
NEWSLETTER

IP NEWS FROM GERMANY AND EUROPE

DECEMBER 2011

I. NEWS ABOUT US

New Office in Innsbruck/Austria



“Goldenes Dachl” in the center of Innsbruck
(picture: Innsbruck Tourism)

We are very pleased to announce the opening of our new branch office in Innsbruck, Austria. The city of Innsbruck is also known as “the heart of the Alps” and is beautifully situated in the Inn river valley surrounded by mountains up to almost 2300 m high. Innsbruck is frequented by many tourists and is a skier’s paradise, but we will of course focus on work and are pleased to offer the full range of our services and knowledge in the field of intellectual property.

Our Innsbruck office’s address is:

**Kador & Partner
Bienerstrasse 2A
A-6020 Innsbruck**

and we can be contacted there by phone

+43 512 58 33 12

or by mail

mail@kadorpartner.at

More details can be found on our general website

www.kadorpartner.com

We look forward to welcoming our clients at the new spot!

New Support

We are pleased to announce new support for our team:

Lydia “Lilli” Neumann, born 1976, joined Kador & Partner as a Patent Attorney Trainee in January 2011.



Lydia “Lilli” Neumann

Lilli studied biology at Ludwig-Maximilians-University in Munich. Her main focus was on genetics, biochemistry, molecular biology and physical chemistry. She graduated in 2002 with a Diploma in Biology. For her diploma thesis she spent one year in Great Britain at the Sainsbury Laboratory in Norwich. During this time she worked on immunity and disease resistance in plants.

For her doctorate Lilli came back to Ludwig-Maximilians-University in Munich, this time to the Institute for Immunology at the Faculty of Medicine. She worked on tumor biology, specifically examining gene regulation of proteins associated with human melanoma.

Dr. Sebastian Siebenhaar, born in 1981, joined Kador & Partner as a Patent Attorney Trainee in May 2011.

Sebastian studied biochemistry at the University of Bayreuth, focusing on bioorganic chemistry, macromolecular chemistry, genetics and microbiology. He finished his studies in 2006 with his diploma thesis on the recombinant preparation of protein thioesters.



Dr. Sebastian Siebenhaar

His dissertation at the Department of Bioorganic Chemistry at the University of Bayreuth dealt with the heterologous expression and chemical modification of protein fragments and with the semi-synthesis of uniform glycoproteins by native chemical ligation. His doctorate was awarded “summa cum laude”.

Office Excursion to Padua/Italy

This year the Kador team went on a cultural trip to Padua, which is one of the oldest towns of Italy.

It would not have been like us, especially like Dr. Kador, not to go hiking somewhere in the area. After a big tempest we went up to the lovely “Colli Euganei”, a beautiful hilly landscape with vineyards and known as the Prosecco area of Italy.



The Kador Team before the hike

Of course, we also enjoyed the wonderful Italian food and wine, were introduced to the interesting history of Padua during a guided city tour, and explored the surroundings.



Villa Pisani

ECTA Conference, Stockholm

This year's Annual ECTA Conference took place in Stockholm, Sweden, at the very best moment of the Swedish summer, in June.

Our office was represented by **Ms. Barbara Regensburger** who enjoyed gathering information on current trade mark and design topics, especially a more detailed insight into the "Study on the Overall Functioning of the European Trade Mark System" by the Max Planck Institute for Intellectual Property and Competition Law (MPI), commissioned by the European Commission.

As always, the social events were also very pleasurable and at the best places in Stockholm, such as the welcome reception at the City Hall (venue of the Nobel Prize banquet), a dinner at the VASA Museum, where the delegates went by boat and had magnificent impressions of Stockholm.

INTA, San Francisco

In May 2011, **Dr. Utz Kador and Ms. Corinna Probst**, attorney at law at Kador & Partner, travelled to San Francisco to take part in the 133rd INTA annual meeting. As always, it was a great opportunity to exchange ideas, discuss important issues and meet with clients and colleagues from all over the world.

