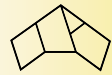


IP Report

»THE BARDEHLE PAGENBERG IP REPORT«

2005/II – www.bardehle.com



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1. Dr. Pagenberg nominated as Germany's leading lawyer in patent expertise

According to the most recent survey by Who's Who Legal, "Jochen Pagenberg of Bardehle Pagenberg Dost Altenburg Geissler is the number one practitioner in Germany for patent legal expertise." This is stated in the fourth edition of "The International Who's Who of Patent Lawyers" published by "Who's Who Legal" this March.

Dr. Pagenberg received more nominations from clients and peers in the course of the research than any other patent practitioner in the country. He was described as "first class" by respondents, and he is joined in the final publication by his colleagues Bernhard H Geissler and Reinhardt Schuster. The book is a result of six months of independent research incorporating feedback from lawyers and in-house counsel, and covers 292 lawyers in 38 separate jurisdictions.

Managing Editor Callum Campbell said, "It is impossible to buy entry into this publication, only those lawyers who receive sufficient nominations from their peers are included. This book represents a truly global, highly qualitative survey of only the best patent lawyers, based on exhaustive research."

2. BARDEHLE PAGENBERG organized seminars on IP Litigation in China

In cooperation with the Shanghai Patent and Trademark Office (SPTL), two IP judges of the Intermediate Courts of Shanghai gave several one-day seminars on the topic of "IP Litigation in China".

These events for the clients of BARDEHLE PAGENBERG took place at four different locations in Germany and France:

April 5, 2005, in the Munich office of BARDEHLE PAGENBERG

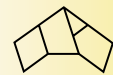
April 7, Frankfurt Airport, Hotel Sheraton

April 8, Düsseldorf, Wirtschaftsclub
Düsseldorf

April 11, in the Paris office of BARDEHLE PAGENBERG

For industry representatives and members of the IP community the seminar provided the unique possibility to gain a first hand insight into IP litigation – in particular into practical aspects of patent litigation – in China.

3. Use of "Distinguishing Marks" of a competitor – Referral of question by the Federal Supreme Court to the ECJ (I ZR 273/01)



In a referral decision dated December 2, 2004 (I ZR 273/01), the German Federal Supreme Court has put the following questions before the ECJ relating to the interpretation of Art. 3 a sec. 1 lit. g of the Directive 97/55/EC, amending Directive 84/450/EEC concerning misleading advertisement so as to include comparative advertising.

The questions are as follows:

1. Is the reputation of an „other distinguishing sign or identifier“ of a competitor in the sense of Art. 3 a sec. 1 lit. g of the Directive 84/450/EEC taken unfair advantage of if the advertiser identically adopts a distinguishing sign or identifier of a competitor known in the specialized trade circles (here: ordering code system) or refers to the identical adoption in his advertising?

2. When assessing the degree of unfairness of the taking advantage of the reputation in the sense of Art. 3 a Sec. 1 lit. g of the Directive 84/450/EU, is the advantage of an identical adoption for the advertiser and the consumer a decisive factor?

In the underlying case, the plaintiff produces control devices operated by software and is market leader worldwide in the automation technology. Since 1983, he uses a combination of letters and numbers as an ordering code system for its products.

The defendant is also active in the area of control and steering technology. Amongst others, the defendant produces and markets components which can be integrated in the products of the plaintiff. For ordering purposes, the defendant has adopted the ordering code system of the plaintiff in his catalogues and uses it on his own products.

The Munich District Court granted the claims of the plaintiff based on unfair competition and trademark infringement due to the identical adoption of the ordering code system. Conversely, the Munich Appeal Court set aside the judgement of the first instance and rejected the court action.

In the grounds for the referral, the Federal Supreme Court seeks clarification from the ECJ whether the adoption of the ordering code system of the plaintiff by the defendant is tantamount to taking unfair advantage of the reputation of this distinguishing mark. The

Court was inclined to take this position, since by using the system, it was suggested to the consumer that the products were of equal quality. Even if there was no risk of confusion, since the ordering code systems were known to the trade circles concerned, the adoption gave rise to an association between the competitors which went beyond a legitimate comparison as permitted by Directive 84/450/EEC. As a result, in the opinion of the court, the code ordering system was unfairly taken advantage of. The court also pointed out that if the plaintiff did not act, there was the possibility that the code ordering system would become generic.

Reported by Claus M. Eckhartt

4. New OHIM Fees in the Pipeline

The draft of a Commission Regulation amending Regulation No. 2869/95 on the Fees payable to the Office for Harmonization in the internal market (OHIM) is currently under discussion with the European Commission's Trademark Working Group. The draft reflects the fact that a considerable increase in the revenue of OHIM is expected in the medium term, as a consequence, in particular, of the payment of renewal fees for the Community trademarks.

While acknowledging that a slight surplus is justified, the draft takes into account that according to Art. 139 (2) of the Community Trademark Regulation, the amounts of the fees payable to OHIM are to be fixed at such a level as to ensure that the revenue is balanced. The draft therefore proposes to subsequently reduce the official fee for a new application covering up to three classes of goods and services from € 975.00 to € 600.00. An additional reduction of € 100.00 will be made in case the application is made online.

Conversely, the draft foresees that the appeal fee should be raised by € 400.00, thereby encouraging users not to bring groundless appeals. Furthermore, the fees for oppositions and applications for revocation or for a declaration of invalidity are also to be increased, the latter by € 300.00, thereby effecting a more appropriate cost balance between these two types of proceedings.



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The Commission's Trademark Working Group first met to review the draft on March 17, 2005, the next meeting is set for April 28, 2005.

Reported by Claus M. Eckhartt

Moreover, the Code of Conduct for Lawyers in the European Community issued by the CCBE (Council of the Bars and Law Societies of the European Community) <http://www.ccbe.org/UK/publications.htm> is applicable to all lawyers of BARDEHLE PAGENBERG

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