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# NEWSLETTER

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IP NEWS FROM EUROPE AND GERMANY

March 2018

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## NEWS ABOUT US

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### Training Course on European Patent Law in October 2018

We kindly invite all of our clients to an advanced training course on European IP Law, taking place on our premises in Munich from 6 to 13 October, 2018!

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 seminar participants*



*Famous Neuschwanstein Castle*

- 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 European Union Trademark 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 **Dr. Ludwig von Zumbusch**, litigation specialist at Preu Bohlig & Partner and **Mr. Konstantin Schallmoser, LL.M.**, specialist on International Private Law and International Law on Civil Procedure also at Preu Bohlig & Partner.

Aside from work, a variety of social activities will be offered to participants, such as a trip to the famous Neuschwanstein Castle of king Ludwig II of Bavaria, 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 Bamberg

In autumn last year, our team made an excursion to the beautiful city of Bamberg in Franconia (northern part of Bavaria), which is a UNESCO world heritage site.



*Our team hiking on the “Frankenweg”*

During our visit we took a tour through Bamberg’s extended tunnel system which came into existence as early as medieval times, in search of sand used for scouring powder. In the 17th and 18th century, the tunnels were used as a storage place for wine and beer.

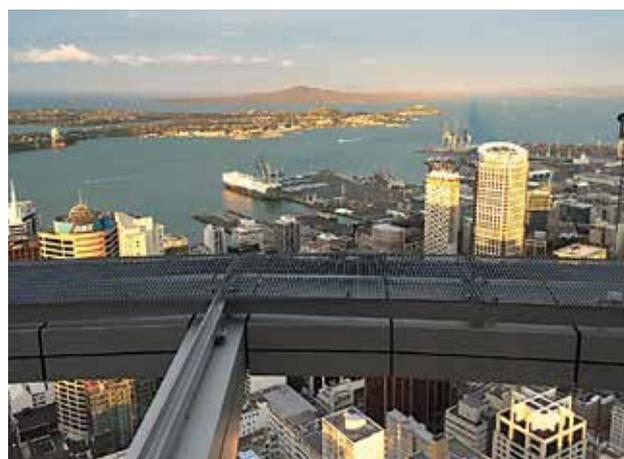
We also tasted the famous “Rauchbier” (smoked beer because brewed using malt roasted over open fire) and hiked the beautiful “Frankenweg”, a hiking trail extending across Franconia and other parts of Bavaria.

## APAA

**Dr. Utz Kador** attended the APAA Conference in November 2017 in Auckland, New Zealand. There, it was spring and the Manuka bushes were blossoming.

The conference in the downtown convention center was well attended so that Utz could greet many good friends and make new acquaintances.

A walk on the small ring around the Sky Tower at 200 meters altitude was quite an experience.



*View from the Sky Tower/Auckland*

## Enlarged Board of Appeal on criteria for the allowability of undisclosed disclaimers<sup>1</sup>

In a landmark decision, the Enlarged Board of Appeal (EBA) of the European Patent Office (EPO) recently decided on fundamental questions of law regarding the allowability of disclaimers.

A Technical Board of Appeal (TBA) had referred the following questions to the Enlarged Board of Appeal for decision<sup>2</sup>:

1. Is the standard referred to in G2/10 for the allowability of disclosed disclaimers under Art. 123(2) EPC, i.e. whether the skilled person would, using common general knowledge, regard the subject-matter remaining in the claim after the introduction of the disclaimer as explicitly or implicitly, but directly and unambiguously, disclosed in the application as filed, also to be applied to claims containing undisclosed disclaimers?

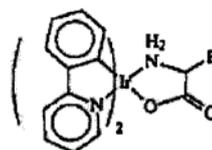
2. If the answer to the first question is yes, is G1/03 set aside as regards the exceptions relating to undisclosed disclaimers defined in its answer 2.1?

