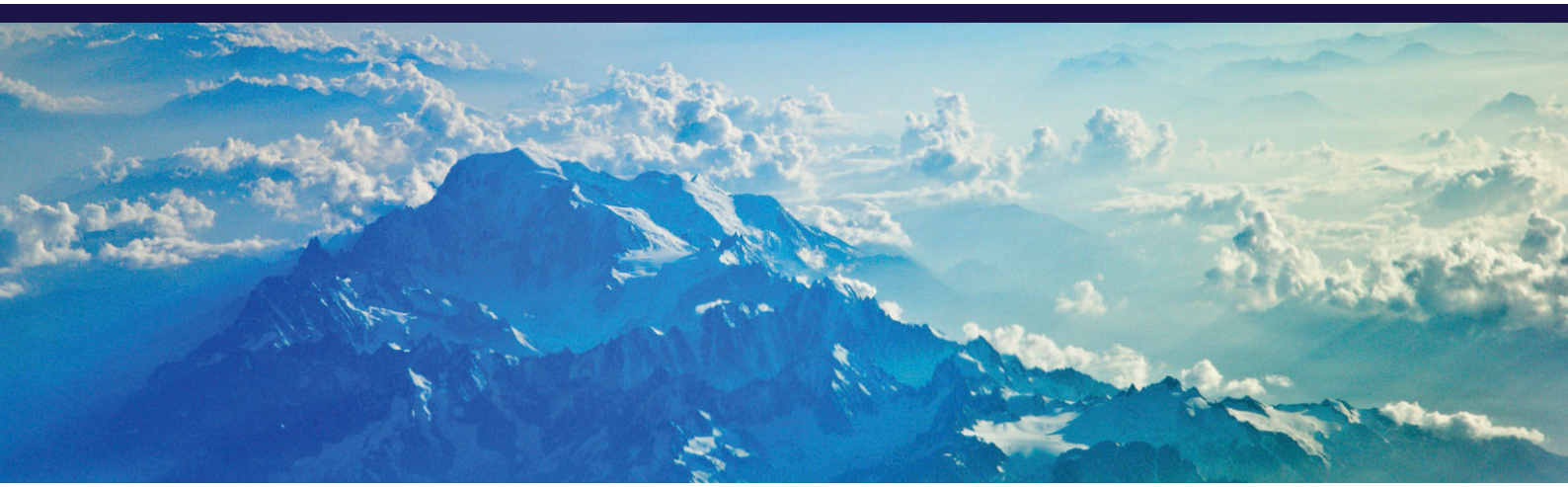
PREU BOHLIG



Newsletter March

ISSUE 1/2022

News

Preu Bohlig appoints two counsels as of 1 June 2022 02

Intellectual Property

Code-X / Cody's 03

Impact of the NFT boom on intellectual property rights 05

New requirements for discount price information, § 11 PAngV n.F. 08

New provisions in the UWG (Unfair Competition Act) by the Act to Strengthen Consumer Protection in Competition and Trade Law 10

Countdown to the Unified Patent Court has begun 15

Renate Künast successful before the Federal Constitutional Court - strengthening the rights of those affected by violations of personal rights 16

The unregistered Community design: Independent protection of individual parts in the case of disclosure of an overall product - the CJEU decision "Ferrari/ Mansory Design [Front kit]" (C-123/20) 18

"NJW-Orange" 21

Awards

Legal 500 Deutschland 2022 - Patent 04

Legal 500 Deutschland 2022 - Trademark 04

Legal 500 Deutschland 2022 - Competition Law 06

Legal 500 Deutschland 2022 - Health 06

Best Lawyers Germany 2023 – Biotechnology Law, Healthcare Law and Life Sciences Practice 07

Best Lawyers Germany 2023 – Pharmaceuticals Law 11

Best Lawyers Germany 2023 – Intellectual Property Law 13

Best Lawyers Germany 2023 – Technology Law 14

WTR 1000 – World Trademark Review 17

MLI - Media Law International 17

Lectures and Seminars 23

Would you like to receive our newsletter? 25

Our Locations 26

Preu Bohlig appoints two counsels as of 1 June 2022

Preu Bohlig appoints Moritz Körner and Jakob Nüzel, both from the Munich office, as counsels as of 1 June 2022.

With these appointments, we recognise years of successful work. The appointees have not only always demonstrated outstanding legal skills, but also the constant endeavour to offer our clients the best advice at all times. Therefore, they contribute significantly to the success and positive development of Preu Bohlig.

About Moritz Körner

Since 2013 Moritz Körner has been working in the Munich office of Preu Bohlig in the field of intellectual property and pharmaceutical law, with a focus on trademark, design and competition law as well as the law on advertising of medicinal products. In addition, Moritz Körner advises clients on the licensing of their intellectual property rights as well as on cooperation in the field of research, development and the drafting of contracts for clinical studies.

Moritz Körner already worked for Preu Bohlig during his legal traineeship, followed by positions in the automotive industry and one of the largest IP law firms in Brazil.

About Jakob Nüzel

Since 2015 Jakob Nüzel has been working in Preu Bohlig's Munich office in the field of intellectual property and competition law, focusing on trademark law, patent law and competition law. Furthermore, he advises clients on the drafting of licence, supply and development agreements as well as the antitrust aspects arising in this context.

Jakob Nüzel represents and advises, inter alia, manufacturers in proceedings against product counterfeiting and infringement as well as industrial companies in patent law disputes with competitors and in the legal structuring and problem solving in their supply chains.

Code-X / Cody's

In a recently published judgment, the European Court of Justice ruled on a likelihood of confusion between the trademarks "Cody's" and "CODE-X" (T-198/21, judgment of 23 February 2022) and dealt in detail with the assessment of phonetic similarity and the factual circumstances.

The subject matter was the application for the EU word mark "CODE-X" for, inter alia, non-alcoholic soft drinks and energy drinks. The opponent, Cody's Drinks International GmbH, filed an opposition based on its earlier German word mark "Cody's" as well as the German and the international registration designating the European Union figurative marks “Cody's", also registered for, inter alia, beers and non-alcoholic beverages in Class 32.

The Opposition Division rejected the opposition on the ground that there was no likelihood of confusion. The Board of Appeal allowed the appeal in its entirety and annulled the decision of the Opposition Division. In view of the identity of the opposing goods, the normal level of distinctiveness of the earlier sign and an above-average degree of similarity from a visual point of view and a high degree of similarity from a phonetic point of view, there was a likelihood of confusion.

The action brought against this decision was successful. The General Court annulled the decision of the Board of Appeal and rejected the opposition.

First, the Board of Appeal wrongly considered the relevant public's level of attention to be below average. According to settled case-law, the goods in question are everyday consumer goods aimed at the general public, whose level of attention is average.

