



KADOR & PARTNER

NEWSLETTER

IP NEWS FROM EUROPE AND GERMANY

March 2024

I. NEWS ABOUT US



We are delighted and honored to announce the momentous occasion of Kador & Partner's 50th-year anniversary in 2024!

Established by Dr. Utz Kador in 1974, our firm has been dedicated to serving clients across the globe in matters related to German, European, and international intellectual property. As we stand at this significant juncture, we want to take a moment to express our profound gratitude to our esteemed clients, dedi-

cated colleagues, committed employees, and cherished friends. Your unwavering trust, loyalty, and support have been the cornerstone of our success over the past five decades.

This milestone is a testament to the collaborative efforts and relationships that have shaped our journey. We recognize that without the support of all those who have been a part of our story, reaching this 50-year mark would not have been possible. As we celebrate this achievement, we are filled with gratitude and humility.

Looking ahead, we remain dedicated to providing exceptional service, striving to exceed expectations and meet the evolving needs of our clients. With your continued support, we are confident that the next 50 years will be marked by even greater achievements and milestones.

Thank you for being an integral part of our journey. Here's to celebrating the triumphs of the past, and envisioning the future successes of both Kador & Partner and our esteemed clients! Cheers!

Advanced Training Course on European IP Law in September 2024

We cordially invite our valued clients and colleagues to an exclusive training course on European IP Law. The event will be held at our premises in Munich from September 14th to 21st, 2024. We look forward to providing an enriching and insightful experience. Please save the dates!

The course will begin with an overview of the European patent system and procedures, continuing with an in-depth treatment of the following topics:

- assessment of novelty and inventive step under the EPC, requirements of sufficient disclosure of the invention,
- the strict approach of the European Patent Office on amending claims – added matter,
- best practice in opposition and appeal proceedings, and
- infringement and litigation under European and German law.

Furthermore, an overview will be given of the new Unitary European Patent and the Unified European Patent Court, as well as the Community Trade Mark system.

During the course, participants will attend an appeal hearing at the EPO to experience such proceedings first-hand.



Dr. Utz Kador welcoming the participants of our seminar



Neuschwanstein Castle

The lectures will be presented by Kador & Partner attorneys as well as by prominent IP professionals from the European Patent Office, private practice and industry, including **Dr. Ludwig von Zumbusch**, litigation specialist at Preu Bohlig & Partner and **Mr. Konstantin Schallmoser, LL.M.**, specialist on International Private Law and International Law on Civil Procedure also at Preu Bohlig & Partner.

Aside from work, a variety of social activities will be offered, such as a trip to the famous Neuschwanstein Castle of king Ludwig II of Bavaria, a sight-seeing tour of Munich and a trip to the picturesque lake Chiemsee.

For comprehensive details about the seminar, including in-depth descriptions of the lectures and leisure activities, we invite you to visit our website at www.kadorpartner.com and navigate to the "The Seminar" section.

We look forward to seeing you in September!

New Kador & Partner Webpage

We're excited to share that Kador & Partner has a fresh online look! Our new website features a modern design, user-friendly navigation, and updated content. Explore more at www.kadorpartner.com to learn about our firm's team and services, as well as to stay informed with the latest insights and company news.

Celebration of New Partnership Team

Although **Karoline** (Dr. Karoline Bopp) officially became a part of our partnership team already in July 2022, we seized the opportunity to celebrate this last summer in the courtyard of our office building.

We continue to rejoice in having Karoline as an integral part of our partnership team, and we wanted to express our appreciation for all the valuable contributions she has made!



Our partnership from left to right: Sebastian, Bernhard, Karoline and Alexander

New Patent Attorney Trainee

We are delighted to introduce **Thomas** (Dr. Thomas Bromberger), who became a valuable addition to our team as a Patent Attorney Trainee in November 2023.

Thomas studied Molecular Biotechnology at the Technical University Munich, focusing mainly on genetic engineering,

protein biochemistry and medical biotechnology. He finished his studies in 2015 with his Master thesis on gene expression analyses.



