



Newsletter December

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News

Unified Patent Court Agreement (UPCA) advancing by the inch 02

The German Federal Court of Justice approves accession to opposition proceedings even after a motion for preliminary injunction has been filed 03

Intellectual Property

EU-wide competence and applicable law for multi-territorial property right infringements – ECJ „Nintendo / BigBen“ 04

Another decision of the OLG Düsseldorf regarding the FRAND objection 09

Regarding the Requirements for an „Offer to sell“ under Patent Law and Conclusions drawn from the final product about the content of an offer 11

Possibility of change not enough for patent infringement: The Regional Court of Mannheim has issued a clarifying decision on the BGH shunting trolley case 14

The difference between „distinctive trademark“ and „independent distinctive role“ for the assessment of serious trademark use 16

Awards

JUVE Handbuch Wirtschaftskanzleien 17/18 02

FOCUS Spezial Magazine: Preu Bohlig & Partner is once again „Top Business Law Firm of 2017“ 06

Best Lawyers Germany 2018 - Intellectual Property Law 15

Best Lawyers Germany 2018 - Health Care Law 20

Lectures and Seminars

Seminars in Tokyo on German and European patent law and on the IP protection of artificial intelligence 18

Seminars on Current Developments in the Protection of Intellectual Property Rights in Japan and Germany 19

Current Lectures and Seminars 20

Would you like to receive our newsletter 21

Our Locations 22

Unified Patent Court Agreement (UPCA) advancing by the inch

At the end of October / beginning of November, various institutions started or completed further steps toward ratification of the UPC. At the end of October, the Scottish Parliament approved the UPC's Privileges and Immunities Protocol, thereby clearing the way for Scotland to ratify the last puzzle piece that had been missing from the jigsaw puzzle of British ratification of the UPCA.

Important steps forward were taken in November and December in both chambers of the British Parliament. A committee of members of the House of Lords and of the House of Commons did not formulate any objections against the Privileges and Immunities Protocol. The House of Commons approved on 4 December 2017 the Protocol. On 6 December 2017, the House of Lords Grant Committee also approved the Protocol. Last steps to be taken in United Kingdom are now approval by the House of Lords (probably before 15 December 2017) and final approval of the Privy Council, most probably in January 2018. After these final steps the British Government can ratify the package consisting of UPCA, Protocol on Provisional Application and the Privileges and Immunities Protocol.

Great Britain would be the 15th member state to ratify the UPCA. So far there have still not been any announcements or indications from the UK of not wanting to ratify the UPCA after all or of postponing ratification. Accordingly, ratification by the UK is expected in January or February 2018.

Further ratifications by Latvia and Slovenia are imminent. According to Art. 89 UPCA, after a ratification by the United Kingdom, only Germany would still have to deposit its instrument of ratification. All other requirements cited in

Art. 89 UPCA have in the meantime been satisfied.

However, there is nothing really new to report from Germany, specifically from the Federal Constitutional Court. Even though by now both appellant and grounds of appeal are known, there has not been any announcement from the Federal Constitutional Court regarding next steps. The only thing that is clear is that the comment period for national and state governments and other interested associations (DAV, EPLAW) has been extended to 31 December 2017. Therefore, a detailed timetable for the Agreement's coming into force will likely not be drawn up before the end of February.



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The German Federal Court of Justice approves accession to opposition proceedings even after a motion for preliminary injunction has been filed

In its 29 August 2017 ruling on the matter “Ratchet Wrench” (file no. X ZB 3/15), the German Federal Court of Justice (“Bundesgerichtshof” - BGH) made it clear that even a third party against whom the patent owner has filed for a preliminary injunction on account of patent infringement may accede to opposition proceedings as opponent. This issue had been controversial in both case law and legal literature. Preu Bohlig & Partner had already obtained a ruling to this effect from the German Federal Patent Court in 2011, which the BGH has now taken up explicitly.

In its 29 August 2017 ruling on the matter “Ratchet Wrench” (file no. X ZB 3/15), the German Federal Court of Justice (“Bundesgerichtshof” - BGH) made it clear that even a third party against whom the patent owner has filed for a preliminary injunction on account of patent infringement may accede to opposition proceedings as opponent. This issue had been controversial in both case law and legal literature. Preu Bohlig & Partner had already obtained a ruling to this effect from the German Federal Patent Court in 2011, which the BGH has now taken up explicitly.

The decisive aspect for the BGH was that with the receipt of the application for preliminary injunction the area of mere out-of-court proceedings against third parties has been left behind and a level of dispute has been reached that is tantamount to the filing of legal action and can no longer be categorised as part of an out-of-court dispute (margin number 26).

Moreover, the defence against the infringement may be hopeless or economically unsound and that the party attacked on the basis of the patent cannot be denied the option to choose an appropriate defence strategy that is limited to attacking the legal validity of the patent. According to the BGH, it cannot be justified that the party attacked should have to challenge the patent holder in the main action and thus have to enter into legal proceedings in which the party attacked must accept the patent's validity to be asserted against said party itself (margin number 27).

This ruling must be welcomed unequivocally. Following re-

cent, fairly pragmatic approaches by the BGH in its “Kurz-nachrichten” ruling of 16 September 2014 (X ZR 61/13), allowing the preliminary stay of compulsory execution proceedings after a first-instance destruction in line with § 719 sect.1 German Code of Civil Procedure [Zivilprozessordnung, ZPO], this ruling represents another step of the BGH toward rectifying the repercussions of the “Separation Principle” that bestow unfair advantages on a participant. The fact that one-sided, systemic advantages are a thorn in the side of the BGH had been made sufficiently clear by the chairman of the 10th Civil Senate, Prof. Meier-Beck, in his case law review of the year 2014 (GRUR 2015, 721). Along the same lines, in his essay „Bifurkation und Trennung“ [“Bifurcation and Separation”] (GRUR 2015, 929) Prof. Meier-Beck discusses a number of considerations aimed at offsetting or mitigating the disadvantages of the Separation Principle. Ultimately, the goal is to preserve appeal of national patent litigation ahead of the UPCA.