3. If the answer to the second question is no, i.e. if the exceptions relating to undisclosed disclaimers defined in answer 2.1 of G1/03 apply, in addition to the gold standard, may this standard be modified in view of these exceptions?

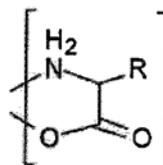
## A. The Appeal Proceedings

During the proceedings before the TBA, the proprietor submitted a request comprising the following claim:

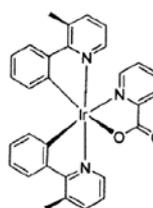
“Phosphorescent organometallic compound of formula  $L_2IrX$ , wherein  $L$  and  $X$  are inequivalent bidentate ligands,  $X$  is a monoanionic bidentate ligand, and the  $L$  ligands are monoanionic bidentate ligands each coordinated to Ir (iridium) through an  $sp^2$  hybridized carbon and a heteroatom, excluding the compounds having formula



wherein the ligand



is an  $\beta$ -amino acid residue selected from glycine, L-alanine, L-valine, D-leucine, L-proline, or L-phenylalanine and excluding the following compound:



The two negative features („disclaimers“) were introduced into the claim in order to restore novelty over two prior art documents (D5 and D7).

The TBA found that the two disclaimers were „undisclosed“, i.e. neither the two negative features nor the subject-matter excluded by it had a basis in the application as originally filed. The TBA had doubts whether the claim after the introduction of the disclaimers complied with the requirements of Art. 123(2) EPC, and whether the criteria set out

<sup>1</sup> G1/16 dated December 18, 2017, to be published in the OJ EPO

<sup>2</sup> T437/14 dated October 17, 2016, published in OJ EPO 2017, A50

in G1/03<sup>3</sup> relating to undisclosed disclaimers were applicable without modification or whether the fundamental disclosure test referred to decision G2/10<sup>4</sup> referring to disclosed disclaimers would exclusively or additionally be applicable.

## B. The EBA decision

In the present decision G1/16, the EBA first set out definitions for the term „undisclosed disclaimer“ and „disclosed disclaimer“ and further to the fundamental disclosure test referred to in G2/10 (also called „gold standard“ test).

### a. Definitions

An „undisclosed disclaimer“ relates to the situation in which neither the disclaimer itself nor the subject-matter excluded by it have been disclosed in the application as filed<sup>5</sup>.

The term „disclosed disclaimer“ relates to the situation in which the disclaimer itself might not have been disclosed in the application as filed but the subject-matter excluded by it has a basis in the application as filed, e.g. in an embodiment<sup>6</sup>.

The „gold standard“ test is the standard approach applied in the assessment of aspects of added subject-matter (Art. 123(2) EPC), of novelty (Art. 54 EPC) and of the validity of a claimed priority (Art. 87 EPC). According to the gold standard, any amendment to the parts of an European patent application or of an European patent can only be made within the limits of what a person skilled in the art would derive directly and unambiguously, using common general knowledge and seen objectively and relative to the filing date, from the whole of the documents of the application as filed<sup>7</sup>.

### b. Preceding Case Law

The EBA then summarized the fundamental former decisions G1/03 and G2/10. The answers given in G1/03 relating to the allowability of an undisclosed disclaimer, in so far as it is relevant to the present case, were the following:

*„1. An amendment to a claim by the introduction of a disclaimer may not be refused under Article 123(2) EPC for the sole reason that neither the disclaimer nor the subject-matter excluded by it from the scope of the claim have a basis in the application as filed.*

*2. The following criteria are to be applied for assessing the allowability of a disclaimer which is not disclosed in the application as filed:*

*2.1 A disclaimer may be allowable in order to:*

- restore novelty by delimiting a claim against state of the art under Article 54(3) and (4) EPC;*
- restore novelty by delimiting a claim against an accidental anticipation under Article 54(2) EPC; an anticipation is accidental if it is so unrelated to and remote from the claimed invention that the person skilled in the art would never have taken it into consideration when making the invention; and*
- disclaim subject-matter which, under Articles 52 to 57 EPC, is excluded from patentability for non-technical reasons.*

