:

www.trilateral.net

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Selection of the starting point for the assessment of the obviousness of a patent-protected subject matter

GRUR, Edition 11/2009, Year 111 , page 1063

**German Federal Court of Justice,
Decision dated June 18, 2009 – Xa ZR 138/05 (German Federal Patent Court)
EPC Art. 56; PatG § 4 (German Patent Law)–Fischbissanzeiger (“fish bite detector”)**

According to the classic problem-solution-approach the closest prior art is defined for the assessment of inventive step to determine how the person skilled in the art – based on said closest prior art – would have taken the approach to reach the subject matter of the invention (or not).

The German Federal Court of Justice has now decided that the closest prior art may not always be the one or the only starting point for the further action of the person skilled in the art. “The assessment of obviousness of a patent-protected subject matter may not always

be based on the ‘closest’ prior art as the only starting point. The selection of a starting point (or of several starting points) rather needs a special justification, that is normally derived from the effort of the person skilled in the art, to find a better – or only a different - solution for a certain purpose than is provided by the prior art. ... Also the EPC does not offer a basis for gearing only to the ‘closest’ prior art.”

*Dipl.-Ing., Dipl.-Berufspäd. Dr. Susanne Schollweck
(Patent Attorney)*

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Result

The decision shows once again that jurisdiction grants the person skilled in the art the competence given to him with objective examination.

Anti-competitive defamation in a patent?

FCJ: Decision of December 10, 2009 – I-ZR 46/07 – Fischdosendeckel (fish can packages)

In the year 1993 the defendant filed a patent for fish can packages in particular for a lid construction. A prior patent was cited in the prior art in this patent application and later on also in the printed patent specification. Since the defendant pointed out disadvantages of the invention of the cited patent in his own patent application and due to said disadvantages came to the advantageous solution of his own patent, the patent owner of the document cited in the prior art filed an action to cease and desist and in addition requested cancellation of the, according to his opinion, untrue and disparaging presentation from the patent specification. The action was based on the fact that

the product of the patent owner and plaintiff was inadmissibly diminished in the patent specification which is a violation of § 4 No. 8 (Law against Unfair Competition).

As the Regional Court and the Higher Regional Court have seen an anti-competitive defamation in the objected statement, the defendant filed an appeal at the Federal Court of Justice.

According to the Federal Court of Justice the current statutory provisions of the Patent Law apply for the grant of a patent so that a prosecution before the ordinary courts (Regional Court, Higher Regional Court) is not compatible with the patent granting procedure regulated separately in the Patent Law. Therefore an action before the ordinary courts (Regional Court, Higher Regional Court) is inadmissible, with

which influence is exerted on the grant of a patent or the following legal concerns of a granted patent. According to the Federal Court of Justice the action is admissible regarding the cease and desist request beyond the scope of a patent application, however in this case unfounded, since the plaintiff did not show that the defendant will make disadvantageous statements about the product of the plaintiff in

future. Therefore the action was dismissed.
Dipl.-Biotechnol. Vanessa Bockhorni



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TRADEMARK LAW

ECJ: Does „Bavaria beer“ also have to come from Bavaria?

In 1993 the Bavarian Brewers Federation applied for the registration of the term “Bayerisches Bier” (“Bavarian beer”) as a protected geographical indication. This request led – despite objections of diverse Member States – to the registration of the geographical indication “Bavarian beer”.

Bavaria is a Dutch beer producer being strongly present on the international market and using the term “Bavaria” since 1925. Bavaria is the owner of diverse trademarks with the component “Bavaria” that have been registered in the time since 1947. Bavaria Italia belongs to business group of Bavaria.

In the year 2004 the Bavarian Brewers Federation filed an action, just as before in different other Member States, in Turin at the Tribunale di Torino requesting to ban Bavaria and Bavaria Italia from using their trademarks in Italy. The Tribunale di Torino partially allowed the action of the Bavarian Brewers Federation, however, Bavaria and Bavaria Italia lodged an appeal. Against this background the Italian Court of Appeal presented several questions for a preliminary ruling to the Court of Justice re-

garding the validity of the regulation about the protection of geographical indications and its effects resulting from the registration of the geographical indication “Bavarian beer” for the trademarks with the term “Bavaria” that already existed before.

The ECJ’s review of the questions presented has not brought any results touching the validity of the regulation about protected geographical indications, neither in respect of the field of use, nor of the legal basis, nor in regard of the so-called “facilitated registration procedure”.

The ECJ points to the fact that examination of the registration conditions of a term as a geographical indication requires well-grounded knowledge of the particulars of the respective Member State and is incumbent on the inspection of the national courts. Said registration conditions were checked by the German authorities at that time without putting the validity of their decision into question before a national court. The ECJ states that the geographical indication “Bavarian beer” fulfils the substantial registration conditions and has not be-

come a generic term, since the direct relation between the established image of Bavarian beer and its geographical origin has not been harmed.