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EU-wide competence and applicable law for multi-territorial property right infringements – ECJ „Nintendo / BigBen“

The EU Trade Mark Regulation (EUTMR) and Community Design Regulation (CDR) each comprise provisions concerning international competence (Art. 125 EUTMR and Art. 82 CDR, respectively) and concerning the scope of court rulings (competence to decide) (Art. 126 EUTMR and Art. 83 CDR, respectively). Regarding the question of applicable law, these provisions refer to national laws, including the provisions of Private International Law (Art. 129 EUTMR, Art. 88 CDR) for all matters which are not covered by the relevant provision. Sanctions that arise not directly from these regulations as such (right to information, disclosure of account, determination of liability for damages, destruction and recall of infringing goods, publication of rulings as well as the reimbursement of attorney fees / patent attorney fees) are, pursuant to Art. 8 para. 2 of the Rome II Regulation (regulation (EC) no. 864/2007), subject to the law of the EU member state where they take effect. In the highly anticipated ruling „Nintendo Co. Ltd. / BigBen Interactive GmbH et al.“ of September 27, 2017 (German Association for Industrial Property and Copyright (GRUR) 2017, 1120 et seq.), the ECJ stipulates important exceptions for cases with multiple defendants and in case of acts of infringement pertaining to multiple member states.



1. The ECJ had to address the question whether a national court may within the scope of infringement proceedings concerning a Community Design also impose *EU-wide sanctions* against additional defendants domiciled in another member state, in addition to a defendant who was domiciled within the court's jurisdiction.

The issue of the applicable law, which had to be addressed by the ECJ, concerned Art. 8 para. 2 of the Rome II Regulation, which stipulates that in case of non-contractual obligations in the context of an infringe-

ment of *unitary Community intellectual property rights*, the laws of the member state *where the infringement was committed* shall be applicable to matters which are not covered by the relevant EU legislative instrument. The specific issue that had to be addressed was how the location "where the infringement was committed" should be determined in Art. 8 para. 2 Rome II Regulation, if the infringer offers design-infringing goods for sale on a website and if this website is - also - aimed at other member states besides the one where the infringer is domiciled.

2. The ECJ ruling was pronounced in the context of two submissions from the Higher Regional Court (OLG) in Düsseldorf in the matter of „Fernbedienung für Videospielkonsolen“ (“Remote Control for Video Consoles”) (GRUR 2016, 616) and „Balance Board“ (GRUR-RS 2016, 02936). In both proceedings, Nintendo filed a Community Design action against BigBen, a company domiciled in France (BigBen France) and its affiliate domiciled in Germany (BigBen Germany). Both defendants distributed accessories for the game console “Wii” which is manufactured by Nintendo. The parent company BigBen France manufactured the accessories compatible with the Wii game console and directly offered these accessories for sale on its own website for consumers in France, Belgium, Luxemburg and other countries. BigBen Germany was in charge of selling and distributing these accessories in Germany and Austria via its own website. Orders placed by consumers with BigBen Germany were passed on to BigBen France and then delivered from France. As a consequence, Nintendo filed a suit against BigBen France and BigBen Germany at the Regional Court of Düsseldorf for injunctive relief, provision of information, disclosure of accounts, determination of liability for damages, destruction and recall of the contested goods, on charges of design infringement without any territorial restriction.

3. While the international competence and EU-wide competence to decide of the seized court for BigBen Germany followed clearly from Art. 82 para. 1, 83 para. 1 CDR, the international competence for claims against BigBen France was based on Art. 79 para. 1 CDR in conjunction with former Art. 6 no.1 of the European Convention on Jurisdiction and the Enforcement of Judgements (ECJEU) (regulation (EC) no. 44/2001). In cases with multiple defendants, the CDR does not stipulate any priority regulations, so the ECJEU remains applicable (Art. 79 para. 1 CDR). This equally applies to EUTMR regulations (Art. 121 para. 1 EUTMR). Former Art. 6 no. 1 ECJEU (now: Art. 8 no.1 ECJEU – regulation (EC) no. 2015/1215) provides that actions against joint defendants domiciled in different member states may

be filed at the court of the location where one of the defendants is domiciled, provided that the individual lawsuits are closely related to each other to such an extent that joint proceedings and rulings seem warranted in order to avoid separate proceedings that might result in contradictory rulings.

Although the Regional Court of Düsseldorf affirmed its international competence for the French parent company pursuant former Art. 6 no. 1 ECJEU, the court limited the scope of its ruling for secondary claims not directly covered by the CDR to acts carried out by the parent company BigBen France in connection with deliveries to BigBen Germany. This interpretation of former Art. 6 no. 1 ECJEU, where the international competence regarding a defendant domiciled in another member state is affirmed while the scope of the ruling is limited to acts carried out in connection with the acts forming the base for the lawsuits, was rejected by the ECJ (para. 53 et seq.).

4. Referring to a court ruling still pronounced within the context of the former Community Trade Mark Regulation (regulation (EC) no. 40/94) in the matter „DHL Express France“ (GRUR 2011, 518), the ECJ explains that the territorial scope of an injunctive relief based on a Community Trade Mark is limited by the *territorial competence* and by the *territorial scope of the exclusive law* applicable to the proprietor of the infringed Community Trade Mark (para. 53). Due to the similarities between the Community Trade Mark Regulation and the Community Design Regulation, the ECJ applies this approach directly to the EU-wide injunctive relief (Art. 89 para.1 lit. a CDR) in case of Community Design infringements (para.54).

The ECJ, however, goes further than that and also applies the same principles in determining the territorial scope for orders issued by a EU Trade Mark Court or a Community Design Court, respectively, regarding other sanctions and measures which are not directly derived from EU Law, but from national law (para. 55).

