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# NEWSLETTER

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IP NEWS FROM GERMANY AND EUROPE

JANUARY 2010

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## I. NEWS ABOUT US

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### New Support

In times of global changes, we are especially pleased to introduce our new support for the patent team:



Dr. Laura Fè

**Dr. Laura Fè**, born in 1972, joined Kador & Partner in September 2009 as a European Patent Attorney, after having worked in various large international pharmaceutical companies for several years.

Ms. Fè obtained a degree in Physical and Inorganic Chemistry from the University of Parma, Italy, and a PhD from the University of Leuven, Belgium. Her dissertation dealt with the syn-

thesis and crystallization behavior of complex metal oxides and their application in the semiconductor industry.

At Kador & Partner she handles patent cases in different fields ranging from inorganic chemistry to pharmaceutical technology. In addition to her mother tongue Italian, Dr. Fè is fluent in English, speaks Dutch and has a basic knowledge of French and German.

### Trade Mark Lecture Vienna

In October 2009, **Ms. Susanna Heurung**, attorney at law at Kador & Partner, gave a speech in Vienna on the occasion of an annual meeting between the Austrian and the German Chambers of Commerce. In her talk she focused on practical requirements for getting a trade mark registered, the necessity to develop non-descriptive terms and also recommendations on use requirements of registered trade marks. Kador & Partner has been a member of the German Chamber of Commerce for 35 years now.

## Office trip to San Sebastian

This year's trip took the Kador team to San Sebastian, Spain. As Dr. Kador is a passionate "Camino de Santiago hiker", we all shared the pleasure of walking 20 km of the Camino together.



We followed the sign.

It was a lovely experience and we enjoyed the landscape and the beautiful path all together.



The Kador team enjoying a short rest...

A highlight of each evening was a visit to several tapas bars. In the Basque language "tapas" are called "pinxos". Finally, we also had some cultural activities. For example, we went to the famous sculpture park dedicated to the Spanish artist Eduardo Chillida, who was born in San Sebastian. If you are interested, more information can be found at

<http://www.museochillidaleku.com/tasting>

## LESI Conference Manila

The Licensing Executives Society International (LESI) is an association of **32 national and regional societies** composed of professionals who have an interest in the transfer of technology, or licensing of intellectual property rights - from technical know-how and patented inventions to software, copyright and trademarks.

This year, the LES Annual Conference, hosted by LES Philippines in Manila, took place in June 2009. **Dr. Kador** participated in this meeting and gave a lecture on "*The importance of oppositions at the European Patent Office*". This conference is always an adequate occasion to exchange IP knowledge throughout the world.

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## II. EUROPEAN PATENT LAW

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### Important Amendments of the EPC Implementing Regulations

According to two decisions of the Administrative Council of the EPO dated March 25, 2009<sup>1</sup>, the Implementing Regulations to the European Patent Convention (EPC) will be amended as of April 1, 2010.

These amendments relate to a variety of regulations, especially for the examination proceedings. They have in common that the handling of European patent applications will be facilitated for the European Patent Office, but for the applicant the procedural options will be limited or further burdens imposed.

#### a) Changes in the practice for filing divisional applications

Rule 36 EPC has been amended to read as follows:

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

*(a) the divisional application is filed before the expiry of a time limit of twenty-four months from the Examining Division’s first communication in respect of the earliest application for which a communication has been issued, or*

*(b) the divisional application is filed before the expiry of a time limit of twenty-four months from any communication in which the Examining Division has objected that the earlier application does not meet the requirements of Article 82, provided it was raising that specific objection for the first time.*

*(2) A divisional application shall be filed in the language of the proceedings for the earlier application. If the latter was not in an official language of the European Patent Office, the divisional application may be filed in the language of the earlier application; a translation into the language of the proceedings for*

*the earlier application shall then be filed within two months of the filing of the divisional application. The divisional application shall be filed with the European Patent Office in Munich, The Hague or Berlin.”*

By these provisions, the EPO severely restricts the period during which a divisional application may be filed. Up to now, filing of a divisional application was possible during the whole time during which the parent application was still pending.

As of April 1, 2010, the applicant has to observe a 24-month time limit for filing a divisional application, starting on the date of the Examining Division’s first communication on the earliest application from which the divisional application derives (Rule 36(1)(a) EPC).

The “first communication” means the first substantive examination report of the Examining Division, in contrast to the European Search Opinion annexed to the European Search Report.

