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# NEWSLETTER

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IP NEWS FROM GERMANY AND EUROPE

March 2015

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## NEWS ABOUT US

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### Training Course on European Patent Law in October 2015

We kindly invite all of our clients to an advanced training course on European IP Law taking place on our premises in Munich from October 9 to 17, 2015!

The course will begin with an overview of the European patent system and procedures, continuing with an in-depth treatment of the following topics:



*Utz welcoming our 2014 seminar participants*



*Excursion to and beer drinking in famous Munich Hofbräuhaus*

- assessment of novelty and inventive step under the EPC,
- requirements of sufficient disclosure of the invention,
- the strict approach of the European Patent Office on amending claims - added matter,
- best practice in opposition and appeal proceedings, and
- infringement and litigation under European and German law.

Furthermore, an overview will be given of the new Unitary European Patent and the Unified European Patent Court, as well as the existing Community Trade Mark system.

During the course, participants will attend an opposition hearing at the EPO to experience such proceedings first-hand.

The lectures will be presented by Kador & Partner attorneys as well as by prominent IP professionals from the European Patent Office, private practice and industry, including **Mr. Robert Young**, former chairman of a Board of Appeal and member of the Enlarged Board of Appeal of the EPO, **Dr. Ludwig von Zumbusch**, litigation specialist at Preu Bohlig & Partner, and **Dr. Jörg Dietz**, former IP litigation director of Novartis International AG.

Aside from work, a variety of social activities will be offered to participants, such as a trip to the famous castle Neuschwanstein of Bavarian king Ludwig II, a sight-seeing tour of Munich and a trip to the picturesque lake Chiemsee.

For more information on the seminar and for a detailed description of both the lectures and the leisure activities please see our web page [www.kadorpartner.com](http://www.kadorpartner.com), under the link "The Seminar".

We look forward to seeing you in October!

## Excursion to Würzburg 2014

On the last weekend of September 2014 we had our annual office trip on which we went to the wonderful city of Würzburg and its surroundings.

Würzburg lies in northern Bavaria in a region called Franconia, and is famous for, amongst other things, its great architecture and wine growing.



*Beautiful landscape close to Volkach at "Mainschleife"*

On the first day we went on a hike through the beautiful landscape of the "Mainschleife" (river Main loop) close to Volkach, which is covered with vine yards.

Most of the wine grown in this area is white wine, with the most famous grapes cultivated being "Silvaner" and "Riesling". During an extended rest, we already tested area's food and, of course, wine specialties. In the evening, we had dinner at the Bürgerspital restaurant, well-known for the wines from its own vine yards.

On the second day we took a guided city sight-seeing tour in Würzburg with its rich cultural and architectural heritage, including the world cultural heritage site known as the "Residenz", the seat of the prince-bishops of Würzburg, built by Balthasar Neumann, the famous architect in the Baroque period.



*Part of our group in front of the Residenz in Würzburg*

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## EUROPEAN PATENT LAW

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### Extension of European Patents to Tunisia and Morocco

In 2014 the European Patent Office and the Tunisian Patent Office signed a validation agreement which will allow European patents to take legal effect in the Tunisian Republic<sup>1</sup>. Under the terms of the agreement, European patent applicants and proprietors will be able to validate the legal effects of their European patents and applications in Tunisia, even though Tunisia is not an EPO member state. For the agreement to come into force it will have to be ratified.

Similarly, in January 2015 the European Patent Office and the Moroccan Industrial and Commercial Property Office (OMPIC) signed an agreement allowing European patents to be validated in Morocco<sup>2</sup>.

From March 1, 2015, on, anyone filing a European patent application will be able to request validation for Morocco against the payment of a fee. European applications and patents validated for Morocco will have the same legal effects there as Moroccan ones and will be subject to Moroccan patent law.

With these new additions, patent protection for up to 41 countries can be obtained simultaneously with a single European patent application.

### New Practice of the EPO with respect to Handwritten Amendments

Since January 1, 2014, handwritten amendments are no longer allowed in

documents of the first-instance departments of the EPO (Rules 49(8) and 50(1) EPC) as well as amendments in patent specification documents in opposition proceedings (Rule 86 EPC).

