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# NEWSLETTER

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IP NEWS FROM GERMANY AND EUROPE

APRIL 2011

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## I. NEWS ABOUT US

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### New Support

We are pleased to announce new support for our trade mark team:



**Ms. Astrid Purner**, born in 1972, joined Kador & Partner as an attorney-at-law in January 2011.

Ms. Purner studied law at the University of Innsbruck, Austria, and the University of Alcalá de Henares, Spain. After passing the exam for the recognition of her degree in Spain at the University of Granada, she worked for an international law firm in Málaga, Spain, for the past ten years, mainly on litigation cases in the field of economic law.

Ms. Purner is fluent in Spanish and English and has a basic knowledge of French and Italian.

### New Premises in Innsbruck

We are pleased to announce that as of summer this year we will open an office in the beautiful city of Innsbruck (Austria). We will thus be able to be even closer to the many of our clients in the alpine region.

### Non-US INTA Roundtable

On the occasion of the INTA Roundtable held in our premises in Munich on October 28, 2010,

Ms. Elisabeth Fink, Member of the 4th Board of Appeal, OHIM, Alicante, gave a very interesting overview of current decisions of the Boards of Appeal.

OHIM's Boards of Appeal are responsible for deciding on appeals from decisions from the first instance in Community trade mark as well as design matters. Altogether almost 2000 appeals were filed in 2010 and the number is constantly growing.

Ms. Fink discussed current decisions based on absolute grounds such as the "LEGO brick" (three dimensional trade mark, the application failed as the shape was deemed to be purely functional); single letters such as the Greek letter "α" (registered, distinctive); slogans like "Vorsprung durch Technik" (registered, inappropriate to apply stricter distinctiveness criteria to slogans than those applied to other trade marks).



Ms. Elisabeth Fink (on the right), OHIM, and Ms. Corinna Probst, attorney at law at Kador & Partner

Furthermore, Ms. Fink presented decisions on relative grounds such as "Barbara Becker/Becker" (Becker = common family name, Barbara Becker = well-known person, case referred to the General Court), "Solfrutta/Frutisol" (dan-

ger of confusion denied), "Kids Vits/Vits4kids" (danger of confusion confirmed), "Eliza/Elise" (conceptually similar, danger of confusion confirmed).

## Office Trip to Wachau

As every year, our whole team was invited to our firm's excursion, which led us to a beautiful part of Austria autumn last year. There, we rented bikes and rode along the river Danube in the UNESCO world cultural heritage "Wachau", 70 km west of Vienna.



Stift Melk



Wine Tasting in Dürnstein

We stayed at the city of Dürnstein and biked about 30 km to the famous Stift Melk, where we had a guided tour. This place is really worth seeing ([www.stiftmelk.at](http://www.stiftmelk.at)).

We further visited Krems, a lovely town which is more than 1000 years old, and tried the good white wines of this area. As always, we felt like a large group of friends and are sure that our team spirit has been strengthened even more.

## APAA Conference South Korea

In October 2010, Dr. Utz Kador participated in the Asian Patent Attorneys Association 58th Council Meeting at the International Convention Center, Jeju, Korea.

## AIPPA World Congress in Paris

**Dr. Bernhard Pillep** represented Kador & Partner at the 42nd AIPPA World Intellectual Property Conference in early October 2010.

The venue attracted more than 2500 participants from all over the world so that a lively exchange on all kinds of intellectual property matters took place.

The gala dinner was held at the impressive Palace of Versailles, so that everybody could feel like the famous "Sun King" Louis XIV for a bit.

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## II. EUROPEAN PATENT LAW

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### Non-Allowability of Swiss-Type Claims for Second Medical Uses

As already reported in our Newsletter of August 2010, the Enlarged Board of Appeal in decision G 2/08<sup>1</sup> ruled that so-called Swiss-type claims, as instituted by decision G 5/83 for second or further medical uses, are no longer allowable under the EPC. The Enlarged Board specified in this decision that this will apply to all applications which have a filing date or earliest priority date later than three months after the publication of G 2/08, which took place on October 28, 2010.

