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# NEWSLETTER

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APRIL 2007

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## I. NEWS ABOUT US

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### 1. Additional Support



**Stefan Bühling**, born in 1962, joined Kador & Partner in September 2006. He is a German and European patent and trade mark attorney and has practiced as a patent attorney since 1995. Previously he worked for a large patent attorneys' firm in Munich. He acquired special experience in prosecution, opposition and appeal proceedings

before the European Patent Office, the German Patent and Trade Mark Office and the German Federal Patent Court.

Mr. Bühling acquired a degree as a graduate chemist at the Technical University of Munich. He obtained experience in industrial property rights in a US patent attorneys' office in Alameda, California. In our firm Mr. Bühling handles all stages of patent cases, including expert opinions, patent clearances and litigation. Mr. Bühling has special expertise in organometallic chemistry, polymer chemistry as well as biotechnology.

We are further pleased to announce that **Dr. Kerstin Reitwiessner** joined our firm in October 2006 as a patent attorney trainee.

Dr. Reitwiessner studied chemistry with a focus on biochemistry at the Technical University of Darmstadt and completed her studies in 2000 as a graduate engineer with a diploma thesis in the field of cellular and molecular biology.



In her subsequent dissertation at the Clemens-Schöpf Institute of Organic Chemistry and Biochemistry of the TU Darmstadt, she dealt

with the molecular mechanism of apoptosis in human endothelial cells and was awarded a doctorate degree (Dr.-Ing.). She specializes in biochemistry and has knowledge of medicine and chemical engineering

### 2. World IP Services Contacts Handbook

We are proud to inform you that Kador & Partner was ranked as one of the leading firms in Germany in the area of trade marks in the World IP Services Contacts Handbook 2005 – Managing Intellectual Property.

### 3. INTA Roundtable

In December, **Mr. Achim Bender**, Member of the Boards of Appeal, OHIM, gave a very interesting lecture on “Current case law regarding Community Trade Marks” on the occasion of an INTA Roundtable held in our office in Munich. Due to Mr. Benders long term experience and expertise, all participants of the INTA Roundtable received very valuable information and took the chance to discuss current topics.



Dr. Kador and Mr. Bender

### 4. International Conferences

#### INTA CHICAGO

The International Trade Mark Association's (INTA) Annual Meeting is a must-attend event for intellectual property practitioners. From April 29 to May 2, 2007, more than 7,500 participants from all over the world were expected to meet in Chicago.

Kador & Partner was represented by Dr. Utz Kador, Dr. Elisabeth Vorbuchner, Ms. Susanna Heurung and Ms. Barbara Regensburger.

#### ECTA DEAUVILLE

In June 2007, Dr. Utz Kador and Ms. Barbara Regensburger will attend the ECTA (European Communities Trade Mark Association) Conference in Deauville, France. Deauville will certainly be a wonderful place for the celebration of ECTA's 26th Annual Conference and will gather delegates from all over the world.

For its Annual Conference, ECTA has put together a programme under the title “And...Action! Producers need their IP Experts before every take”. We look forward to meeting colleagues, representatives of the European Commission, OHIM (Office for Harmonization in the Internal Market) and WIPO (World Intellectual Property Organization) and to learning

more about current European case law, design protection and domain names.

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## II. EUROPEAN PATENT LAW

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### 1. Referral of questions regarding divisional applications to Enlarged Board of Appeal

In recent decisions T39/03, T1409/05 and T1040/04, the Technical Boards of Appeal of the European Patent Office have referred several questions relating to the content of divisional applications and patents which have emerged therefrom to the Enlarged Board of Appeal. The cases are pending under the reference numbers G1/05, G1/06 and G3/06, respectively.

The questions referred to in the first decision concern the validity of a divisional application which, at its actual filing date, contains subject matter extending beyond the content of any earlier parent application. In particular, the questions referred to the Enlarged Board of Appeal are the following:

“1)

Can a divisional application which does not meet the requirements of Art. 76(1) EPC because, at its actual filing date, it extends beyond the content of the earlier application be amended later in order to make it a valid divisional application?

2)

If the answer to question 1) is yes, is this still possible when the earlier application is no longer pending?

3)

If the answer to question 2) is yes, are there any further limitations of substance to this possibility beyond those imposed by Art. 76(1) and 123(2) EPC? Can the corrected divisional application in particular be directed to aspects of the earlier application not encompassed by those to which the divisional as filed has been directed?”