This new procedure is said to be due to IT modernization efforts of the EPO which shall enable the electronic processing of documents and applies to all documents filed in proceedings on or before January 1, 2014. Thus, in order to guarantee that application documents and amended patent specifications are recognizable by OCR software (optical character recognition) handwritten amendments are no longer allowed.

According to this new procedure, descriptions, claims, abstracts, requests for grants as well as documents replacing application documents and amended patent specification documents have to be provided in type or print. Exceptions are graphic symbols and characters, chemical and mathematical formulae and the unambiguous striking out of lines or words.

As it is the responsibility of the applicant/proprietor to provide formally correct submissions and, in particular, comply with Rule 49(8) EPC, this new procedure also applies to oral proceedings. This means that documents containing handwritten amendments may still be used as a basis for discussion until agreement is reached on the final text of the patent. However, a final decision granting a patent or maintaining it in amended form may only be taken on the basis of a document which is not formally deficient, that is, a document which does not contain handwritten amendments.

#### **Our comment:**

*This new procedure is said to be an important step in the IT modernization efforts of the EPO.*

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<sup>1</sup> see e.g. <http://www.epo.org/news-issues/press/releases/archive/2014/20140704.html>

<sup>2</sup> see e.g. <http://www.epo.org/news-issues/news/2015/20150119.html>

*The EPO announced that it would provide applicants and patent proprietors with electronic copies of the patent application intended for grant (“Druckexemplar”) or patent specification (EP-B). The intention is to make those documents available for downloading from the European Publication Server in editable formats.*

*With respect to oral proceedings the EPO has started providing technical facilities allowing the parties to create formally adequate, electronic versions of the relevant documents in case amendments have to be performed during oral proceedings.*

*However, although the EPO is trying to implement this procedure as smoothly as possible, it still costs applicants and proprietors some additional time and money. Especially for applications and opposition proceedings dating back several years, there is often not yet an editable text file provided by the EPO. Thus, creating the respective documents in an analogously or digitally editable format is time-consuming.*

*Furthermore, using handwritten amendments, for example to adapt the specification to an amended set of claims maintained, had the big advantage, especially in opposition proceedings, that the amended sections could be seen at a glance and there was no need to study all the documents again and compare the amended editable document with the printed patent as granted. The new regulation is therefore also perceived by many members of opposition divisions to be very impractical, so that, hopefully, the new practice will be given up again at least for opposition procedures.*

## **Inside the European Patent Office**

Since February 2014 the EPO commits to a new quality policy. A new Quality Management System (QMS) was implemented, certified

according to ISO 9001. This QMS supports the goal to maintain and improve the quality of EPO products. According to the QMS all granted patents as well as all reports not containing documents classified as relevant for the invention (“X” or “Y”) are reviewed. Of all other EPO products, random samples are chosen and reviewed, with every examiner being audited regularly. Every examination section, the directors as well as the opposition division and the boards of appeal are integrated in the new QMS.

Just recently the EPO disclosed information on the time each examiner may spend on a file on average. Not surprisingly, that time varies depending on the technical field. In the chemical field an examiner may spend about 3 days for search, examination, grant and oral proceedings. In physics it is 3.5 days and in computer sciences about 4 days per file. It is of interest to note that every examiner is encouraged to achieve a certain product mix represented by the S / E ratio (search to grant). This rate should preferably be between 1.2 and 1.4.

## **Unitary Patent: Advocate General Proposes to Dismiss Spain’s Actions against Unitary Patent Package**

The Court of Justice of the EU has recently announced<sup>3</sup> that Advocate General Yves Bot proposes that the Court should dismiss the actions seeking annulment of the two regulations on the creation of unitary patent protection brought by Spain.

According to Mr. Bot, the sole purpose of the regulation on unitary patent protection is to incorporate recognition of unitary effect through a European patent already granted under the EPC.

<sup>3</sup> CJEU, Case Numbers C-146/13 and C-147/13 - Spain vs. Parliament and Council, Press Release No 152/14

He continued that the EU legislature limited itself to stating the nature, conditions for grant and effects of unitary protection and covering only the phase subsequent to the grant of the European patent. The protection thus conferred is regulated by the uniform implementation provisions of the regulation.