Consequently, the non-allowability of Swiss-type claims will apply to all European patent applications having a filing or earliest priority date of January 29, 2011, or later. However, if such claims are nevertheless present in an application, the EPO will invite the applicant to correct this deficiency which he may do by e.g. putting the claim into the newly available second medical indication product claim format according to Art. 54(5) EPC.

### Decision of the Enlarged Board of Appeal Regarding Language of the Proceedings

In decision G 4/08<sup>2</sup>, the Enlarged Board had to answer questions regarding the language of the proceedings of a case referred to it with decision J 8/07.

In this case, the Appellant filed an international application in French which was published in French. Upon entry into the regional phase before the EPO, the Appellant filed an English translation of the application and requested that the language of proceedings should be English or, failing that, that English should be used in all written proceedings and decisions.

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<sup>1</sup> see Official Journal EPO 10/2010, page 456

<sup>2</sup> see Official Journal EPO 11/2010, page 572

The Enlarged Board now made it unmistakably clear in its ruling that where an international application has been filed in one of the official languages of the EPO, it is not possible, upon entry into the European regional phase, to change this language to one of the other official languages. In particular, the Enlarged Board concluded in its answers to the questions referred to it:

*“To question 1: If an international patent application has been filed and published under the PCT in one official language of the EPO, it is not possible, on entry into the European phase, to file a translation of the application into one of the other two EPO official languages.”*

*To question 2: In written proceedings on a European patent application or an international application in the regional phase, EPO departments cannot use an EPO official language other than the language of proceedings used for the application pursuant to Article 14(3) EPC.”*

## Amendment of Rule 161(1) EPC

Rule 161(1) EPC specifies that for Euro-PCT applications (i.e. international applications which enter the European regional phase) for which the EPO acted as International Searching Authority (ISA), and where a demand under Art. 31 PCT was filed also as the International Preliminary Examining Authority (IPEA), the applicant must comment on the written opinion of the ISA or on the international preliminary examination report (IPER) where there are any deficiencies noted therein.

Rule 161(1) EPC as in force since April 1, 2010, specifies that for filing his comments the applicant has only a one-month term after receipt of an EPO communication under Rule 161(1) EPC. Failing to comply with Rule 161(1) EPC means that the application is deemed to be withdrawn. This term has been heavily criticized by applicants and professional representatives as being much too short to permit adequate commenting. Apparently in reaction to this criticism the EPO has (again) amended Rule 161(1) EPC, so that it now specifies a term of six months for filing the comments. The new version of Rule 161(1) EPC will enter into force as of May 1, 2011.

As only the term for submitting the comments on the written opinion of the IPER has been amended, all other explanations that have been given in a notice from the EPO regarding Rule 161(1) EPC remain valid (see Official Journal EPO, 11/2009, pages 533 to 541, item 5.2).

## Amendment of Rule 36(1) EPC

Rule 36(1) EPC as enacted April 1, 2010 sets the conditions for a so-called “voluntary division”, i.e. for filing a divisional application on the applicant’s own volition. Accordingly, a divisional application may only be filed up to 24 months “after the **Examining Division’s first communication** in respect of the earliest application for which such a communication has been issued”.

This formulation of Rule 36(1) EPC has been perceived as being vague and mistakable, as the EPO wanted “Examining Divisions first communication” to mean a communication under Art. 94(3) and Rule 71(1)(2) EPC or, where appropriate, Rule 71(3) EPC<sup>3</sup>. However, the Examining Division also issues, for example, communications under Rule 161 EPC earlier than communications under Art. 94(3) and Rule 71(1)(2) or (3) EPC.

The EPO has, thus, clarified the wording of Rule 36(1) EPC so that it now reads as follows:

*“(1) The applicant may file a divisional application relating to any pending earlier European patent application, provided that:*

*(a) the divisional application is filed before the expiry of a time limit of twenty-four months from the Examining Division’s first communication under Article 94, paragraph 3, and Rule 71, paragraph 1 and 2, or Rule 71, paragraph 3, in respect of the earliest application for which a communication has been issued, ...”*

Rule 36(1) EPC in the new wording entered into force on October 26, 2010, but since it involves a mere clarification in wording, no substantial change is introduced by the new version of Rule 36(1) EPC.