*2.2 A disclaimer should not remove more than is necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.*

*2.3 A disclaimer which is or becomes relevant for the assessment of inventive step or sufficiency of disclosure adds subject-matter contrary to Article 123(2) EPC.”*

<sup>3</sup> EBA G1/03 – “Disclaimer/PPG”, OJ EPO 2004, 448

<sup>4</sup> EBA G2/10 – “Disclaimer/Scripps”, OJ EPO 2012, 367

<sup>5</sup> G1/16, supra, reasons no. 14

<sup>6</sup> G1/16, supra, reasons no. 15

<sup>7</sup> G1/16, supra, reasons no. 17 and 18

In G2/10 relating to the allowability of a disclosed disclaimer, the Enlarged Board ruled as follows:

*“1a. An amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Article 123(2) EPC if the subject-matter remaining in the claim after the introduction of the disclaimer is not, be it explicitly or implicitly, directly and unambiguously disclosed to the skilled person using common general knowledge, in the application as filed.*

*1b. Determining whether or not that is the case requires a technical assessment of the overall technical circumstances of the individual case under consideration, taking into account the nature and extent of the disclosure in the application as filed, the nature and extent of the disclaimed subject-matter and its relationship with the subject-matter remaining in the claim after the amendment.”*

### **c. Reasoning of EBA in G1/16**

After having carefully analyzed the existing jurisprudence of the Technical Boards of Appeal on disclaimers and on pertinent national jurisprudence on disclaimers, the EBA first underlined the “ratio” of Art. 123(2) EPC being that an applicant or patent proprietor should not be allowed to improve his position by adding subject-matter not disclosed in the application as filed, as this would give him unwarranted advantage and could be damaging to the legal security of third parties relying on the content of the original application<sup>8</sup>.

The EBA then identified different types of undisclosed disclaimers (type A, B and C) which may be allowable under the criteria set out in answer 2.1 of G1/03 and undisclosed disclaimers (type D) which do not belong to any of types A to C and which do not fulfill the criteria laid down in answer 2.1 of G1/03:

Type A relates to an undisclosed disclaimer to restore novelty by delimiting the claim against state of the art under Art. 54(3) EPC (non-published prior art).

Type B relates to an undisclosed disclaimer to restore novelty delimiting the claim against an accidental anticipation under Art. 54(2) EPC (published prior art).

Type C relates to an undisclosed disclaimer to disclaim subject-matter which, under Art. 52 to 57 EPC is excluded from patentability for non-technical reasons.

Finally, type D relates to an undisclosed disclaimer which is intended to overcome other objections to patentability than those mentioned under answer 2.1 of G1/03 and/or the disclaimer removes more than is necessary to restore novelty or disclaim subject-matter excluded from patentability for non-technical reasons within the meaning of answer 2.2 of G1/03, and/or the disclaimer is or becomes relevant for the assessment of inventive step or sufficiency of disclosure within the meaning of answer 2.3 of G1/03. As type D clearly goes beyond the criteria laid down in G1/03, the present EBA ruled that its introduction cannot be justified by that decision<sup>9</sup>.

In its reasoning, the EBA first re-affirmed the finding of decision G2/10 that the gold standard disclosure test is the appropriate basis for assessing the allowability of a disclosed disclaimer under Art. 123(2) EPC. It added that the gold standard is the only test to be met in this situation<sup>10</sup>.

As the referring questions related to the assessment of undisclosed disclaimers under Art. 123(2) EPC, it had to be decided whether the gold standard test is also to be applied to the assessment of allowability of undisclosed disclaimers under Art. 123(2) EPC. The referring Board noted that if this was the case, virtually no chance would exist that an undisclosed disclaimer is found to be

<sup>8</sup> EBA G1/93 – “limiting feature”, OJ EPO 1994, 541, reasons, no. 9 and G1/16, supra, reasons, no. 36

<sup>9</sup> G1/16, supra, reasons no. 37

<sup>10</sup> G1/16, supra, reasons no. 41

allowable. As an undisclosed disclaimer relates to subject-matter and excluding subject-matter not being contained in the original application, the gold standard test cannot be met per definition.