Regarding the grounds of an internationally competent court's EU-wide competence to decide even on any secondary claims governed by the national law of a member state, the ECJ refers in particular to the objective of the CDR, which is to effectively protect rights pertaining to Community Designs in the entire European Union. According to the ECJ, this objective, which follows from the 29th recital of the CDR, is of paramount importance since the Community Design is harmonised and has, pursuant to Art. 1 para. 2 CDR, the same effect in the entire EU. The system for the protection of an unitary right created by the CDR is implemented by a number of fundamental sanctions, which are regulated autonomously in the CDR and also through further, nationally regulated sanctions and measures (para. 56 + 57).

5. In order to assess the territorial scope of the competence of a Community Design Court where infringement proceedings are filed pursuant to Art. 81 CDR and whose international competence for at least one of the defendants is based on Art. 82 para. 1 CDR (domicile or establishment of the defendant within the national

jurisdiction) and for the other defendant on the former Art. 6 no.1 ECJEJ in conjunction with Art. 79 para. 1 CDR, the ECJ holds that a Community Design Court's competence to decide is not expressly governed by Art. 83 CDR in this case. In the ECJ's view, neither from the wording of former Art. 6 no. 1 ECJEJ nor from any case law regarding this regulation does it follow that a lawfully seized court only has limited competence for a defendant who is not domiciled in the member state where the court is located (para. 63).

According to the ECJ, the *territorial competence* of a Community Design Court thus also extends to the *entire EU* even for defendants who are not domiciled in the member state where the court is located (para. 64).

6. This ECJ ruling is of importance not only for enforcing rights pertaining to a Community Design, but also directly for EU Trade Marks. The ECJ explained that the application of national law basically does not necessarily preclude the application of Art. 8 no. 1 ECJEJ if the core issue of the infringement act must be



FOCUS Spezial Magazine:

Preu Bohlig & Partner is once again “Top Business Law Firm of 2017”

In the special edition of Germany's leading news magazine FOCUS featuring “Germany's Top Attorneys” (October/November 2017 issue) Preu Bohlig & Partner is listed once again among the “Top Business Law Firms of 2017” in the categories of “Patent Law”, “Trademark and Utility Model Law” as well as “Press and Entertainment Law”.

The list of Germany's top business law firms was compiled for FOCUS by Statista Institute in Hamburg. Attorneys in business law firms and legal departments from 26 different areas of specialisation were surveyed. The selection was based on the frequency of recommendations by colleagues. Participants were invited to recommend one or more colleagues in their own specialty outside of their own law firm.

addressed in the exact same manner across the EU; otherwise this would run counter to the purpose of Art. 8 no. 1 ECJEJ which is to avoid contradictory rulings.

7. Concerning the issue of the applicable Substantive Law, which must be separated from the issue of international competence, the ECJ states in para. 93 that regarding sanctions and measures not covered by the relevant regulation, both the EUTMR and the CDR refer to the national law, including the provisions of Private International Law of the seized court (Art. 129 EUTMR; Art. 88 CDR).

Since for all EU member states (except for conflict-of-law provisions in the Kingdom of Denmark) the International Private Law was harmonized with regard to non-contractual obligations in civil and commercial matters, including obligations arising from the infringement of unitary intellectual property rights by the Rome II Regulation (regulation (EC) no. 864/2007), this reference must be interpreted as a reference to the Rome II Regulation insofar as it concerns International Private Law (para. 93).

8. The court holds that the purpose of the Rome II Regulations is to improve the predictability of court rulings within the EU through harmonized regulations and to provide appropriate reconciliation of interests between persons whose liability is enforced and the aggrieved party. For this purpose, the regulation generally refers to the rule embodied in Art. 4 para.1 of the Rome II Regulations which stipulates that the law of the member state where the damage is occurred must be applied to non-contractual obligations („lex loci damni“). The court further states that Art. 8 para. 2 of the Rome II Regulation represents a particular provision with priority over the fundamental rule for non-contractual obligations derived from *infringements of unitary intellectual property rights* (para. 96). Pursuant to Art. 8 para. 2 of the Rome II Regulation, in such cases the law of the state where the infringement was committed must be applied for matters not covered by a relevant EU legislative instrument.

9. The ECJ holds that in cases where the same defendant is accused of multiple infringement acts against unitary intellectual property rights committed in multiple member states, the determination of the event giving rise to the damage occurred cannot be based on each individual alleged infringement act; rather, the defendant's *actions must be assessed overall* in order to determine where the *original infringement act* on which the alleged action is based was committed or might be committed (para. 103).

The ECJ justifies this interpretation of Art. 8 of the Rome II Regulations by stating that this is the only manner in which the seized court is able to bring the applicable law in line with the objective and the purpose of the Rome II Regulation with a consistent connecting factor (the location where the infringement act was or might be committed and on which multiple acts allegedly committed by the defendant are based) (para. 104).

10. According to the ECJ, an event giving rise to damage claims due to the infringement of a unitary intellectual property right on a website which is aimed at consumers in multiple member states is constituted if an economic operator offers the contested goods for sale, in particular by publishing such an offer on its website. Pursuant to Art. 8 para. 2 of the Rome II Regulations, the location where the process of publishing the offer was started by the economic operator on its website is thus the location of the event giving rise to damage claims (para. 107 + 108).

11. In practice, this means that the plaintiff's obligation to state the details of member state rights pertaining to secondary claims for infringements of a EU Trade Mark or a Community Design, respectively, with expensive legal opinions no longer applies, provided the contested infringement actions share a common context inside the state where the plaintiff is domiciled.

12. The ECJ ruling has direct consequences for the competence and the applicable law in infringement

proceedings pertaining to a EU Trade Mark or a Community Design. Whether national courts actually apply the principles stipulated by the ECJ on infringements of national parts of a European patent remains to be seen. The fact that the European patent from the day of the relevant publication concerning its award in the European Patent Bulletin, (only) grants its owner the rights he would have been granted by a national patent award (Art. 64 para. 1 EPC) seems to speak against such application. The relevant publication concerning the patent award in the European Patent Bulletin does therefore not constitute an unitary intellectual property right, which means it is unlikely that Art. 8 para. 2 of the Rome II Regulation is relevant.