<sup>3</sup> see Official Journal EPO 11/2009, pages 481 to 485, in particular page 482

## Amended Rule 141(1) EPC

Under amended Rule 141(1) EPC an applicant claiming the priority of a previous application has to file a copy of the results of any search carried out by the Authority with which the previous application was filed (= Office of First Filing (OFF)). This has to be done upon filing of the European Patent Application or, in case of a European PCT application, upon entry into the European phase.

Amended Rule 141(1) EPC does not require, however, that copies of the documents cited in the OFF search results have to be filed. Nor is a translation of the search results necessary in case the language of the OFF is different from the official languages of the EPO.

In case the OFF search results are not available upon filing of the European Patent application or when entering the European phase, the applicant must file the results without delay after they have been made available to him.

Amended Rule 141(1) EPC is complemented by new Rule 70b(1) EPC which states that if at the time by which the Examining Division assumes responsibility of the application the copy of the relevant search results has not yet been filed, the EPO invites the applicant to do so within a period of two months.

## Decision G 1/09 on When Refused Applications are Pending

The Enlarged Board of Appeal of the EPO ruled in decision G 1/09 of September 27, 2010<sup>4</sup>, that a European patent application which has been refused by a decision of the Examining Division is thereafter pending within the meaning of Rule 25 EPC (1973) and Rule 36(1) EPC, until expiry of the time limit for filing a notice of appeal, even if no appeal is actually filed.

As a consequence, a divisional application can still be filed based on the refused European patent application within two months after notifica-

tion of the decision (Art. 108 EPC) provided, of course, that the time limit of Rule 36(1) EPC is met.

### **Our comment:**

*In practice, it is no longer necessary to file a divisional application prior to oral proceedings before the Examining Division if it has to be expected that the Examining Division will refuse the application. It is further no longer necessary to file an appeal after refusal of a European patent application by the Examining Division merely in order to have the right to file a divisional application. The situation is now similar to the practice at the German Patent and Trademark Office.*

## Enlarged Board of Appeal Decisions G 01/08- “Broccoli” and G 02/07 “Tomatos” – “Essentially biological processes”

In these decisions the Enlarged Board of Appeal (EBA) answered legal questions of fundamental importance relating to the exclusion of “essentially biological processes” from patent protection under Art. 53(b) EPC.

Two different Technical Boards of Appeal (TBA) referred similar questions to the EBA, one of which related to the breeding and crossing of broccoli species (T 83/05)<sup>5</sup> and the other relating to the breeding and crossing of tomato species (T 1242/06)<sup>6</sup>.

The “broccoli method” claims included steps of “using molecular markers to select hybrids with genetic combination encoding expression of elevated levels of 4-methylsulfinylbutyl glucosinolates, or 3-methylsulfinylpropyl glucosinolates”. Although the Board considered the method to be generally patentable, it referred the following questions to the EBA (G 1/08)<sup>7</sup>:

<sup>4</sup> not yet published in the Official Journal of the EPO, but accessible on the EPO website at <http://www.epo.org/law-practice/case-law-appeals/eba/number.html>

<sup>5</sup> Official Journal EPO 12/2007, 644-669

<sup>6</sup> Official Journal EPO 11/2008, 523-540

<sup>7</sup> Not yet published in the OJ EPO, but accessible on the EPO website at <http://www.epo.org/law-practice/case-law-appeals/eba/number.html>

*“1. Does a non-microbiological process for the production of plants which contains the steps of crossing and selecting plants escape the exclusion of Article 53(b) EPC merely because it contains, as a further step or as part of any of the steps of crossing and selection, an additional feature of a technical nature?”*

*2. If question 1 is answered in the negative, what are the relevant criteria for distinguishing non-microbiological plant production processes excluded from patent protection under Article 53(b) EPC from non-excluded ones? In particular, is it relevant where the essence of the claimed invention lies and/or whether the additional feature of a technical nature contributes something to the claimed invention beyond a trivial level?”*

The “tomato method” claims included steps of crossing, collecting hybrid seeds, growing and pollinating plants and “screening for reduced fruit water content by extended preservation of the ripe fruit and wrinkling of the fruit skin”.