The EBA ruled that the proper and exclusive test for the allowability of undisclosed disclaimers is whether the criteria of G1/03 are fulfilled. In other words, once an amendment by an undisclosed disclaimer has met the requirements of G1/03, the introduction of such an undisclosed disclaimer for legal reasons may be considered allowable under Art. 123(2) EPC without prejudice to the other requirements of the EPC.

No modifications are to be made to, nor any conditions are to be added, which go beyond the criteria of G1/03<sup>11</sup>. The EBA further made clear that after a claim amended by an undisclosed disclaimer has met the criteria laid down in G1/03, it is not open to the assessment under the gold standard disclosure test of G2/10.

The EBA added some clarifying remarks, particularly in view of the reasoning in G1/03 that an amendment to a claim must have *“no bearing on the technical information in the application”* as it considered this passage in G1/03 to have a potential for being understood too broadly and in too undifferentiated manner.

Thus, the example of a claim was considered which before an amendment reads *“a chemical compound characterized by formula X”* and being amended by the addition of the stipulation that *“X is not A”*. The original technical information is, accordingly, *“compounds of formula X achieve effect Y”* which is then reduced by means of the disclaimer to *“compounds of formula X-A achieve effect Y”*.

The EBA underlined that the amended claim contains different subject-matter based on different technical information. Nevertheless, in the above example, the technical teaching based on the subject-matter of the amended claims has

been changed by simply reducing the number of compounds now claimed to yield the desired effect Y<sup>12</sup>. As the information as to which compounds achieved effect Y constitutes an essential element of the technical teaching the correct question to be asked in this context is not whether an undisclosed disclaimer quantitatively reduces the original technical teaching (this being inevitably the case) but rather whether it qualitatively changes it in the sense that the applicant's or patent proprietor's position with regard to other requirements for patentability is improved. If this is the case, then the original technical teaching has been changed by the introduction of the disclaimer in an unallowable way<sup>13</sup>.

The EBA further expressed that the above concept of prohibition of a qualitative change in the original teaching applies in an absolute way, meaning in particular that the evaluation of inventive step has to be carried out disregarding the undisclosed disclaimer<sup>14</sup>. In this way, any unallowable modification of the original technical teaching in the assessment of inventive step is avoided.

Accordingly, the EBA in G1/16 provided the following answers to the referred questions:

*“In respect of question 1, the Enlarged Board, while confirming decision G1/03, holds that the gold standard disclosure test referred to in decision G2/10 is not the relevant test for examining whether a claim amendment by an undisclosed disclaimer complies with the requirements of Art. 123(2) EPC.*

*However, rather than simply answering that question in the negative, the Enlarged Board considers it appropriate also to provide the following clarification of how the criteria laid down in G1/03 are to be applied when assessing the allowability of an amendment to a claim by the introduction of an undisclosed disclaimer:*

<sup>11</sup> G1/16, supra, reasons no. 44

<sup>12</sup> In accordance with decision “Phosphatidylcholin” of the German Federal Supreme Court, see this Newsletter below

<sup>13</sup> G1/16, supra, reasons no. 46.2-46.4

<sup>14</sup> As proposed in T710/92, reasons, no. 5, not published in OJ EPO

***For the purpose of considering whether a claim amended by the introduction of an undisclosed disclaimer is allowable under Art. 123(2) EPC, the disclaimer must fulfill one of the criteria set out in point 2.1 of the order of decision G1/03.***

***The introduction of such a disclaimer may not provide a technical contribution to the subject-matter disclosed in the application as filed. In particular, it may not be or become relevant for the assessment of inventive step or for the question of sufficiency of disclosure. The disclaimer may not remove more than necessary either to restore novelty or to disclaim subject-matter excluded from patentability for non-technical reasons.***