**It is very important to note that after the expiry of the 24-month term of Rule 36(1)(a) EPC no divisional application may be filed any more, unless the (exceptional) scenario of Rule 36(1)(b) EPC applies.**

In the scenario of Rule 36(1)(b) EPC, the applicant is granted a further 24-month time limit for filing a divisional application in case the Examining Division issues a communication in which the Examiner objects to a lack of unity of the invention.

It should be specifically noted that the **new time limits according to Rule 36 cannot be extended and are not subject to a request for further processing** (amended Rule 135(2) EPC).

To cope with situations where the 24-month time limit according to amended Rule 36(1) EPC has already expired before April 1, 2010, a transitional provision stipulates:

*“If the time limits provided for in amended Rule 36(1) EPC have expired before 1 April 2010, a divisional application may still be filed within six months of that date. If they are still running on 1 April 2010, they will continue to do so for not less than six months.”*

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<sup>1</sup> Official Journal EPO 5/2009, pp. 296-304.

Accordingly, in situations where the 24-month time limit already expired on April 1, 2010, or will expire at a date less than 6 months from April 1, 2010, the applicant has the opportunity to still file a divisional application until October 1, 2010. This 6-month time limit, too, may neither be extended nor is it subject to a request for further processing (Art. 3, 3rd sentence of the Decision of the Administrative Council of 25 March 2009).

**Our comment:** *With these (and other) provisions the European Patent Office severely restricts the procedural possibilities of the applicant. For example, the tactical filing of a divisional shortly before grant of the parent application is no longer possible. The applicant needs to verify at a much earlier time whether or not certain parts of the invention disclosed in the earliest application should be or must be prosecuted in one or more divisional applications.*

*Furthermore, the 24-month time limit develops a retroactive effect as it also applies to all pending applications. Thus, a considerable administrative effort is required to verify cases where the 24 months already expired or will expire soon and where a decision whether or not to file a divisional has not yet been finally made. For the latter situation, **October 1, 2010**, is the very last date for filing a divisional application.*

**Thus, we kindly ask all of our clients to inform us soon in case assistance is needed with the monitoring of the time limit for filing divisional applications.**

#### **b) Applications containing more than one independent claim per category – Rule 43(2) EPC**

Even in case the requirement of unity of invention (Art. 82 EPC) is met, a European patent application may only contain more than one independent claim per category where one of the following exceptional circumstances set forth in Rule 43(2) EPC is given:

The independent claims relate to

- a plurality of interrelated products,
- different uses of a product or apparatus
- alternative solutions to a particular problem, where it is inappropriate to cover these alternatives by a single claim.

Otherwise, the European patent application is considered as being unclear (Art. 84 EPC).

The regulations currently in force do not allow the EPO to put forward an objection under Rule 43(2) EPC at the search stage, i.e. all claims have to be searched regardless whether or not the claim set complies with Rule 43(2) EPC.

Under new Rule 62a(1) EPC, the EPO can already issue a communication prior to carrying out the search, requesting the applicant to indicate the claims on the basis of which the search is to be carried out within two months. In case no response is filed the search is carried out only on the first claim in each category.

The finding of the Search Division may be challenged during search and examination and, if the search examiner is persuaded by the reply or the examining division finds that the objection was unjustified, the search will be carried out, if necessary anew, on the unsearched subject-matter.

However, if the objection persists, the claims must be restricted to the subject-matter searched, as claims may not be amended to unsearched subject-matter not sharing a single inventive concept with the searched subject-matter, i.e. the claims not searched must be excised from the application and can only be further pursued in a divisional application.

Thus, in case the EPO issues a communication under Rule 62a(1) EPC the claims to be initially searched should be carefully chosen because the claims which were not searched can only be pursued in one or more divisional applications in case the objections cannot be overcome.

#### **c) Applications for which no meaningful search for the whole or part of the claims can be carried out**

In case the European patent application is considered not to comply with the EPC such that a meaningful search of a part or the whole of the subject-matter claimed is not possible, the EPO currently issues a reasoned declaration or draws up a partial search report in case this is possible (current Rule 63 EPC).

Under the new Rule 63 EPC the EPO will issue a communication informing the applicant that a meaningful search cannot be carried out over a part or the whole of the range claimed and requests that a statement be filed indicating the subject-matter to be searched. The search will then be conducted based on the statement of the applicant. In case all objections are overcome, a full search report will be drawn up.