As in previous years, COMTAI (Community Trade Mark Advisory Initiative), an association of Munich attorneys of which Kador & Partner is an active member, organized a harbor cruise on the occasion of the INTA conference. During the boat tour, which offered a fantastic view of San Francisco's skyline, attendees had the chance to test their knowledge of European trade mark law in an entertaining trade mark quiz. During the quiz, our colleague Ms. Probst presented the case Zyro/zero, where, in spite of identity of goods, the Board of Appeal of the Office for Harmonization decided that there was no likelihood of confusion. Would you have guessed?



COMTAI harbor cruise with Corinna (middle) and colleagues.

Lecture in Wuxi/China

On the occasion of a business trip to China, **Dr. Bernhard Pillep** was invited to give a lecture on the European patent and trade mark system by the local government of Wuxi/China, which is a dynamic city close to Shanghai.

The lecture was well attended and a vivid discussion took place during and after the event, which was continued at a wonderful, delicious dinner together with Chinese colleagues and representatives of the government.

II. EUROPEAN PATENT LAW

Finland Accedes to the London Agreement

On of November 1, 2011, the London Agreement has entered into force for Finland as the 17th EPC contracting state.

This means that for European patents granted with effect for Finland on or after November 1, 2011, a Finnish translation of the European patent specification no longer needs to be filed if the patent is granted in English or if an English translation of the patent is filed with the Finnish Patent Office in accordance with Art. 65(1) EPC. However, a Finnish translation of the claims still has to be filed.

New Options for Applicants under PCT Chapter II with EPO Acting as IPEA

The European Patent Office (EPO) has announced¹ that it will revise its practice under Rule 66.4 PCT when acting as International Preliminary Examining Authority (IPEA) in the procedure under Chapter II PCT. Accordingly, a further opportunity is provided for a dialogue of the applicant with the EPO in its capacity as IPEA, in reaction to a negative first written opinion.

The current practice of the EPO when acting as IPEA is to issue only one written opinion to which the applicant may file a reply. As a next communication, the International Preliminary Examination Report (IPER) is issued, regardless of whether or not the Examiner is convinced by the applicant's arguments which were filed in reply to the written opinion.

In the revised procedure, the EPO will now issue one additional written opinion ("second written opinion") before issuing a negative IPER, in which a time limit will be set within which the applicant may reply by filing further arguments and/or amendments. A request for such a second written opinion need not be filed, however;

the second opinion will be issued on the condition that the applicant filed a reply to the first written opinion established by the EPO in due time.

According to the new procedure, the applicant may also file a request for a consultation by telephone. As a rule, the EPO will grant such a request only once.

If the applicant files a request for consultation by telephone *before* a second written opinion is issued, the applicant, after the consultation has taken place, will be sent the minutes of the consultation together with an invitation to submit further amendments and/or arguments within a specified time limit. In such a case, no second written opinion will be issued, as the telephone consultation is regarded as replacing the second written opinion.

If the applicant requests a consultation by telephone **and/or** a second written opinion *before* the second written opinion is issued, the EPO will decide on the most appropriate way and will either consult the applicant by telephone or establish a second written opinion.

However, if the applicant files a request for consultation by telephone *after* a second written opinion has been issued, the minutes of the consultation will be sent to the applicant, but will only be accompanied by an invitation to submit further amendments and/or arguments if agreed upon during the consultation by telephone.

The time limit for replying to a second written opinion/minutes of a telephone consultation will normally be between 1 and 2 months. The new practice will apply to International applications for which the time limit for establishing the IPER will expire on or after December 1, 2011, unless the IPER is established before October 1, 2011 (Rule 69.2 PCT).

Our comment:

The new practice of the EPO acting as IPEA can be highly appreciated. It will hopefully help to re-establish the International Preliminary Examination Procedure before the EPO (Chapter II PCT) as a true dialogue between the Examiner and the

¹ see Official Journal EPO 2011, pp. 532-535

applicant, with a real possibility to overcome objections raised by the Examiner in the first opinion.