The question whether the former Art. 6 no.1 ECJEJ (now: Art. 8 no. 1 ECJEJ) applies within the context of lawsuits filed in multiple member states due to infringements of a European patent granted in each of these member states has already been addressed by the ECJ's ruling in the „Roche Nederland“ matter (GRUR 2007, 47). That ruling stipulates that each of these lawsuits must be examined solely pursuant to the national law which applies in the state for which the European patent was granted. The ECJ holds that any different rulings cannot be qualified as contradictory and that there was thus no connection pursuant to former Art.6 no.1 ECJEJ which would make a joint ruling seem expedient in order to avoid contradictory rulings by multiple courts.



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Another decision of the OLG Düsseldorf regarding the FRAND objection

In a still unpublished judgment of 30 March 2017, the Higher Regional Court of Düsseldorf (15 U 65/16) specified additional responsibilities of the patent holder of a standard essential patent (SEP). In the Sisvel decision, a patent exploitation company had gone after a mobile phone manufacturer that had filed an antitrust complaint to protect against the right to injunctive relief as well as against parts of the claims for



The judgment has caused the holders of SEPs to take to heart a whole series of significant clarifications and additional obligations.

First, it was clarified, again, that the SEP holder has no claim to damages and an associated information disclosure claim unless he fulfils his obligations to make a FRAND offer. He can sue only for the enrichment claim as well as an associated claim to information in the amount of the standard (FRAND) license fee.

Furthermore, the SEP holder must submit a fully formulated and substantiated FRAND license offer on his own initiative, and the Court must determine—and do so not just summarily—whether the license offer actually satisfies FRAND terms. Along with the FRAND license offer, the type and economic basis of the calculation of the FRAND license offer must also be disclosed. It is not enough to just name the royalty rate.

Rather, all license agreements already concluded with third parties must also be disclosed. This will allow the recipient of the offer to determine in a transparent way whether the offer submitted to him satisfies FRAND terms and whether there is fundamental equal treatment.

Even if possibly not all companies on the market would have to receive the identical offer of the SEP holder, there must be no inappropriately discriminatory differences in the economic and legal terms of the FRAND license offer. If there is unequal treatment, such treatment is objectively justified only if the differences appear as conditions conforming to the principles of competition for a balancing of interests and are not based on arbitrariness or on considerations that are outside the bounds of economically or commercially reasonable behaviour. However, in no case should the differences prove to be an expression of abusive ex-

exploitation of a market-dominating position. In the specific case, massive differences emerged between the license offer that Defendant had received and licenses that Sisvel had already negotiated in the past with third parties. In these old cases, the licensees had received high discounts, in some cases more than half of the required license fee.

The reductions resulted in the Higher Regional Court judging the license offer with the license fee demanded as manifestly discriminatory and evidently abusive, and the FRAND objection of Defendant was successful. The right to injunctive relief was therefore rejected as currently unjustified.

The Higher Regional Court also did not grant Plaintiff any easing of his FRAND obligations because it was a transitional case; thus, the suit had already been pending before the Huawei/ZTE decision of the ECJ. The Higher Regional Court justified its decision by explaining that such transitional periods cannot be granted by the case law and indeed had not been granted by the ECJ in the case ruled on although this would have genuinely been the first ever transitional case.

Ultimately, the judgment, especially by its reasoning, represents a heavy blow to Sisvel and its licensing program, and still more charges are being brought in connection with investigations into breach of fiduciary duty and corruption against a patent attorney who has been arrested.

Ultimately, the FRAND objection, particularly in the communications industry, appears to be becoming increasingly substantiated, and the courts are beginning step by step to more clearly define the rules of the game in this area.

Ultimately, there can be no doubt, however, that in the case of technologies that are standardised and abounding in patents, the right to injunctive relief stemming from an SEP cannot be enforceable. No business entity and no citizen in this country can or wants to imagine that mobile wireless networks or landline networks or television broadcasts can simply be shut down at

the instigation of a single patent holder. These standardised and intensely patent-encumbered infrastructures, like electricity and running water, are part of the indispensable preconditions of everyday existence and are not subject to the discretionary power of a single patent holder. Should it ever come to such a shut-down, the citizenry would soon compel the legislature to bring about an amendment of the patent law. If the industry wants to avoid this, the case law must take this step itself.



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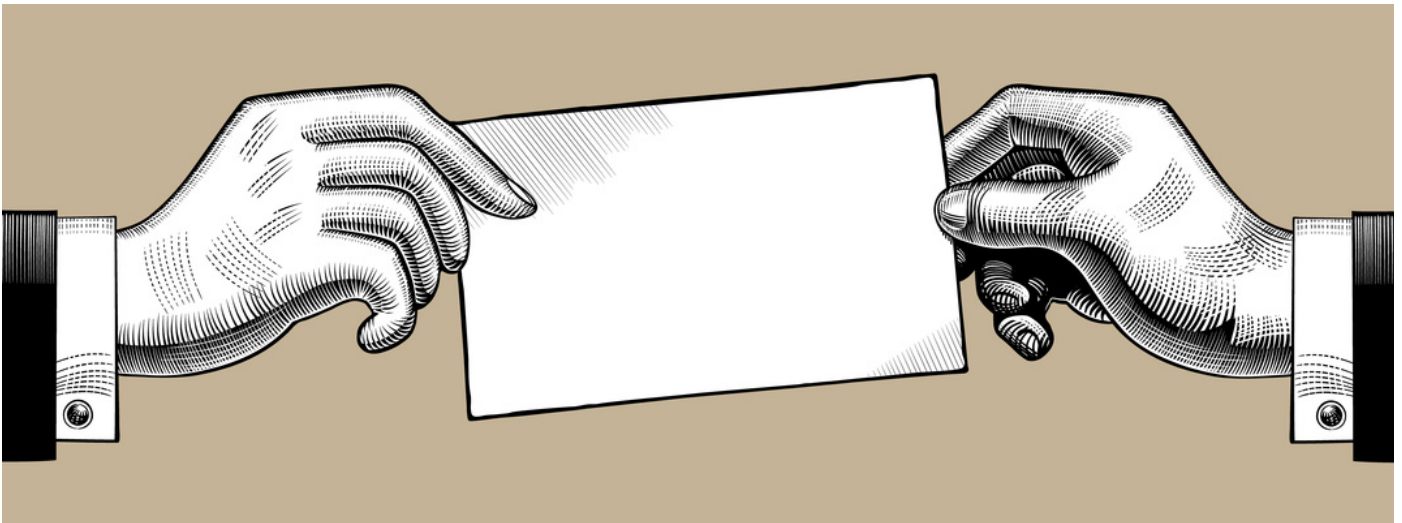
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Regarding the Requirements for an „Offer to sell“ under Patent Law and Conclusions drawn from the final product about the content of an offer