Subsequently, he prepared his dissertation at the Max-Planck Institute of Biochemistry and continued his work as a postdoctoral scientist at the Institute of Experimental Hematology of the university hospital Rechts der Isar, Munich.

We are happy to have Thomas in our team and look forward to working with him!

Presentation at Max Planck Institute (MPI) in Frankfurt

Karoline (Dr. Karoline Bopp) was invited by the Max Planck Institute of Biophysics in Frankfurt am Main to give a talk in the graduate program of the Max Planck Society (International Max Planck Research Schools) on career development in May last year.

The talk was attended by many interested students and scientists to gain insights on the job profile of a patent attorney following individual more intense sessions with the participants.

We are pleased to contribute to raising awareness about intellectual property, especially as it increasingly plays a pivotal role in the realm of science. It's notable that many students are still unfamiliar with these topics, making our contribution all the more valuable.

Seminar on European Patent Matters in Bangalore (India)

In June 2023, **Alexander** (Dr. Alexander Racz) and **Bernhard** (Dr. Bernhard Pillep) contributed to a seminar organized

by the Indo-French Chamber of Commerce and K & S Partners in Bangalore.

The seminar covered an introductory overview of the new European Unitary Patent System, alongside a comprehensive evaluation of both its advantages and disadvantages.

Excursion to Nuremberg

In October 2023, we embarked on our annual team excursion to the picturesque city of Nürnberg (Nuremberg). Upon our arrival at the centrally located hotel, we made our way up the hill to explore the majestic Kaiserburg, where we marveled at its impressive deep fountain towering 50 meters high and ascended the tower for breathtaking panoramic views of the city and surrounding mountains. Following this unforgettable experience, we enjoyed a guided tour of the historic old city, complete with insider tips on where to find the renowned gingerbread (Lebkuchen) and delectable ice cream treats.

The next days, we visited, among other places, the Documentation Center and the "Reichsparteitagsgelände," where the National Socialists convened their Reich Party Rallies from 1933 to 1938.

To conclude our excursion, we savored the delightful flavors of Nürnberger Bratwurst, accompanied by traditional side dishes such as sauerkraut.



Our team visiting the old town of Nürnberg

II. EUROPEAN PATENT LAW

First Experiences with the European Unitary Patent /Unified Patent Court (UPC)

Since June 1, 2023 European Unitary patents (officially termed “European patents with unitary effect”) effective in 17 EU countries can be registered after grant of a European patent. The latest statistics underscore the dynamic utilization of this new system, with the European Patent Office recording a noteworthy 18,070 registered Unitary Patents as of January 22, 2024.

Also the Unified Patent Court (UPC) officially commenced its operations as of June 1, 2023 in the 17 member states of the European Union that have ratified the Agreement on a Unified Patent Court. The UPC holds jurisdiction over cases involving Unitary patents and traditional European patents that have not been opted out of the new system.

The structure of the UPC involves a first instance, organized as a central division located in Paris, Munich, and soon to be in Milan, along with various local and regional divisions scattered across Europe. The appellate function is fulfilled by the Court of Appeal, situated in Luxembourg.

Throughout the initial seven months of activity in 2023, the Courts of First Instance processed a total of 160 cases. Among these, 67 cases involved infringement actions, while 24 were revocation actions. Additionally, there were 48 counterclaims for revocation lodged by defendants in infringement cases, along with 13 applications for provisional measures.

In 2023, the Court of First Instance saw Munich and Paris emerge as the most prominent locations in terms of case volume. Revocation actions are primarily

handled by the central division, necessitating their processing in one of these two cities (20 cases in Paris and 4 in Munich), unless they are filed as counteractions within infringement cases. In such instances, they would be heard by the local division handling the infringement case.

The local division in Munich, which managed 23 infringement actions, 24 counterclaims for revocation, and 7 applications for provisional measures, totaling 54 cases, was notably the busiest among all local and regional divisions of the UPC.

Slightly more than half a year after the effect date of the UPC, on December 18, 2023 the first oral hearing before the Court of Appeal was held in Luxembourg. Subject of the appeal was a preliminary injunction ruling by the Munich local division in a conflict between NanoString and 10x Genomics.