In the standing practice, the applicant had only “one shot” to reply to a negative written opinion, and experience shows that in many cases this was not enough to have the Examiner appropriately consider the arguments and/or amendments filed as a reply.

On the basis of the EPO’s announcement and the accompanying description of the new procedure, it seems that the most appropriate way to act as an applicant after filing an appropriate reply to the first negative opinion is to wait for the second written opinion and to request a telephone consultation when filing the reply to the second opinion. By doing so, the applicant can fully exhaust all new options given.

In any case, the new procedure should help to increase the number of positive International Preliminary Examination Reports which in turn will be very helpful when entering the national phases of the PCT application.

Enlarged Board of Appeal on Admissibility of Disclaimers Based on Disclosed Embodiments

The Enlarged Board of Appeal of the EPO recently gave a ruling² on the following question, which had been referred to it with decision T 1068/07 of June 25, 2010:

“Does a disclaimer infringe Article 123(2) EPC if its subject-matter was disclosed as an embodiment of the invention in the application as filed?”

Case T 1068/07 concerned an application for a specific catalytically active DNA molecule defined mainly by a particular first and second binding region. The applicant had filed requests in which in claim 1 a disclaimer was used corresponding to subject-matter which was disclosed as an embodiment of the invention. The disclaimer had been introduced into the claim in order to distinguish it from a prior art document

that belonged to the same technical field as the claimed invention.

In the reasons for the decision, the Enlarged Board of Appeal, after a thorough analysis of the question which had been referred to it, first came to the conclusion that a reformulated version of it should rather be answered, which is:

“Does an amendment to a claim by the introduction of a disclaimer disclaiming subject-matter disclosed in the application as filed infringe Art. 123(2) EPC?”

The Board then summarized and analyzed the pertinent case law, in particular prior decision G 1/03, which dealt with the issue of so-called undisclosed disclaimers, i.e. disclaimers which have no basis whatsoever in the application as filed. In the case law of the Technical Boards of Appeal following G 1/03 different views had been taken as to whether G 1/03 may also be applied to disclaimers disclaiming embodiments which originally are disclosed as being a part of the invention, as in the present case.

In accordance with G 1/03 the Enlarged Board in the present decision first concluded that the term “disclaimer” means an amendment to a claim resulting in the incorporation therein of a “negative” technical feature, typically excluding from a general feature specific embodiments or areas. (see 2.2 of the reasons for the decision).

With respect to the term “embodiment” the Enlarged Board pointed out that this term is commonly used to define a specific combination of features or a specific mode of carrying out the invention. However, as a disclaimer usually does not exclude a specific “embodiment” only, but a plurality of embodiments, the Enlarged Board decided to construe “embodiment” in a wider sense, so as to include whole (sub-)groups or areas of the claimed subject-matter.

On the basis of these definitions, the Enlarged Board discussed the applicability of decision G 1/03 to the present case, and came to the conclusion that, being specifically directed to the situation in which neither the disclaimer nor the subject-matter excluded by it has a basis in the application as filed, G1/03 is not applicable to the present case.

²Case G 2/10 of August 30, 2011, not yet published, but can be downloaded from EPO website

Rather, the test for admissibility of an amendment to a claim disclaiming subject-matter disclosed as part of the invention in the application must be whether or not the skilled person is confronted with new technical information, i.e. with subject-matter, which he would not derive from the application as filed directly and unambiguously, using common general knowledge.

In this regard the Enlarged Board emphasized that this assessment cannot be done schematically, in the sense that the question posed can e.g. be unequivocally answered in the affirmative or negative. Rather, a case-by-case assessment and decision is necessary.

Thus, in every case, regardless of whether a disclaimer or positively defined feature is introduced into a claim, the assessment of whether or not the amendment is in accordance with Art. 123(2) EPC has to be based on the overall technical circumstances.