These claims were considered by the Opposition Division to be excluded from patent protection under Art. 53(b) EPC and the TBA referred the following questions to the EBA (G 2/07)<sup>8</sup>:

*1. Does a non-microbiological process for the production of plants consisting of steps of crossing and selecting plants fall under the exclusion of Article 53(b) EPC only if these steps reflect and correspond to phenomena which could occur in nature without human intervention?*

*2. If question 1 is answered in the negative, does a non-microbiological process for the production of plants consisting of steps of crossing and selecting plants escape the exclusion of Article 53(b) EPC merely because it contains, as part of any of the steps of crossing and selection, an additional feature of a technical nature?*

*3. If question 2 is answered in the negative, what are the relevant criteria for distinguishing non-microbiological plant production processes excluded from patent protection under Article 53(b) EPC from non-excluded ones? In particular, is it relevant where the essence of the claimed invention lies and/or whether the additional feature of a technical*

*nature contributes something to the claimed invention beyond a trivial level?”*

In its decisions G 1/08 and G 2/07 the EBA first interpreted in detail the term “essentially biological processes” as contained in Art. 53(b) and Rule 26(5) EPC, also considering the existing Case Law. It came to the conclusion that the wording of Rule 26(5)<sup>9</sup> is ambiguous if not contradictory, as the acts of “crossing and selection” are not natural phenomena but are method steps which generally involve human intervention.

The Board thus found that Rule 26(5) EPC does not give useful guidance on how to further interpret the term “essentially biological process for the production of plants” in Art. 53(b) EPC.

In its further conclusions, the EBA ruled out an analogy to Art. 52(4) EPC 1973 (exclusion of methods for the treatment of the human or animal body) and found that the mere presence of a biological feature in a process cannot automatically confer an “essentially biological” character on the process as a whole.

An analogy to computer-related invention was also ruled out. Thus, a single non-biological process step cannot make the process escape the exclusion under Art. 53(b) EPC.

The EBA then examined the criteria set out in T 320/87<sup>10</sup> where it was found material whether specific operations by human intervention occur in nature or whether a technical feature in the claim is trivial or alters the character of a known process in a fundamental way or whether the essence of the claimed invention lies in it. However, this approach was dismissed either as it conflates considerations relevant for patentability with those relevant for novelty and inventive step, which is detrimental to legal certainty during the lifetime of a patent.

Based on the object and purpose of the exclusion as derivable from the legislative history of the EPC 1973, the EBA finally reached the conclusion:

<sup>8</sup> see footnote 7

<sup>9</sup> Rule 26(5) EPC: “A process for the production of plants or animals is essentially biological if it consists entirely of natural phenomena such as crossing or selection.”

<sup>10</sup> OJ EPO 1990, 71-80

*“A process for the production of plants which is based on the sexual crossing of whole genomes and on the subsequent selection of plants, in which human intervention, including the provision of a technical means, serves to enable or assist the performance of the process steps, remains excluded from patentability as being essentially biological within the meaning of Article 53(b) EPC”.*

**Thus, the questions of law referred to the EBA were answered as follows:**

*“1. A non-microbiological process for the production of plants which contains or consists of the steps of sexually crossing the whole genomes of plants and of subsequently selecting plants is in principle excluded from patentability as being “essentially biological” within the meaning of Article 53(b) EPC.*

*2. Such a process does not escape the exclusion of Article 53(b) EPC merely because it contains, as a further step or as part of any of the steps of crossing and selection, a step of a technical nature which serves to enable or assist the performance of the steps of sexually crossing the whole genomes of plants or of subsequently selecting plants.*

*3. If, however, such a process contains within the steps of sexually crossing and selecting an additional step of a technical nature, which step by itself introduces a trait into the genome or modifies a trait in the genome of the plant produced, so that the introduction or modification of that trait is not the result of the mixing of the genes of the plants chosen for sexual crossing, then the process is not excluded from patentability under Article 53(b) EPC.*

