KADOR & PARTNER

NEWSLETTER

IP NEWS FROM GERMANY AND EUROPE

AUGUST 2010

I. NEWS ABOUT US

INTA Annual Meeting Boston

At this year's 132nd annual INTA conference in Boston, Kador & Partner yet again took an active part in meeting international clients and colleagues. More than 8,000 participants from 190 countries took the opportunity of exchanging knowledge and socializing with colleagues.

Ms. Corinna Probst and Ms. Susanna Heurung with Taiwanese colleagues.

Kador & Partner was represented by our attorneys at law, **Ms. Corinna Probst, Ms. Susanna Heurung and Dr. Elisabeth Vorbuchner.**

Lecture in Tokyo

In March 2010, **Dr. Bernhard Pillep**, was invited to Japan by the INFOPAT Association (Association for the Study of International & Foreign Patent & Trademark Laws & Practice) to hold a lecture on the premises of AIPPI Japan.

INFOPAT is composed of a group of Japanese patent attorneys and corporate patent experts who are interested in the laws and practice relating to intellectual property in foreign countries.

On this occasion, Dr. Pillep held a seminar on the topic of *"Drafting patents under European practice with special consideration of the case law of the EPO Boards of Appeal and the recent changes to the EPO rules".*

APAA Assembly in Hong Kong

Dr. Utz Kador attended the Asian Patent Attorneys Association (APAA) Conference in Hong Kong in November 2009. After the conference he took the opportunity to make an extended visit to China in order to personally meet our long-term business partners on their own turf.

Non-US INTA Roundtable

At the first non-US INTA Roundtable of this year in February in our Munich office, we had the honor of Ms. Gerrit Höfer, LL.M, Legal Counsel at OMV Group, Vienna, holding a lecture on the following topic:

"A view on enterprises´ trade mark strategies – Field report by the OMV Group"

We gained insight into the history of one of the largest Austrian companies having more than 40,000 employees worldwide. The coverage and variety of their trade mark portfolio composed of word marks, design marks, three-dimensional marks, slogans and color marks was presented and discussed.

Another debated issue was the different approaches and considerations within a company between the marketing and legal departments when creating a new trade mark, especially one involving potentially descriptive terms as these are rather desirable from a marketing point of view, but may cause problems in the registration of trade marks."

From left to right: Ms. Susanna Heurung, Ms. Barbara Regensburger, Ms. Gerrit Höfer, Ms. Corinna Probst

Congratulations to Ms. Susanna Heurung

We are very happy to announce that **Ms. Susanna Heurung**, Attorney at Law in our firm, had her second baby, a daughter named **Miriam Nadia**, on March 5, 2010. Both mother and baby are in excellent shape and Susanna already returned to work on a part-time basis. We wish to congratulate her and her husband on their new family member.

LESI Conference South Africa

In April this year, **Dr. Utz Kador** as a member of the Licensing Executives Society International (LESI) traveled to South Africa to participate in this international conference.

The main intention of LESI is to bring together professionals who have an interest in the transfer of technology and licensing of intellectual property rights – from technical know-how and patented inventions to software, copyright and trademarks.

Skiing in Alpbach/Austria

Our traditional skiing excursion took place in February 2010 again in Alpbach, Austria. Three non-skiing employees of our team got skiing lessons from a professional instructor and at the end of two days they were already able to ski and we had a lot of fun together.

Part of the Kador skiing team in Alpbach.

Lecture in Vienna

Dr. Bernhard Pillep was invited by the association of Austrian patent engineers, called "RING", to give a lecture on June 9, 2010, in the beautiful city of Vienna. The topic of Dr. Pillep's talk was the recent changes to the German Employee Invention Act (Arbeitnehmererfindungsgesetz ArbNErfG) and their practical implications.

The lecture took place in a cordial atmosphere and a very lively discussion already developed during the lecture, showing that the German Employee Invention Act with its unique structure is of great interest to patent practitioners.

II. EUROPEAN PATENT LAW

Deadline for Filing "Voluntary" Divisional Applications with the EPO

As already reported in our Newsletter of January 2010, the European Patent Office (EPO) drastically changed the provisions relating to the filing of divisional applications.

According to amended Rule 36(1)(a) EPC, an applicant may file a divisional application relating to a pending earlier European patent application on his own volition (i.e. without an Examiner having expressed a lack of unity objection) only within a period of 24 months. The term starts on the date of the Examining Division's first communication in respect of the parent application.