*In the light of the answer given to question 1, the other two questions do not need to be answered.”*

### **Our Comment:**

*The present decision of the EBA provides fundamental and important supplemental criteria for applicants and patent proprietors on how to assess the allowability of a claim amendment consisting of a negative technical feature (“disclaimer”) where neither the disclaimer itself nor the subject-matter excluded by it have been disclosed in the application as filed (“undisclosed disclaimer”).*

*The EBA confirmed that exclusively the criteria laid down in order 2.1 of decision G1/03 are applicable to such undisclosed disclaimers but not the criteria according to the “gold standard” set out in G2/10 which are applicable to “disclosed disclaimers”. Accordingly, the present decision confirms the fundamental rulings in G1/03 and in G2/10 and further adds criteria how to discriminate between situations where the former or the latter criteria have to be applied. Therefore, this decision is certainly a fundamental and remarkable landmark decision giving applicants and patent proprietors further guidance in situations where a disclaimer may need to be added to a claim.*

### **German Federal Supreme Court on “undisclosed disclaimers”**

In a recent decision<sup>15</sup>, the German Federal Supreme Court (FSC), which was issued some months before the EBA of the European Office handed down decision G1/16 (see above), advanced its jurisdiction regarding the question of whether or not a feature introduced into a claim of a German patent application which was not originally disclosed (undisclosed disclaimer) may remain in the claim or must be regarded as an inadmissible extension beyond the original disclosure.

In the first head note of the decision, the FSC confirmed pertinent jurisdiction in that a patent application has to be rejected if the subject-matter of the claim extends beyond the content of the application as originally filed and this deficiency is not remedied by the applicant upon request by the examining section<sup>16</sup>.

In its second head note the FSC made clear that the introduction of a feature, according to which a claimed preparation may not contain a particular substance, does in general not constitute an inadmissible extension<sup>17</sup>.

The decision concerns an important situation for patent applicants amending a claim by a feature constituting a limitation, where neither the limiting feature nor the subject-matter of the amended claim is contained in the application as originally filed (so-called “undisclosed disclaimer”).

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<sup>15</sup> FSC – “Phosphatidylcholin”, decision of July 25, 2017, X ZB 5/16

<sup>16</sup> Continuation of FSC – “Regelventil” (“Control Valve”), decision of September 17, 1974, X ZB 17/73

<sup>17</sup> Limitation against FSC – “Reifenabdichtmittel” (“Agent for sealing tires”), decision of July 12, 2011, X ZR 75/08

Background of the case was a patent application filed before the German Patent and Trademark Office (GPTO) in May 2001 directed to a cosmetic preparation of sodium chloride and glycerin and its use in skin care products. Claim 1 prosecuted by the applicant was directed to the cosmetic, non-therapeutic use of 5 to 30 wt.-% of sodium chloride and 5 to 30 wt.-% of glycerin, based on the total weight of the preparation, respectively, in hand-care creams, purification milks, sun protection lotions, nutrition creams, day and night creams for the strengthening of the barrier function of the skin.

During the examination procedure, the applicant introduced the feature “*wherein this preparation is free of phosphatidylcholin*” into the claim. The examining section of the GPTO refused the application because the disclaimer was not disclosed in the application as filed.

The application documents as originally filed did not contain indications that certain substances, in particular phosphatidylcholine, should not be contained in the cosmetic preparation. Phosphatidylcholine as such was not literally mentioned in the application.

Nevertheless, the application mentioned soy oil as source of lecithin as one of various fatty acid glycerides, which may be used as an oil phase for the emulsion. Further, lecithin was mentioned as one of various emulsifiers. According to a specific embodiment, a preparation contained 5 wt.-% of glycerin and 7 wt.-% of sodium chloride, however, this preparation did not contain phosphatidylcholine.