In case no response is filed, or the response is not considered to remedy all objections, a reasoned declaration or a partial search report will be issued as under the current Rule 63 EPC.

Under the new Rule 63 EPC the objections can be challenged at the examination stage.

Taken literally, new Rule 63 EPC provides that instead of directly issuing a reasoned declaration or drawing up a partial search report, the applicant is given the opportunity to correct alleged deficiencies or to provide an explanation of the claimed subject-matter to receive a full search report. However, it is reasonable to assume that objections under the new Rule 63 EPC will be issued more frequently by EPO examiners, as the changes are intended to increase the quality of the patent applications. It remains to be seen how the EPO practice in this regard will develop.

#### **d) Reply to the extended European search report or the supplementary search report issued for EURO-PCT applications for which the EPO did not act as ISA**

At present, the EPO issues an extended European search report (EESR) for direct EP applications or a supplementary European search report for European regional phase applications (EURO-PCT) for which the EPO did not act as international searching authority (ISA). Such search reports usually contain a first opinion of the Examiner regarding the patentability of the application. A reply thereto is currently not required, although recommendable as in case no response is filed the objections brought forward in the search report are usually repeated in the first report during substantive examination.

Starting from April 1, 2010, a reply must be filed to the search opinion accompanying the above-mentioned search reports. The due date for

such a reply is usually six months from the publication date of the extended or supplementary European search report. In case no reply is filed the application is deemed withdrawn. Of course, a reply is not required in case the search opinion is entirely positive.

#### **e) European regional phases of PCT applications for which the EPO acted as ISA or IPEA**

New Rule 161(1) EPC concerns European regional phases of PCT applications (EURO-PCT) for which the EPO acted as international searching authority (ISA) or, in case a demand under Art. 31 PCT (Chapter II demand) has been filed, as international preliminary examination authority (IPEA).

In case the EPO acted as ISA, neither a supplementary nor an extended European search report for the EURO-PCT application is drawn up. Hence, the opinion of the examiner currently comes with the first examination report issued by the EPO usually setting a four-month term which is extendable at least by two months.

Under new Rule 161(1) EPC the EPO may issue a communication under Rule 161(1) EPC requesting to correct the deficiencies mentioned in the international search report (ISR) or the international preliminary report on patentability (IPRP). The due date for a reply to such a communication is **one month and not extendable**.

Hence, in case PCT applications are intended to enter the European regional phase a detailed analysis of the IPRP (or the ISR) should be made when it is issued, as otherwise the time for a discussion of the raised objections is quite short upon receipt of the communication under Rule 161(1) EPC.

All the above-described changes enter into force on April 1, 2010, and apply to European patent applications for which the respective communication is issued after the above date.

## Notice from the European Patent Office concerning internet citations as prior art documents<sup>2</sup>

The EPO has recently issued a notice on the usage of internet publications, especially on the assessment of the date the content of the publication was made available to the public (“publication date”).

Disclosures on the internet form part of the state of the art according to Art. 54(2) EPC and Art. 33(2) PCT. In some technical fields, e.g. information and software technology, relevant prior art is often only available via the internet.

To establish the publication date it must be assessed separately whether a given date is indicated correctly and whether the content in question was indeed made available to the public.

The nature of the internet can make it difficult to establish what was published and when, as not all web pages mention their publication date and they are often updated. An archive or records of the changes are often unavailable. Furthermore, manipulation is possible.

The standard of proof applied is the balance of probabilities, whereby the examining division “must be convinced that the publication date is correct”.

The burden of proof initially lies with the examiner but shifts to the applicant in case, on the basis of the balance of probabilities, the examiner comes to the conclusion that the publication was made publicly available at a particular date. The applicant then has to show that the assumed publication date is incorrect.

The reliability of a given internet publication date is regarded in accordance with the internet source. The notice from the EPO differentiates between the following sources

- a) technical journals,
- b) other “print equivalent” publications,
- c) non-traditional publications, e.g. usenet groups, blogs, and
- d) disclosures which have no date or an unreliable date.

Publications a) are considered to have high reliability. Publications by e.g. academic institutions, international organizations, newspapers, periodicals, standardization bodies (e.g. ASTM/ISO) fall into category b) and are also considered to have high reliability.

The publication date of type c) publications is more difficult to access. However, they usually contain computer-generated time-stamps or a “last-modified” entry which is treated as the publication date by EPO examiners.