With its judgment of 6 April 2017, file no. I-2 U 51/16, the Higher Regional Court of Düsseldorf decided that for an offer within the meaning of § 9 no. 1 PatG it is sufficient if the infringer, according to an assessment of his overall behaviour, has actually generated a demand for products that infringe intellectual property rights. If in the purchase process an offer, at least in its essentials, was sent out from within the country where patent protection is in effect, then a system built abroad in a patent-free country that realises all features of the patent justifies the conclusion that the proceeding domestic offer comprised such product in accordance with the patent. The offer itself does not necessarily have to disclose or contain all features of the patent at the time it was submitted. It suffices if the negotiations between the buyer and the seller (infringer) held later in a patent-free country led to a concrete formulation of the offer that then resulted in a realisation of all patent features while still being at least within the scope of the original domestic offer. The judgment of the Higher Regional Court of Düsseldorf is published in BeckRS 2017,109833.



The Plaintiff in the proceedings is the exclusive licensee for the German part of the European patent concerning an “Apparatus for the drying of moist particulate materials in superheated steam.” Defendant manufactures and supplies machines and equipment for “fluidised-bed evaporation dryers”. Defendant manufactures these dryers according to the individual requirements of its contractual partners and, therefore, does not offer any standard products. Defendant was in possession of a demonstration model located in its domestic facilities that showed the operating principle of fluidised-bed evaporation drying.

Defendant also exhibited different versions of evaporation dryers on its website, at trade fairs and in workshops. However, neither the demonstration model nor the embodiments thus presented realised all features of the patent in suit. Nevertheless, Defendant installed an evaporation dryer that realised all features of the patent in suit at a customer’s facility in a patent-free country. The extent to which this evaporation dryer that was installed in the patent-free country was based on a domestic offer to sell by Defendant and not just on negotiations in the patent-free country remained in dispute between the parties.

The District Court of Düsseldorf convicted Defendant of making patent-infringing offers. The Court based this judgment on the presentation of the demonstration model in the domestic facilities of Defendant and the presentation of various versions of evaporation dryers on the Defendant's website and at trade fairs and in workshops. As mentioned, none of these products thus presented, in and of themselves, realised all features of the patent in suit. In support of its judgment, the District Court explained that whether the presented products realise all features of the claim of the patent in suit is irrelevant. Rather, what matters is solely the objective explanatory value of Defendant's advertising. Defendant presented those demonstration models and exemplary embodiments in the expectation that a corresponding evaporation dryer would be demanded by the relevant sector of customers, with all participants realising that each of these evaporation dryers would be adapted to the requirements of the respective customer. Thus, Defendant has – in principle – also expressed that it is able and ready to manufacture and supply an evaporation dryer according to the invention. However, the District Court rejected as unsubstantiated the argument of Plaintiff regarding Defendant's offer related to the system actually built in the patent-free country (namely, a system that realised all features of the patent in suit). According to the Court, Plaintiff had not provided any substantiated pleadings regarding the content of this offer.

The Higher Regional Court of Düsseldorf ultimately upheld the judgment of the District Court but based its decision solely on Defendant's offer concerning the system built in the patent-free country. As the exact content of the offer was not known to the Court and was in dispute between the parties, the Higher Regional Court drew a conclusion about the corresponding offer based on the realised system. According to the Court, it must be assumed that an earlier offer relates to the product (in accordance with the patent) that then is subsequently actually built or delivered. That offer does not yet have to include all features of the patent at the time it is submitted as long as the offer's specifics – possibly even carried out only in a patent-free country – are still within the scope of the original subject of the offer, thus merely developing and not changing it.

The present decision of the Higher Regional Court of Düsseldorf follows, first of all, the Court's existing case law in considering all preparatory actions as offers that make possible or promote the subsequent conclusion of a transaction regarding a proprietary product (see, e.g., Higher Regional Court of Düsseldorf GRUR-RS 2015, 18679 – Verbindungsstück). In contrast, the Bundesgerichtshof (Federal Court of Justice = BGH) regards as an offer any action that according to its objective explanatory value visibly offers the product to the demanding parties for their acquisition (BGH GRUR [Gewerblicher Rechtsschutz und Urheberrecht = Journal of the German Association for the Protection of Intellectual Property] 2006, 927 – Kunststoffbügel). It is, therefore, not necessary for the product to be already manufactured or for the offer to be regarded legally as a contractual offer (Kühnen, Handbuch der Patentverletzung [Manual of Patent Infringement], 9th edition, part A, recitals 224 + 225). For trademark law, the 1st Civil Division of the BGH has even tightened the requirements for what constitutes an offer. According to the Division, the mere exhibiting of a product at a trade fair does not constitute an inherent invitation to purchase the (patent-infringing) product (BGH GRUR 2010, 1103 – Pralinenform II; BGH GRUR 2015, 603 – Keksstange and BGH GRUR 2017, 793 – Mart-Stam-Stuhl). The District Court of Mannheim has also applied this case law of the 1st Civil Division to the patent law (District Court of Mannheim, InstGE 13, 11 – Sauggreifer). The Higher Regional Court of Düsseldorf has already rejected this view (Higher Regional Court of Düsseldorf GRUR-RS 2014, 16067 – Sterilcontainer) – with the exception of a pure competition exhibition. The Court now appears to further lower the requirements for the substantial pleading about infringing offers and their contents.