Concerning the evolution of UPC case law in infringement proceedings, an intriguing question has emerged: will the UPC embrace the concept of file wrapper estoppel in claim interpretation?

Presently, the state of UPC case law is bifurcated: The local division of the UPC in Düsseldorf has denied the applicability of a file wrapper estoppel (see *Ortovox vs Mammut PI* decision (UPC_CFI_452/2023)), in line with standing German case law.

However, in contrast to the decision of the Düsseldorf local division and established German case law, the local division of the UPC in Munich relied on the prosecution history for claim construction (cf. UPC_CFI_292/2023).

Consequently, it falls upon the Court of Appeals of the UPC to promptly clarify this pivotal issue, which holds paramount significance for all UPC users.

Questions Relating to Public Prior Use referred to the Enlarged Board of Appeal of the EPO

In the Interlocutory Decision of Technical Board of Appeal 3.3.03 dated June 27, 2023 (case number T 438/19)¹, the Board referred several questions regarding public prior use to the Enlarged Board of Appeal. The case is currently pending under number G 1/23.

The following questions have been referred to the Enlarged Board of Appeal:

“1. Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of [Article 54\(2\) EPC](#) for the sole reason that its composition or internal structure could not be analysed and reproduced without undue burden by the skilled person before that date?

2. If the answer to question 1 is no, is technical information about said product which was made available to the public before the filing date (e.g. by publication of technical brochure, non-patent or patent literature) state of the art within the meaning of [Article 54\(2\) EPC](#), irrespective of whether the composition or internal structure of the product could be analysed and reproduced without undue burden by the skilled person before that date?

3. If the answer to question 1 is yes or the answer to question 2 is no, which criteria are to be applied in order to determine whether or not the composition or internal structure of the product could be analysed and reproduced without undue burden within the meaning of opinion [G 1/92](#)? In particular, is it required that the composition and internal structure of the product be fully analysable and identically reproducible?”

¹ <https://www.epo.org/en/legal/official-journal/2023/12/a113.html>

Our Comment:

The questions referred to the Enlarged Board of Appeal are highly relevant, particularly (but not only) in the field of polymer chemistry, where opponents in opposition proceedings against European patents often rely on materials that were publicly sold before the priority date of the challenged patent.

However, such materials are typically not accompanied by detailed descriptions of their production processes or internal structures. The crucial issue is therefore to determine what information was actually made available to the public through the sale of these materials. This is where the referred questions become significant, addressing whether and to what extent these materials could be analyzed and whether the skilled person would have been able to reproduce them.

Traditionally, it has been widely accepted in the polymer field that if public prior use, such as selling a product, could be proven, the product, including all its properties and internal structure, would be considered part of the prior art. However, the specific challenges associated with analyzing and reproducing such inherently complex materials have so far not been adequately addressed.

The responses from the Enlarged Board are eagerly anticipated, especially given the expectation that the Board, considering its current case law, will likely rule that if a material cannot be sufficiently analyzed and/or reproduced without undue burden for the skilled person, it should not be considered as prior art. If the Enlarged Board confirms these expectations, it will significantly increase the challenges faced by opponents in opposition proceedings against polymer patents seeking to rely on public prior use.

Assessment of Amendments (Art. 123(2) EPC) in European Patent Practice – Is the EPO Raising the Bar even further?

In two recent decisions of the Boards of Appeal (BoA) of the European Patent Office (EPO), namely T 0350/20² and T 1137/21³, the opposed patents in question were revoked for not fulfilling the requirements of Art. 123(2) EPC, i.e. for containing added subject matter.

It is well-known that compared to other major jurisdictions, the EPO applies a rather strict approach when assessing the allowability of amendments made to European patent applications or European patents. Legal basis is Art. 123(2) EPC which stipulates that a European patent application or European patent may not be amended in such a way that it contains subject matter which extends beyond the content of the application as filed.

