KADOR & PARTNER

NEWSLETTER

IP NEWS FROM GERMANY AND EUROPE

JULY 2009

I. NEWS ABOUT US

1. New Support

Dr. Karoline Bopp

We are pleased to announce new support for our team:
Dr. Karoline Bopp, born in 1978, joined Kador & Partner as a Patent Attorney Trainee in August 2008.

Dr. Bopp studied biology with a focus on biochemistry, genetics and developmental biology at Technical University of Darmstadt and finished in 2004 with her diploma. She did her diploma thesis at Ludwig-Maximilians-University, Munich, working in the field of molecular cell biology.

Her dissertation at the Department of Molecular Structural Biology of the Max Planck Institute of Biochemistry dealt with the in vitro expression and functional analysis of protein complexes for their subsequent structure determination in a close to native state by means of cryo-electron tomography.

Dr. Bopp is fluent in English and speaks some French.

2. INTA Roundtable at Kador & Partner

It is always a pleasure for us to host INTA Roundtables at our office. These meetings are a good occasion for trade mark specialists to come together, update their knowledge and discuss current issues. Our target is to invite speakers with various IP backgrounds so that an exchange of knowledge and experience can take place.

At our latest INTA Roundtable in November 2008, Mr. David Keeling, Member of the Boards of Appeal at the Office for Harmonization, Alicante, spoke about “Quo vadis Trade Mark Law? Quo vadis Europa?”

Ms. Barbara Regensburger (Kador & Partner), Dr. Utz Kador, Ms. Elisabeth Fink (German Patent Court) and Mr. David Keeling (Boards of Appeal, OHIM)

Mr. Keeling gave a very vivid and interesting speech about recent and potential future developments in European trade mark jurisdiction.

3. Office Trip to Trento

As every year, the entire Kador team enjoyed a two day trip, this time to Trento, Italy. It was a special mixture of various activities such as hiking, a guided tour through Trento and wine tasting.

This photo shows us on the top of the mountain Monte Calisio, enjoying lunch after our climb.

4. Specialized IP Attorney

We are pleased to announce that Ms. Susanna Heurung is now a Specialized IP Attorney. This title is accorded to German attorneys at law who demonstrate profound knowledge and expertise in IP matters. This requires not only a substantial number of practical cases in the various areas of IP law, but also theoretical knowledge evidenced by a number of written tests.

II. EUROPEAN PATENT LAW

1. Changes of Fees for European Patent Applications

On April 1, 2009, a variety of changes of the rules relating to EPC fees entered into force, affecting especially fees relating to filing and prosecution of European patent applications. The most relevant changes are outlined below.

a) Claims Fees

The European Patent Office (EPO) has considerably increased the claims fees for applications comprising more than 50 claims. For European (divisional) patent applications and international applications entering the regional phase the following fees now apply:

Claims 1 to 15:	no claims fee
Claims 15 to 50:	EUR 200 per claim
Claims 51 and following:	EUR 500 per claim

b) Page Fees as Part of Filing Fees

For applications comprising more than 35 pages, a fee of EUR 12 per page falling due at the time of filing was introduced, in addition to the regular filing fee (unchanged). This fee replaces the page fee of EUR 11 per page which fell due as part of the printing fees shortly before grant.

c) Designation Fees

The former system of individual designation fees of EUR 85 per state or EUR 595 for seven or more states has been replaced by a single flat-rate designation fee of EUR 500 for all contracting states.

The extension fee of EUR 102 for each “extension state”, i.e. Albania, Serbia and Bosnia/Herzegovina, still applies.

***Our comments**: Especially the new claims fees may cause an undesirable increase of total filing costs for a European Patent application. We thus recommend reducing the number of claims for applications to at most 50, preferably at most 15, wherever possible. In this regard, the possibility of filing claims with multiple dependencies under European practise is very useful.*

A reduction of the number of claims can be done at our end. We will take care that in spite of the reduction no disclosure present in the omitted claims will be lost. In such cases, we kindly ask our clients to provide us with the application in good time before the due date for filing.

2. How to Avoid Extra Costs for Applications Containing Sequence Listings

Since the coming into force of the EPC 2000 in December, 2007 we experience in an increasing number of cases problems when an application is filed including sequence listings. This often results in unnecessary extra costs. To avoid this situation, we recommend to consider the following points.