Already the first-instance decision of the District Court of Düsseldorf is thus only seemingly based on the case law of the BGH. In the decisions BGH GRUR 2003, 1031 – Kupplung für optische Geräte and BGH GRUR 2005, 665 – Radschützer, the BGH considered that patent infringements through an offer may be confirmed even if the advertising for a product does not show all features of the patent claim as long as the product referred to in the advertisement coincides in its actual configuration with the technical teaching of the patent claim.

The District Court of Düsseldorf now let it suffice for the patent infringement by offering already if the overall picture of individual offers shows that the defendant is prepared and ready to manufacture a (not yet existing) product also in a patent infringing way.

The Higher Regional Court has sustained this decision merely in terms of the legal effect, but (in an approach back to the BGH case law) it has again focused on the concrete individual action. However, in so doing, the Higher Regional Court has not examined the content of the offer itself, but instead has drawn a conclusion from the actually manufactured and installed system (in a patent-free country) to Defendant's offer sent by Defendant from its domestic (patent-covered) principal office. The Higher Regional Court did not accept the Defendant's objections that this offer did not yet disclose all features of the patent but, in fact, the respective construction planning and necessary meetings were only conducted at the installation location in the patent-free country. If these changes and additions to the offer are still within the scope of the original domestic offer's subject, they have to be regarded as already being part of the original offer.

The Higher Regional Court based its interpretation of the concept of an "offer" again on the presence of an actually existing or customisable embodiment. However, it postpones the requirement of recognisability of the compliance of the offer with all the features of the patent to a later point of time. The recognisability is not yet required at the time the offer is made; rather, it is sufficient if the product actually manufactured later realises all features. A conclusion may be drawn based on the realised embodiment about the content of the offer.

Conclusion: By its decision, the Higher Regional Court significantly expands the options of a domestic patent owner for attacking infringing acts abroad. Even if a patent-infringing product is exclusively manufactured in and delivered to a patent-free country, a conclusion may be drawn – if the infringer is based in the country where the patent is protected – about a patent-infringing domestic offering. It is then the potential infringer's responsibility and burden to state and, if necessary, to prove that he has either not submitted an offer from its company's dome-

stic principal place or that the product actually delivered represents a complete change and not merely a specification or refinement to the original offer. As the patent owner generally has no access to the contents of the offer, according to case law up to now, he ran the risk that his pleading regarding the infringer's offers would be rejected as unsubstantiated. However, the patent owner can only claim the privileging by means of the inference from the actual embodiment if it is established or is ascertainable that the item delivered or built in a patent-free country actually realises all features of the patent.



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Possibility of change not enough for patent infringement

The Regional Court of Mannheim has issued a clarifying decision on the BGH [Bundesgerichtshof = Federal Court of Justice] Rangierkatze [shunting trolley] case

In case law, the number of cases is growing in which patent holders, based on device claims, attack products that with only more or less minor changes represent a patent infringement. In these cases, the patent holders consistently invoke the formulations of the BGH Rangierkatze decision, judgment of 13 December 2005 - X ZR 14/02, GRUR [Gesellschaft für gewerblichen Rechtsschutz und Urheberrecht e.V. = German Association for the Protection of Intellectual Property] 2006, 399.



The guiding principle of this decision states that an infringement exists in any case if the features of the patent claim are realised and the contested embodiment is objectively suited to achieve the patented properties and effects. According to the court, the fact that a device is normally operated differently and that customers normally do not make use of the patent-infringing teaching does not preclude a patent infringement.

In infringement suits, it is often inferred from the above formulation that the device does not have to satisfy all features of the claim, but that it suffices that those features could be achieved in the contested device even if only via slight modifications. In particular with respect to computers, communication devices and similar items, this is often the case.

The Regional Court of Mannheim has now put a stop to this interpretation in a series of similar judgments (file no. 2 O 200/15, judgment of 21 February 2017). According to the Regional Court's ruling, the central precondition of a patent infringement formulated by the Federal Court of Justice, namely, the possibility of the contested embodiment using the teaching of the patent, is not met if the product in question would have to be altered. In contradistinction to the BGH's Rangierkatze decision, for the Regional Court does not find infringement has occurred if the contested product first has to be modified or if its functionality settings have to be changed. If the features of a patent would be realised only after a redesign of a product, then there would be no infringement up to that point, but instead just a risk of infringement of the patent. How-

ever, the patent holder could contest such a risk only if the risk of infringement being committed is imminent and if there are serious and tangible indications that in the near future the user will behave illegally, that is, will carry out the modifications. According to the court, if such a threat of imminent infringement is not present, however, there is no justification for preliminary injunctive relief. According to the court, the second option of a possible defence against the risk of infringement is inherent in the definition of contributory or indirect patent infringement. However, if the preconditions for this are not met either and the modification or redesign is not realised via a self-evident and so-called everyday ingredient, then the non-infringing product - which could only become an infringing product by a modification - cannot be contested.

Therefore, the BGH's Rangierkatze decision cannot serve to extend the definition of indirect patent infringement and the right to preventive injunctive relief to such products that require a redesign or a reprogramming and, therefore, are not infringing as delivered.