The General Court then dealt in detail with the visual, phonetic and conceptual similarity of the signs.

From a visual point of view, the Court found that, notwithstanding the similarities in the first three letters, the word elements are distinguished by the last two letters and, in particular, by the introduction of a hyphen or an apostrophe. These signs and the presence of different vowels and consonants at the end of the sign represented significant differences. The difference created by the alphabetic characters separated by different punctuation marks was visually perceptible. Accordingly, the Court concluded that the signs were visually similar to only a low or perhaps average degree.

From a phonetic point of view, the Court noted that, irrespective of whether the mark applied for was pronounced in three or two syllables, the hyphen had an effect on the pronunciation of the mark by punctuating one of the syllabic breaks. The relevant public would therefore pause before pronouncing the final syllable. In the earlier word mark, on the other hand, the apostrophe would have no effect on pronunciation. Thus, the letter 'X' and the hyphen preceding it in the mark applied for would mark a hyphenation which is absent in the earlier word mark. Against this background, the Court considered the signs to be phonetically similar only to an average degree.

Conceptually, it was not questioned that the signs were different.

Notwithstanding the similarities, the Court denied a likelihood of confusion. In the context of the global assessment of the likelihood of confusion, the visual, phonetic and conceptual aspects of the conflicting signs could be given different weight, depending on the objective conditions under which the marks may appear on the market. However, in that context, the reference must be to the circumstances in which the types of goods covered by the marks in question are normally marketed.

The perception of the signs in a particularly noisy environment, such as a bar or a nightclub, is not the only factor to be taken into account. Rather, it is necessary to take into account how those signs are perceived by the relevant public under normal conditions of distribution. Although drinks, in particular

alcoholic beverages, are often ordered orally, there is no evidence that the ordering conversation takes place in a crowded and noisy bar or restaurant. For example, orders would also be placed after looking at the drinks menu. Moreover, bars and restaurants are not the only distribution channels for drinks. Drinks are also sold in supermarkets and other retail outlets, where the consumer can choose the product and rely on the image of the mark affixed to it.

In conclusion, the Court held that even if phonetic perception was sometimes preponderant in the case of beverages, such a consideration did not apply in all cases.

Finally, in assessing the likelihood of confusion, the Court took into account that conceptual differences between the signs at issue may counteract phonetic and visual similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately. Thus, the relevant public would immediately perceive the opponent´s word mark "Cody's" as a reference to the possessive form of the name "Cody". The element 'code' in the mark applied for would also be regarded as part of the basic vocabulary of the German language and immediately understood. Due to the different meanings in each case, the conceptual difference would cancel out phonetic and visual similarities. A likelihood of confusion could therefore be ruled out.

The General Court annulled the decision of the Board of Appeal, made use of its power to alter decisions under Art. 72 (3) of the Regulation and rejected the opposition.

Astrid Gérard, LL.M.
Lawyer, Partner
Munich

Tel +49 (0)89 383870-0
asg@preubohlig.de
Profil: Link Website

Legal 500 Deutschland 2022 – Patent

Leading Firm 2022
Leading Names: Prof. Dr. Christian Donle

Legal 500 Deutschland 2022 – Marken

Leading Firm 2022

Impact of the NFT boom on intellectual property rights

Non-fungible tokens, so-called NFTs, are currently the talk of the town and dominate the headlines not only in the art market. Simple image files whose authenticity is secured by means of NFTs are being traded for dizzying sums, such as images from the "Bored Ape Yacht Club" collection (https://opensea.io/collection/boredapeyachtclub) or the collage "Everydays: the First 5000 Days" by the artist Mike Winkelmann, which was sold as an NFT for USD 69.3 million (https://en.wikipedia.org/wiki/Everydays:_the_First_5000_Days).

A token represents an asset, asset or economic good. In the world of cryptocurrencies, tokens are fundamental building blocks for operations with crypto assets. A crypto token is a digitized representation of assets stored on a blockchain of assets stored in a decentralized manner. They are assigned a specific function or value. These values can represent a wide variety of properties, functionalities or rights (see https://www.bafin.de/SharedDocs/Downloads/EN/Merkblatt/WA/dl_wa_merkblatt_ICOs_en.html)

What is an NFT? NFTs are unique encryption codes generated using blockchain technology that allow verification of the authenticity and ownership of the artwork attached to it - from anywhere. An NFT is neither a thing nor a right. However, it can be linked to any type of work, from a digital or analogue work of visual art to a song, an entire album or a fashion item. Through tokenisation, the token, which is legally neutral in itself, is "charged" with an asset outside the blockchain by means of a legal link. Unlike cryptocurrencies such as Bitcoin or Ethereum, however, NFTs are not exchangeable ("fungible tokens"), as they have a unique identification code and metadata that distinguish one NFT from another. It is also possible to build contractual terms into an NFT by means of so-called "smart contracts", in which, for example, sales shares are stipulated through which the artist automatically receives a certain percentage of the resale price in the event of a resale. Furthermore, this type of trade has the advantage for the artist that no intermediary is needed to sell the works together with the NFTs.

While from a legal point of view there are still various questions in connection with NFTs that are currently not conclusively clarified, e.g. the platform linkage or server resilience for their tradability, the following will briefly address the extent to which NFTs affect existing intellectual property rights.

Rights may have to be considered both in the NFT itself and in the work linked to it. First, copyrights may exist in the NFT, i.e. its code. Since each NFT is unique and can be designed with various clauses via smart contracts, among other things, there is much to suggest that the code underlying the NFT is copyrightable as a computer program. Then there is the work linked to the NFT, for which copyright, design or trademark rights can also be claimed.

And this is where the questions already begin: If one acquires an NFT, does one thereby also acquire all rights to the work linked to it? Or - if there are copyrights to the work in question - only simple rights of use? At least according to the German reading, property rights in digital works are out of the question; such rights could only be acquired in the data carrier if the work linked to the NFT is on it. The moral rights and, if applicable, the further rights of use and exploitation lie in any case originally with the author. The buyer of an NFT linked to a digital work thus only acquires a right of use to it. The exact scope of this right of use should be apparent from the smart contracts if this point is regulated therein. However, this is not always the case. One quickly realises that more would have to be regulated than just the link to a specific work.