The FSC considered that the person skilled in the art knows that phosphatidylcholine is a phospholipid belonging to the group of lecithins. The FSC mentioned that there was no hint derivable from the application documents in total that phosphatidylcholine is an essential component of the preparation or that its addition is regarded as advantageous.

Consequently, the FSC stressed that the introduced disclaimer expresses that among the possible variety of preparations disclosed in the application only those were excluded which contain phosphatidylcholine. The feature serves to limit the claimed subject-matter from the prior art. Accordingly, the FSC ruled that the introduced disclaimer, which as such was not disclosed in the application as filed, was allowable and did not extend beyond the content of the application as originally filed. Therefore, the FSC disagreed to the finding of the German Federal Patent Court who had found that the introduction of the disclaimer was not allowable.

It is interesting to note that the FSC further remarked that the allowability of the non-disclosed disclaimer in the present case is in accordance with the criteria applied by the Enlarged Board of Appeal (EBA) of the European Patent Office as regards the admissibility of the disclaimer for restoring of novelty vis-à-vis the prior art<sup>18</sup>. According to these EBA decisions, a disclaimer, i.e. a negatively formulated technical feature introduced into a claim by which certain embodiments or ranges of a general feature are excluded, is not allowable in case the limitation is technically relevant.

For the present case, the FSC found no hints that the feature “*wherein these preparations are free of phosphatidylcholin*” would imply an additional technical effect or in that the skilled person would receive new technical information thereby<sup>19</sup>.

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<sup>18</sup> EBA G1/03, G2/03 – “Disclaimer/PPG” and “Disclaimer/Genetic Systems”, OJ EPO 2004, 413 and 448; EBA G2/10 – “Disclaimer/Scripps”, OJ EPO 2012, 367

<sup>19</sup> See also this Newsletter discussing EBA decision G1/16 above

## Our Comment:

*This decision of the FSC is remarkable as it clarifies certain standards on the admissibility of non-disclosed disclaimers introduced into a patent claim of a German patent application. The jurisdiction confirms standard case law and renders more concrete the criteria under which a negatively formulated feature not contained in the original application documents may be introduced into a patent claim without extending beyond the content of the application document as originally filed. Therefore, the decision is well-balanced and advances pertinent case law in this regard.*

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## GERMAN TRADE MARK LAW

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### German Federal Supreme Court on Right-Preserving Use of Trademarks

In the recent decision<sup>20</sup>, the German Federal Supreme Court (FSC) expressed its view on the question whether the use of a trade mark in a form which deviates from the form as registered can still be seen as a right-preserving use of said trade mark.

This question is of high practical relevance because, as also recognized by the FSC in the decision, trade marks very often are used in a way which differs from the registered form e.g. because laudatory messages or informative statements are used together with the sign as registered. If, however, the additions lead to the finding that the sign used has a distinctive character which is different from the distinctive character of the mark as registered, the rights offered by the registration cannot be inferred against third parties anymore and, worse still, the trade mark may even get lost entirely in a cancellation action because of non-use.

<sup>20</sup> FSC – “Dorzo”, decision of May 11, 2017, I ZB 6/16 (BPatG)

The present FSC decision concerned an opposition against the word mark “Dorzo plus T STADA” based on the earlier registered trade mark “Dorzo”. Both trademarks were registered for, i.a., pharmaceutical products in class 05.

During the opposition procedure, the proprietor of the opposed trademark raised a non-use objection against the earlier mark and, to counter that, the opponent provided evidence that the trade mark had been used, i.a., in the following form:



Such an objection of non-use may e.g. be raised in an opposition procedure if the earlier mark was registered already five years or longer before the decision in the opposition is reached. The Supreme Court, accordingly, had to decide whether the use of the sign “Dorzo-Vision®” constituted proper, i.e. right preserving use of the registered mark “Dorzo”.