For type d) publications, corroborating evidence is required showing the relevant publication date. Internet archiving services such as the so-called “Wayback Machine” ([www.archive.org](http://www.archive.org)) may be used here.

In case no date can be reliably determined the Examiner may nevertheless cite the publication in the search report together with a short explanation of why the document has been cited. Consequently, said disclosure becomes publicly available on the publication date of the search report. Said publication may then not be relevant for the patent application for which the search report is drawn up, but for patent applications having a filing/priority date after the publication date of the search report.

## Decision on the “Principle of prohibition of double patenting”<sup>3</sup>

In a recent decision, the Technical Board of Appeal 3.3.07 has expressed its view on the applicability of the so-called principle of prohibition of double patenting under the European Patent Convention (EPC). In brief, the Board acknowledged that in spite of missing regulations under the EPC, this principle is applicable. The Board summarized its view in the following head notes:

*I. The principle of prohibition of double patenting, namely that the inventor (or his successor in title) has a right to the grant of one and only one patent from the European Patent Office for a particular invention as defined in a particular claim is applicable under the EPC, and can be deduced from the provision of Article 60 EPC stating “The right to a European patent shall belong to the inventor or his successor in title.”*

<sup>2</sup>Official Journal EPO,8-9/2009, p. 456 et seqq.

<sup>3</sup>Decision of Technical Board of Appeal 3.3.07 dated July 03, 2007, T307/03, Official Journal EPO7/2009, pages 422-432

II. Decision T587/98 (Official Journal EPO 2000, 497) to the effect (see its point 3.6) that there is no basis in the EPC prohibiting “conflict claims” is not followed.

III. A double patenting objection can be raised also where the subject-matter of the granted claim is encompassed by the subject-matter of the claim later put forward, that is where the applicant is seeking to re-patent the subject-matter of the already granted patent claim, and in addition to obtain patent protection for other subject-matter not claimed in the already granted patent. In particular, where the subject matter which would be double patented is the preferred way of carrying out the invention both of the granted patent and of the pending application under consideration, the extent of double patenting the claims of the pending application should be confined to the other subject-matter that is not already patented, to allow the examination procedure to focus on whether a claim to this other subject-matter meets the requirements of the EPC.

The detailed considerations which lead the Board to the above conclusions are given in the “Reasons for the Decision”, items 2.1 to 2.7. The Board concludes that the principle of prohibition of double patenting applies under the EPC in spite of the fact that the EPC, unlike certain national legislation, contains neither in the Convention itself nor in the Implementing Regulations any provisions relating to the question of double patenting.

The Board derives the applicability of this principle from Art. 60 EPC which states that “*the right to a European patent shall belong to the inventor or his successor in title*”. The Board concludes that once a patent has been granted to the inventor, the right to a patent under Art. 60 EPC has been exhausted and the European Patent Office is entitled to refuse to grant a further patent for the subject matter for which the inventor has already been granted a patent.

Further considerations are given in item 2.3. Here, the Board states that for practical reasons no legitimate interest can be recognized for anyone having two or more identical patents with the same claims. Among the practical considerations given in item 2.3 the Board states that “*double patenting is expensive and most proprietors would not wish to incur the expense. The legislator cannot be expected to have made provisions to regulate what will on grounds of economics alone be a very rare occurrence*”.

In item 2.5 reference is made to Enlarged Board of Appeal (EBA) decisions G1/05 and G1/06 (Official Journal of the EPO 2008, pages 271 and 307, respectively). In point 13.4 of these decisions the existence of the principle of prohibition of double patenting has already been acknowledged by the EBA.

A further decision of the Board of Appeals (T9/00, Official Journal EPO 2002, page 275) is cited in item 2.6 where especially the principle has been stressed that no one is entitled to have an administrative authority or a court take a second substantive decision on a case which has already been settled.

Finally, in item 2.7 of the reasons the Board discusses and disagrees with decision T587/98 (Official Journal EPO 2000, page 497) where it was decided that neither Art. 125 EPC (which requires the European Patent Office to take into account the principle of procedural law recognized in the contracting states in the absence of procedural provisions in the EPC) nor the provisions relating to divisional applications prevent “conflicting claims”.

