

# IP Report

»THE BARDEHLE PAGENBERG IP REPORT«

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### 1. Reinhardt Schuster, Johannes Lang, Alexander von Mühlendahl win "IP Awards"

On November 30, Reinhardt Schuster, attorney at law, and Johannes Lang, patent attorney, of BARDEHLE PAGENBERG received the "European IP Awards" in the category of "Best achievement in patent practice". The award was offered by the IP publisher informa (publisher inter alia of "Patent world" and "Trademark world") during a glamorous celebration and dinner in the London Dorchester Hotel, with 250 invited lawyers and industry representatives. On this occasion also Alexander von Mühlendahl, former Vice President of the Office for the Harmonisation of the Internal Market (OHIM) and since November 2005 a new member of the BARDEHLE PAGENBERG firm, was honoured for his "Lifetime achievement in IP".

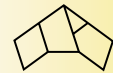
Reinhardt Schuster and Johannes Lang of BARDEHLE PAGENBERG won the IP Award for their representation of the chip maker Micron as lead counsel in a chain of computer memory related patent litigations in 2000–2005 against patentee Rambus in Germany before the District Court Mannheim and in opposition and appeal proceedings before the European Patent Office (EPO) and the German Federal Patent Court.

German chipmaker Infineon AG, another party in the prolonged multinational litigation against Rambus Inc., was also represented by a BARDEHLE PAGENBERG team. Led by patent attorney Peter K. Hess and attorney at law Jochen Pagenberg, it significantly contributed to the revocation of key patents of Rambus by the EPO. The law suit between Infineon AG and Rambus was settled in early 2005.

### 2. Dr. Alexander von Mühlendahl joined BARDEHLE PAGENBERG as of 1st November '05

The IP law firm BARDEHLE PAGENBERG is pleased to announce that as of November 2005, Dr. Alexander von Mühlendahl, LL.M., JD, Vice President of the Office for Harmonization of the Internal Market (OHIM) in Alicante, joined the firm as trademark law specialist after his retirement this month from his function at the OHIM.

The practice of Dr. Alexander von Mühlendahl will focus on key trademark and design protection cases for the clients of the firm, with the offices of BARDEHLE PAGENBERG in Alicante and Munich as the bases of his work. With his profound legal, procedural and political experience from his past functions, which prior to his function at the OHIM included heading the Division



for Trade Mark and Unfair Competition Law at the German Ministry of Justice from 1985–1994, Alexander von Mühlendahl will be an invaluable member of the trademark and design practice group of BARDEHLE PAGENBERG.

His joining of the firm was celebrated with an illustrious audience of representatives of the OHIM, its Board of Appeal, the EU Commission and high profile members of the international and local IP world and trademark profession at a reception hosted by BARDEHLE PAGENBERG at the Casino of Alicante on Sunday, October 23, 2005. In his forward looking speech, Alexander von Mühlendahl emphasized his determination to continue his devotion to IP practice in the new framework of BARDEHLE PAGENBERG.

Other Farewell Celebrations had been organized in Alicante. On October 22 at a dinner celebration with close friends Alexander von Mühlendahl received out of the hands of the three editors Verena von Bomhard, Jochen Pagenberg and Detlef Schennen a “Festschrift” entitled “Harmonization of Trademark Law” for his outstanding contribution to the harmonisation of European trademark law, as one of the co-drafters of the European Trademark Directive and the author of the new German Trademark Act of 1995. Among the 30 eminent trademark specialists from many European countries and the US who have contributed to the book are German Supreme Court judges and presiding judges of the German Federal Patent Court, members of OHIM, the Boards of Appeals and the EU Commission, professors of trademark law and a great number of trademark practitioners.