The amended rules have been made applicable retroactively to all pending applications. The EPO – conscious of the fact that in many pending applications the Examining Division's first communication was issued a considerable time ago – has provided a transitional provision which stipulates:

"If the time limits provided for in amended Rule 36(1) EPC have expired before April 1, 2010, the divisional application may still be filed within six months of that date. If they are still running on April 1, 2010, they will continue to do so for not less than six months."

This means in practice that for all pending applications for which the 24-month time limit already expired or will expire before October 1, 2010, the applicant still has the opportunity to file divisional applications on his own volition until October 1, 2010. This deadline may neither be extended nor is it subject to a request for further processing.

In view of the short time remaining until October 1, 2010, we would like to remind our clients once again of this deadline, and would also like to ask for instructions in case divisional applications are intended to be filed.
The deadline of October 1, 2010, applies only to those pending applications where the 24-month time limit stipulated in Rule 36(1)(a) EPC expired already or expires before this date. However, we recommend that our clients take this approaching deadline as an opportunity to review all pending European applications as to whether or not a divisional application should be filed.

Such a procedure will ensure that the time limit for filing a divisional application is not missed and there is enough time to properly prepare the documents for filing such a divisional application

Enlarged Board of Appeal Decisions G 1/07 and G 2/08

At the beginning of this year, the Enlarged Board of Appeal (EBA) of the European Patent Office issued two important decisions in the pharmaceutical and biotechnological field – G 1/07 and G 2/08[1].

Decision G 1/07 relates to the question of whether a method for a diagnostic purpose which comprises or encompasses an invasive step, i.e. a substantial physical intervention on the body, but in which the intervention does not per se aim at maintaining the health and life of the subject, is excluded from patent protection under the EPC.

G 2/08 relates to the question of whether a dose regime of a medical composition is able to substantiate the patentability of said composition.

In the following these two decisions will be briefly discussed.

a) G 1/07

The case is based on European patent application No. 99918429 which was refused by the Examining Division in their decision of April 17, 2003. One of the claimed methods was a cardiac imaging method which relies on directly delivering polarized 129Xe to a region of the heart via injection and the like into the left ventricle.

[1] Decisions G 1/07 of February 15, 2010 and G 2/08 of February 19, 2010 of the Enlarged Board of Appeal, both decisions yet to be published in the Official Journal of the EPO, are available already on the EPO webpage: www.epo.org /patents/appeals/eba-decisions/number.html

According to the Examining Division, the claimed method relates to a method practiced on the human or animal body which is not allowable under EPC 1973. The applicant filed an appeal from this decision.

The Board of Appeal, in the interlocutory decision T 992/03 in its corrected version dated August 20, 2007, decided to refer the following three legal questions to the EBA:

Question 1: Is a claimed imaging method for a diagnostic purpose (examination phase within the meaning given in G 1/04), which comprises or encompasses an invasive step representing a substantial physical intervention on the human or animal body (in the present case, an injection of a contrast agent into the heart), to be excluded from patent protection as a "method for treatment of the human or animal body by surgery" pursuant to Article 52(4) EPC if such step does not per se aim at maintaining life and health?

Question 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 claims so as to omit the step at issue, or disclaim it, or let the claim encompass it without being limited to it?

Question 3: Is a claimed imaging method for a diagnostic purpose (examination phase within the meaning given in G 1/04) to be considered as being a constitutive step of a "treatment of the human or animal body by surgery" pursuant to Article 52(4) EPC if the data obtained by the method immediately allow a surgeon to decide on the course of action to be taken during a surgical intervention?

The EBA gave the following answers to these questions, expressed as head notes of G 1/07:

1. A claimed imaging method, in which, when carried out, maintaining the life and health of the subject is important and which comprises or encompasses an invasive step representing a substantial physical intervention on the body which requires professional medical expertise to be carried out and which entails a substantial health risk even when carried out with the required professional care and expertise, is excluded from patentability as a method for treatment of the human or animal body by surgery pursuant to Art. 53(c) EPC.

2a. A claim which comprises a step encompassing an embodiment which is a "method for treatment of the human or animal body by surgery" within the meaning of Article 53(c) EPC cannot be left to encompass that embodiment.

2b. The exclusion from patentability under Art. 53(c) EPC can be avoided by disclaiming the embodiment, it being understood that in order to be patentable the claim including the disclaimer must fulfill all the requirements of the EPC and, where applicable, the requirements for a disclaimer to be allowable as defined in decisions G1/03 and G2/03 of the Enlarged Board of Appeal.