What about when the rights of the works linked to an NFT are held by a third party? In principle, according to Section 16 (1) UrhG, only the author of a work is permitted to make copies of his work, and thus a copy of his work associated with an NFT. But what are the legal issues when the rights to a work are not held by the creator of the NFT? Such a case is currently being fought out in the USA in the case Hermès International and others v Mason Rothschild (https://www.documentcloud.org/documents/21181175-hermes-international-vs-mason-rothschild?responsive=1&title=1), in which the claimant sees its famous handbag trademark "BIRKIN" infringed in Mr Rothschild's NFTs, which have precisely these Birkin bags - in various designs - as their subject matter. Hermès sees here not only their well-known brand, but also the worldwide known design of the Birkin bag infringed by the unauthorised takeover by Mr Rothschild, who is trying to profit from it. A case in the UK also made waves, where an alleged Bansky NFT was purchased for GBP 244,000, which, however, did not originate from the artist Bansky at all (https://www.theguardian.com/technology/2021/sep/01/collector-buys-fake-banksy-nft-for-244000). NFTs can be used to prove the authenticity of a work, but not that the rights to the attached work also belong to the creator of the NFT. The mere fact that a work is linked to an NFT does not change the basic premise that third party rights may not be used without the corresponding permission of the respective right holder. Particularly in the case of well-known trademarks or designs, claims for unfair conduct may apply here in addition to the relevant claims under the Trademark or Design Act if no corresponding rights of use were obtained from the right holder for the creation of an NFT. Thus, there are constellations in which, on the one hand, one can prove by means of an NFT that one is the owner of the work linked to it; at the same time, however, this infringes the rights of third parties because no rights were granted by the right holder for the creation of the NFT and these cannot be acquired in good faith either.

The fact is, NFTs are currently a global trend. Whether this trend will continue is an open question. However, the introduction of NFTs has the potential to advance digitisation in various areas, not only for the creators of artworks, but also for users as diverse as public authorities or event organisers. For example, this technology could also be used to ensure the authenticity of vaccination certificates, tickets for music or sporting events, digital identity documents and much more.

Legal 500 Deutschland 2022 - Competition Law

Leading Firm 2022

Legal 500 Deutschland 2022 - Health

TOP TIER 2022

Peter von Czettritz is named in „Hall of Fame“

What is already clear, however, are the manifold legal issues involved in the commercialisation of this form of blockchain technology when it comes to ownership, third-party rights, applicable law or the enforcement of any claims. A blockchain network is decentralised and stored on many computers in different countries, so without appropriate regulation under the NFT, it is not certain which law will apply. The tamper-proof certification by the NFT is of course of value to the owner of the work linked to it; however, it does not automatically guarantee that the originator of the NFT was also entitled to link a particular work to it. All in all, this is a very rich breeding ground not only for investors and creators, but also for the legislature and the judiciary, which are called upon to clarify a wide range of regulatory and substantive issues.

We at Preu Bohlig will continue to stay on the ball for you on this topic.

Dr. Alexander Bayer, LL.M. (McGill)
Lawyer, Partner
Munich

Tel +49 (0)89 383870-0
aba@preubohlig.de
Profil: Link Website

Best Lawyers Germany 2023 – Biotechnology Law, Healthcare Law and Life Sciences Practice

Listed: Peter von Czettritz

New requirements for discount price information, § 11 PAngV n.F.

On 28.05.2022, a new regulation on the labelling of discount prices will come into force with § 11 PAngV (Preisangaben-verordnung – Price indicataion regulation). Accordingly, a retailer is obliged to indicate to consumers, whenever he announces a price reduction for a product, the lowest total price which he has demanded for this product within the last 30 days before the price reduction. Price reductions can be conducted by discount information ("10% discount"), by comparison with the crossed out normal price or by textual highlighting ("now cheaper"). Not covered by the new regulation is the mere application of a new (cheaper) price to a product without indication of a price reduction.

The new regulation raises the following questions in particular:

Obligated persons

The regulation in § 11 PAngV concerns companies in business with consumers. It therefore does not apply in business transactions between companies (so-called "b-2-b"). The regulation also does not apply across companies within a group. Thus, if a company A operates a retail shop, it does not have to indicate the lowest previous total price of a group-affiliated company B, which operates the online shop.

Furthermore, in the legal literature an even narrower approach is sometimes taken (see e.g. Köhler/Bornkamm/Feddersen, UWG, 40th ed., § 11 PAngV marginal no. 9 ff.): The lowest previous total price always refers only to the respective sales channel (e.g. online shop/store), even if they are operated by the same company. The development of case law in this question remains to be seen.

Period of the last 30 days

It is questionable whether the lowest total price which was demanded within a related period of 30 days (so-called "continuous solution") is to be taken into account or the one at any time within the last 30 days (so-called "punctual solution").

In our opinion, the view of a punctual solution of the pricing within the last 30 days is likely to prevail.

Relevant is therefore the lowest total price that a retailer has demanded during any period within the last 30 days before the start of the current price reduction. This 30-day period remains the relevant comparison period for the entire reduction period.

Multiple discount promotions within a 30-day period

In the case of a uniform discount promotion, i.e. an increase in the price reduction within a uniform reduction occasion (e.g. end-of-season sale with a discount increasing in time), the previous lowest total price is to be indicated as that

from the 30-day period before the start of the uniform discount promotion, not the price after the first reduction.

In the case of a uniform discount campaign with interruption (i.e. interim return to the "normal price") or in the case of several unrelated discount campaigns within the last 30 days (e.g. Black-Friday-Sale and subsequent End-Of-Season-Sale), on the other hand, the previous lowest total price is the price of the first discount level / discount campaign.

Assortment discounts

It is still unclear what applies in the case of flat-rate price reductions on the entire assortment (e.g. "20 % off all items") or in the case of discount promotions for owners of customer cards etc. According to the wording of § 11 PAngV n.F., in the case of such advertising, the lowest total price of the last 30 days would have to be indicated for each product subject to the flat-rate discount. This would probably lead to a considerable effort on the part of the retailer.

Discount Calculation / Relation to the Unfair Competition Act

In Germany, there is a long-standing case law on the permissibility of discount price advertisement.

Discount advertising is permissible if the retailer has seriously demanded the original price to which the discount or price comparison refers for a reasonable period of time prior to the discount advertising (even if a discount has been applied in the meantime). It is therefore forbidden to advertise a discount in relation to so called "moon prices" or (more expensive) prices demanded only for a very short period of time. A comparison with the manufacturer's valid RRP can also be made if it is obvious to the consumer that it is the manufacturer's recommended price and not the retailer's previous price.

It remains to be seen whether the regulations in Section 11 PAngV replace the existing provisions on price reduction advertisement under Unfair Competition Act ("UWG") or whether both regulations will exist alongside. Correctly, the new regulations in § 11 PAngV do not conflict with the existing regulations (developed in the UWG) on price reduction advertisement. It is therefore still possible to advertise the discount in relation to the "normal price" if – insofar as there are deviations – the lowest total price demanded within the last 30 days according to Section 11 PAngV is indicated additionally.