The Higher Regional Court of Dusseldorf dealt with a similar issue along the same lines. There, the Higher Regional Court of Dusseldorf, in the judgment of 19 February 2015 – I-15 U 39/14 regarding a TV satellite box, dismissed the action, in which software was included that could have resulted in the realisation of a claim. However, the software was not activated, and in order to activate it a modification of the device would have been required.



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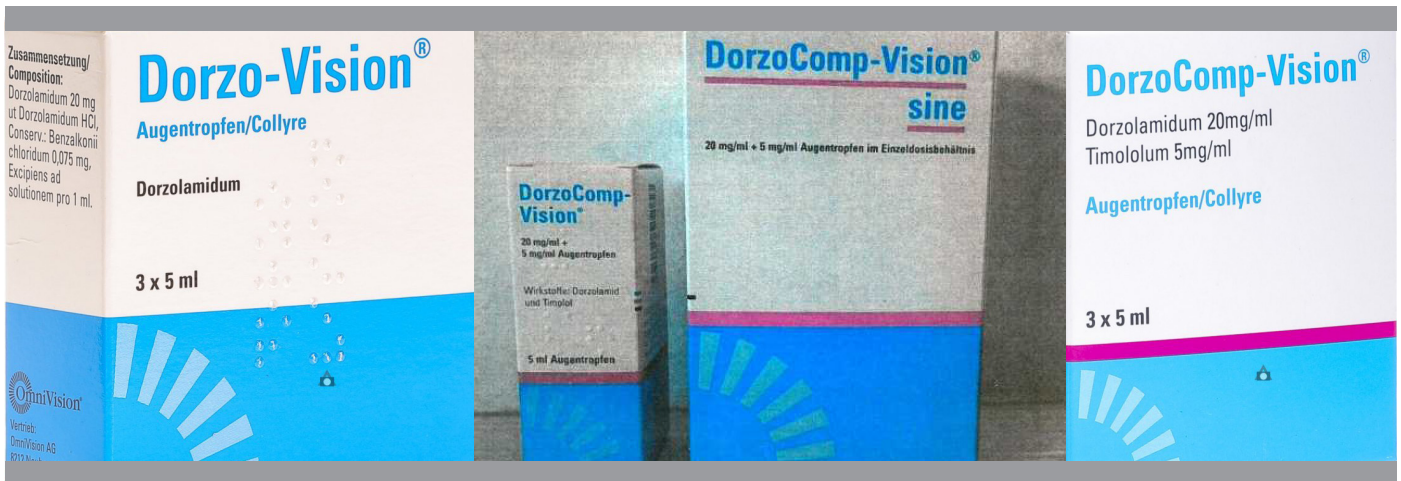
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The difference between „distinctive trademark“ and „independent distinctive role“ for the assessment of serious trademark use

With its ruling of 11 May 2017 (file ref.: I ZB 6/16), the German Federal Court of Justice (“Bundesgerichtshof, BGH”) stipulated that in assessing whether a use of a mark that differs from the registered use changes its distinctive character it does not matter whether the trademark has an independent distinctive role in the context of its actual use. On the other hand, if the relevant public had perceived the registered trademark in the context of its actual use as an „independent mark“, this would have been sufficient to find for a serious trademark use pursuant to § 26 sect. 1 German Trademark Act (“Markengesetz, MarkenG”). This BGH ruling is also published in the Newsletter for German Patent Attorneys (“Mitteilungen der deutschen Patentanwälte”), issue 10/2017, p. 459 et seq.



In opposition proceedings concerned, the opponent drew upon the older registered word mark “Dorzo”. The proprietor of the contested and more recent trademark pleaded for non-use pursuant to § 43 sect.1 Trademark Act. As prima facie evidence for its use, the opponent submitted that his licensee had generated significant revenue with the trademark. His licensee had used the trademark in the past five years prior to the ruling by the German Federal Patent Court as follows: „Dorzo-Vision®“, „DorzoComp-Vision®“ and „DorzoComp-Vision® sine“.

The trademark „Dorzo“ was thus used with addenda in commercial practice. The designation used thus deviated from the registered trademark. Pursuant to § 26 sect. 3 Trademark Act, a registered trademark is deemed being used even if said trademark is used in a shape that deviates from the registration if the deviations do not alter

the distinctive character of the trademark. The distinctive character of a registered trademark is not altered if the relevant public still generally equates the mark used in a deviating shape with the registered trademark — that is, if the relevant public perceives the shape used as still the same trademark (cf. inter alia BGH GRUR 2013, 840 margin number 20 – PROTI II, with other references.). If the registered trademark is used with additions, as in the present case, a use preserving the rights in the mark is (still) to be assumed if the relevant public perceives the designations in question as separate and thus independent trademarks. If, however, the relevant public perceives the marks used as dependent components of a new uniform trademark, the proprietor of the trademark is not using the component of the new mark that is registered as a trademark in a way that preserves his rights.

The opponent had argued in particular that the registered trademark „Dorzo“ played an independent distinctive role in the designations used „Dorzo-Vision®“, „DorzoComp-Vision®“ and „DorzoComp-Vision® sine“, which would be sufficient to show use of the registered trademark via the designations used.

According to the author, the trademark „Dorzo“ does indeed occupy an independent distinctive role in the designations used (cf. inter alia Ströbele/Hacker, regarding § 9 margin note 452 et seq., with other references), which means that considering the identical nature of the goods in this case, there is a likelihood of confusion between the registered trademark „Dorzo“ and the designations used of „Dorzo-Vision®“, „DorzoComp-Vision®“ and „DorzoComp-Vision® sine“.