Moreover, the Enlarged Board clarified in its decision that

“with this provision, i.e. subject to the claimed subject-matter fulfilling the requirements of the EPC, the applicant is free, i.e. he is entitled, not to claim protection for an embodiment or even a part of the disclosed invention.” (see item 4.5.5, fourth paragraph of the reasons for decision)

The Board summarized its conclusions in the following answers:

“1a. An amendment to a claim by the introduction of a disclaimer disclaiming from it subject-matter disclosed in the application as filed infringes Art. 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.”

Our comment:

With the present decision, the Enlarged Board of Appeal, by giving very elaborate reasons, probably disappoints the hopes of the referring Board for a universally valid answer to the question posed. It has made clear that the mere fact that a disclaimed embodiment has been disclosed as an embodiment of the invention leads neither to the admissibility nor to the inadmissibility of the disclaimer. Rather, the subject-matter of the claim including the disclaimer has to be determined and it has to be assessed whether this (amended) subject-matter has a basis in the application as filed.

All in all, the decision can be agreed with because the Enlarged Board is correct in ruling that an amended claim including a disclaimer must have a basis in the application, thus going back to the essence of Art. 123(2) EPC. It remains to be seen, however, how such cases will be judged by the Boards of Appeal in practice, as it seems that the body of jurisprudence developed for the assessment of the allowability of incorporation of “positive” features cannot be directly transferred to disclaimer cases. In any case, a decisive issue will certainly be whether or not the new claim has to be seen as a new combination of features which was not present in the application as filed.

III. GERMAN PATENT LAW



Decision “Kosmetisches Sonnenschutzmittel III” of the German Federal Supreme Court on Inventive Step³

The decision concerned an invalidation action against a patent directed to a dermatological composition for UV protection of skin, including UV-A and UV-B filtering compounds. The UV-A filter compounds used were dibenzoyl methane derivatives (Compounds 1) and the UV-B filters triazine derivatives (Compounds 2). The composition furthermore comprised certain acrylate compounds (Compounds 3) which were also active as UV-B filters.

³German Federal Supreme Court, decision of March 01, 2011, X ZR 72/08

In the patent it was explained that the invention had been made based on the finding that Compounds 3 could stabilize Compounds 2 which, without stabilization, would readily degrade in the presence of Compounds 1 used as UV-A filters.

The prior art as cited by the plaintiff showed a different picture, however. One document disclosed a UV protective composition comprising Compounds 2 as well as Compounds 3 as UV-B filters. Furthermore, it was indicated in this document that it would be desirable to also have a UV-A filter in the composition. A further prior art document disclosed Compounds 1 as UV-A filters in a composition together with Compounds 3 as a UV-B filter.

The Court came to the conclusion that by starting from the first prior art document and combining its disclosure with the second prior art document, the skilled person would come to the invention in an obvious way. Furthermore, the Court stressed that for the assessment of inventive step even an appropriately formulated object may not necessarily be the sole starting point for the assessment of inventive step, but that it should be considered as well whether the technical solution of the patent may have been obvious when trying to solve a different technical problem pertaining to the same field of objects (see especially item (19) of the reasons).

The Court continued that when determining the problem underlying an invention for assessment of inventive step, it has to be determined what in fact the invention objectively achieves over the prior art and that an object described in the patent itself represents merely an aid in the assessment of the objective technical problem. This was in conformity with prior decisions, such as e.g. "Fettsäurezusammensetzung", decision of February 24, 2011, X ZR 121/09.

The patent was finally revoked.

In this decision, the Federal Supreme Court had also to decide the question of whether or not limited claims, which had been accepted during the limitation procedure at the EPO may be objected to as lacking clarity in German invalidation proceedings. The Court came to the conclusion that, as lack of clarity is not a ground for revoca-

tion of a granted patent, this also applies to a patent which has been maintained by the European Patent Office in a limitation procedure with amended claims.