Furthermore, in decision T1409/05 the Board of Appeal has referred the following questions to the Enlarged Board of Appeal:

“1)

In the case of a sequence of applications consisting of a route (originating) application followed by divisional applications, each divided from its predecessor, is it a necessary and sufficient condition for a divisional application of that sequence to comply with Art. 76(1) EPC, second sentence,

that anything disclosed in that divisional application can be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed?

2)

If the above condition is not sufficient, does said sentence impose the additional requirement

a) that the subject matter of the claims of said of the claims of its divisional predecessors?

or

b) that all the divisional predecessors of said divisional comply with Art. 76(1) EPC?"

Finally, with decision T1040/04, relating to an opposition matter and underlying G3/06, the Board of Appeal has referred the following question to the Enlarged Board of Appeal:

"Can a patent, which has been granted on a divisional application, which did not meet the requirements of Art. 76(1) EPC, because at its actual date of filing, it extended beyond the content of the earlier application, be amended during opposition proceedings in order to overcome the ground of opposition under Art. 100(C) EPC and thereby fulfil said requirements?"

In view of the fact that the subject matter of all the above-mentioned questions are closely linked, the Enlarged Board of Appeal has decided to consider the points of law referred to it in consolidated proceedings, i.e. there will be one common decision issued by the Enlarged Board of Appeal in which all these questions are answered.

*Our comments: all the questions referred to the Enlarged Board of Appeal in G1/05, G1/06 and G3/06 center around the correct interpretation of Art. 76(1) EPC. In essence, the question to be answered by the Enlarged Board of Appeal is whether or not it is possible to amend the content of a divisional application in the application procedure and/or opposition procedure so as to remove added subject matter according to Art. 76(1) EPC.*

*The referral of these questions to the Enlarged Board of Appeal confirms our long standing policy as regards the submission of divisional applications, which simply is to file any divisional application with exactly the same description and figures as were filed with the parent application, and to file amendments only at a later stage. By doing so, it is ensured that the requirement of Art. 76(1) EPC is complied with, regardless of the future ruling of the Enlarged Board of Appeal on the above-mentioned questions.*

## 2. Decision J 18/04 on re-establishment of rights for filing a divisional application

The case underlying recent decision J 18/04 of the Legal Board of Appeal was that a divisional application had been filed based on a parent application for which, however, the mention of grant had already been published in the European Patent Bulletin two months before. The problem was that Rule 25(1) EPC prescribes that a divisional application may (only) be filed relating to any pending earlier European patent application. The parent application, however, was no longer pending, because an application ceases to be pending one day before the date of publication of the mention of its grant.

Together with the filing documents for the divisional application, a request for re-establishment of rights had been submitted in which it was argued that the provision of Rule 25(1) EPC defined a time limit in the sense of Art. 122(1) EPC. Hence, an applicant, who, in spite of all due care, failed to file the divisional application at the time when the earlier application was still pending, should be re-established in his rights.

The receiving section had refused the request for re-establishment of rights with the result that the filed application was not treated as a divisional application. The Legal Board of Appeal has now rejected the appeal filed against this refusal by the applicant. In its quite detailed reasoning, the Board of Appeal has, first, made clear that the term "pending patent application" as used in Rule 25(1) EPC does not establish a time limit in the sense of Art. 122(1) EPC, but rather constitutes a substantive requirement which has to be fulfilled at the time when a divisional application is filed. The Board further stated that the fact that this substantive requirement can only be fulfilled within a certain time frame, and, hence, an applicant has to proceed in a similar manner as if dealing with a proper procedural time limit, does not create such a procedural time limit (see in particular point 7. of the reasons for the decision).

The Board also refused the request for re-establishment of rights for a second reason. It argued that from a procedural point of view the subject matter of a divisional application is established only on its actual filing date by the description, claims and drawings filed. Accordingly, the Board stated that the rights which may be potentially lost if a divisional application is not filed while the earlier application is pending, are not established before the divisional application is actually filed, simply because there is no existing divisional application. Therefore, the Board stated that these non-existing rights cannot be lost (see in particular reason points 38 and 37).

*Our comments: This decision J 18/04 of the legal Board of Appeal makes it unmistakably clear that for filing a divisional application the requirement as stated in Rule 25(1) EPC must be obeyed and if not, no remedy e.g. via re-establishment of rights is present. Thus, we recommend to consider filing of a divisional application upon receipt of the Official Communication under Rule 51(4) EPC at the latest.*

### 3. Decision of the Enlarged Board of Appeal on Diagnostic Methods

In recent decision G1/04, the Enlarged Board of Appeal has decided on several questions which were referred to it by the President of the EPO (see our Newsletter of September 2004).