Conclusion

As is often the case with amendments to the law, there are still a number of unanswered questions regarding the interpretation of Section 11 PAngV n.F., which will have to be clarified by the courts in the coming years.

Jakob Nüzel
Lawyer, Munich

Tel +49 (0)89 383870-0
jnu@preubohlig.de
Profil: Link Website

New provisions in the UWG (Unfair Competition Act) by the Act to Strengthen Consumer Protection in Competition and Trade Law

On 28 May 2022, the Act to Strengthen Consumer Protection in Competition and Trade Law will come into force, which will again significantly amend the Unfair Competition Act (UWG) and some ancillary laws, barely half a year after the Act to Strengthen Fair Competition came into force. The Act to Strengthen Consumer Protection implements the requirements of Directive (EU) 2019/2161; in addition, the German legislator has taken the opportunity to reformulate individual provisions of the Unfair Competition Act, to restructure the misleading provisions in Sections 5 - 5b UWG (new version) and to make provisions on influencer marketing.

So what specific changes in the law do we have to be prepared for?

Section 1 (2) UWG (new version): Principle of Speciality

First of all, Section 1 (2) UWG (new version) stipulates that provisions regulating special aspects of unfair acts take precedence over the UWG provisions when assessing whether an unfair commercial act exists. Section 1 (2) UWG (new version) thus does nothing more than establish the general principle of speciality, which has already been anchored in German law up to now - so it does not bring anything new.

Expansion of the legal definitions contained in Section 2 UWG

The legal definitions contained in Section 2 UWG are arranged in alphabetical order and expanded by some definitions of terms:

Section 2 (1) no. 2 UWG (new version), the legal definition of a commercial act, clarifies that "goods and services" also include digital contents and services and that for a "commercial act" to exist there must not only be an "objective", i.e. functional connection with the promotion of the sale or purchase of goods and services, but also a "direct" connection. According to the explanatory memorandum, the latter is lacking if an influencer recommends goods or services without receiving anything in return.

In addition, the list of legal definitions has been expanded to include the terms "online marketplace" and "ranking":

• An **"online marketplace" within the meaning of Section 2 (1) no. 6 UWG (new version)** is a virtual marketplace which the operator makes available for business transactions and which consumers can use, e.g. for the conclusion of distance contracts within the meaning of Section 312c (1) BGB (German Civil Code). This includes in particular internet providers such as Amazon or eBay, but also rating and comparison portals where consumers can conclude contracts directly.

• According to the explanatory memorandum to the Act, a "ranking" within the meaning of **Section 2 (1) no. 7 UWG (new version)** is the relative prominence of the offers of companies or the relevance attributed to search results, depending on how they are presented, organised or communicated by the trader. This refers to the order in which the results of the respective search entry are listed, whereby the ranking is determined by the search engine operator. The type of technical means used should not play a role.

New version of the misleading advertising provisions, Sections 5, 5a and 5b UWG (new version)

The provisions contained in the previous Sections 5 and 5a UWG have been restructured in Sections 5 - 5b UWG (new version) in order to improve the readability of the provisions.

A new provision is **Section 5 (3) no. 2 UWG (new version)** According to this provision, a commercial act is also misleading if it markets a product in an EU member state as being identical to a product made available on the market in other EU member states, although these products differ substantially in their composition or in their integrity, and this is not justified by legitimate and objective factors (so-called **"dual quality"**). The addressees of the regulation are thus first and foremost the manufacturers of branded products who decide on the use of the brand and the recipe.

In addition to the use of the same trademark, "identical marketing" within the meaning of Section 5 (3) no. 2 UWG (new version) requires that the product is offered in a matching presentation. The decisive factor is whether the consumer can easily recognise existing differences in the presentation of the product. In this respect, the front label of the product is primarily decisive. The correct wording of the list of ingredients will probably not be sufficient in case of doubt.

Furthermore, the elements of Section 5 para. 3 no. 2 UWG (new version) require that the labelled goods differ substantially from each other in their composition or their integrity. In the case of foodstuffs, this may be the case if the individual ingredients are used in different quantities or the declared nutritional values differ by 10%.

However, identical labelling and product presentation despite significant differences in the product composition is only misleading if there is no justification for it. Such justification may be, for example, different national laws, different availability or seasonality of raw materials or different eating habits in the individual geographical markets.

Section 5a (1) UWG (old version), according to which, when assessing whether the concealment of a fact is misleading, its significance for the consumer's business decision and its suitability for influencing the decision must be taken into account, was repealed and the other provisions of Section 5a UWG (old version) were restructured.

Best Lawyers Germany 2023 – Pharmaceuticals Law

Peter von Czettritz and Dr. Alexander Meier are listed as „Best Lawyer in Health Care Law and Pharmaceuticals Law“

Section 5a (4) sentence 1 UWG (new version) obliges the consumer to disclose the commercial purpose of a commercial act, unless this purpose can be derived directly from the circumstances. The **new sentence 2 of Section 5a (4) UWG (new version)** also clarifies that a commercial purpose does not exist in the case of an act in favour of another company if no consideration is given. Pursuant to sentence 3 of the provision, the receipt or promise of a consideration is presumed, unless the trader makes it credible that he has not received any consideration. As the term "prima facie evidence" makes clear, it is not necessary to render full proof of the absence of consideration; rather, the submission of an affidavit is also admissible within the meaning of section 294 of the Code of Civil Procedure. In this respect, sentence 3 of the provision contains not only a reversal of the burden of proof but also a reduction of the standard of proof.

Section 5b (1) UWG (new version) provides a definition - only valid for consumer transactions - of "public information" within the meaning of Section 5a UWG (new version). This includes

- all essential characteristics of the goods or services in a scope appropriate to the means of communication used,
- the identity and address of the trader,
- the total price together with all additional costs
- the terms of payment, delivery and performance, insofar as they deviate from the requirements of entrepreneurial diligence,
- the existence of the right of withdrawal or cancellation, and
- in the case of goods or services offered through an online marketplace, information on whether the provider of the goods or services is a trader.

If a trader makes consumer reviews of its goods and services available, it must also provide information on whether and how it is ensured that the published reviews come from persons who have actually used or purchased the goods or services.

Prohibition of infringement of consumer interests, Section 5c UWG (new version)

In the new Section 5c UWG, those unfair acts are listed which, according to Section 19 UWG (new version), can also be punished with a fine. In detail this concerns

- Acts which are per se unlawful according to nos. 1 - 31 of the annex to section 3 (3) UWG (new version),
- • aggressive commercial acts according to Section 4a (1) sentence 2 UWG (new version),
- • misleading commercial acts according to Section 5 (1) or Section 5a (1) UWG (new version) as well as
- unfair commercial acts pursuant to Section 3 (1) UWG (new version) which are continued although they have already been prohibited by an enforceable order of the competent authority or an enforceable court decision.