**Our comment:**

*The pending legal actions of Spain against the EU regulations regarding unitary patent protection and the applicable translation arrangements are the last serious obstacles to overcome before it can be regarded as certain that (and only a matter of time until) the new system of the European Patent with Unitary Effect comes into force.*

*The recently issued opinion of the Advocate General of the CJEU can be seen as a big step towards final dismissal of Spain's actions, as the CJEU follows the advice of the Advocate General in its decisions in the majority of cases.*

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## GERMAN PATENT LAW

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### **Decision „Sitzplatznummerierungseinrichtung“ (“Seat Numbering Device”) of the German Federal Supreme Court on Differing Decisions of the EPO**

In a recent decision the German Federal Supreme Court (FSC, German: “Bundesgerichtshof”, BGH) gave a ruling on the issue of differing decisions of German courts and the EPO as well as courts of other EPC member states.

The case under discussion related to a German utility model being split-off from a European Patent. An opposition against the

European Patent at the EPO was rejected as the presented state of the art was not held relevant by the opposition division of the EPO.

However, a request for cancellation of the split off German utility model at the German Patent and Trademark Office (GPTO) was successful.

The proprietor filed an appeal from that decision with the German Federal Patent Court (FPC). In that appeal the FPC upheld the GPTO's decision despite the differing decision of the opposition division of the EPO. In its ruling the FPC considered the decision of the EPO opposition division but interpreted the state of the art with respect to inventive step differently. The proprietor appealed the decision of the FPC on the grounds that his right to be heard was violated.

This appeal to the FSC was rejected on the grounds that the right to be heard was not violated. The FSC ruled that German courts must consider decisions of the instances of the EPO or other courts of EPC member states. However, the German courts are not bound by those decisions. In case a differing decision is issued by a German court such a decision needs to be reasoned appropriately and the differing decision needs to be considered adequately.

The opposition division of the EPO had not provided an elaborate argumentation on the technical aspects under discussion. As the FPC had taken the decision of the opposition division of the EPO into consideration and acknowledged it sufficiently, it is permissible for the FPC to interpret technical aspects differently.

**Our comment:**

*By that ruling the FSC concretizes its jurisdiction regarding the obligatory consideration of differing decisions of the EPO and other courts of member states. Thus, in case a differing ruling is issued by*

*a German court it is crucial that the German court shows it is considering the differing decision appropriately. This means that if a critical aspect was discussed in great detail by the EPO or the other court of a member state, the differing decision of the German court needs to be more elaborate and especially well reasoned.*

*From this follows that it is possible to obtain decisions of German courts that differ from decisions of bodies of the EPO. Our advice is that a party seeking such a differing decision at a German court should substantiate its allegations appropriately and discuss the differing decision in detail in order to increase its chances for success.*

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## EUROPEAN TRADE MARK LAW

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### OHIM Fast Track Procedure for Trade Mark Applications

Since the end of 2014, the Community Trade Mark Office (OHIM) has offered a free-of-charge “Fast-Track” procedure for trade mark applications. The benefit of this initiative is that applications will already be published three weeks after the application date and, if no objection or opposition follows, the trade mark will be registered after 4 months. In general, the overall time saving will be approximately 2 to 4 months compared to the regular application procedure.

Especially for clients in need of a quick examination and end of opposition period this may be of major interest, e.g. for using the CTM application/registration as the basis for an international registration.

#### **The most important Fast Track conditions are:**

■ Goods and services: The goods and services have to be selected from OHIM’s

harmonized database. For applicants who have very specific or unusual goods/services or have constructed their individual list of goods and services, there is no fast-track.