2c. Whether or not the wording of the claim can be amended so as to omit the surgical step without offending against the EPC must be assessed on the basis of the overall circumstances of the individual case under consideration.

3. 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) EPC merely because during a surgical intervention the data obtained by the use of the method immediately allow a surgeon to decide on the course of action to be taken during a surgical intervention.

Our comments:

As a preliminary remark, Art. 52(4) EPC referred to in the questions put to the EBA and Art. 53(c) EPC referred to in the answers have identical content. The change in article numbering was effected by EPC 2000 for systematic reasons.

The present decision of the EBA is largely in line with previous decision G 1/04. The EBA (again) made it unmistakably clear that a diagnostic method which comprises a method step that involves surgery is excluded from patentability under the EPC, even if said step is only one step in a multi-step method which is not directed to surgery as such (see e.g. item 3.2.5 of the reasons for the decision).

However, the EBA has now pointed out that the definition of "method of surgery" covering "any physical intervention on the body" as used in G 1/04 is too broad. It made clear in head note 1 that "surgery" in the sense of Art. 53(c) EPC leading to an exclusion from patentability is only given if a "substantial

physical intervention on the human or animal body" is carried out (see also item 3.4 of the reasons for the decision).

As further guidance in this regard, the EBA stated in item 3.4.2.3 of the reasons that "… uncritical methods involving only a minor intervention and no substantial health risks…" should be seen as not falling under the new, narrower definition of "surgery". However, the EBA did not further specify what must be understood by those terms, but indicated that this will have to be determined by the departments of first instance and the Boards of Appeal based on "the technical reality of the individual cases under consideration" (see item 3.4.2.4 of the reasons).

This re-definition of "surgery" by the EBA can be appreciated because it now makes it possible for methods such as tattooing, which in the general common understanding would hardly be seen as "surgery", to now be patented under the EPC.

The EBA has, furthermore, made clear that a claim implicitly or explicitly encompassing a surgical step cannot be left unamended. However, the Board has now opened up the possibility of amending such a claim by introducing a disclaimer, which in many cases will be the method of choice to "save" an otherwise unpatentable claim from the exclusion of Art. 53(c) EPC, although such an amended claim must of course comply with all other requirements of the EPC (see item 4.2 of the reasons).

Finally, the EBA states in head note 3 that methods which as such do not encompass a surgery step but may be used as a tool in surgery clearly do not fall under the exclusion of Art. 53 (c) EPC.

All in all, it can be said that decision G 1/07 can be well appreciated by the users of the European Patent System. This decision, while upholding well-established principles of the jurisdiction pertaining to the patentability exclusion of Art. 53(c), limits the exclusion somewhat by requiring a "substantial physical intervention on the human or animal body".

Furthermore, due to the explicitly mentioned possibility of using disclaimers, it will be of great practical help for applicants in obtaining patents on new developments in the medical field which have their focus outside of "true" surgical methods.

b) G 2/08

In the case underlying G 2/08, the Examining Division refused European patent application No. 94 306 847 relating to the use of nicotinic acid for the treatment of hyperlipidemia as lacking novelty, in spite of the fact that claim 1 contained a specific drug dosage regime (the drug should be given once a day prior to sleep) which was not disclosed in the prior art.

The Division reasoned that the dosage regime represented a medical activity that is excluded from patentability under Art. 52(4) EPC 1973 (now Art. 53(c) EPC 2000). Therefore, this feature, albeit unknown, could not contribute to making the claimed subject-matter a novel medical indication.

After the applicant filed an appeal, the Technical Board of Appeal, with decision T 1319/04, referred the following questions to the EBA:

Question 1: Where it is already known to use a particular medicament to treat a particular illness, can this known medicament be patented under the provisions of Articles 53(c) and 54(5) EPC 2000 for use in a different, new and inventive treatment by therapy of the same illness?

Question 2: If the answer to question 1 is yes, is such patenting also possible where the only novel feature of treatment is a new and inventive dosage regime?

Question 3: Are any special considerations applicable when interpreting and applying Articles 53 (c) and 54 (5) EPC 2000?