Section 5c UWG (new version) is intended to enable uniform and thus effective enforcement of consumer rights throughout Europe.

Section 9 UWG (new version) - Compensation for Damages

Pursuant to Section 9 (1) UWG (new version), a person who intentionally or negligently commits a commercial act that is unlawful under Sections 3 or 7 UWG (new version) is obliged to compensate competitors for the resulting damage. The new paragraph 2 inserted into the provision now also gives **consumers the right to claim damages**. However, consumers are still not entitled to injunctive relief.

The claim for damages under Section 9 (2) UWG (new version) presupposes that the consumer was induced to make a business decision that he would not otherwise have made by a commercial act that is unlawful under Section 3 UWG (new version). Thus, business acts according to Sections 3a, 4, 6 and 7 UWG (new version) as well as according to no. 32 of the appendix to Section 3 (3) UWG (new version) do not justify compensation. Moreover, only such damages are to be compensated which result directly from the business decision taken by the consumer, not, however, any consequential damages. Other claims for damages of the consumer, e.g. on the basis of civil law provisions, remain unaffected.

Jurisdiction, Section 14 (4) UWG (new version)

Pursuant to Section 14 (4) UWG (new version), the jurisdiction of the courts for consumer claims for damages based on Section 9 (2) UWG (new version) is governed by the general provisions. Thus, the local courts have subject-matter jurisdiction for actions for damages with an amount in dispute of not more than 5,000 pursuant to Section 23 no. 1 GVG (Courts Constitution Act). With this provision, the legislator wanted to prevent an overloading of the district courts, which otherwise have exclusive jurisdiction for unfair competition cases, and to keep costs low for consumers who file complaints.

New Elements in the Annex to Section 3 (3) UWG (new version)

The Annex to Section 3 (3) UWG was amended by the Act to Strengthen Consumer Protection by adding Nos. 11a, 23a, 23b, 23c, 26 and 32:

- No. 11a concerns the display of search results in a ranking without the indication that the position of the ranking may be influenced by paid advertising or special payments.

- No. 23a of the Annex prohibits the circumvention of restrictions on the purchase of tickets for major events and the resale of tickets to consumers in the black market.

- No. 23b declares the reproduction of consumer reviews of goods or services unlawful unless reasonable and proportionate measures have been taken to verify that the reviews actually come from consumers who have purchased or used the goods or services

- According to No. 23c of the Annex, the transmission or commissioning of falsified consumer reviews or recommendations as well as their misrepresentation in social media for the purpose of sales promotion is per se unlawful, and

- according to No. 26 of the Annex, persistent and unwanted solicitation of consumers, e.g. by telephone calls, unless this is justified for the legitimate enforcement of a contractual obligation.

- According to No. 32 of the Annex, it is also unlawful to ask the consumer to pay for a product or service purchased on the same day during an unwelcome visit to the consumer's home, if the price of the product or service exceeds 50.

Amendment of the Price Indication Regulation

In order to achieve a better comprehensibility of the regulations, the Price Indication Ordinance has (PAngV) also been reworded:

- Section 2 PAngV (new version) now contains definitions of the terms "working or bulk price",

Best Lawyers Germany 2023 – Intellectual Property Law

Andreas Haberl, Daniel Hoppe, Jürgen Schneider, Ludwig von Zumbusch, Christian Donle, Konstantin Schallmoser, Axel Oldekop, Alexander Harguth are listed as „Best Lawyer in Intellectual Property Law“

"pre-package", "total price", "basic price", "loose goods", "open package", "self-filling", "trader" and "consumer".

- Furthermore, Section 11 PAngV (new version) contains a new regulation on price reductions and

- in Section 14 (2) PAngV a provision on charging e-vehicles at publicly accessible charging stations.

- Sections 7, 4 and 10 PAngV concern the (separate) labelling of deposit fees, the "unambiguous, clearly recognisable and legible" indication of the basic price next to the total price (and no longer only in "immediate proximity thereto") and price indications in shop windows.

Dr. Stephanie Thewes
Lawyer, Counsel,
Munich

Tel +49 (0)89 383870-0
sth@preubohlig.de
Profil: Link Website

Best Lawyers Germany 2023 – Technology Law

Christian Kau is listed as „Lawyer of the Year in Technology Law“

Countdown to the Unified Patent Court has begun

On 19 January 2022, the Protocol on the Provisional Application of the UPC Agreemententered into force. Thus, the Unified Patent Court now exists as a legal entity.

The constituent meeting of the Administrative Committee took place on 22 February 2022. The Administrative Committee will adopt the necessary legal texts and appoint the judges in the coming months. It will be supported by the so-called Advisory Committee, consisting of judges, lawyers and patent attorneys, which will conduct interviews and propose a list of judges between March and May 2022. The IT system is also to be finalised in the summer. Opt-out requests can then be submitted to the court registry.

As soon as Germany deposits the instrument of ratification in Brussels, the actual countdown to the launch of the UPCA as an operating court system will begin. The Agreement will then enter into force on the 1st day of the 4th month after Germany deposits its instrument of ratification. During this time, the grant of a pending EP application can be delayed until the entry into force of the UPCA upon request to the EPO, which creates the possibility of requesting unitary effect.

The remaining months until the final launch should be used to familiarise oneself with the new system. Filing strategies should be put to the test with a view to the unitary patent as a new means of protection, the integration of the EP into the new court system and the abolition of the prohibition of double protection in some states, e.g. Germany and France. Furthermore, precautions must be taken in the case of co-ownership of European patents, licence agreements or current or pending proceedings.

Preu Bohlig & Partner will guide you professionally and competently through this preparatory phase. In March, we will publish a special EPC Newsletter highlighting all aspects of the new system. We are also planning further online seminars:

- Tuesday, 10 May 2022, 17:00 - 19:00: EPCIP - Review: Introduction and basics of the new European patent system (in German)w
- Tuesday, 24 May 2022, 09:30 - 12:30: Countdown to the UPCA - What you need to prepare now (in German)
- Tuesday, 28 June 2022, 8:30 - 12:00: Countdown UPCA (in English)
- Tuesday, 28 June 2022, 17:00 - 20:30: Countdown UPCA (in English)

You can already register with Ms Anja Friedrich (anf@preubohlig.de). Are several people from your firm/ company interested in participating or would you like to forward the invitation to selected partners, colleagues or clients at home and abroad? Please do not hesitate to contact us.