*4. In the context of examining whether such a process is excluded from patentability as being “essentially biological” within the meaning of Article 53(b) EPC, it is not relevant whether a step of a technical nature is a new or known measure, whether it is trivial or a fundamental alteration of a known process, whether it does or could occur in nature or whether the essence of the invention lies in it.”*

#### **Our comment:**

*The EBA fundamentally examined the objects, purpose and legal history of Art. 53(b) EPC, dismissed analogies to other provisions in the EPC not directly applicable to “essentially biological processes” and also dismissed the approach established by former*

*TBA decision T 320/87. The EBA further found that Rule 26(5) giving a definition of “essentially biological process” is confusing or even conflicts with the operations usually performed in classical breeder processes which generally do involve human intervention.*

*The EBA, thus, gave an interpretation of Art. 53(b) EPC on its own. It reached the conclusion that steps of sexually crossing the whole genomes of plants and of subsequently selecting plants characterized the process as “essentially biological”, and an additional step of a technical nature which serves to enable or assist the performance of the above crossing and selecting steps does not alter the nature of the “essentially biological process”.*

*According to the EBA, the exclusion under Art. 53(b) EPC does not apply, however, if the additional step by itself introduces a trait into the genome or modifies a trait in the genome of the plant produced, so that the introduction or modification of that trait is not the result of the mixing of the genes of the plants chosen for sexual crossing. It was found irrelevant whether the additional step is of technical nature or occurs in nature, whether it is trivial or essential for the process or whether it is new or known.*

*Thus, the EBA developed a modified interpretation of Art. 53(b) EPC which overrules the criteria established by the Case Law of the Appeal Boards, while still taking into consideration future technological advancement, so that breeders are free from constraints by patent protection when new technical means within the classical breeder’s processes are developed. At the same time, the Board made it clear that a process involving a step which goes clearly beyond the “classical” breeding steps, i.e. a microbiological step, does no longer fall under the exemption of Art. 53(b) EPC.*

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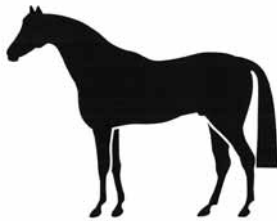
### III. EUROPEAN TRADE MARK LAW

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#### Simple Pictogram of Animal Cannot be Registered as Trade Mark

In a case dated July 8, 2010<sup>11</sup>, the General Court of the European Union (“EGC”)<sup>12</sup> found that the simple pictogram of a horse cannot be registered as a trade mark for “goods made of leather, bags; clothing, footwear, headgear; animal foods, foods and drinks for pets” (EGC, legal case T-386/08).

On December 26, 2005, an application for registration as a Community trade mark was filed showing the following pictogram of a horse:



The mark was filed for “goods made of leather, bags; clothing, footwear, headgear; animal foods, foods and drinks for pets”. The application was refused for absolute grounds. The Appeal Division found that the sign applied for was devoid of distinctive character and descriptive for the goods concerned, because the representation of a horse on animal foods and accessories was quite customary and served as an indication of the intended use of the goods concerned.

The applicant argued that regarding “goods made of leather, bags” in class 18, use of these goods for horse riding was only one of many possible types of use. With the exception of specific goods like halters and reins, there was no need to keep the representation of a horse freely available as an indication of the use of the goods concerned. Neither the Examiner nor the Appeal Division had presented any evidence that representations of horses were typically used to des-

ignate the intended purpose of goods in class 18. Also, there was no direct link between the representation of a horse and “clothing” in class 25 because these goods were not supposed to be used by horses. Finally, with respect to “animal foods” in class 31, there was a long tradition of using representations of animals as trade marks so that the relevant customers had become used to the fact that such animal designs should in fact be considered trade marks.

The EGC, however, found that the pictogram of a horse was descriptive for the goods concerned in class 18, as “goods made of leather” also comprised goods specifically made for use in horse riding like halters and reins. The fact that goods applied for may also comprise other goods could not change this finding.