The Court summarized its decision in the following two headnotes:

"1. As a starting point for the evaluation of inventive step one may not exclusively consider the "problem" to be solved according to the description of the patent in suit, but one should also consider whether solving a (different) problem belonging to the field of activity of the skilled person has rendered this solution obvious (in continuation of the "Hochdruckreiniger" decision).

2. A patent claim which was limited in a European limitation procedure before the European Patent Office in accordance with Art. 105(a), 105(b) EPC may, for lack of a relevant ground for invalidation, not be examined for clarity (Art. 84 EPC) in a German invalidation procedure any more than the patent claims of the granted patent."

Our comments:

This decision of the German Federal Supreme Court can be agreed with in both main points as expressed in the head notes.

The first point concerning the starting point and formulation of the objective technical problem in the assessment of inventive step is very well in line with previous decisions of the Court, and with the related jurisdiction of the Boards of Appeal of the EPO.

In essence, the Court emphasizes that for the assessment of inventive step a "neutral" view has to be taken on the pertinent prior art and all possible motivations for the skilled person to come to the claimed invention in an obvious manner must be considered. While the Court also acknowledges that the problem outlined in the patent may be one of the possible starting points, it stresses that other possible ways must be taken into account.

This takes account of the fact that often not all prior art is duly considered when a patent application is drafted or when the applicant chooses to draft and express the problem behind a claimed subject-matter in a rather subjective way.

In the second point decided by the Court it was made unmistakably clear that invalidation actions before the German authorities are independent of European procedures and hence, cannot be seen as a kind of continuation of those proceedings. Thus, possible attacks on the patent due to lack of clarity cannot be introduced into invalidation proceedings “through the back door”, even if the claims have undergone a limitation procedure before the EPO. This part of the decision can be highly appreciated because, as experience shows, lack of clarity objections may be raised almost in all cases and German legislation therefore rightly did not allow this kind of objection in invalidation actions, like the EPC, in which lack of clarity is not a ground for opposition.

IV. EUROPEAN TRADE MARK LAW

Mediation at OHIM

The Community Trade Mark Office (“Office of Harmonization for the Internal Market”, OHIM) has recently introduced a mediation service, which will be an alternative to proceeding with an appeal to the Boards of Appeal in trade mark and design cases.

The service has been offered since October 24, 2011, by a team of OHIM’s experienced staff, that has undergone special training in preparation for it. Mediation is only available where the matter at issue is already under appeal and the normal appeal fee in the amount of € 800 has thus been paid.

If the parties travel to OHIM’s premises in Alicante, no further fees will have to be paid for using an OHIM mediator. However, if OHIM’s Brussels office is used, a fee in the amount of € 750 will become due for the mediator’s travel expenses.

Our comment:

We welcome OHIM’s new approach, as Kador & Partner already has an office in Alicante and it will be convenient for our clients to use this new service there. Mediation can be a very successful route to resolving disputes between parties as it is more flexible than litigation before the courts and it can make far more commercial sense for the parties.

European General Court on Bang & Olufsen 3D Trade Mark

By decision of October 6, 2011, in case T-508/08, the European General Court confirmed the contested decision of the First Board of Appeal of OHIM of September 10, 2008, which rejected Bang & Olufsen’s application for registration of the three-dimensional sign



as a Community Trade Mark for goods in classes 9 (loudspeakers, etc.) and 20 (music furniture), considering the sign to consist exclusively of a shape which gives substantial value to the goods within the meaning of Article 7(1)(e)(iii) of the Regulation on the Community Trade Mark (CTMR)⁴. This is the second time the General Court had to deal with Bang & Olufsen’s application.

OHIM’s examiner had first rejected the application for lack of distinctiveness of the sign. The First Board of Appeal had confirmed this finding, but the General Court, by judgment of October 10, 2007, in case T-460/05 decided that the sign does not lack any distinctiveness because it does not represent one of the customary shapes of the goods in the sector concerned or a mere variant of those shapes, thus enabling it to distinguish the goods from those of another commercial origin.