Konstantin Schallmoser, LL.M. (Paris II)
Lawyer, Partner
Munich, Paris
Tel +33 (0)153815040
ksc@preubohlig.de
Profil: Link Website

Renate Künast successful before the Federal Constitutional Court – strengthening the rights of those affected by violations of personal rights

The Federal Constitutional Court (BVerfG) has strengthened the rights of those affected by hate speech in a noteworthy decision (decision of 19.12.2021, ref. 1 BvR 1073/20). In particular, the Federal Constitutional Court clarified that even politicians do not have to accept every insult because of their professional position, even if it is not purely defamatory criticism.

At the beginning of 2019, a false quote by the German politician Renate Künast (Bündnis 90/Die Grünen) was spread on the social network Facebook, to which numerous Facebook users reacted with hate speech directed against Ms Künast. Ms Künast then filed a request for information with the Berlin Regional Court pursuant to Section 14 (3) of the German Telemedia Act (TMG, old version) in order to oblige Facebook to hand over the inventory data of the authors of the comments so that Ms Künast would be enabled to take civil action against them . The success of such a request presupposes, among other things, that the comments complained of are illegal content pursuant to § 1 para. 3 NetzDG, in this case criminal insults pursuant to § 185 StGB.

Upon Ms Künast's request, the Berlin Regional Court only allowed the provision of information regarding some formal insults such as "piece of shit" or "bitch" and rejected the request for the most part. The Higher Regional Court Berlin (Kammergericht), as the next higher instance, allowed the provision of information also with regard to further statements such as "green filthy pig" and "perverse filthy sow", but essentially confirmed the opinion of the Regional Court. According to the Kammergericht, comments such as "paedophile bimbo", "mentally ill" or "brain-amputated" were covered by freedom of expression and thus not punishable. In particular, the statements in question were factually connected to an interjection by Künast in the context of a debate in the Berlin House of Representatives in 1986 on the position of the Greens on paedophilia. Such hostilities, which were not mere formal insults, were to be accepted by professional politicians.

In response to the constitutional complaint lodged by Ms Künast against the decision of the Kammergericht, the BVerfG countered this view. Although the BVerfG stated that the boundaries of permissible criticism of politicians are to be drawn wider than in the case of private individuals. However, this should not lead to politicians having to accept any insult, as long as it is not purely defamatory criticism. Even if there is a factual connection with a public debate, the meaning of each individual statement must be examined and then, within the framework of an overall assessment of the circumstances of the individual case, the freedom of expression of the person making the statement (Article 5 of the Basic Law) must be weighed against the right of personality of the person concerned (Articles 1 and 2 of the Basic Law). This applies to private individuals as well as to politicians.

The Regional Court and the Higher Regional Court failed to carry out this necessary weighing in their decisions and instead wrongly assumed that professional politicians had to accept any hostility in the public battle of opinions, as long as any factual connection with a public statement or factual debate could be established.

The BVerfG correctly points out that politicians also have a claim to the protection of their personal rights and that this is also in the public interest. If the personal rights of politicians are not sufficiently protected, a high degree of willingness of the individual to participate in the state and society can hardly be expected.

The BVerfG also rightly opposed the opinion of the courts of instance that, due to the decline in language and the brutalisation to the point of radicalisation of social discourse that can be observed on the internet, a more generous standard should be applied in favour of the

authors of hate comments. In the opinion of the BVerfG, it must be taken into account whether a statement was made verbally, ad hoc and in a heated debate or - as in the present case - in text form. Especially in the case of written or textual statements, however, a higher degree of consideration and restraint is to be expected from the author. This also applies to statements in social networks.

The BVerfG upheld Ms Künast's constitutional complaint, overturned the decisions of the courts of first instance and referred the case back to the Kammergericht for a new decision.

The case of the politician Tareq Alaows (Bündnis 90/Die Grünen) shows what hate speech in social networks can lead to. Due to numerous attacks and threats against his person, he was forced to withdraw his candidacy for the parliamentary elections in 2021. The announcement of Ms Ricarda Lang's candidacy as federal leader of Bündnis 90/Die Grünen in December 2021 was also followed by a large number of hate comments on social networks. Preu Bohlig & Partner has already been successful in several cases for Ms Lang with requests for information pursuant to Section 21 (2) and (3) TTDSG (Section 14 (3) TMG a.F.). Due to the recent decision of the Federal Constitutional Court, the chances of success of such requests are likely to have increased even more.

Anja Böhm, LL.M. (Cape Town)
Lawyer,
Düsseldorf

Tel +49 (0)211598916-0
abo@preubohlig.de
Profil: Link Website

Dr. Torben Düsing

Lawyer, Partner
Düsseldorf

Tel +49 (0)211598916-0
tdu@preubohlig.de
Profil: Link Website

MLI - Media Law International

Ranked Firm 2022

WTR 1000 – World Trademark Review

Named are: Astrid Gérard, LL.M. and Dr. Jan Peter Heidenreich, LL.M.

The unregistered Community design: Independent protection of individual parts in the case of disclosure of an overall product - the CJEU decision "Ferrari/Mansory Design [Front kit]" (C-123/20)

On 28 October 2021, the CJEU (C-123/20) ruled on a reference for a preliminary ruling from the German Federal Court of Justice (FCJ) that individual parts of a product can enjoy independent protection when a whole product is disclosed: Where images of a product are made available to the public, this can result in a design on a part of that product being made available to the public and possibly acquiring independent protection as an unregistered Community design within the meaning of Articles 1(2)(a), 11(2) CDR.

1. The reference for a preliminary ruling by the FCJ was preceded by a legal dispute between Ferrari SpA and Mansory Design & Holding GmbH due to the alleged infringement of rights arising from several unregistered Community designs (UCD) of Ferrari.

Ferrari first unveiled its FXX K sports car in a press release on 2 December 2014, which showed photographs of the car as follows::

The FXX K's special feature is the "V"-shaped element on the front bonnet, the fin-like elements protruding centrally from the front bonnet, the two-piece front spoiler integrated into the bumper, and its central connecting bar that joins the front spoiler to the front bonnet. According to Ferrari, these elements are understood as a unit that determines the individual "facial features" of this vehicle (cf. para.18).

Mansory Design offered several tuning kits to alter the appearance of other Ferrari models to the appearance of the FXX K.

Ferrari based its claim on a total of 3 UCDs: the "V"-shaped front bonnet, in the alternative the two-layer front spoiler and further in the alternative the vehicle as a whole as disclosed in the press release in an oblique view. In addition, Ferrari asserted claims limited to Germany based on supplementary protection of intellectual property under competition law (Sec. 4 no. 3 German Act against Unfair Competition (UWG)) (para. 19 et seq.).