In its reasoning, the Enlarged Board of Appeal first pointed out that the reason why diagnostic methods, although regarded as inventions, are deemed in the systematics of the EPC to be not susceptible to industrial application by legal fiction, is that the medical and veterinary practitioners should be free to take the actions they consider suited to diagnose illnesses by means of investigative methods and not inhibited by patents.

The Board then continued to state that the term “diagnostic methods” is to be understood as comprising the steps of

- i) the examination phase involving the collection of data,
- ii) the comparison of these data with standard values,
- iii) the finding of any significant deviation, i.e. a symptom, during the comparison, and
- iv) the attribution of the deviation to a particular clinical picture, i.e. the deductive medical or veterinary decision phase.

As further pointed out by the Board, the crucial question to be answered is whether the “diagnostic methods” referred to in Art. 52(4) EPC comprise only the deductive medical or veterinary decision phase consisting in attributing the detected deviation to a particular clinical picture, i.e. the diagnosis for curative purposes *stricto sensu*, or whether they are also meant to include one or more of the preceding steps relating to examination, data gathering and comparison.

In point 6. of the reasons for the decision, the Board gave the opinion that when determining the scope of

the exclusion from patentability under Art. 52(4) EPC in respect of diagnostic methods, a narrow interpretation should be applied. Accordingly, a diagnostic method is only excluded from patentability if it comprises all of the above-mentioned steps (i) to (iv), and all of preparatory steps (i) to (iii) are performed on a living human or animal body. In contrast, a broad interpretation of the scope of exclusion would have meant that all methods practised on the human or animal body which relate to or which are of value for the purpose of diagnosis would have been excluded from patentability.

These considerations led the Enlarged Board of Appeal to answer the points of law referred to it by the President of the EPO as follows:

“1) In order that the subject matter of a claim relating to a diagnostic method practised on the human or animal body falls under the prohibition of Art. 52(4) EPC, the claim is to include the features relating to:

- (i) the diagnosis for curative purposes *stricto sensu* representing the deductive medical or veterinary decision phase as a purely intellectual exercise,
- (ii) the preceding steps which are constitutive for making that diagnosis, and
- (iii) the specific interactions with the human or animal body which occur when carrying those out among these preceding steps which are of technical nature.

2) Whether or not a method is a diagnostic method within the meaning of Art. 52(4) EPC may neither depend on the participation of a medical or veterinary practitioner, by being present or by bearing the responsibility, nor on the fact that all method steps can also, or only, be practised by medical or technical support staff, the patient himself or herself or an automatic system. Moreover, no distinction is to be made in this context between essential method steps having diagnostic character and non-essential method steps lacking it.

3) In a diagnostic method under Art. 52(4) EPC, the method steps of a technical nature belonging to the preceding steps which are constitutive for making the diagnosis for a curative purposes *stricto sensu* must satisfy the criterion “practised on the human or animal body”.

4) Art. 52(4) EPC does not require a specific type and intensity of interaction with the human or animal body; a preceding step of a technical nature thus satisfies the criterion “practised on the human or animal body” if its performance implies any interaction



with the human or animal body, necessitating the presence of the latter.”

Finally, under points 10 and 11 of the reasons for the decision, the Enlarged Board pointed out that the conclusions given in the present decision will stay valid to the full extent when the revised version of the EPC (“EPC 2000”) comes into force in December 2007.

*Our comments: To briefly summarize the Enlarged Board of Appeal’s view, a diagnostic method comprises three preparatory steps which are of a technical nature and form the basis for the fourth and last step being a purely mental activity and consisting in the determination of the illness by way of deduction. It is made clear by the Enlarged Board that a diagnostic method is only excluded from patentability if it comprises all the above-mentioned steps and if all the technical steps preceding the deductive last step (i.e. the diagnosis stricto sensu) are practised on the human or animal body.*

*The decision gives virtually the most narrow interpretation of “diagnostic methods” as excluded from patentability by Art. 52(4) EPC. It hence offers the opportunity to obtain patent protection for most of the technical applications in the field of diagnosis which are predominantly technical devices or methods for obtaining data in order to assist the medical practitioner in performing the last deductive step of the diagnosis. Accordingly, one can circumvent the exclusion of Art. 52(4) EPC if a claim either does not comprise the last step of the diagnosis stricto sensu or comprises at least one preceding step which is not practiced on the human or animal body.*