**Our comment:**

*The present decision confirms the practice of the European Patent Office prohibiting “double patenting”, as described e.g. in the “Guidelines for Examination in the European Patent Office, C-IV 7.4.*

*The reasons given by the Board, however, are not completely convincing. First, the practical considerations as to the costs of double patenting should not have any impact on the legal question of whether or not the principle of prohibition of double patenting should be applied under the EPC (item 2.3 of the reasons). Furthermore, Art. 60 EPC, which assigns the right to a European patent to the inventor or his successor in title, seems to be interpreted very broadly in order to derive the principle of prohibition of double patenting from it.*

*The main justification for applying this principle is, thus, rather to be seen in the fact that it is present in many of the national European patent systems. Unfortunately, as regards other principles present in the national patent systems, such as the cross appeal, the Boards have not shown the same courage to apply those principles also under the EPC in spite of lacking provisions.*

*The Board already pointed out in head note II that there is a conflicting decision which has not been followed. Thus, a final clarification of this matter must come from the Enlarged Board of Appeal. In this regard, however, the statement in decision G1/05 and G1/06 to which the present decision refers in item 2.5 already makes it quite clear that the Enlarged Board of Appeal will tend to follow the ratio of the present decision.*

*This decision means for the applicants that even more care will have to be exercised when drafting claim sets for divisional applications in order to make sure that no subject matter is covered which is already covered in the previous application.*



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### III. GERMAN PATENT LAW

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Several important changes to German patent law (Patentgesetz, PatG) entered into force on October 01, 2009.

#### Compulsory licenses for pharmaceutical products intended for export into least-developed countries

New § 85a PatG has been added which is a result of Regulation No 816/2006 of the European Union establishing a procedure for the grant of compulsory licenses in relation to patents and supplementary protection certificates concerning the manufacture and sale of pharmaceutical products, in case such products are intended for export to eligible (least developed countries) countries.

§ 85a PatG defines the competency of the German Federal Patent Court for the grant of compulsory licenses based on Regulation No. 816/2006.

#### Changes to the nullity proceedings (§§ 111 et. seqq. PatG)

Previously (before October 1, 2009) the appeal proceedings before the second instance (Bundesgerichtshof, BGH) were a “full trial”, i.e. all facts and submissions of the first instance had to be completely discussed anew. Furthermore, the introduction of new facts and evidence into the appeal proceedings was easier compared to the new regulations. Often, less effort was made in the first instance proceedings before the German Federal Patent Court (Bundespatentgericht, BPatG) and the main discussion on the case was made during appeal.

The changes to the patent act strengthen the first instance, as the appeal proceeding is now based on the facts ascertained by the first instance. The main focus of the appeal is now the assessment of whether errors of law, fact or procedure were made.

The possibilities of introducing new facts and evidence in the appeal stage have been severely limited. The introduction is basically limited to facts and evidence which

- concern an aspect overlooked or considered immaterial by the first instance,
- were not claimed in the first instance due to a lack of procedure, or
- were not claimed in the first instance in case this was not based on negligence of the party.

Furthermore, the possibility of filing new requests has also been limited for the complainant and the patentee in the appeal proceedings. New requests are only allowable in case they are a result of new facts and evidence introduced into the proceedings (cf. above), are considered as being relevant by the appeal court or are accepted by the opponent.

In turn, the court of first instance is now required to point out relevant facts and issues which have not been amply discussed by the parties. The parties can focus the discussion on the relevant issues and, in addition, all facts and evidence on the issues considered relevant by the first instance court can be presented by the parties.

***Our comment:** Owing to the recent changes to the German Patent Act, the parties to nullity proceedings must be careful to provide all relevant facts and evidence as well as a full discussion thereof in the first instance proceedings. The patentee must also already carefully consider the filing of suitable auxiliary requests of sets of claims with a more limited scope of protection during the first instance.*

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## IV. EUROPEAN TRADE MARK LAW

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### Decision of the European Court of First Instance on evidence of genuine use<sup>4</sup>

In a decision dated May 13, 2009, the European Court of First Instance (CFI) gave important guidelines on the evergreen question of evidence of genuine use of a trade mark in opposition proceedings.

In the case, the company Leder & Schuh AG (the “applicant”) had applied for registration of the figurative Community trade mark “jello Schuhpark and design“ for goods including footwear. The application was opposed by the company Schuhpark Fascies GmbH (the “opponent”) based on the earlier German word mark “Schuhpark”, also registered for footwear.