- Payment: Payment can be made by any of the accepted payment methods but not via a third party’s current account. However, the applicant must make sure that the application fee is paid immediately.
- Applicant: The applicant must be domiciled in the European Union or identify a valid representative.
- The mark: Fast Track is available for the following trade mark types: word, figurative, 3D or sound marks. The relevant attachments must be included for figurative, 3D or sound marks. If colours are claimed, only the colours as stated in the form can be used since a custom colour cannot be specified. There should be no trade mark description or a disclaimer.
- Priority/seniority claims: There should be no priority or seniority claims. However, priority/seniority claims are allowed if the trade mark on which the claim is based can be imported from the TMView database or if the corresponding certificate of such mark is attached. If exhibition priority is claimed, an attachment containing the corresponding certificate must be provided.
- Language of the application: When the first language of the application is not one of OHIM’s five languages (English, French, German, Italian and Spanish), the applicant must accept the translation provided by the Office in the second language.
- Although some applications may comply with the conditions of Fast Track at the time of filing, they may lose the Fast Track condition later on. This can result from the trade mark not being distinctive. If the application loses the Fast Track condition, OHIM will inform in writing.

## **Our comment:**

*To make full use of the new fast track system offered by the OHIM, we will usually file new trade mark applications under the fast track procedure for our clients if we find that the application is eligible for this procedure, e.g. if the list of goods and services only contains pre-approved terms of the OHIM database.*

*For clients that have a more specific list of goods and services we will discuss the advantage/disadvantage of amending the specification according to the harmonized terms provided by OHIM and according to the time factor.*

### **Non-Distinctive/Weak Components of Marks in the Examination of Likelihood of Confusion**

Many trade mark opposition or infringement proceedings involve trade marks which share an identical component which is non-distinctive, or descriptive or highly evocative of the goods or services concerned or their characteristics or purpose, but differ in the remaining element(s).

In Germany, it is usually assumed that a non-distinctive or weak component cannot cause a risk of confusion on its own. The owner of a complex mark with such a component cannot derive any rights from this component. Usually, a non-distinctive or weak element is not considered to be a, or the, dominant element of a complex mark, and it is assumed that consumers will focus their attention on the other elements of the marks.

Though such components must not be neglected in the overall comparison of the marks, as they may still play a role in their overall impressions and lead to a likelihood of confusion between the marks seen as a whole, this will in principle only be the case

if the remaining elements of the marks are similar as well.

For example, the German Federal Patent Court declared that there was no risk of confusion between the signs PANTOPREM and PANTOPAN for gastro-intestinal compounds, as the common element “PANTO” is an abbreviation for the active ingredient “pantoprazole” and therefore has only weak distinctiveness.

The Court further stated that consumers will direct their attention to the additional elements of the signs, so that the different suffixes make them sufficiently dissimilar.

In contrast, the European General Court (EGC) has repeatedly based a finding of likelihood of confusion on the presence of a common element of weak distinctiveness at the beginning of the conflicting signs, despite the differences in the suffixes.

For example, the Court held the mark CLORALEX confusingly similar to the older mark CLOROX for cleaning products<sup>4</sup>, considering that despite being descriptive of one of the ingredients of the cleaning products (namely chlorine), the common element ‘clor’ determines to a large extent the overall impression conveyed by the marks. As a consequence, the Court assumed an average degree of visual and phonetic similarity and even a high degree of conceptual similarity.

In another decision<sup>5</sup> it found the marks NICORETTE and NICORINO to be confusingly similar for smoking cessation products. The EGC considered that although the common element ‘nico’ has a weak distinctive character (being a descriptive abbreviation of “nicotine”), it makes a significant contribution to the overall impression produced by the marks and the relevant public will attribute at least as much importance to it as to the final

<sup>4</sup> EGC, T-0135/11, 10.07.2012, confirmed by the ECJ in C-422/12, 13.1.2014  
<sup>5</sup> EGC, T-580/11, 6.6.2013

part of the marks at issue. It concluded that the similarities between the signs outweigh the differences and that the marks must be regarded as being visually, phonetically and conceptually similar.

As the different approaches to the treatment of non-distinctive/weak elements in the comparison of complex signs create legal uncertainty and may even lead to different results in opposition or infringement proceedings, the national IP offices of the majority of EU member states and the OHIM, under the umbrella of the Convergence Programme, have agreed on a series of principles to be applied in the examination of likelihood of confusion between trade marks with common non-distinctive/weak components, which were published on October 2, 2014, in a “Common Communication on the Common Practice of Relative Grounds of Refusal – Likelihood of Confusion (Impact of non-distinctive/weak components)” (referred to as “Common Communication” in the following).