The ECJ states that – on the basis of a prior examination of the question whether the consumer might be misled in view of the identity of the product - the Community authorities may deny registration of a geographical indication in cases where there is a conflict with a previous trademark. If a geographical indication has once been registered, then it is the responsibility of the national courts to check whether the trademark has been registered in good faith prior to the date of the request for registration of the geographical indication and whether it is not subject to certain arguments for the invalidity or the revocation, to allow its further use that is in conflict with the geographical indication. *U. Pfaller (Attorney)*



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Result

As long as the national courts are of the opinion that Bavaria has registered the trademarks in good faith and that the customer is not misled by the term Bavaria for beer in view of origin, the trademarks may be used further. For future trademarks however applies that “Bavarian beer” also has to come from Bavaria.

[An exclamation mark may not be registered as a Community trademark](#)

ECJ dated September 30, 2009

Reference: T-75/08 u. T 191/08

The famous clothing manufacturer JOOP! GmbH filed two exclamation marks (!) as figurative marks in a different figurative design at the Office for Harmonization in the year 2006. The Office for Harmonization has negated registrability of both applications due to lack of distinctiveness and stated that exclamation marks are by the respective business circles only seen as an advertising promotion or eye catcher but not as an indication to business origin of the goods.



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The company JOOP has filed a suit against this decision at the Court of Justice European Communities, whereby the ECJ has fully agreed to the argumentation of the Office for Harmonization and negated registrability.

The company JOOP however claimed that the trademark has now gained distinctiveness due to respective use for the goods and services registered and would therefore be registrable. Since the company JOOP has only presented documents regarding the use in the German market JOOP's request was rejected by the ECJ. In addition, the ECJ has clarified that distinctiveness of the mark must have been achieved by use before the date of filing.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

Result

Registration of a non-distinctive trademark due to use is only possible if said trademark has achieved distinctiveness by respective strong use before the date of filing. A further requirement is that fact that this has to be proven for the entire area of the European Community.

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ECJ prohibits the registration of CANNABIS for beer

ECJ Decision - November 19, 2009

Reference: T-234/06

In the last instance the Court of First Instance of the European Community has negated the registrability of the word mark CANNABIS for the goods beers, wines and spirits.

The Office for Harmonization in the Internal Market has originally registered CANNABIS as a Community trademark. An invalidity request was filed against this on the basis of the mark CANNABIS CLUB, whereby the petitioner himself has named a beer CANNABIS CLUB having the aroma of cannabis.

The Office for Harmonization has thereupon revoked the Community trademark CANNABIS, since the average consumer takes canna-

bis as a clear and direct reference to the features of the goods, for which the mark has been registered. The Court of Justice of the European Communities followed this view and furthermore declared that there is a factual connection between cannabis and particular features of beers, since cannabis is used in the production of numerous foodstuffs. In addition, cannabis is a scientific Latin term existing also in several languages of the European Community and is known to the general public. That is why the average consumer will see the mark CANNABIS as descriptive for the goods beers and the like and it may possibly also be decisive for the purchase decision of the consumer, who will hope for the same effects when purchasing a beer named like this, as he can expect by consuming cannabis.

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

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„Schneeweiße ./ Seeweisse“

The patent owner of the earlier mark “**Schneeweiße**” filed an opposition against the registration of the mark “**Seeweisse**” registered in particular for beer and beer mix drinks because his mark “Schneeweiße” is registered for partially identical goods, namely wheat beer.

The German Patent and Trademark Office (GPTO) had rejected the opposition despite partially identical goods, since the attacked trademark “Seeweisse” maintains a sufficient character spacing to the mark “Schneeweiße”. The GPTO does not act on the assumption of likelihood of confusion of both marks, since there are typeface differences (a different amount of letters in the first syllables “See” and “Schnee”), term differences (no similar meaning) and differences in sound. Within related fields of business a describing indication to wheat beer is seen in particular in the last syllables “weisse” and “weiße”. Therefore the beginning of the word is of greater importance and there is a difference in sound, since “Seeweisse” starts with the voiced labiodental “S”, intensified by the following, bright sounding double vocal “ee” and “Schneeweiße” with the unvoiced sound “Sch” and the following consonant “n” faint in sound. Therefore the first syllable “See” is pronounced faintly compared to “Schnee” which is pronounced harshly.