Giving effect to this first decision of the General Court, the First Board of Appeal of OHIM annulled the examiner’s decision in so far as it held that the mark applied for was not devoid of any distinctive character, but then applied the abso-

⁴ Art. 7(1)(e)(iii) CTMR reads : „...The following shall not be registered:...signs which consist exclusively of...the shape which gives substantial value to the goods”

lute ground for refusal of Article 7(1)(e)(iii) of the CTMR⁵ and rejected the application.

In its present second decision, the General Court declared that for the goods at issue, the design is an element which will be very important for the consumer's choice, even if the consumer also takes other characteristics of the goods at issue into account. The Court stated that it is apparent from the evidence, and the applicant itself admitted, that the specific design of the product increases its appeal and makes an important selling point.

The Court recalled that the immediate purpose in barring registration of merely functional shapes or shapes which give substantial value to the goods is to prevent the exclusive and permanent right which a trade mark confers from serving to extend the life of other rights which the legislature has sought to make subject to 'limited periods'.

The Court concluded that the Board of Appeal was correct in holding that the shape in respect of which registration was sought gives substantial value to the goods concerned, adding that the fact that the shape is considered to give substantial value to the goods does not preclude that other characteristics of the goods, such as the technical qualities, may also confer considerable value on the goods at issue.

Our Comment:

The absolute ground for refusal of Article 7(1)(e)(iii) CTMR applies to signs which consist exclusively of shapes which give substantial value to the goods.

According to the General Court, for this ground for refusal to apply, it is not necessary that the design of the product is the only or main reason for the consumer to purchase it, but rather it is sufficient that the design is "very important" in the consumer's choice and therefore gives substantial value to the product.

This means that any sign which consists exclusively of a shape is barred from registration if this shape is a specific design which substantially increases the

appeal of the product and is an important reason for the consumer to decide to purchase it, even if other reasons, such as the technical qualities, also confer considerable value on the goods.

By contrast, German case law applies this ground for refusal rather restrictively only to cases where the consumer will see the value of the product only in the design itself, as is the case for objects of art. As the consumer e.g. does not buy the "ROCHER" chocolate ball only for its specific shape, but also for its taste, the ground for refusal of the "shape which gives substantial value" was not found to apply to the ROCHER chocolate ball.

It now remains to be seen whether the General Court's interpretation of Article 7(1)(e)(iii) CTMR will be confirmed by the Court of Justice. If so, the German authorities will have to adapt their jurisdiction, and trade marks such as HERMES' "Kelly Bag" will have to be considered to fall under this ground for refusal.



Similarity of Signs and Scope of Protection Involving Trade Marks with a High Reputation

In a very concise decision (EGC, 27.09.2011, T-207/09 – NIKE/NC NICKOL), the General Court of the European Union annulled a contested decision of the Second Board of Appeal of the OHIM (Case R 554/2008-2). The reason was that the Board of Appeal had assessed the similarity of an earlier trade mark of Nike International Ltd. and the mark applied for (see below) in a contradictory manner, by finding a lack of similarity between the marks when assessing the existence of likelihood of confusion but a sufficient degree of similarity between the same signs for the application of Article 8(5) of the Regulation on the Community Trade Mark (CTMR) on the protection of marks with a reputation.

The trade marks in question were the following:



⁵ See footnote 4

The applicant of the “NC NICKOL” mark regularly - and sometimes successfully - seeks to register marks that strongly resemble well-known marks.

In the annulled decision, the Board of Appeal first came to the conclusion that there are sufficient differences between the marks to rule out a likelihood of confusion, and even declared the signs to be dissimilar.

The Board then proceeded to assess the conditions for the application of Article 8(5) CTMR, which are the reputation of the earlier mark, identity or similarity between the marks, and the likelihood that the use of the younger mark would take unfair advantage of or damage the reputation of the older mark.