The EBA answered the question in the head note of G 2/08 as follows:

1. *Where it is already known to use a medicament to treat an illness, Art. 54(5) EPC does not exclude that this medicament be patented for use in a different treatment by therapy of the same illness.*

2. *Such patenting is also not excluded where a dosage regime is the only feature claimed which is not comprised in the state of the art.*

3. *Where the subject matter of a claim is rendered novel only by a new therapeutic use of a medicament, such claim may no longer have the format of a so called Swiss-type claim as instituted by decision G 5/83.*

In the reasons for the decision, the EBA first found that the provisions of EPC 2000 must be applied to the case, in particular revised Art. 53(c), Art. 54(4) and Art. 54(5) EPC 2000.

The Board then assessed whether or not the revised provisions introduced changes to the EPC (item 5 of the reasons for the decision). It concluded that this was effectively not the case for Art. 53(c) EPC 2000 (corresponding in substance to Art. 52(4) EPC 1973) and Art. 54(4) EPC 2000 (corresponding to Art. 54(5) EPC 1973) (items 5.1 to 5.8 of the reasons).

However, new Art. 54(5) EPC 2000 has no counterpart in EPC 1973 and now explicitly allows the claiming of substances or compositions already known as medicines for specific new therapeutic uses, i.e. allows the claiming of a second medical indication of a substance/composition in a purpose-bound product claim (item 5.9 of the reasons).

Under EPC 1973 the only possibility of claiming such second medical indications was the so-called "Swiss-type" claim ("Use of a substance X for the manufacture of a medicament for the treatment of disease Y") as established by EBA decision G 5/83.

In connection with the considerations regarding Art. 54(5) EPC, the Board concluded that a second medical indication need not necessarily consist in the treatment of a new disease, but may also consist in a different treatment of the same illness (see head note 1).

The Board further concluded that a new dosage regime may also be such a new treatment (head note 2), but emphasized that the new dosage regime must not only be verbally different from what was described in the prior art but must reflect a different technical teaching.

In particular, the Board emphasized that *"the whole body of jurisprudence relating to the assessment of novelty and inventive step"* must be applied to assess the patentability of a second medical indication claim distinguished from the prior art only by the dosage regime (item 6.3 of the reasons).

Finally, the Board concluded that due to the presence of new Art. 54(5) EPC allowing the claiming of a second medical indication in a product claim, the "Swiss-type" claim is no longer necessary and must therefore no longer be used.
However, the Board indicated that this will not apply retroactively to pending applications but only to applications with a priority date later than three months after publication of G 2/08 in the Official Journal of the EPO.

Our comments:
With the present decision the EBA has opened the window wide for a protection of inventions relating to the second medical use of substances or compositions already known as medicines for the treatment of illnesses.

The EBA has made clear that the "specific use in a method referred to in Art. 53(c) EPC" as referred to in Art. 54(5) EPC must be interpreted in a broad sense, namely not only to mean uses for a treatment of a disease different from that known in the prior art, but also to mean treatment of the same disease with a new mode of application such as a new dosage regime.

On the other hand, the Board has also made very clear that a second medical indication claim which is distinguished only e.g. by a new dosage regime may be formally novel, but must be inventive as well to be patentable.

In that regard the EBA has emphasized that "the whole body of existing case law" as regards patentability and especially inventive step will have to be applied to such claims. This indicates that the Board wanted to give clear guidance to the departments of first instance and the Boards of Appeal to strictly apply case law and thoroughly assess especially the question of the inventive step of such claims.
Thus, for second medical indication claims distinguished from the prior art only by a new dosage regime, it will be essential in practice that the effect of the new dosage regime is clearly demonstrated and that the dosage regime is clearly distinct from that already known.

Finally, the prohibition of "Swiss-type claims" for new applications is a consistent step, because these Swiss-type claims were a rather artificial construction anyway and were intended to give protection to subject matter which can now be more appropriately covered by the second medical indication product claims.

III. GERMAN PATENT LAW

Decision of German Federal Supreme Court on the validity of claims containing open ranges

In a recent decision[2] the German Federal Supreme Court (FSC) expressed its view on the validity of claims containing open ranges.

Underlying the present case was the German part of a European patent against which an invalidity suit had been filed with the German Federal Patent Court (FPC) based on the grounds of lack of patentability and insufficient disclosure.

Claim 1 of the patent in suit related to a thermoplastic composition comprising a compatibilized polyphenylene ether/ polyamide base resin and an electro-conductive carbon black which was characterized by an Izod notched impact strength of more than 15 kJ/m^2 and a volume resistivity of less than 106 ohm/cm.

In the patent, a novel process for the manufacture of those compositions was furthermore disclosed.

The FPC as first instance revoked the patent in its entirety based on the reason that the claimed subject matter lacked an inventive step over the prior art. In the decision, the FPC did not assess the question of insufficient disclosure.