The owner of the earlier trademark filed an appeal against the decision of the GPTO at the German Federal Patent Court, whereby it was particularly referred to the similarity in sound of the marks. Decisive, so the owner of “Schneeweiße”, are the similarities of the syllables and the vocal sequence (ee-ei-e) just like the long-drawn pronunciation of the conform vocal sequence “ee” at the beginning of the word. Moreover, the first consonant of both marks “S” and also the word endings are identical. Therefore the minor variations of the first syllable make no difference, in particular since the drinks are mostly ordered by word of mouth and since there are often unfavourable transmission conditions in restaurants.



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The German Federal Patent Court confirmed the GPTO in its decision regarding the identity of beer as a good. Just like the GPTO the German Federal Patent Court states that the word ending “weiße” respectively “weisse” stands for wheat beer, whereby the elder mark receives its characterizing function by the first syllable. This, so the Patent Court, however is of describing nature, since “Schnee” is associated with the wheat beer’s head. Furthermore, when assessing direct likelihood of confusion, it has to be referred to given overall impression, whereby this mainly depends on the assessment of the average consumer. In regard of the typeface the different amount of letters in the first syllable is sufficient for differentiation of the marks. Phonetically the sharp and short pronunciation of “Seeweisse” in comparison to the softly pronounced mark “Schneeweiße” is pointed out. Termwise the first syllables are known in related fields of business with their own respective meaning and may therefore be distinguished. According to the Patent Court there is no likelihood of confusion of both marks so that the appeal with decision dated July 01, 2009 was rejected.

Dipl.-Biotechnol. Vanessa Bockhorni

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BIOTECH

The German Federal Court of Justice remits „embryonic stem cell“ problem to the ECJ

Patentability of an invention comprising the use of human embryonic stem cells is put into question once again. Ethical concerns come along with such biotechnological inventions, where “human embryos” are used and killed for the extraction of stem cells.

The patent in dispute of the scientist Oliver Brüstle from Bonn provides the transplantation of still progressive precursor cells into the nervous system, the protected method making the therapy of neurological diseases like Parkinson and multiple sclerosis possible. However in order to obtain the precursor cells, human embryos must be destroyed in a preceding step.

The environmental control group Greenpeace filed a suit against this patent at the German Federal Patent Court and for the most part the Court agreed with Greenpeace in the first instance. The Federal Patent Court revoked Brüstle’s patent as far as it concerns cells that are extracted from embryonic stem cells of human embryos. Since human embryos are used and then killed for the extraction of stem cells the patent violates the public order and the code of ethics (§2 German Patent Law). Moreover, patents using human embryos for industrial or commercial purposes are excluded from patentability (§2 paragraph 2, page 1 No. 3 German Patent Law and Art. 6 Directive 98/44/EC on the legal protection of biotechnological inventions).

Brüstle lodged an appeal against the decision of the Patent Court at the Federal Court of Justice. Here, it has to be noted that the Stem Cell Law in Germany allows importation of cell lines of embryonic stem cells that have developed before May 01, 2007. Since the patent commission is in conflict regarding “the use of human embryos for industrial and commercial purposes” with the legal permission (Stem Cell Law) for importation of embryonic stem cells, the Federal Court of Justice has suspended the proceedings and submitted several questions for the interpretation of statutory requirements to the European Court of Justice (ECJ).

The term “embryo” is very broadly formulated and up to now it has not been clarified in how far blastocysts (4th – 7th day after fertilization of the ovum) are included, from which the promising cells are extracted. The Luxembourg judges of the ECJ will now have to decide whether the stem cell extracted from the blastocyst is already an embryo in terms of the law or whether extraction of stem cells requires the consumption of blastocysts. Finally it still has to be clarified whether use for research purposes or therapeutical purposes is considered as “commercial” use in terms of Art. 6 of the Directive 98/44/EC.

Dipl.-Biotechnol. Vanessa Bockhorni

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Result

Whatever the decision may be, on the one hand it will influence the investment climate regarding embryonic stem cell research in Europe and on the other hand it will limit or pro-competitively support the patenting propensity if there are highly relevant research results in comparison to other international players in this field.

COPYRIGHT LAW / MEDIA LAW

Translators may demand profit sharing

Decision of the German Federal Court of Justice dated October 07, 2009 Reference: I ZR 38/08

The German Federal Court of Justice has now surprisingly decided that literature translators can now claim for appropriate compensation in form of a percentaged share of the sales profit next to the usual translation fee per page if there is a circulation of at least 5000 copies of the translated version.

The plaintiff had translated two novels from the English language and, as usual, granted license of her translation to the publishing house. The fee per page amounted hereby to about 15 €. However, the plaintiff also wanted to have a share of the sales profit.