Rule 30 (1) and (3) EPC require for filing a sequence listing:

> *"(1) If nucleotide or amino acid sequences are disclosed in the European patent application, the description shall contain a sequence listing conforming to the rules **laid down by the President of the European Patent Office** for standardized representation of nucleotide and amino acid sequences.*
>
> *(3) Where the applicant has not filed a sequence listing complying with the requirements under paragraph 1 at the date of filing, the European Patent Office shall invite the applicant to furnish such a sequence listing and pay the late furnishing fee. If the applicant does not furnish the required sequencelisting and **pay the required late furnishing fee** within a period of two month after such an invitation, the application shall be refused."*

Thus, in contrast to the EPC 1973, filing of a non-conform sequence listing with the application causes additional costs (EUR 200 official fees + attorney fees) for filing the listing in the required form.

The mandatory requirements for filing a sequence listing – both for filing a European or PCT-application with the EPO – are the following:

1. The Sequence listing has to be filed on paper and in an electronic version.

2. The Sequence listing has to comply with the **WIPO Standard ST. 25**. Consequently, the sequence listing should be generated by using the official Program of the WIPO "PatentIn".

3. The electronic version should be filed in a computer readable form, i.e. the sequence listing should be filed as **".txt" data file**. In this regard please note that a ".pdf"version will not be accepted by the EPO.

4. The electronic data carrier shall be accompanied by a statement of the applicant that the information recorded on the electronic data carrier is identical to the sequence listing filed on paper.

3. Decision G 2/06 of the Enlarged Board of Appeal

In decision G 2/06 dated November 25, 2008 [1], the Enlarged Board of Appeal (EBA) of the European Patent Office (EPO) had to decide on four legal questions involving the patentability of products relating to human embryonic stem cell (hES) cultures which could, at the filing date, only be obtained by a process involving the destruction of human embryos.

The legal questions were referred to the EBA with decision T 1374/04 dated April 7, 2006 [2].

[1] Not yet published in the Official Journal of the EPO
[2] OJ EPO 2007, 313

The main claim of the application in suit [3] related to a stem cell culture comprising primate embryonic stem cells which (i) are capable of proliferation in vitro culture over one year, (ii) maintain a karyotype in which all chromosomes normally characteristic of the primate species are present and are not noticeably altered through culture for over one year, (iii) maintain the potential to differentiate to derivatives of endoderm, mesoderm, and ectoderm tissues throughout the culture, and (iv) are prevented from differentiating when cultured on a fibroblast feeder layer.

The following legal questions were answered by the EBA:

Question 1:
Does Rule 23d(c) [now 28(c)] EPC apply to an application filed before the entry into force of the rule?

Rule 23d(c) EPC entered into force on September 1, 1999, and reads:
"Under Article 53(a), European patents shall not be granted in respect of biotechnological inventions which, in particular, concern the following:
.....
(c) uses of human embryos for industrial or commercial purposes; …"

In essence, the EBA decided that at the time the rule entered into force, no transitional provisions for pending cases were adopted. However, the EBA pointed out that in (unchanged) Article 53(a) EPC there is no indication that the commercial exploitation of human embryos was ever regarded as patentable. Therefore, the EBA decided that the answer to question 1 is yes.

Our comment*: This ruling is perfectly in line with the history and intention of the legislation.*

Question 2:
If the answer to question 1 is yes, does Rule 23d(c) EPC forbid the patenting of claims directed to products (here: human embryonic stem cell cultures) which - as described in the application - at the filing date could be prepared exclusively by a method which necessarily involved the destruction of the human embryos from which the said products are derived, if the said method is not part of the claims?

The EBA considered that this rule does not mention claims but refers to "inventions". Therefore, not just the explicit wording of the claims has to be looked at, but the technical teaching of the application as a whole describing how the invention is to be performed. As the making of the claimed products involved the destruction of human embryos and this use is an integral part of the industrial and commercial exploitation of the claimed invention, the EBA found that it violates Rule 23d(c) EPC. Therefore, the answer to question 2 was also yes.