The EGC then continued that the pictogram was also descriptive for goods in class 25 because, for example, it was clear to the consumer concerned that “articles of clothing” designated with the representation of a horse were supposed to be used for horse riding.

Finally, with respect to “animal food” in class 31, the EGC found that the applicant’s argument that a pictogram of a horse could theoretically also be used as a trade mark was as such not enough to demonstrate sufficient distinctiveness of the specific pictogram in question. In the present case, the pictogram as filed was a clear indication of the purpose of the concerned goods as food for horses and did not show any distinctive or individual features.

The trade mark was therefore rejected.

#### ***Our comment:***

*This decision once again shows that it is very difficult to successfully register simple graphic representations of animals or other objects that have a clear link to the goods concerned.*

*The argument that the goods concerned, such as in the present case “clothing”, could also comprise goods with no reference to the sign in question, for example in the present case “articles of clothing not for horse riding”, does not lead to sufficient distinctiveness. If it is possible that a sign is descriptive with respect to just one specific product falling*

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<sup>11</sup> Judgment T-386/08

<sup>12</sup> Following the entry into force of the Treaty of Lisbon on 1 December 2009, the former Court of First Instance of the European Union is now called the “General Court”.

*into one category of goods as claimed in the application, the application will be rejected for this whole category of goods.*

*Therefore, if registration of a graphic representation of an object with a direct link to the goods concerned is desired, it is vital to ensure that the graphic representation shows distinctive and individual features.*



## Court of Justice of the European Union Confirms Rejection of Calvin Klein's Opposition to a CTM Application Starting with "CK"

In a recent decision the Court of Justice of the European Union (CJEU)<sup>13</sup> has held that the trade mark "CK CREACIONES KENNYA" is not similar to the trade mark "CK" registered by the Calvin Klein Trademark Trust for goods in classes 18 and 25.

The dispute arose when the Calvin Klein Trademark Trust (Calvin Klein), holder of registered trade marks including "CK" and "CK Calvin Klein", filed an opposition to the Community Trade Mark application for "CK Creaciones Ken-nya", filed by the Spanish company Zafra Marroquineros SL (Zafra) covering identical goods in classes 18 and 25, namely inter alia "clothing, footwear, trunks and traveling bags".

The Opposition Division of the Office for Harmonization in the Internal Market (OHIM) rejected the opposition stating that the two trade marks were not sufficiently similar to cause likelihood of confusion pursuant to Art. 8(1) (b) of EC Regulation 40/94 (CTMR). This position was confirmed by the Second Board of Appeal and by the General Court when Calvin Klein filed an action to annul OHIM's decision.

On further appeal, Calvin Klein argued that Zafra had actually used the sign "CK CREACIONES KENNYA" in such a way that the element "CK" was depicted in large highlighted letters and separate from the element "CREACIONES KENNYA", which was depicted in very small letters, so as to copy the famous CK trade marks, as the initials "CK" are highly distinctive for Calvin Klein products. However, the Court of Justice of

the European Union (CJEU) held that the General Court did not err in law by not having taken into account the allegedly wrongful conduct by Zafra, as such circumstances could not be taken into consideration in the assessment of similarity. Wrongful conduct by the trade mark applicant was a significant factor in the context of cancellation proceedings pursuant to Art. 51(1) (b) CTMR (bad faith) but it is not relevant in opposition proceedings under Art. 8 CTMR.

As regards the assessment of likelihood of confusion as such, the CJEU determined that the similarity of marks did not require that they shared a component which was a dominant element in the overall impression of the mark applied for. It was sufficient if the shared component was not an insignificant element. However, the finding of the General Court that the common element "CK" only had an ancillary position in Zafra's trade mark whereas "CREACIONES KENNYA" was the dominant element of the mark resulted, in essence, in the conclusion that "CK" was an insignificant element in Zafra's mark.

According to the CJEU, the General Court had assessed the similarity between the signs on the basis of a properly conducted analysis. The CJEU also confirmed that there was no likelihood of confusion between the marks, notwithstanding the reputation of the earlier CK marks and the identical goods covered by the two marks. The CJEU finally held that Art. 8(5) CTMR, namely the refusal of a trade mark registration if it takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the earlier mark, was not applicable if, as in the present case, the trade marks at issue were not similar, no matter how the degree of reputation of the earlier trade mark was.