An additional official reception by the OHIM was hosted on October 24 by OHIM’s President, Wubbo De Boer during the meeting of the OAMI Users Group, where Dr. von Mühlendahl received several minutes of standing ovations after his farewell speech by a great number of representatives of NGO’s who were joined by a number of former officials such as Jean-Claude Combaldieu, former OHIM President, Bertold Schwab, a former high official of the European Commission and Rainer Faupel, former State Secretary of Brandenburg. As a particular honour, the OHIM President Wubbo de Boer announced that the main library of the OHIM will be named Alexander von Mühlendahl Library, an honour which so far has only been bestowed on Jean-Claude Combaldieu at his departure as first president

of OHIM when the central conference room had been named after him. Jean-Claude Combaldieu and Alexander von Mühlendahl are recognized as the decisive promoters for the success of the Community Trademark and the Community Design, with the OHIM expecting this year ca. 62000 trademark applications and ca. 65000 design applications.

### **3. Enlarged Board of Appeal of the EPO has to decide on divisional applications**

**The following legal questions have been referred to the Enlarged Board of Appeal (T 39/03):**

**(1) Can a divisional application which does not meet the requirements of Article 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 Articles 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 had been directed?**

The above questions have a strong impact on the flexibility of the applicant. So far EPO practice has been very liberal. However, the referring Board sees a conflict between this practice as laid down in the Guidelines for Examination and Article 76 as well as Rule 25 EPC. Interestingly, the Board’s concerns are partly based on the development of the UK Patents Act in which an express possibility to remove added matter from a divisional application was introduced in order to overrule case law excluding this possibility under the previous version of Section 76. There are mainly two problems addressed in the referral:

- Can added subject-matter contained in the original text of a divisional application be removed in order to remedy a deficiency under Article 76(1) EPC?



- In case of successive divisional applications, can the applicant claim in the second divisional application subject-matter disclosed but not claimed in the first divisional application?

Examiners have been instructed to stop prosecution of applications in which the referral is relevant for the final decision. A communication to this effect in the Official Journal is to be expected.

Reported by Dr. Rudolf Teschemacher

#### **4. Court experts or private experts in patent infringement litigation in Europe?**

**On November 23, 2005, Senior Partner Heinz Bardehle hosted a seminar on the topic "Technically qualified judges and technical court experts". Numerous judges of German Courts as well as representatives from industry and from the European Patent Office participated in the seminar.**

Generally speaking, the present practice of German courts for ensuring a correct assessment of the technical questions in patent litigation proceedings as well as in patent invalidation proceedings is as follows:

1. Specialized patent litigation courts and appeal courts:

The judges of specialized patent litigation courts and appeal courts are lawyers who have (in most cases) no technical qualification. Nevertheless, in most patent litigation cases, they succeed in assessing the technical questions on a very high level without a court expert. With that, infringement proceedings are decided in the first instance within a very short time period (District Court Duesseldorf: about 12 months; District Court Mannheim: about 6 to 12 months).

2. Federal Patent Court in nullity proceedings:

The Boards of the Federal Patent Court consist of technically qualified judges and legally qualified judges. Validity of an attacked patent is decided with a deep understanding of all technical questions within a reasonable time period (presently about 1 1/2 years).

3. Federal Supreme Court in nullity appeal proceedings:

The Federal Supreme Court consists of judges with legal qualification of highest level. In nullity appeal proceedings, the Federal Supreme Court always appoints a technical court expert for clarifying all technical questions which are relevant for deciding on validity of an attacked patent. The court expert is expected to answer technical questions from the viewpoint of an average skilled person in the relevant art so that the court has a sound basis for deciding on validity. Since this approach is time consuming and the number of nullity cases has considerably increased, nullity appeal proceedings usually require between 2 and 3 years.

In view of the possible future practice for a European patent litigation system under a Community patent or the European Patent Litigation Agreement where court experts as well as party experts might be used the advantages and disadvantages of these systems have been discussed among the participants. Since the future European courts will most likely also use technical judges in infringement proceedings, one of the proposals was to make nullity appeal proceedings before the Federal Supreme Court more efficient by relying more on the technical facts ascertained by the technical judges of the Federal Patent Court. But the majority of the discussants agreed that the present approach of German patent courts of clarifying technical questions results in a very high quality with by and large predictable results within reasonable time periods.

Reported by Dr. Frank Peterreins

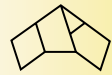
#### **Imprint**

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