2. The Duesseldorf Regional Court dismissed the action in its entirety. The Duesseldorf Higher Regional Court dismissed Ferrari's appeal on the grounds that only an UCD had arisen in the sports car published by the press release as an overall product, but that this was not infringed by the distribution of the tuning kits in dispute by Mansory Design (para. 24).

3. In the appeal proceedings, the FCJ referred the following questions to the CJEU by way of a preliminary ruling under Article 267 TFEU (para. 28):

(1) Can unregistered Community designs in individual parts of a product arise as a result of disclosure of an overall image of a product in accordance with Article 11(1) and the first sentence of Article 11(2) of Regulation No 6/2002 (CDR)?

(2) If Question 1 is answered in the affirmative: What legal criterion is to be applied for the purpose of assessing individual character in accordance with Article 4(2)(b) and Article 6(1) CDR when determining the overall impression of a component part which – as in the case of a part of a vehicle's bodywork, for example – is to be incorporated into a complex product? In particular, can the criterion be whether the appearance of the component part, as viewed by an informed user, is not completely lost in the appearance of the complex product, but rather displays a certain autonomy and consistency of form such that it is possible to identify an aesthetic overall impression which is independent of the overall form?'

4. In its decision of 28 October 2021, the CJEU first states in general terms (para. 31) that the objective of the CDR is, inter alia, to introduce a design which confers protection in all member states of the EU and thereby leads to innovation and the development of new products and encourages investment in the manufacture of such products (para. 31). Furthermore, by introducing the UCD, the EU legislature had intended to promote innovation in designs specifically for products which have only a short life on the market and for which their designers desire rapid and effective protection without registration formalities, and for which the duration of protection is of lesser significance (para. 32).

5. The material conditions required for the protection of a Community design, whether registered or not, i.e. novelty and individual character, are the same for products and their parts. For the protection of the appearance of a component part of a complex product, the requirements set out in Art. 4(2) CDR must also be observed (para. 33). These are (i) visibility during normal use and (ii) novelty and individual character of the visible features of the component part itself.

6. With regard to the formal condition for giving rise to an UCD, the CJEU states (para. 36) that, according to Article 11(2) CDR, a design has to be published, exhibited, used in trade or otherwise disclosed in such a way that, in the normal course of business, these events could reasonably have become known to the circles specialised in the sector concerned, operating within the EU.

7. Against this background, the CJEU concludes that, in order for an UCD to arise in respect of a part of a product disclosed in its entirety, it is first essential that the appearance of that part be clearly identifiable when the design is made available. If not, the specialised circles cannot reasonably acquire the knowledge required as regards the part of the product concerned (para. 38). However, it was not necessary for the requirement concerning the ability to identify the subject matter of the protection to disclose each individual part of a product separately. Such an obligation would be contrary to the objective of simplicity and rapidity which justified the establishment of the UCD (para. 40).

8. However, the CJEU held that, in order to review the specific character of the UCD, it was necessary that the part of a product or the component part of a complex product at issue must be visible and defined by features which constitute its particular appearance, namely by particular lines, contours, colours, shapes and texture. According to the CJEU, this presupposes that the appearance of that part of a product or of that component part of a complex product is capable, in itself, of producing an overall impression and cannot be completely lost in the product as a whole (para. 50).

9. Against this background, the CJEU answers the questions posed by the FCJ as follows:

(1) Article 11(2) CDR must be interpreted as meaning that the making available to the public of images of a product, such as the publication of photographs of a car, entails the making available to the public of a design of a part of that product, within the meaning of Article 3(a) CDR, or of a component part of that product, as a complex product, within the meaning of Article 3(c) and Article 4(2) CDR, provided that the appearance of that part or component part is clearly identifiable at the time the design is made available.

(2) In order for it to be possible to examine whether that appearance satisfies the condition of individual

character referred to in Article 6(1) CDR, it is necessary that the part or component part in question constitute a visible section of the product or complex product, clearly defined by particular lines, contours, colours, shapes or texture.

10. The CJEU's decision provides new guidelines for the assessment of UCDs and significantly strengthens their importance. In future, it will be possible to derive rights from an UCD also for individual parts of an overall product. It is important that the corresponding element is clearly recognisable and visible and is not lost in the appearance of the overall product.

Andreas Haberl
Lawyer, Partner
München

Tel +49 (0)89383870-0
aha@preubohlig.de
Profil: Link Website

Moritz Körner
Lawyer,
München

Tel +49 (0)89383870-0
mko@preubohlig.de
Profil: Link Website

"NJW-Orange"

By decision of 22.7.2021 (Ref.: I ZB 16/20), the Federal Supreme Court (BGH) ruled on an application for cancellation against the abstract colour mark "Orange" for legal journals reproduced above. The decision is printed, for example, in WRP 2021, 1566 et seq. The proprietor of the trade mark is C. H. BECK oHG. The trade mark was applied for at the German Patent and Trade Mark Office on 10.6.2008 and registered as a trade mark enforced in the course of trade on 25.2.2009.

Beck-Verlag uses the colour mark "orange" for the Neue Juristische Wochenzeitschrift (NJW), which has been published since 1947 and is mainly read by lawyers, notaries, judges, judicial officers, legal trainees and law students. According to the entry in Wikipedia, the weekly circulation amounts to a good 30,000 copies.

In a written submission dated 15.10.2015, the applicant in the proceedings requested cancellation of the abstract colour mark "Orange" on the grounds of absolute grounds for refusal under Section 50 Trademark Law, relying on various grounds for refusal. The German Patent and Trade Mark Office rejected the request for cancellation. The Federal Patent Court dismissed the applicant's appeal against the decision of the German Patent and Trade Mark Office on the basis of the oral hearing on 2.10.2019. The applicant's appeal on points of law was directed against this, whereby the subject matter of the proceedings before the Federal Supreme Court was only the ground for refusal of lack of distinctiveness pursuant to Section 8 (2) No. 1 Trademark Law.

Both the Federal Patent Court and the Federal Supreme Court found that the abstract colour mark "orange" was devoid of distinctive character. The trade mark could therefore only endure if this ground for refusal had been overcome either on the date of the trade mark application on 10.6.2008 (see BGH WRP 2018, 451 - Quadratische Tafelschokoladenverpackung I; BGH GRUR 2013, 1143 - aus Akten werden Fakten) or at the time of the decision on the cancellation request (this being the conclusion of the oral hearing before the Federal Patent Court on 2.10.2019) by prevailing in the market pursuant to Section 8(3) MarkenG. An application for cancellation under Section 50 Trade-mark Law is only successful if the ground for refusal still exists at the time of the decision, Section 50(2), first sentence, Trademark Law. Accordingly, if the ground for refusal had already been overcome on the date of filing the trade mark application, the application for cancellation cannot be successful for this reason alone. In other words, if the ground for refusal had been overcome on the date of filing the trade mark application, the registered trade mark will continue to exist, even if the requirements for passing off are no longer fulfilled at a later date.