The Federal Supreme Court (FSC) reversed the decision of the Patent Court and, in particular, considered in detail the ground of insufficient disclosure.

In his arguments supporting the ground of insufficient disclosure, the plaintiff had brought forward that the patent did not disclose the measurement of volume resistivity in sufficient detail. The Court refused this argument, indicating firstly that it only concerned a lack of clarity of the claim and that the skilled person got the information on how to obtain a composition of claim 1 from the disclosure of the process of the invention.

However, the Court decided that the ground of insufficient disclosure applied insofar as claim 1 gave ranges both for the Izod impact strength and for the volume resistivity which were open, i.e. had no upper or lower limit .

The Court further stated that these open ranges had the consequence that all those compositions fell within the ambit of claim 1 which fulfilled the requirements of an Izod impact strength of more than 15 kJ/m2 and a volume resistivity of less than 106 ohm/cm. However, not all such compositions could be obtained by the disclosed production process because in order to obtain a low volume resistivity a certain carbon black amount was necessary which goes contrary to an improvement of the Izod impact strength.

The Court concluded that the generalization of the Izod impact strength and volume resistivity to open ranges led to a scope of protection of claim 1 going beyond the solution offered by and described in the patent. The Court strongly emphasized the principle that the possible patent protection must be limited by the contribution of the disclosed subject matter to the art.

In this regard, the Court also cited several decisions of the Boards of Appeal of the EPO, e.g. T 409/91 “Diesel fuels”, in which this principle was expressed, to support its position.

The Court further stated that the solution provided by the patent in suit was the disclosed process which, at the same time, was the limit of the contribution to the art that the patent provided. The Court thus decided that claim 1 as granted was unpatentable due to lack of sufficient disclosure, but it allowed an amended claim 1 introducing the feature that the compositions were “obtainable by” the process of the invention.

The head notes of the decision given by the Court are the following:

*“**1.** An enabling disclosure of the invention may have to be denied if the subject matter protected by the patent claim is generalized by the introduction of open ranges for physical properties beyond the solution provided by the entirety of the application documents for the skilled person is extended so far that the patent protection goes beyond the contribution of the invention to the state of the art.*

[2] BGH, decision of February 25, 2010 – Xa ZR 100/05 (BPatG)

***2**. In case a process is disclosed by which a compound or another product may be obtained which has physical properties falling within the open range, the product according to the invention which has been sufficiently disclosed may be characterized by the feature that it is obtainable by the disclosed process."*

Our comments:
With the present decision, the Federal Supreme Court for the first time expresses its view on the allowability of parametric features containing open ranges in claims. In the considerations leading to the decision, the Court applies the principle that the possible scope of protection must be justified and limited by the contribution of the patent to the state of the art.

The Court emphasizes that a generalization of features which is too broad in view of the factual disclosure in a patent is not allowable. "Too broad generalization" means in the Court's opinion that the skilled person is not put in a position to obtain the claimed subject matter within the scope of the claim based on the disclosure in a patent.

In the present case, consequently, a claim having two parametric features with ranges open at one end were not allowed because not each and every embodiment of the composition falling under the scope of protection of the claim could be obtained with the process disclosed in the patent.

The present decision shows that the Federal Supreme Court has adopted the very strict approach taken by the EPO as regards the sufficiency of disclosure, apparently in an attempt to harmonize German and European case law in this regard. In the present case, the patentee could only save the patent by introducing a product-by-process feature, namely that the claimed composition is obtainable by the process of the invention.

In practice, this means that when drafting patents one must pay even more attention to the question of whether or not the whole scope of the claims is properly supported by the disclosure, in particular the examples. Furthermore, while the present decision does not fundamentally exclude claims with parametric features having open ranges from patentability, one should as a precautionary means at least introduce fall-back positions into an application in which a limit for the open range is disclosed.

IV. EUROPEAN TRADE MARK LAW

Decision of the Court of Justice on Word Mark "Barbara Becker"

In a recent decision[3] the European Court of Justice (ECJ) rejected the ruling of the General Court that Barbara Becker's full name was visually, phonetically and conceptually too similar to "Becker" and "Becker Online Pro" of Harman International Industries Inc. The General Court will now have to re-examine the case.