According to the “gold standard” (outlined in Enlarged Board of Appeal decision G2/10), applied by the EPO when assessing compliance with Art. 123(2) EPC, an amendment is only considered allowable, if the skilled person would directly and unambiguously derive the same, using common general knowledge, from the overall disclosure of the application documents as filed. Put another way, the skilled person must not be presented with new technical information after the amendment.

In practice, this means that it is most of the time not allowable to combine features taken from separate embodiments described in a European application/a European patent, unless there is a clear pointer towards such a specific combination of features in the application as filed.

² See <https://www.epo.org/en/case-law-appeals/decisions/recent/t200350eu1>

³ See <https://www.epo.org/en/case-law-appeals/decisions/recent/t211137eu1>

In T 0350/20, claim 1 of the main request and of all auxiliary requests contained a combination of the features of claims 1, 3, 6, 7, 12, 15 and 19 of the application as filed. In the application, dependent claim 3 referred back to independent claim 1 while claims 6, 7, 12, 15 and 19 were multiple dependent and each referred back to any of the preceding claims.

Owing to these dependencies, the patent proprietor argued that the claimed combination of features was clearly and unambiguously disclosed in the application as filed. While the competent BoA acknowledged that each of the individual features can be found in claims 1, 3, 6, 7, 12, 15 and 19, it was held that there was no clear and unambiguous disclosure of the claimed *combination* of said features derivable from the application as filed.

As a reasoning, it was essentially outlined that the application as filed contained a total of 22 dependent claims, which were all dependent on the preceding claims, hence allowing for a huge number of different combinations of features. The Board further stated that of all 22 dependent claims, only features of six dependent claims (3, 6, 7, 12, 15 and 19) were specifically selected for a combination with the features of independent claim 1 whereas other features from the remaining dependent claims were disregarded.

As a result, it was held that an individual combination of features was singled out of “*a forest of optional features*”. Since also the description including the examples were found to lack a pointer towards the specific combination of features as claimed, it was eventually decided that none of the requests of the patent proprietor met the requirement of Art. 123(2) EPC, so that the appeal was dismissed and the patent was revoked.

In T 1137/21, another BoA took a similar

decision based on essentially the same reasoning.

Specifically, independent claim 1 of the patent proprietor’s main request and all auxiliary requests contained a combination of features emanating from claims 1, 4, 9, 11, 13 and 17 of the application as filed. Dependent claim 4 referred back to independent claim 1 as filed while dependent claims 9, 11, 13 and 17 again referred back to any of the preceding claims. Owing to this and to the fact that all inventive examples still fell under claim 1 of the main request, thereby presumably providing a pointer towards the claimed combination, the patent proprietor claimed that the application as filed would clearly and unambiguously support the claimed combination of features.

The competent BoA did not follow this argumentation but held that the claims as filed provided a huge number of possible combinations of features whereas new claim 1 of the requests constituted a multiple selection resulted in a very specific combination of features of different levels of preference from specific dependent claims as filed.

As to the inventive examples, the BoA found that these were not eligible as a pointer towards the specific combination of features as claimed, as said examples also fulfilled a number of optional features found in dependent claims as filed that were not selected to be introduced into independent claim 1 as filed.

Eventually, it was decided that claim 1 of the main request corresponded to a multiple selection from large number of lists and possibilities without a specific pointer so that the requirement of Art. 123(2) EPC was regarded as not fulfilled.

Our comment:

The above decisions make it quite clear

that a mere formal support of an amended claim containing features taken from several dependent claims does not assure that the new combination of features is considered to meet the requirements of Art. 123(2) EPC.

Similarly, examples may not always act as pointers towards a specific combination of features, in particular in case the examples simultaneously fulfil other optional features and/or in case examples parameters fall into preferred ranges which are not claimed.

For applications that have already been filed, this stricter EPO case law on amendments means that the options to amend claims by incorporating features from dependent claims are further limited.

However, considering this case law upon drafting of new application suggests to not only disclose optional/preferred features and/or ranges separately, but to additionally describe potentially relevant embodiments with all of their features explicitly listed in their very combination. By doing this, a respective amendment may be argued to be based on such an individual embodiment instead of a combination of features taken from different claims and/or paragraphs of the description.