Our comments: *It is important to note that it does not "help" an applicant that the destruction of a human embryo is not described in a claim if the claimed subject-matter can nevertheless only be obtained by doing so. Thus, even skilful claim drafting cannot circumvent the prohibition of Rule 23d(c) EPC.*

Question 3:
If the answer to question 1 or 2 is no, does Article 53(a) EPC forbid patenting such claims?

This question did not need to be answered, because both questions 1 and 2 were answered with "yes".

Question 4:
In the context of questions 2 and 3, is it of relevance that after the filing date the same products could be obtained without having to recur to a method necessarily involving the destruction of human embryos (here: e.g. derivation from available human embryonic cell lines)?

The EBA ruled that "When assessing whether a claim contravenes Rule 28(c) EPC, technical developments which became publicly available only after the filing date cannot be taken into consideration."

Thus, a deficiency in complying with that rule cannot be "cured" by the occurrence of subsequent technical developments (such as induced pluripotent stem cells (iPS), available only after the filing date of the application, which technique relies on existing cell cultures). Any other conclusion would lead to legal uncertainty and risk being to the detriment of any third party.

[3] EP application no. 96 903 521.1

Our comments: *Although this ruling is bad news to an applicant eager to improve his invention by technical developments after the filing date, legal certainty of a third party is the overruling principle making it impossible to supply an alternative method fulfilling the provisions of Rule 23d(c) EPC after the filing date.*

For applicants working in the field of making and using hES it is highly advisable to deposit a hES line, if available, before the filing date of an EP application to avoid the need of destroying a human embryo for practicing the invention.

The ruling also has an implication for pending EP applications: Unless a method not requiring destruction of a human embryo is disclosed in the originally filed documents, applications relating? to the manufacture and use of hES will be refused by the EPO, regardless of the product or method claimed.

4. Decision T1366/07 on Insufficiency of Disclosure Due to Lack of Test Method Description [4]

In the case underlying T1366/07, a patent had been opposed, inter alia, on the ground of "insufficient disclosure" (Art. 100 b)/Art. 83 EPC).

The Opponents argued that the claimed process required as a starting material a bimodal polyethylene which was characterised, inter alia, by its weight and number average molecular weight and its molecular weight distribution. However, the patent contained no indication about the particular method and conditions to be used for the measurement of the molecular weight parameters, and hence the skilled person could not reliably determine those parameters. This, in turn, would lead to the situation of the skilled person not knowing which polyethylene to take as a starting material for the claimed process and, thus, not being in a position to carry out the process.

Furthermore, the Opponents argued that the examples given in the patent, where the production of bimodal resins to be used as a starting material was described, were lacking important details so that the skilled person could not carry out the examples.

The Patentee counter-argued, firstly, that the patent contained four detailed examples on the basis of which the skilled person would obtain four different starting materials for the claimed process. The missing details in the description of the production process could easily be supplemented by the skilled person using his general common knowledge.

Secondly, the Patentee argued that in spite of the lack of description of the measurement method, the molecular weight of a polyethylene was one of its fundamental properties and the skilled person would know very well how to select an appropriate method for its determination, e.g. the most commonly used gel permeation chromatography (GPC), and the conditions to be applied in that method. Thus, he would be able to determine the claimed molecular weight parameters on a given resin although a certain expertise would be required.

In the proceedings of first instance, the Opposition Division followed the argumentation of Opponents and revoked the patent due to lack of sufficient disclosure.

The Board of Appeal overturned in its recent decision the decision of the Opposition Division. In the reasons for the decision, the Board followed both lines of arguments brought forward by the Patentee.

Firstly, the Board acknowledged that in spite of the fact that the description of the production process of the bimodal polyethylenes in the examples may be lacking certain details, the skilled person was in a position to supplement the missing information by his general knowledge. Thus, the Board concluded that the skilled person was capable of working the examples and thereby obtaining bimodal polyethylenes as required by the claimed process as a starting material.

Decision T1366/07 of Technical Board 3.2.5 dated Dec. 12, 2008, issued on May 11, 2009.

Secondly, as regards the determination of the molecular weight parameters, the Board found that in spite of the missing details on the determination method, it did not constitute an undue burden for the skilled person to identify an appropriate method and suitable conditions therefor, e.g. a calibrated GPC test method.