Assertion of distinctiveness requires that, in principle, at least 50% of the relevant public perceive the sign applied for as a trade mark of the applicant (see, inter alia, Ströbele/Hacker/Thiering, 13th ed., § 8, marginal no. 665 with further references). The relevant public in this case were lawyers, notaries, judges, judicial officers, trainee lawyers and law students. A survey report according to which more than 50% of the public concerned considered the colour mark "orange" to be a trade mark of Beck-Verlag was not available in the proceedings.

The Federal Patent Court was of the opinion that the ground for refusal of lack of distinctive character had been overcome by prevailing in the trade. It was true that a corresponding demoscopic expert opinion was not available. However, indirect indications such as turnover, market share, intensity, geographical distribution and duration of use of the trade mark for the legal journal "Neue Juristische Wochenschrift" would suggest that the ground for refusal had been overcome at the time of filing the application by way of acceptance by the public pursuant to Section 8 (3) Trademark Law. It was not beyond doubt that the facts and indications established, which proved that the NJW was well known, were sufficient to render proof that the colour mark had

become established in the relevant circles of the public. However, the applicant's submission in this respect was unsubstantiated, so that the remaining doubts would be to the applicant's detriment.

Accordingly, the Federal Patent Court took the view that the applicant had to prove in the proceedings that the ground for refusal of lack of distinctive character had not been overcome by prevailing in the trade. So far, this was also in line with the case law of the Federal Supreme Court.

With the aforementioned decision of 22.7.2021, the BGH abandoned the case law according to which remaining doubts as to whether or not a ground for refusal existed would be to the detriment of the applicant. In general, it was rather up to the trade mark proprietor to prove in cancellation proceedings those circumstances from which the (continued) existence of his trade mark would result. In the present case, Beck-Verlag had so far failed to prove that on the date of the application for registration of the trade mark or on the date of the decision on the application for cancellation, the trade mark had become established.

For this reason, the Federal Court of Justice set aside the decision of the Federal Patent Court and referred the case back to the Federal Patent Court. In the further proceedings, Beck-Verlag will have the opportunity to prove, by means of an expert opinion, that there was an assertion of distinctiveness at the time of filing or at the time of the decision (which is the date of the conclusion of the new hearing before the Federal Patent Court).

Conclusion:

If a trade mark has been registered only on the basis of acceptance by the public, the proprietor of the trade mark should have a demoscopic opinion that more than 50% of the public concerned considered the trade mark to be the applicant's trade mark at the time of filing. If this is not the case, the trade mark proprietor should ensure that such a demoscopic opinion is available at the latest at the time of the decision on an application for cancellation. Furthermore, the trade mark proprietor should be able to submit documents on the market share, the intensity of use, the geographical distribution, the duration of use, and the advertising expenditure, and should also obtain opinions from chambers of commerce and other professional associations.

Jürgen Schneider
Lawyer, Partner
Munich

Tel +49 (0)89 383870-0
jsc@preubohlig.de
Profil: Link Website

Lectures and Seminars:

see Website „News“

MAY 2022

May 4, 2022, Online-Seminar
„Sicherheit kosmetischer Mittel bei neuen Produkten oder Produktänderungen“
Akademie Fresenius

May 10, 2022, 17:00 -19:00, Online-Seminar
EPGÜ – Wiederholung: Einführung und Grundlagen in das neue Europäische Patentsystem

May 12, 2022, Online-Seminar
„Abgrenzungsvereinbarungen im Markenrecht“
Akademie Heidelberg

May 18, 2022 (also as Live-Stream)
34. Deutscher Pharma Recht Tag 2022

May 24, 2022, 9:30 - 12:30, Online-Seminar
Countdown zum EPGÜ - Was Sie jetzt vorbereiten müssen

JUN 2022

June 28, 2022, Online-Seminar
„Regulatorische Abgrenzung – wann ist ein Kosmetikum noch ein Kosmetikum? Boarderlineprodukte richtig einordnen“
Akademie Fresenius

June 28, 2022, 8:30 – 12:00, Online-Seminar
Countdown UPC and Unitary Patent (in English)

June 28, 2022, 17:00 – 20:30, Online-Seminar
Countdown UPC and Unitary Patent (in English)

Lectures and Seminars:

see Website „News“

SEP 2022

September 20, 2022, Online-Seminar
„Kosmetikrecht kompakt“
Akademie Fresenius

September 21, 2022, Online-Seminar
„Kennzeichnung und Bewerbung von Kosmetika“
Akademie Fresenius

Would you like to receive our newsletter?

PREU BOHLIG & PARTNER
Rechtsanwälte mbB
Telefax +49 (0) 89 383870-22
or info@preubohlig.de

If your colleagues or members of other departments would be interested in receiving our newsletter, please send the completed form to the fax number or email address above..

Firm _____

Name _____

E-Mail _____

Newsletter ☐ German ☐ englisch

PREU BOHLIG & PARTNER Rechtsanwälte mbB sends this newsletter by email at regular intervals. If you are no longer interested in receiving our newsletters, you can send an email to the sender address of the respective newsletter or to the abovementioned email address at any time. You will then immediately be removed from the mailing list and your data will be deleted. Subscription to this newsletter is free of charge.

Our Locations

Berlin
Grolmanstraße 36
10623 Berlin
Tel +49 (0)30 226922-0
Fax +49 (0)30 226922-22
berlin@preubohlig.de

Düsseldorf
Couvenstraße 4
40211 Düsseldorf
Tel +49 (0)211 598916-0
Fax +49 (0)211 598916-22
duesseldorf@preubohlig.de

Hamburg
Neuer Wall 72
20354 Hamburg
Tel +49 (0)40 6077233-0
Fax +49 (0)40 6077233-22
hamburg@preubohlig.de

München
Leopoldstraße 11a
80802 München
Tel +49 (0)89 383870-0
Fax +49 (0)89 383870-22
muenchen@preubohlig.de

Paris
139, boulevard Haussmann
F-75008 Paris
Tel +33 (0)1 538150-40
Fax +33 (0)1 538150-41
paris@preubohlig.de

Imprint:

To read our imprint please follow the link: https://preubohlig.de/impressum/

Editor: Preu Bohlig & Partner Partnergesellschaft mbB (Professional partnership with limited professional liability) based in Munich, entered in the partnership register of the Municipal Court of Munich (Germany) under PR2.

Picture credits: © stock.adobe.com

© Preu Bohlig & Partner 2022. All rights reserved.