Amendments to the Rules of Procedure of the Boards of Appeal of the European Patent Office

With effect of January 1, 2024 the Administrative Council of the EPO has agreed to some changes in the Rules of Procedure of the Boards of Appeal (RPBA)⁴. In particular, the change to Art. 13(2) may play a role in appeal proceedings.

New Art. 13(2) RPBA stipulates that, instead of the notification of a summons

⁴ See <https://www.epo.org/xx/legal/official-journal/2023/12/2023-12.pdf>

to oral proceedings, the communication under Article 15, paragraph 1 will be the critical date after which amendments to a party's case shall, in principle, not be taken into account unless there are *exceptional circumstances*, which have been justified with cogent reasons by the party concerned.

The "*communication under Article 15, paragraph 1*" is the one with which the Board forwards its preliminary opinion on the merits of the case to the parties. Accordingly, in practice the period (so-called phase II) during which the parties to an appeal may submit further arguments/documents will be prolonged, as the summons to Oral Proceedings are regularly sent out several months earlier than the Preliminary Opinion

However, already during said phase II admission of any amendment to a party's case is subject to the discretion of the Board, which is usually exercised very strictly.

III. EUROPEAN TRADE MARK LAW

European Union General Court (EUGC) on Distinctiveness of Figurative Trade Marks

On December 20, 2023, the European Union General Court (EUGC), formerly known as the "Court of First Instance", rendered its verdict in case T-564/22⁵ concerning the registration of a figurative EU trade mark depicting a lion's head encircled by rings forming a chain.

The context of this case unfolds as follows: On November 23, 2017, the applicant submitted an application for the registration of a EU trade mark with the European Union Intellectual Property Office (EUIPO), seeking protection, *inter alia*, in classes 14 and 25, pertaining

⁵ See <https://curia.europa.eu/juris/documents.jsf?num=T-564/22>

to jewellery and clothing, respectively, for the following figurative symbol:



A company lodged an opposition based on the existence of a prior Polish figurative trade mark, also registered for classes 14 and 25, which looked as follows:



The Opposition Division of the EUIPO rejected the application in respect of the goods in classes 14 and 25, as it found that there was a likelihood of confusion between the opposition trade mark and the sign applied for.

An appeal was filed to the Board of Appeal (BoA) which was dismissed. In its reasoning, the BoA confirmed the finding of a likelihood of confusion, by taking into account, *inter alia*, that the goods at issue were identical or very similar, that the marks at issue were visually similar and conceptually identical, since they both conveyed the concept of a lion's head.

The applicant filed an appeal with the EUGC who revoked the decision of the BoA. In its reasons, the EUGC first, regarding the relevant public, concluded that products in class 25 (clothing) include goods which vary widely in quality and price, which also applies to products in class 14 (jewellery), so that these products were directed at both professionals e.g. jewellers and consumers.

The EUGC thus confirmed the Board's assessment of the relevant public and

its level of attention varying from average to high.

However, the EUGC then pointed out that the Board had attached too much importance to the conceptual identity between the marks at issue, since, *inter alia*, the concept represented in the marks at issue, namely a lion's head, was used in a banal and commonplace way in the commercial presentation or the decoration of goods in the fashion sector, so that its degree of inherent distinctiveness must be regarded as low.

The EUGC therefore concluded that in view of the weak distinctive character of the concept being common to the marks at issue and the overall weak distinctiveness of the earlier mark, the fact that the signs are visually similar to an average degree was not sufficient to establish a likelihood of confusion, even if the goods of both trade marks were identical, resulting in the annulment of the contested decision.

Our Comment:

The pivotal outcome of this case underscores that the inherently low distinctiveness of pure figurative trade marks portraying comparatively simple elements like animals are not enhanced through conceptual similarity.

Thus, in cases where figurative trade marks or signs depicting the same type of element (animal) are to be compared, a likelihood of confusion is not necessarily to be assumed even if the goods of the trade marks in question are identical. This is particularly applicable in sectors like fashion, where such symbols are frequently utilized as decorative elements.



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