According to the principles as published in the Common Communication, the distinctiveness of all components of the earlier mark and of the later mark is to be assessed when evaluating likelihood of confusion (LOC), with the coinciding components being prioritized.

When marks share an element with no or a low degree of distinctiveness, the assessment of likelihood of confusion will focus on the impact of the non-coinciding components on the overall impression of the marks. It will take into account the similarities/differences and distinctiveness of the non-coinciding components.

A coincidence in an element with a low degree of distinctiveness will not normally lead to LOC on its own. However, there may be LOC if the other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the

overall impression of the marks is similar or if the overall impression of the marks is highly similar or identical.

In the Common Communication, the following examples were given, among others: the marks COSMEGLOW and COSMESHOW for cosmetics in class 3 are to be considered confusingly similar, but the marks MORELUX and INLUX for beauty treatments in class 44 are not.

A coincidence only in non-distinctive components does not lead to LOC. However, when marks also contain other figurative and/or word elements which are similar, there will be LOC if the overall impression of the marks is highly similar or identical (as in the case of the marks TRADENERGY and TRACENERGY for solar energy collectors for electricity generation in class 9).

It was furthermore considered that marks which contain word elements with no (or low) distinctiveness in English will be considered as having no (or low) distinctiveness in all languages and are understood by the national offices.

### **Our comment:**

*This common practice does not change the practice of national offices but establishes common principles which should lead to higher legal certainty and predictability of results.*

*Though the common practice does not include an agreement on other factors that are considered when assessing the likelihood of confusion – in particular the dominant character of components within a complex mark – the application of these principles should indeed lead to identical results in identical cases before different European IP Offices, as they clearly state that the assessment of likelihood of confusion must focus on the impact of the non-coinciding components on the overall impression of the*

marks and that a common non-distinctive or weak component will not lead to likelihood of confusion unless the other elements of the marks are similar as well and the overall impression caused by the marks is highly similar or identical (or similar if the other components are of a lower (or equally low) degree of distinctiveness or are of insignificant visual impact).

Of course, the EGC, which in the above-cited decisions clearly attributed a dominant role to the common weak components, might always reach different results as the Common Communication is not binding for it in any regard.

### Similarity of Signs with Dissimilar Word Elements Depicted in the Same Typeface

In a surprising decision<sup>6</sup> the European General Court found that the Community trade mark application for goods in classes 29, 30 and 32



of Modern Industrial & Trading Investment Co. Ltd. (Mitico), and the opposition Community trade marks

			
Trade mark No 8 792 475	Trade mark No 3 021 086	Trade mark No 2 117 828	Trade mark No 2 107 118

<sup>6</sup> EGC, T-480/12 of 11.12.2014

of The Coca-Cola Company are similar to a low degree.

The Opposition Division of OHIM had rejected the opposition and the Second Board of Appeal had dismissed The Coca-Cola Company's appeal, considering that the signs were not at all similar, as the word elements, which were more distinctive than the figurative elements, had practically nothing in common and it was difficult to see why a consumer would confuse the word 'master' combined with an Arabic word, with the earlier trade marks containing the words 'coca-cola'.

The Board of Appeal declared that the typeface in which the word elements of both marks were depicted (Spenserian script) was not so distinctive that its appearance in trade marks other than those owned by Coca-Cola would give rise to any suspicion that those marks had the same commercial origin. It declared that the relevant public would not establish a link between the signs, since there was no similarity between them.

The European General Court now stated that as products in classes 29 and 30 are normally purchased in self-service stores, where consumers tend to be guided by the overall visual impression produced by the labels or packaging, the figurative elements play a visual role which is at least as important as that of their word elements.

It declared that the conflicting signs share a figurative element consisting in a "tail" flowing from the first letters of the signs, and are both depicted in a special and distinctive way in the same font, which has a particular distinctive character and is not commonly used.

The EGC found that there is a low degree of visual similarity between the signs and, as the relevant goods are usually sold in self-service stores, the elements of visual similarity and dissimilarity between the signs are of greater importance than the elements of aural

and conceptual similarity and dissimilarity between them.