The relevant statute in the German Trade Mark Law in this regard is § 26 (3) which specifies:

*“The use of a trade mark in a form deviating from the registered form shall also be deemed to constitute use of the mark as registered, insofar as the deviations do not change the distinctive character of the mark. Sentence 1 shall apply even if the trade mark is also registered in the form in which it was used.”*

Thus, the question to be assessed by the Court was whether the addition of “-Vision®” changed the distinctive character of the mark “Dorzo” as registered.

The Court first acknowledged that an isolated use of word marks rarely happens in practice but rather a graphically designed sign possibly with added elements is used. Confirming previous decisions, the Court then pointed out that in the assessment whether a trade mark has been used in its registered form or in any deviating form it must be clarified whether elements added to the registered sign, such as additional words, pictures, shapes, colors, etc. have a relevant connection to the sign, or whether the additions are merely informative or laudatory statements or usual design elements which are independent from the trade mark and do not change its distinctive character.

The Court further pointed out that the decisive question to be answered in this regard is whether the public being aware of the differences still considers the deviating form as having an overall impression which is the same as the trade mark in the registered form.

In the case at issue, the Court confirmed the opinion of the first previous instance (the German Patent Court) that in the sign as shown in the above figure there is a connection between the term “Dorzo” and the added term “-Vision®”, evidenced by the fact that the words are written in the same colour and font style, and are directly attached to each other.

The Court found that, accordingly, the public would perceive the used sign as one uniform sign. It continued to state that this perception of the public would be strengthened by the fact that the “®”-sign, which is attached to trade marks to indicate their registration, was added at the end of the sign as used, thus (incorrectly) suggesting that the sign as a whole was registered.

Based on these considerations, the Court came to the conclusion that the sign as used had a

different distinctive character as the registered mark “Dorzo” and denied that the use of the sign “Dorzo-Vision®” constituted proper, i.e. right preserving use of the registered mark “Dorzo”.

The Court also refused the main argument of the opponent, namely that the term “Dorzo” has an independent distinctive position within the used sign “Dorzo-Vision®”, because “Vision” was merely an allusion to the goods’ purpose (eye drops) so that its distinctive character would be preserved. Here the Court pointed out that also “Dorzo” was an allusive term, namely for the active ingredient dorzolamide, and that, in any case, the question whether the mark as registered has independent distinctive position within the used sign is not relevant for determining the perception and distinctive character of the used sign.

The Federal Supreme Court summarized its conclusions in the following three head notes:

*“a) The supplementation of an otherwise unchanged trade mark by additions does not constitute use of the mark in the registered form in accordance with § 26 (1) Trade Mark Act, if the additions are recognizably linked to the sign. In this case, it is use of the mark in a form other than the registration (§ 26 (3) sentence 1 MarkenG).*

*b) If the public no longer recognizes the trade mark sign used with additions (here: Dorzo-Vision®) as a separate product identifier (here: Dorzo), the deviation fundamentally alters the distinctive character of the trade mark, so that use as per § 26 (3) sentence 1 MarkenG cannot be assumed.*

*c) In assessing whether the use of a trade mark in a form differing from its registered form changes its distinctive character, it does not matter whether the mark has an independent distinctive position within the specific form of use.”*

## **Our Comment:**

*As the Federal Supreme Court has correctly pointed out, it is common practice that a mark is not used in the form as registered but is supplemented by all kind of graphical, laudatory and informative additions. The Supreme Court has made it quite clear that wherever the supplemental elements lead to the fact that the public no longer perceives the sign as consisting of the trade mark as registered but rather as independent sign which comprises the original trademark only as one of its components, such a use is no longer preserving the rights of the trademark owner.*

*This has severe consequences because the trade mark owner may no longer rely on the trade mark to prevent the registration of similar marks (as in the present case) and the trade mark may even get lost if attacked in a cancellation action by a third party due to non-use. Thus, it is of utmost importance prior to the use of a trade mark in forms different from the registered form to carefully assess whether or not these differences change the distinctive character of the trade mark.*



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*Building Bridges*