This Article allows the owner of a mark with a reputation to oppose the registration of a younger mark if these three conditions are fulfilled, even if the goods or services at issue are dissimilar. The European Court of Justice has made clear that this protection also applies in the case of identical or similar goods or services (see ECJ, 23.10.2003, C-408/01 – adidas). Therefore, registration of a younger mark which is not confusingly similar to a mark with a reputation can still be rejected if there is some similarity between the marks and it is likely that the use of that mark would take unfair advantage of the older mark.

In the annulled decision, the Board of Appeal further stated that for Article 8(5) CTMR to apply it is sufficient that the degree of similarity between the mark with a reputation and the sign applied for is such that the relevant section of the public establishes a link between the sign and the mark (see ECJ ‘adidas’).

The Board then again assessed the similarity between the signs and this time declared that “the visual differences are outweighed by the similar overall visual impression of the signs that is caused by the combination of the common features, i.e. the similarly tilted letter ‘N’, and the highly similar curved line (“the swoosh”) which is very prominent in both marks and which, even on its own, is a highly distinctive sign due to its reputation and is well known by the relevant public to be a mark of NIKE. The text ‘NICKOL’ in the mark applied for is also quite negligible due to its small size in the mark, all the more so when

used on the spectacles themselves.”

The Board concluded that the marks are sufficiently similar for the relevant consumer to establish a link between the signs at issue and that it is likely that, by using the contested trade mark, the applicant will take unfair advantage of the repute and the consistent selling power of the earlier trade mark

In another contradiction to its previous findings, the Board also stated that “the relevant public could be led to believe that the goods bearing the contested trade mark were produced under control or license of the opponent since the goods have a clear connection”. This assumption should have led the Board to declare the existence of likelihood of confusion between the marks.

The General Court called to mind that in order for the protection of a mark with a reputation to apply, the similarity between or identity of the two marks at issue is an essential condition.

According to the case law, when, in view of the application of Article 8(1)(b) CTMR (likelihood of confusion), there is a lack of similarity between the mark applied for and the earlier mark, that lack of similarity also precludes the application of Article 8(5) CTMR (see EuCJ, 11.12.2008, C 57/08 - Gateway/ACTIVITY Media Gateway).

The concept of similarity between the marks at issue is the same in the case of a refusal to register a mark applied for because of a likelihood of confusion and of refusal because of damage to the reputation of an earlier mark. In both situations, the condition of similarity between the mark and the sign requires the existence, in particular, of elements of visual, aural or conceptual similarity, so that, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects.

The Court concluded that the Board of Appeal erred in law when assessing the similarity of the marks in a contradictory manner, by declaring the signs dissimilar when assessing the likelihood of confusion and finding a sufficient degree of similarity between the same signs for the application of Article 8(5) CTMR.

Our comment:

The ratio of the General Court's present decision can be agreed with, because it is certainly correct to interpret terms, such as "similarity", in the CTMR in a consistent manner. This reason alone led the Court to annul the Board of Appeal's decision.

Unfortunately, the General Court did not give a ruling on the substantive issue of whether or not the signs in question are to be regarded as similar. It appears that there are at least several visual similarities (e.g. the typical Nike "swoosh" used for the lower part of the "C" in the attacked trade mark) that could very well lead to the finding that there is similarity between the signs.



KADOR & PARTNER

80496 München
Corneliusstraße 15
Phone: +49 89 2015252
Fax: +49 89 2015242
+49 89 2014454
mail@kadorpartner.com

6020 Innsbruck
Bienerstrasse 2A
Phone: +43 512 58 33 12
mail@kadorpartner.at

London SW1V 1QL
99 Warwick Way
Phone: +44 20 78348589
Fax: +44 20 76300286
mail@kadorpartner.com

03001 Alicante
Castaños 10 - Atico 3
Phone: +34 965 215758
Fax: +34 965 215758
mail@kadorpartner.com

www.kadorpartner.de

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