In particular, the Board stated in item 3.1 of the Reasons for the Decision, 11th paragraph:

"Whilst the respondents (opponents) suggest that GPC methods are unreliable, this is in contradiction to the wide use of the method in industry. Further, whilst it is accepted that a considerable level of expertise is required to obtain reliable values using GPC test methods, this does not constitute an undue burden."

Our comments: *Both the decision of the Board and the reasons given therefor can be fully agreed with. Firstly, in the assessment of the requirement of Art. 83 EPC ("sufficiency of disclosure") the Board correctly centred its considerations on the question of whether or not the skilled person following the teaching in the patent could obtain the starting material to be used in the claimed process.*

The Board came to the conclusion that this was the case, following the four examples in the patent. To come to this conclusion, the Board applied the well established case law according to which information given in a patent may be supplemented by the general common knowledge of the skilled person, so that minor deficiencies in the description of an example do not impair its reproducibility.

The Board's view on the measurement of the molecular weight parameters can also be fully agreed with. The Board acknowledged that it may need some expertise to conduct such measurements and to obtain reliable results, but further concluded that it may be assumed that this expertise is present as part of common knowledge and that a method widely used in industry cannot be unreliable if properly conducted.

The decision is certainly crucial for? the assessment of the requirement of "sufficiency of disclosure" and it will help to rebut a too restrictive interpretation of the requirements of Art. 83 EPC as to be found at least in some recent decisions of the EPO.

III. GERMAN PATENT LAW

1. German Federal Supreme Court on Interpretation of Scope of Protection of Patent Claims [5]

The case concerned the German part of European patent EP 383 350 and the German Patents DE 41 42 867 and DE 41 43 603, all three directed to gear hubs for bicycles and owned by the same patentee.

In the Courts of the first and the second instance, an infringement of the patent by the defendant was denied. In both instances, the same technical expert appointed by the court was heard, who not only commented on several technical features of the claims but also interpreted the scope of the claims as a whole.

In the expert's opinion, the scope of the claims was limited not only by the features expressly contained in the independent claim, but also by several further features only mentioned in dependent claims or in the general specification. The Courts of the first and second instance acceded to the interpretation of the claims' scope by the expert and denied an infringement.

The plaintiff then appealed to the German Federal Supreme Court (FSC). The FSC stated that the capacity of the Infringement Courts to interpret the scope of the claims must not be relinquished to an expert but was incumbent only on the Court.

The FSC further emphasized that the scope of the claims was not to be determined by a technical clarification by an expert but exclusively by judiciary construction of the technical facts by the judges. The expert's role was solely to aid the court in understanding the technical facts. This applied especially to the determination of interdependencies of technical features which led to a narrower scope of the claims than literally disclosed.

[5] BGH, Urt. v. 12. 2. 2008 „Mehrgangnabe" – file number X ZR 153/05 (OLG München).

It was further stressed by the FSC that the interpretation of the scope of protection of claims must not be limited ab initio to the working examples or specific embodiments disclosed in the general description.

However, a narrow interpretation could and should be given in cases where the claimed technical effect could not be achieved in the literal scope of the claims but only within one or more specific embodiments. In this regard, not only the disclosure of the patent but also the general knowledge of the skilled artisan had to be taken into account by the court.

The FSC referred the case back to the second instance and further recommended to hear a different technical expert because, in the opinion of the FSC, the previous expert could be prejudiced.

Our comments: *In the present decision the FSC stressed that in infringement proceedings it is solely within the capacity of the court to determine the scope of the claims. A technical expert's role is restricted to clarifying the meaning of technical features contained in the claims.*

This position of the FSC can be fully agreed with because the determination of the scope of protection of claims requires not only technical but also legal expertise, e.g. when considering the rather complicated assessments under the doctrine of equivalents. Thus, this decision gives also guidance to the parties to infringement proceedings to carefully distinguish in their submissions between expert's knowledge to be used for clarifying the meaning of features in a claim, and the interpretation of the protective scope of the claims based on the meaning of the features therein.

IV. EUROPEAN TRADE MARK LAW

1. Substantially Reduced Fees for Community Trade Marks

As of May 1, 2009, the fees for filing a Community trade mark have decreased by around 40%. In particular, there is now only one fee falling due for both application and registration of a Community trade mark. For all applications filed after May 1, 2009, the new application fee will amount to 900 euros.