In the course of the proceedings, the applicant requested evidence of use. In response, the opponent filed a copy of a verdict of The Higher District Court of Hamm, exemplary tags of the concerned goods, a declaration of the opponent’s sales manager, six brochures, seven copies of advertisements and one plastic bag showing the opponent’s prior trade mark.

While the Opposition Division of the Office for Harmonization in the Internal Market (the “OHIM”) granted the opposition, the Appeal Division found that genuine use of the earlier trade mark had not been sufficiently demonstrated for goods but only for retailing services and therefore rejected the opposition. Before the CFI, the opponent presented new evidence including pictures of shoes bearing the earlier trade mark, a confirmation of one of the opponent’s suppliers regarding the delivery of the concerned goods in the relevant period of time, a testimony of one of the opponent’s proxy holders and several decisions of German civil courts.

The CFI found that, according to the relevant provisions of the Community Trade Mark Implementing Regulation (CTMIR), evidence of use must show the territory, time, extent and kind of use of the earlier mark. A trade mark shall be considered as genuinely used where use is consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Where the company name of the opponent is identical to the earlier trade mark concerned, genuine use of a trade mark can only be assumed where the sign is used either on the goods or at least “in relation to the goods or services” concerned. Similarly, where a company sells goods that are actually produced by a third party, this company must use its company name, or the corresponding, identical trade mark, either directly on the goods or “in relation to” the goods concerned.

Regarding the verdict of the Higher District Court in Hamm, the CFI confirmed the Appeal Division’s ruling that without knowing the contents of the court’s file, the Appeal Division did not know the facts leading to the verdict and could therefore not consider the verdict as suitable evidence. Also, even if the verdict was considered, it could only show that the opponent had sold shoes bearing the trade mark but did not contain any indication of the place, time and extent of use of the trade mark as required by the CTMIR.

With respect to the advertisements, brochures and plastic bag presented by the opponent, the CFI again confirmed the Appeal Division’s ruling and found that these documents could only show the opponent’s use of the earlier trade mark for retailing services but not for shoes. The reason for this was that the documents did not show shoes bearing the earlier mark but only shoes showing no mark at all or trade marks of a third party. The sign was also not used “in relation to” shoes but only as a company name, i.e. as an indication for the consumers of where the shoes shown on the documents could be acquired.

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<sup>4</sup> CFI, decision dated May 13, 2009, legal case T-183/08 – Schuhpark/jello Schuhpark.

The CFI then held that sample tags and the declaration of the opponent's sales manager were not suitable to demonstrate that the opponent had actually sold shoes bearing the tags. In particular, the opponent had at no time submitted evidence that would have supported the sales figures given in the sales manager's declaration and that could have demonstrated the extent and frequency of the use of the earlier trade mark according to the requirements of the CTMIR.

The CFI finally rejected all evidence that had been introduced to the proceedings only before the CFI but not before OHIM as inadmissible.

**Our comment:** This decision once again shows how difficult it can be to submit suitable evidence of genuine use in opposition proceedings. In our experience, the OHIM as well as the CFI are rather strict and trade mark owners are therefore well advised to continuously collect suitable evidence. The availability of suitable evidence of genuine use should always be considered as one of the relevant factors for the chances of success before initiating any proceedings against a younger trade mark.

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## V. GERMAN TRADE MARK LAW

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### New Grounds for Opposition

Due to recent changes in the German Trade Mark Act, an opposition against a younger trade mark may now also be based on a prior company name as well as unregistered trade marks.

**Our comment:** In Germany, rights to an unregistered trade mark may exist where the sign has acquired prominence as a trade mark among the trade circles concerned due to the use of the sign. However, no details are regulated in the German Trade Mark Act. The competent authorities refuse to settle on any fixed value for the percentage at which a trade mark should be considered as having acquired prominence. It is therefore usually quite arduous to establish that a trade mark has acquired protection as an unregistered right.

In contrast, a company name is automatically protected in Germany when it is used in the course of trade. We therefore expect that a considerable number of oppositions may be based on company names in the future. As a consequence, when choosing a trade mark, applicants should consider the enhanced possibilities of proprietors of a company name to protect their rights in opposition proceedings. Not all companies are registered in trade registers and protection of a company name depends on use rather than registration in a trade register. We therefore recommend including prior company names in searches prior to filing in order to ensure that the future trade mark owner has the best possible overview over existing prior rights in order to be able to make an informed decision about the future trade mark.



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