In the case, Barbara Becker, the former wife of three-time Wimbledon champion Boris Becker, filed a Community Trade Mark application for the word mark "Barbara Becker" for electronic products, among others. The company Harman International Industries Inc., producer of navigation systems and car hi-fi systems, and owner of Community Trade Marks "BECKER" and "BECKER PRO ONLINE", filed an opposition against the registration of "Barbara Becker".

The Opposition Division of the Office for Harmonization in the Internal Market ("OHIM") found a likelihood of confusion. In contrast, the Board of Appeal regarded the signs to be dissimilar. The General Court then, again, found a possible confusion between the marks. The ECJ now cancelled the decision and referred the case back to the General Court.

According to the ECJ, all the relevant factors of each case must be taken into account. It stated that the General Court erred in law in basing its assessment on the conceptual similarity of the marks. The General Court did not consider the case-specific factors, including Barbara Becker's status as a well-known person.

The ECJ further stated that *"although it is possible that in some parts of the EU surnames have a more distinctive character than first names, it is appropriate to take account of factors specific to the case, in particular if the surname concerned is unusual or very common, which is likely to have an effect on the distinctive character"*. In addition, the Court held that it must be considered whether or not the person requesting that his first name and surname be registered together as a trade mark is well known. The General Court will now have to take all these factors into account.

Our comments:

This decision shows that it is not generally possible to monopolize a surname merely by protecting it as a trade mark, which is important not only for well-known persons but also for anyone who wants to do business under his own name. The new decision from the General Court will provide legal certainty, in particular for persons doing business under a commonly used name.

The ECJ's decision is also of special interest as it clarifies a misinterpretation concerning the "Medion" case (THOMSON LIFE C-120/04). From this case the wrong principle had been derived that there would be always a likelihood of confusion between a prior trade mark –"LIFE"– and a younger trade mark, which comprises the prior trade mark and an additional component –"THOMSON LIFE"–. The ECJ explicitly pointed out that the Medion case was a specific case, in which a business sign had been added to the prior trade mark. This will hopefully contribute to avoid wrong decisions in the future.

[3] Case C-51/09 P, dated June 24, 2010

V. GERMAN TRADE MARK LAW

No violation of trade mark consisting of shape of product

In April 2010, the District Court of Cologne (the "Court") gave a ruling that once again shows how narrow the scope of protection is for trade marks that consist of the shape of the concerned products.

The plaintiff in this case manufactures suitcases, in particular suitcases made of aluminum with the surface showing a pattern of grooves at specific, regular intervals. This appearance of the suitcases is protected by various trade marks in Germany and the European Union. The defendant distributes suitcases with a wavelike surface. While the products concerned in this case were identical, namely suitcases, the protected trade marks and the appearance of the suitcases offered by the defendant showed considerable differences.

The plaintiff nevertheless claimed an infringement of his trade mark rights, claiming in particular that the groove pattern of his suitcases was famous and that the distinctiveness of his trade marks was therefore increased.

The defendant claimed that there was no "use" of the plaintiff's trade marks, that there were considerable differences between the protected trade marks and the shape of his goods, and that the waves or grooves were used for technical reasons, namely to make the suitcases lightweight and stable at the same time.

The Court denied all claims of the plaintiff. Citing a previous decision of the Higher Regional Court of Cologne in a similar case, the Court firstly denied that the wavelike appearance of the defendant's suitcases could be considered "use" of the plaintiff's trade marks. Where a trade mark consists of the shape of a product, consumers will usually not consider this shape as an indication of origin. Another product's shape will therefore only be considered as making "use" of the protected earlier trade mark where exceptional circumstances apply, for example where the earlier trade mark has an increased level of distinctiveness or where the earlier trade mark and the third party's product show substantial similarities in the characteristic features of the protected trade mark.

From the Court's point of view, however, the plaintiff had failed to give sufficient evidence for the alleged increased distinctiveness. Therefore, the distinctiveness of the plaintiff's trade marks could be considered of average nature at best. Since the third party's product showed considerable differences in comparison with the plaintiff's trade marks and had, in particular, not copied the characteristic features of these trade marks, there was no "use" of the protected trade marks and therefore no violation of the plaintiff's trade mark rights.

Our comments:

We are especially pleased with this decision since we acted as representatives of the defendant in this case. In our opinion, this decision is in line with long-established case law of the German Courts, according to which trade marks consisting of the mere shape of a product either may not be protected as trade marks or, where they are protected as trade marks, have a very narrow scope of protection. In the interest of a free economy, the common shape of a product that is not in any way exceptional or out of the ordinary must remain free for general use, in particular where certain features of the shape have technical effects.

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