In addition, for all registrations of Community trade marks taking place after May 1, 2009, no registration fee will fall due. This applies even to those trade mark applications that have been filed before May 1, 2009, but are ready for registration only after May 1, 2009.

Our Comments: *We are happy to see that these changes contribute to a considerable decrease in costs for obtaining a Community trade mark. Of course, we have also adapted our agency fees to the new situation. Our detailed schedule of charges listing all new fees is available upon request.*

2. European Court of First Instance Strengthens Scope of Protection of Community Trade Marks [6]

The European Court of First Instance (CFI) has strengthened the scope of protection of trade marks that are of limited original distinctiveness and that target professional and hobbyist consumers.

The owner of the earlier trade marks "Alumaxx", "Ferromaxx" and "Inomaxx" filed oppositions with the Office for Harmonization (OHIM) against the Community trade mark applications "Alumix", "Ferromix" and "Inomix", all registered for welding gases.

[6] CFI, judgement dated October 15, 2008, joined cases T-305/06 to T-307/06.

The Board of Appeal of the OHIM rejected the oppositions and found that the similarities between the marks were limited to the secondary, if not negligible, elements “ferro”, “ino” and “alu”, respectively. These, however, were considered descriptive of certain characteristics of the goods concerned, so that the signs in dispute were found to be significantly different.

The Board concluded that, taking further into account a lack of inherent distinctiveness of the earlier trade marks and a high degree of attention of the relevant public, likelihood of confusion was excluded even though the marks were registered for identical goods.

The CFI now overturned the decision of the Board and ruled that where the goods in question are identical or highly similar and the signs in question are similar to some extent, a high level of attention of the public concerned is not sufficient to rule out danger of confusion, even if the earlier trade mark is of limited original distinctiveness.

The CFI stressed that the signs have to be considered as a whole and that the marks in question are visually and phonetically similar. The CFI continued that the finding of a weak distinctive character of the earlier trade mark does not preclude the finding that there is likelihood of confusion.

While the distinctive character of the earlier mark must be taken into account when assessing likelihood of confusion, it is only one of a number of elements entering into that assessment. Even in a case involving an earlier mark of weak distinctive character, likelihood of confusion may exist due to the similarity between the signs and the goods or services covered.

Otherwise, the approach of the OHIM would result in the fact that, where the earlier mark is only of weak distinctive character, likelihood of confusion would exist only where the mark applied for is completely identical to the earlier mark. Such a result would not, however, be consistent with the very nature of the global assessment which the competent authorities are required to undertake according to the relevant provisions of the Community Trade Mark Regulation.

Also, the high level of attention of the public concerned is not sufficient to rule out the likelihood that the public may believe that the goods in question come from the same or economically linked undertakings.

Our comments: *We agree with this decision of the CFI because it is convincing to assume danger of confusion where the goods concerned are identical and the signs are identical in all but one letter. Even professionals may overhear or overlook the difference in just one out of several letters, in particular where identical goods are concerned.*

By denying danger of confusion in cases like the present one where the goods are identical and the signs are highly similar, namely identical in all but one letter, one would effectively limit the scope of protection of the earlier trade marks to cases of completely identical infringement, contrary to the express provisions of the Community Trade Mark Regulation.

V. GERMAN TRADE MARK LAW

1. German Federal Supreme Court on Scope of Protection of Descriptive Trade Marks [7]

Similarly to the case of the European Court of First Instance discussed above, the German Federal Supreme Court (FSC) held that the scope of protection of trade marks referring to descriptive terms is not limited with respect to other trade marks that also refer to this descriptive term.

The plaintiff, a company called HEITEC, owned a German trade mark HEITEC for goods and services covering in particular electronic data processing systems and related services. The defendant, a company called HAITEC, used the sign HAITEC for the development and production of computer based electronic data processing systems and related services. The plaintiff claimed that there was danger of confusion between the terms HEITEC and HAITEC, both pronounced like “high tech” in German and both used for identical goods and services. The plaintiff therefore requested cease of use of the term HAITEC and damages from the defendant.