Regarding this argument, the BGH stated that the legal concept of the independent distinctive role needs to be analysed only in case of an infringement. For trademark uses in a different shape, however, the court holds that the independent distinctive role is irrelevant. Rather, what matters is whether the registered trademark is perceived as “independent trademark” in the combined mark used (registered trademark & addition). According to the court, this is not the case here. The relevant public perceives the designations „Dorzo-Vision®“, „DorzoComp-Vision®“ and „DorzoComp-Vision® sine“ as uniform trademarks. For one thing, the designations are hyphenated, and for another thing, the superscripted „®“ was not added after the opposing trademark „Dorzo“, but after the combined designations. According to the court, this points toward a uniform trademarking and speaks against the assumption of two distinct trademarks. The relevant public usually interprets the addition of „®“ as an indication that there is a trademark with exactly that name. Thus, since the relevant public does not perceive the registered trademark as independent marks in the full designations used here, the combined designations used here alter the distinctive character of the registered trademark. The opponent did thus not provide credible evidence concerning the use of his registered trademark, with the consequence that his opposition had to be rejected.

Conclusion: When using registered trademarks in commercial practice, additions should be avoided where possible. Care should be taken in particular when adding additional word elements to a registered trademark; however, adding graphical elements is less likely to alter the distinctive character of a registered word mark (cf. Ströbele/Hacker, in § 26, margin note 163 et seq.). In the opinion of the author, the present case would likely have been decided differently if the opponent or his licensee, respectively, had used the registered trademark in commercial practice as follows: „Dorzo® Vision“. In that case, in the author’s view, the relevant public would perceive the registered trademark as an „independent mark“ even in the combined designations. If the additional word - here: “Vision” - had been registered as a trademark, it would be expedient to use the two marks as follows in commercial practice: „Dorzo® Vision®“. In that case, the relevant public would perceive each of the two trademarks as an independent trademark (cf. inter alia BGH GRUR 2014, p. 662 et seq., margin note. 25 – Probiotic; BGH GRUR 2013, p. 840 et seq., margin note 35 – PROTI II).



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Seminars in Tokyo on German and European patent law and on the IP protection of artificial intelligence

In the context of the long-standing cooperation with the Japanese law firm, **Sonderhoff & Einsel**, **Dr. Axel Oldekop (Munich)** and **Dr. Christian Kau (Düsseldorf)** of **Preu Bohlig & Partner** had the opportunity to present lectures to audiences from industry, science and the legal profession in Tokyo in September 2017.



In the first event on 27 September 2017, Dr. Kau and Dr. Oldekop together with patent attorneys Dr. Dorothea Hofer and Dr. Christian Einsel from the Munich IP law firm Prüfer & Partner introduced the audience to German and European patent application procedure as well as the particular characteristics in enforcing utility model rights in Germany. These key subjects were supplemented by an update on the latest developments regarding the Unitary Patent and Unified Patent Court.

The second event in the EU Japan Centre for Industrial Cooperation in Tokyo on 28 September 2017 revolved around the topic "Artificial Intelligence and IP," the European Unitary Patent system and patent protection in the life sciences. In addition to the German attorneys and patent attorneys, the panel of presenters included the Japanese attorneys Ayuko Nemoto, Grant Tanabe and Felix-Reinhard Einsel from the law firm Sonderhoff & Einsel as well as Prof. Noriko Otani from Tokyo City University and Prof. Toshiko Takenaka from Keio University Law School. The event, which was attended by a large number of participants from the areas of science, industry and the legal profession, concluded with a panel discussion followed by a reception in the foyer of the EU-Japan Centre.



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Seminars on Current Developments in the Protection of Intellectual Property Rights in Japan and Germany

With great success, the law firms Preu Bohlig & Partner and Sonderhoff & Einsel co-hosted an updated version of a lecture programme regarding the latest developments in the protection of intellectual property rights in Japan and Germany. The event took place in the Kaufmanns Casino in Munich on 5 October 2017.



In the morning, Ms. Ayano Ueda (Sonderhoff & Einsel) together with Dr. Christian Kau (Preu Bohlig) explained employee invention law from Japanese and German perspectives. In the afternoon, Nobuchika Mamine (Sonderhoff & Einsel) and Andreas Haberl (Preu Bohlig) elaborated on the registration of design rights in Japan and Germany in accordance with The Hague Convention. Kengo Sakai (Sonderhoff & Einsel) and Martin Momtschilow (Preu Bohlig) provided information about patent litigation in Japan and the special aspects of preliminary injunction proceedings in Germany. Felix-Reinhard Einsel, Managing Partner of Sonderhoff & Einsel, concluded the event with a presentation of the latest developments in Japanese patent opposition proceedings. An extensive discussion with the audience was followed by a relaxed get-together in the Kaufmanns Casino.

This event was repeated on 10 October 2017 at the Industrie-Club in Düsseldorf. Under the auspices of the German-Japanese Business Council, the aforementioned speakers familiarised the Düsseldorf audience with the latest developments in protection of intellectual property rights in Japan and Germany.



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Current Lectures and Seminars

Below you find a list of current lectures and papers by our lawyers:

<i>Information on seminar activities</i>	<i>Date, Place</i>	<i>Speaker(s)</i>
Moderne Vergütungsmodelle - Grundlagen der Zusammenarbeit von Patentanwälten	30. November 2017, Munich, Hotel Excelsior	Albrecht Lutterbeck, Dr. Christian Kau
World IP Forum Seminare PATENT ASSERTION ENTITIES AND TROLLS STRATEGIC CONSIDERATIONS IN VIEW OF THE UNITARY PATENT AND CERTIFIED PATENT COURT IN EUROPE	16.-18. January 2018, Dubai	Dr. Alexander Harguth
Abgrenzungsvereinbarungen im Markenrecht	02. February 2018, Würzburg, Novotel	Jürgen Schneider, Dr. Volkmar Bonn
30. Deutscher Pharma Recht Tag 2018, BeckAkademie Seminar	22. February 2018, Frankfurt, Steigenberger Frankfurter Hof	Leitung und Moderation: Peter von Czettritz
Fachanwaltslehrgang für den gewerblichen Rechtsschutz	02. und 23. February 2018, Munich, Munich Workstyle	Andreas Haberl, Dr. Axel Oldekop

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