### **Our comment:**

*This decision is very surprising. In its interpretation of this case the Court departed from its well established case law that similarity between trade marks is only one element that has to be taken into account when assessing likelihood of confusion and cannot be considered in isolation from other criteria such as the similarity between the goods*

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<sup>13</sup> Judgment C-254/09 P of September 2, 2010

and the distinctiveness and reputation of the earlier mark. Finally, the reasoning is also contrary to the specific legal criteria for protection of a renowned trade mark. These diverse approaches by the Court seem difficult to reconcile and different results on the same facts will be inevitable in the future.

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#### IV. EUROPEAN DESIGN LAW

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### Decision of German Federal Supreme Court on Community Design

In a recent decision<sup>14</sup> the German Federal Supreme Court (FSC) for the first time expressed its detailed view on the provisions of the harmonized industrial design law. Although the present decision relates to the infringement of a European Community design (which is to be decided upon by the Courts of the European national countries, e.g. a German Court), the principles of the decision can also be applied to the harmonized German national design law.

The plaintiff is right holder of a Community Design concerning the design of the standard model of the “S-Klasse”-type passenger car, which was filed on April 1, 2003, and published on September 20, 2005. Further, the plaintiff is right holder of two Community Designs concerning the design of an extended model of the “S-Klasse”-type passenger car, which were filed on May 11, 2004, and published on July 26, 2005, claiming priority of a German design filed on December 4, 2003. “S-Klasse”-type passenger cars of the present series have been available to the public since 2005.

The defendant distributes extended and armored passenger cars which are produced on the basis of the plaintiff’s series-production cars. The plaintiff claimed infringement of his Community Design rights concerning the designs of the extended model of the “S-Klasse”-type passenger car in Germany.

The defendant claimed that the plaintiff’s Community Designs were not new and did not have individual character in view of the plaintiff’s earlier Community Design concerning the standard model of the “S-Klasse”-type passenger car, and were hence void.

In the decision, the FSC first made some general statements regarding the assessment of, in particular, “individual character” of a Community

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<sup>14</sup> BGH, Judgment of April 22, 2010 - I ZR 89/08 (OLG Stuttgart)

Design. Accordingly, a Community Design has individual character if its overall impression on the informed user is different from the overall impression of any other publicly available design. For this assessment, the design has to be compared with any other design on a one-by-one basis. The Court further stated that “peculiarity” and “level of originality” of a design no longer belong to the requirements for its protection, in contrast to the jurisdiction before the entry into force of the harmonized Design Act in 2004.

*This decision should thus further encourage the filing of design applications, as it can be expected that, due to the lower standards applied, it will be much more difficult for defendants to be successful in arguing that a design is invalid.*

The Court further ruled that, in the present case, the Community Design for the standard model “S-Klasse” car has to be neglected when assessing novelty/individual character of the Community Designs for the extended model, because it had not been made available to the public before the priority date of the latter Designs. In particular, there is no possibility for the general public to acquire knowledge of a non-published Community Design, e.g. by a search or a file inspection.

The Court continued to say that even if the Community Design for the standard model is taken in consideration, the Community Designs for the extended model, although having many features in common with the Design for the standard model, make a different overall impression on the informed user and hence have “individual character”, because “peculiarity” and a certain “level of originality” are no longer required.

The Court finally found that the cars of the defendant made the same overall impression on the user as the Design registrations for the extended cars and hence affirmed an infringement of the plaintiff’s Community Designs.

**Our comment:**

*The present decision makes it clear that the FSC is readily willing to apply the different standards and definitions set in Community Design Regulation/harmonized German national Design Act in assessing the validity and infringement of Design registrations, especially as regards the term “individual character” in contrast to the former notions “peculiarity” and “level of originality”. Accordingly, a comparatively lower “degree of difference” in features of a design is now necessary in order to fulfill the requirements for protection of a design.*



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*Building Bridges*