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### III. GERMAN PATENT LAW

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#### 1. Decision of German Federal Supreme Court on claims containing purpose, effect or function features and on statements in cancellation proceedings

In its recent decision “Deaerator for milk collection equipment” (Luftabscheider für Milchsammelanlage)<sup>1</sup>, the German Federal Supreme Court (FSC) in the first part has clarified its position as regards patent claims which in addition to technical features also contain details as to the purpose, effect or function of those features. The decision concerned an infringement suit which had been filed by the Proprietor of a patent as well as a utility model concerning a deaerator for milk collection equipment.

The patent had been upheld in nullity proceedings before the German Federal Patent Court with a main claim 1 in which the essential features were that between the deaeration vessel and the vacuum pump of a deaerator device, a foam collection vessel is placed, which is connected to the deaeration vessel via a return line. This return line should be lockable by a valve and bypassing the line section between the deaeration vessel and the foam collection vessel. The deaeration device was further characterized in that in the line section between the deaeration vessel and the foam collection vessel a valve had to be placed, which acted contrary to the valve present in the return line.

The allegedly infringing embodiment contained valves in both lines as required by claim 1 of the patent, but the electronic control of the valves did not allow a contrary action as required by the wording of the claim.

The Appeal Court as the previous instance had affirmed an infringement of the patent based on the reasoning that it was sufficient for the realization of the feature “two contrary-acting valves” that two valves are present at the required instances and that, in principle, it was possible to install an electronic control by which the valves would be controlled so as to perform contrary action

The FSC has now ruled that such a claim construction as given by the Appeal Court ignoring the non-realization of the functional relation contained in the claim is not correct. The FSC emphasized that claim 1 requires two valves which are characterized in that they perform contrary action. The scope of the claim thus does not comprise devices with two valves in which such a functional connection is not given but may only be imposed on the device by the addition of a particular electronic control.

On a more general basis, the FSC then stated that details as to purpose, effect or function can, as an element of a patent claim, be part of the latter function of distinguishing the protected subject matter from the state of the art, if they define the device to which they refer as one that must be designed in such a way that it can perform the function in question.

The present decision in its second part gives an interesting ruling based on the general principle of good faith to be applied between parties to an infringement dispute.

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<sup>1</sup>Decision of the Federal Supreme Court of June 7, 2006 – Case No. XZR 105/04

This ruling was triggered by the fact that the infringement suit, in addition to the above-mentioned patent, had also been based on a utility model which originally had been derived from said patent. The utility model had survived a cancellation action with a claim 1 which did not contain the feature that the deaeration device must contain two contrary acting valves. The Appeal Court as a previous instance had found an infringement of the utility model by the attacked embodiment. This finding was confirmed by the Federal Supreme Court in so far as the FSC also found that the attacked embodiment falls under the terms of claim 1 of the utility model. However, during the cancellation action the utility model had been subjected to, the Proprietor had stated that devices in which the milk re-feed is caused by gravity did not fall under the scope of protection of the utility model.

In the attacked embodiment, however, due to its particular construction the re-feed of the milk was caused by gravity. The Federal Supreme Court thus found that in spite of the fact that the attacked embodiment fulfilled all claimed features, the finding of an infringement by the Appeal Court would not comply with the general principle of good faith. The FSC further pointed out that the general principles of the prohibition on acts in breach of good faith apply between the parties to an infringement dispute in general. In addition, the FSC pointed out that such statements may be evidenced not only by their mention in a written decision but also by other kinds of evidence such as the testimony of witnesses.

*Our comments: The present decision is an important one in both aspects the FSC gives a ruling on. First, the FSC has confirmed and further clarified its view on the interpretation of functional features in claims. Accordingly, a device does not fall under the terms of a claim if a functional feature is not fulfilled, in spite of the fact that all structural features may be fulfilled. This applies even if there may be a basic possibility to change the mode of interaction of the structural means so as to fulfil the required function. However, it has to be borne in mind that an infringement may still be possible considering the doctrine of equivalence.*

*The second aspect as pronounced by the FSC is also an important one, because in many inter-parties proceedings such as opposition, nullity or cancellation proceedings, the patent Proprietor makes statements that some embodiments should not be regarded as falling under the scope of protection of a claim to improve his position versus the relevant prior art. The FSC has made clear that such statements should be considered*

*as binding, at least between the parties to opposition, nullity or cancellation proceedings which often take place parallel to infringement proceedings. Thus, the defendant in an infringement action can now rely on statements of the Patentee or utility model Proprietor.*

## 2. German Federal Supreme Court on interpretation of requirement of “inventive step” for utility models

In a recent decision<sup>2</sup> concerning a cancellation action brought against a utility model, the German Federal Supreme Court (FSC) finally had the opportunity to comment on the question of the assessment of inventive step as one of the requirements for protection of a utility model.