The Appeal Court held that the signs were phonetically, visually and also conceptually similar because consumers would associate both terms with the expression “high tech”. However, the similarities of the signs from a phonetic and conceptual point of view were not such as to lead to danger of confusion, and the similarity from a visual point of view was too low to do so. In the grounds of its decision, the Appeal Court held that where trade marks referred to a descriptive term, as in the present case the trade mark HEITEC referring to the term “high tech”, the scope of protection of such trade marks was limited. Therefore, the Appeal Court rejected the claims of the plaintiff.

The FSC confirmed that the global assessment of danger of confusion must take into account all factors relevant to the case. This implies some interdependence between the similarity of signs, the distinctiveness of the earlier mark and the similarity of goods and services, so that a low degree of similarity between the goods or services may be offset by a high degree of similarity between the marks or a high degree of distinctiveness of the earlier mark, and vice versa.

The FSC then continued that, while the Appeal Court was right in finding that the scope of protection of trade marks referring to descriptive terms was limited, the Appeal Court failed to consider that this limitation only served to prevent owners of such marks from extending the rights conveyed by their trade mark to this descriptive term. However, the scope of protection of such trade marks was not limited with respect to trade marks referring to the descriptive term in the same or in a similar way. Therefore, danger of confusion between the signs HEITEC and HAITEC, both used for identical goods and services, could not be excluded.

Our comments: *We agree with this decision of the FSC because it meets economic needs of trade mark owners. While a trade mark is considered strong from a legal point of view when it has no connection whatsoever to the kind, quality or purpose of use of the goods or services concerned, such trade marks must often be promoted at high cost before they are recognized by consumers.*

Trade mark owners therefore often see the need to choose trade marks that are not completely descriptive but still allow the consumer to guess what the kind, quality or purpose of use of the goods or services is. It is correct that such trade marks should not enjoy extensive protection against other trade marks where the signs and goods or services concerned are only similar to a low degree. However, it is economically reasonable that such trade marks, which have after all been deemed sufficiently distinctive for registration, should be protected against trade marks that are highly similar and that are used for identical goods or services.

[7] FSC, judgment dated February 14, 2008, legal case I ZR 162/05 – HEITEC.

VI. COMMUNITY DESIGNS

1. German Federal Supreme Court on Unregistered Community Designs [8]

In a decision dated October 9, 2008, the German Federal Supreme Court (FSC) confirmed important principles of the Community design system, regarding in particular unregistered Community designs.

The plaintiff produces household appliances including electronic cookie presses. It filed a design application and a patent application for these presses with the Chinese Patent Office in 2001. The Chinese design and patent were published in 2002. In 2003, the defendant offered electronic cookie presses in Europe that were similar to those of the plaintiff. The plaintiff claimed that it could rely on an unregistered Community design because it had delivered its presses to a British company in 2002 so that the design had been made available to the public in Europe before 2003.

The FSC, however, confirmed that a design may only enjoy protection as an unregistered Community design if it has first been disclosed to the public within the territory of the European Community. Contrary thereto, a first disclosure of the design outside of the territory of the European Community not only is insufficient for establishing protection as an unregistered Community design, but will even be a bar to the protection of the design as an unregistered Community design.

Therefore, publication of the design in China was insufficient for creating an unregistered Community design in Europe and even excluded later protection in Europe because, due to the prior publication in China, the design was no longer new in Europe.

Our Comments: *This decision is well in line with the provisions of the Regulation on Community Designs as well as previous case law of the competent European and German authorities. From our experience, however, we note that the availability and importance of unregistered Community designs is often overestimated.*

Authors of a design often neglect that protection of a design as an unregistered Community design is only possible where the design has first been disclosed to the public within the territory of the European Community. Any first disclosure outside of this territory will exclude protection as an unregistered Community design.

Moreover, the possibility to defend an unregistered Community design against a younger, allegedly similar design is limited. In fact, based on an unregistered Community design, it is only possible to prevent any third party from using a similar design if the contested use results from copying the unregistered design. The contested use, however, will not be deemed to result from copying the protected design if it results from an independent work of creation by a designer who may be reasonably thought not to be familiar with the design made available to the public by the holder. Thus, the factual basis for proceeding based on an unregistered Community design is very hard to establish.

For all these reasons, we strongly recommend protecting designs as registered designs rather than relying on the "automatic" protection provided by the unregistered Community design.

[8] FSC, decision dated October 9, 2008, legal case I ZR 126/06 – Gebäckpresse.

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