It concluded that there is a low degree of similarity between the signs since, despite the elements of visual dissimilarity, their aural and conceptual differences are cancelled out by the elements of overall visual similarity, which are of greater importance.

As the marks are not dissimilar but similar to a low degree, and it is “not altogether inconceivable that the relevant public could make a link between them”, the Board of Appeal should have examined the other conditions for applying Article 8(5) of Regulation 207/2009 (special protection for wellknown trade marks), i.e. the risk that the use without due cause of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks.

In this regard, the opponent had submitted evidence showing “Master Cola” products marketed with labels and in bottles similar to those of the Coca Cola Company.



The Board of Appeal had dismissed Coca-Cola’s arguments on the actual use of the mark, considering that the marks had to be compared as registered and the way in which they might be used was irrelevant.

The EGC considered that the case-law of the ECJ does not limit to the mark applied for the relevant evidence to be taken into consideration for the purposes of establishing a risk of free-riding (risk that unfair advantage will be taken of the distinctive character or the repute of the earlier trade marks), but allows

account also to be taken of any evidence intended to facilitate the analysis of the probabilities as regards the intentions of the proprietor and any evidence relating to the actual commercial use of the mark applied for.

For these reasons the EGC annulled the appeal decision and the Board of Appeal will have to examine the conditions for applying Art. 8(5), taking into consideration the evidence relating to the commercial use of the mark applied for.

### **Our Comment:**

*It seems probable that the EGC’s assessment of the similarity between the conflicting signs was influenced by the evidence presented by The Coca Cola Company showing “Master Cola” products with labels and in bottles similar to those of Coca Cola.*

*Though the Spenserian script in which the word element of the Coca Cola logo is depicted may not be commonly used nowadays, it is still only a decorative script style and not a special and distinctive design which might indicate origin and lead consumers to believe that a word sign completely dissimilar to the word element of the Coca Cola marks but depicted in the same typeface might have something to do with Coca Cola or its products.*

*As stated by the Board of Appeal of OHIM, it is difficult to see how a consumer confronted with the trade mark applied for in its registered form should be reminded of the Coca Cola marks for the mere reason that the word element “Master” is written in Spenserian script and the letter “M” has a “tail” like the letter “C” in the Coca Cola marks.*

*While it is clear that the labels and bottles shown as evidence by Coca Cola will bring to mind the Coca Cola marks and products, this will probably not be the case for the sign as registered.*

*It seems that in view of the alleged use by Mitico of these labels and bottles for “Master Cola” products, the EGC wanted to allow application of Art. 8(5) of the Community trade mark regulation at all cost. The facts of the cases cited by the Court in support of its findings, however, cannot really be compared to the facts of the case before it (for example, the word elements “McBaby” and “McKids” are not altogether dissimilar as in the case of the word elements “Master” and “Coca”).*

*As the finding of a low similarity between the signs now in fact allows application of Art. 8(5) of the Community trade mark regulation, the Board of Appeal will have to examine whether there is a risk that the use without due cause of the mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade marks, taking into account the evidence submitted by The Coca Cola Company.*

*It is not clear how it can be inferred from the case law of the ECJ that the relevant evidence to be taken into consideration for the*

*purposes of establishing a risk of free-riding is not limited to the mark applied for. In the L’Oréal/Bellure case cited by the EGC (ECJ, C-487/07, 18 June 2009) L’Oréal SA and others attempted to prevent the use of their marks for imitations of fragrances with bottles and packaging similar to the marks. This is not the case here. These are not infringement proceedings against Mitico for the use of the labels and bottles, nor invalidity proceedings against a bad faith application, but opposition proceedings against a trademark application and it has to be determined if the use of the mark applied for might take unfair advantage of the repute of the Coca Cola marks.*

*Evidence of actual use of the mark in a different form (not only slightly modifying the registered mark but altering its distinctive character) which is similar to the Coca Cola marks might indicate bad faith of the applicant and enable the Coca Cola Company to prevent such infringing use. But it is not clear how one could infer from this evidence that the applicant is likely to take unfair advantage of the repute of the Coca Cola marks by making use of the mark as registered.*



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*Building Bridges*