The case concerned a demonstration cabinet which was especially equipped for scientific education. The Federal Patent Court as the previous instance had ruled that the demonstration cabinet did not comply with the requirements of an inventive step as contained in the Utility Model Act.

In an obiter dictum, the Patent Court had stated that in the past, the senate responsible for utility model appeals had sometimes applied a rather low standard in the assessment of inventive step. This standard was that an inventive step was already present if the skilled person had to go beyond the framework of routine action order to arrive at the claimed subject matter. However, a non-obviousness of the claimed subject matter had not been deemed necessary.

The Patent Court had made clear in its decision that this often did not lead to convincing results and, hence, wanted the question of which standards have to be applied for the assessment of inventive step for a utility model to be clarified by the FSC.

In the present decision, the FSC has now made clear that all attempts to define a different, lower standard in the assessment of inventive step for a utility model compared to the standard applied in patent matters are inadequate. The Court, first, considered that these attempts are possibly triggered by the different wording of the requirement of inventiveness in the Utility Model Act which requires an “inventive step” (“erfinderischer Schritt”), whereas in the Patent Act an “inventive activity” (“erfinderische Tätigkeit”) is required.

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<sup>2</sup>German Federal Supreme Court,  
Decision of June 20, 2006 – Case No. XZB 27/05

However, in essence the Court came to the finding that for something to be inventive, it must have been non-obvious so that the standard to be applied in the assessment of an inventive step for a utility model is the same as in the assessment of inventive activity for a patent.

*Our comments: This decision will have severe consequences for the practice of utility models in Germany. Before the decision, it was generally accepted that due to the different formulations in the German Utility Model Act and the Patent Act ("erfinderischer Schritt" vs. "erfinderische Tätigkeit") there must also be some difference in the "extent of the inventiveness". However, in accordance with the decision, all such attempts must now be abandoned and from now on the same criteria have to be applied for a utility model and a patent as regards the non-obviousness of the subject matter for which protection is sought.*

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## IV. GERMAN TRADE MARK LAW

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### 1. German Federal Supreme Court accepts tactile trade marks

In a decision dated October 6, 2006 the German Federal Supreme Court (FSC) held that tactile trade marks may be registered<sup>3</sup>.

In the past, the German Patent Court (GPC) rejected tactile trade marks with the reasoning that such trade marks could not be represented graphically. The GPC held that according to the case law of the European Court of Justice (ECJ), the graphic representation of a trade mark in the register has to be "clear, precise, self-contained, easily accessible, intelligible, durable and objective".

In case of a tactile trade mark, these requirements could not be met. For example, the representation of a photograph of an object published in the register could only represent this object but not the wide range of sensory impressions that could be derived from the object and that were in fact the content of a tactile trade mark. Also, the description of the photograph of an object could not replace the description of the sensory impressions or haptic effects conveyed by that object. Moreover, the variety and diversity of individual sensory impressions could not be described objectively and could therefore not be reproduced graphically as requested by the above stated definition of the ECJ. Registration of tactile

trade marks was therefore excluded without exception.

The FSC, however, held that for a sign that is to be conveyed by sense of touch, only the relevant characteristics of an object have to be described when that object is to convey the sensory perceptions. Contrary thereto, it is not necessary to describe the sensory perceptions as such. The purpose of the requirement of graphic representation can be fulfilled when the object conveying the sensory impressions is described sufficiently in its relevant characteristics. For example, when a specific surface structure of an object is to be conveyed it shall be sufficient to describe the proportions of the cavities and elevations of the object as well as their alignment to each other.

*Our comments: This decision paves the way for tactile trade marks as a new type of trade mark. This decision may eventually also influence and enhance the possibilities of applicants to file and register other modern forms of trade marks such as olfactory marks.*

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<sup>3</sup>German Federal Supreme Court, Decision of October 6, 2006 – Case No. I ZB 73/05



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# BUILDING BRIDGES