The judges of the German Federal Court of Justice stated that the translator does not just have a claim for the usual and appropriate translation fee per page as a guaranteed fee for the translation but the translator may in addition also claim a share of the sales profit if there is a certain circulation figure – the Ger-



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man Federal Court does hereby speak of a circulation of at least 5000 copies. The German Federal Court of Justice has hereby also spoken about values, namely 0.8 % of the store net sales price for hardcover editions and 0.4 % of the store net sales price for soft-cover editions. Moreover, the translator may generally claim half of the net sales profit, which the publishing house gains, by granting license of the translated version to third parties. *Dipl.-Ing. Josef Bockhorni (Patent Attorney)*

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No general claim for protection for the publication of pictures of celebrities

German Federal Court of Justice-Decision dated October 06, 2009 Reference: VI ZR 314/08 and VI ZR 315/08

The German Federal Court of Justice has decided that there is no comprehensive claim of a child against the press to prohibit exposing of photos until majority.

The Beckenbauer family had filed a cease and desist suit against the well-known publishing company Burda in the year 2007 because photos of the underage children of the Beckenbauer family together with their parents had been published in some magazines of the publishing company. The Beckenbauer family's reaction to this was filing a suit.



Both the Regional Court and the Higher Regional Court of Hamburg agreed with the Beckenbauer family and imposed a cease and desist declaration until the majority of the children.

The German Federal Court of Justice however revoked the judgement of the Higher Regional Court and pointed out that for the question of admissibility of a photo publication weighting between the information interest of the public and the interest of the child shown in the photo is necessary in each individual case for the protection of the child's privacy. The minority age of children does not change this either. Furthermore, the German Federal Court of Justice

states that it is possible that there is information interest of the public also in view of children and teenagers in respect of varied and individually unpredictable circumstances of life so that a general prohibition, which would last for many years up to majority age in particular for younger children, is not advisable and would pose an unacceptable impairment of the freedom of speech and press (Art. 5, Para.1 Basic Constitutional Law of Germany).

Dipl.-Ing. Josef Bockhorni (Patent Attorney)

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CURRENT ISSUES & NEWS

Foreign Law

Italy:

- In Italy the so-called inner priority for patents and utility models has been introduced in the meantime so that the priority of first applications in Italy may also be used for later national applications in Italy.

As it is known infringement of a protective right (patents, utility models, trademarks and design patents) in Italy is an offence. Now the penal norms have been rearranged and the penal sanctions have been strongly tightened altogether, which may pose a very effective instrument in Italian patent infringement litigations.

Russia:

- In Russia domain names may be registered in Cyrillic letters on priority basis until March 25, 2010 at the latest.

Owners of registered Russian trademarks in Cyrillic letters hereby have the right to re-

serve their domain names so that registration of a respective trademark in Russia is also required for application.

Financial support for patent applications of small and medium-sized companies in Germany

The German Federal Ministry of Commerce and Technology wants to support small and medium-sized companies, handicraft businesses and founders of new businesses when filing patent applications with the so-called KMU-Patent Action. (KMU stands in German for small and medium-sized companies)

However, only petitioners may receive the financial support who have not filed a patent application yet or who have not filed a patent application within the last five years.

Moreover, the petitioner may not have more than 250 employees respectively the annual turnover may not exceed 50 million euros or

the annual balance amount may not exceed 43 million euros.

The financial support then extends over the entire period of at most 18 months. Supported are searches in regard of prior art, cost-benefit analyses for the exploitation of a patent application as well as costs for the assistance of a patent attorney for preparation and filing of a patent application. Also supported is the professional assistance for the economic exploitation of the invention as well as the assistance of a patent attorney and the fees also of foreign applications.

Further information under: www.signo-deutschland.de

News from our law department

We are pleased to introduce Mrs. Dr. jur. Annemarie Blum von Ann who joined our law firm in January this year. Mrs. Dr. Blum von Ann studied law at the University of Hamburg. After the second state examination she achieved her doctoral degree at the University of Hamburg.

Mrs. Dr. Blum von Ann is an expert in IP matters, she was the Head of the Legal and Patent

Department of GRUNDIG Intermedia GmbH in Nuremberg as well as the Head of the Legal Department and authorized signatory of EMTEC Magnetics GmbH in Ludwigshafen, which as former subsidiary of BASF AG had changed the company name from BASF Magnetics GmbH into EMTEC Magnetics GmbH.

Since 1989 Annemarie Blum von Ann is a qualified lawyer admitted before all German

Local Courts and Regional Courts. She is authorized to represent before the German Patent Court, the German Patent and Trademark Office as well as the Office for Harmonization in the Internal Market in Alicante. She has comprehensive professional experience in national and international Business, Contract,

Competition, Licensing, Trademark and Patent Law and has joined our office in January 2010.



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