IP Report

»THE BARDEHLE PAGENBERG IP REPORT«

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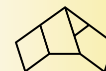

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1. Federal Supreme Court on defining a CD in a product claim by means of method steps (Federal Supreme Court – "Recording Storage Medium"; X ZR 188/01 – "Aufzeichnungsträger")

Method features in product claims are admissible and define the scope of protection insofar as the involved method features give an indication to the skilled person whether and how structural features (constructive or functional product features) of a protected product have to be implemented according to the teaching of the patent.

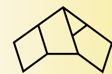
A method or a device which refer to the reproduction of information, are not generally excluded from patent protection. It is decisive whether the claimed invention contains instructions which serve to solve a specific technical problem by technical means. Is this the case, then it is irrelevant whether the involved claim is also directed to the use of an algorithm, a purpose in the commercial field, or an information as result of a method.

In nullity appeal proceedings, the Federal Supreme Court decided on the validity of a patent which was directed to a method for recoding data bits in a sequence of channel bits. Claims 1 to 10 were directed to the method itself; claims 11 and 12 were directed to a recording storage medium – in particular a CD – with an information structure according to one of claims 1 to 8.

Under German law, any party may file a nullity action against all claims of a patent without having to prove a particular legal interest. However, this principle did not apply in the decided case, because the period of protectin of the patent-in-suit had expired during nullity proceedings. Therefore, the Federal Supreme Court held that the nullity action was not admissible regarding claims 1 to 10, because the nullity plaintiff had not been warned or attacked by the patentee for infringement and could not demonstrate any other legal interest to have these claims retroactively be declared invalid.

Regarding claims 11 and 12 which were the basis for a parallel infringement litigation, the Federal Supreme Court affirmed their validity. The interesting aspects of this decision are as follows:

The Federal Supreme Court held that claims 11 and 12 are admissible as product-by-process claims. Interestingly, it was not even discussed whether or not the patentee had the possibility to formulate the product claims by means of the specific formation of the information structure instead of a reference to the method according to claims 1 to 8. Such a requirement had often been mentioned in the past in context with product-by-process claims.



The Federal Supreme Court held that method features in product claims are admissible and define the scope of protection insofar as the involved method features give an indication to the skilled person whether and how structural features (constructive or functional product features) of a protected product have to be implemented according to the teaching of the patent (in the decided case: the information structure on the storage medium). This question has to be clarified by interpretation of the respective method features.

Following previous decisions of the Federal Supreme Court, it was also confirmed that a method or a device which refer to the reproduction of information, are not excluded from patent protection. Instead, only the reproduction of information per se does not constutue an invention according to Section 1 para. 2 German Patent Act. It is decisive whether the claimed invention contains instructions which serve to solve a specific technical problem by technical means. Is this the case, then it is irrelevant whether the involved claim is also directed to the use of an algorithm, a purpose in the commercial field, or an information as result of a method.

Reported by Dr. Frank Peterreins

2. Federal Supreme Court on wording of prayer for injunction in patent actions (Federal Supreme Court – “Blow Film Manufacturing”; X ZR 126/01 – Blasfolienherstellung)

If the parties are in dispute whether and by which means or by which structural form the attacked embodiment realizes features of the claim, the court has to ask for a specified description of the means which allegedly make use of the patent claim so that a decision according to the petition can form the basis of an enforcement. The citation of the wording of the claim is not sufficient even if the Plaintiff alleges an infringement which – although being outside the wording – still makes use of the meaning of the claim features.

In patent infringement proceedings before a German court, the Plaintiff has to file a complaint brief which includes clearly specified petitions or prayers and a specified reasoning in what respect the attacked embodiment infringes Plaintiff‘s patent. In case of literal infringement, the request that the Defendant be enjoined from manufacturing, offering and selling the attacked product may be phrased in most cases as a literal citation of the claim features.

However, if there is no literal infringement, the Plaintiff has to specify the features of the allegedly infringing embodiment in order to clearly describe the subject matter of the requested injunction so that the decision can form a sound basis for an eventual later enforcement. In the decided case it was in dispute whether and by which means or by which structural form the attacked embodiment reproduced the features of the claim.

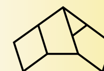
Reported by Dr. Frank Peterreins

3. Federal Supreme Court on license agreements which contravene antitrust law (Federal Supreme Court – “Exhaust Cleaning Device”; X ZR 14/03 - Abgasreinigungsvorrichtung)

If a license agreement is also directed to devices which are sold in countries without patent protection, such an agreement is not in line with German antitrust law, and is thus invalid. The licensee does not have to pay a license fee for acts which could not seriously be regarded as a patent infringement.

A patentee had filed a lawsuit against a company which manufactures devices for cleaning exhaust gases. Since the involved European patent was directed to a method for cleaning exhaust gases, the patentee could only base the action on a contributory infringement (Section 10 German Patent Act). This lawsuit was settled between the parties during appeal proceedings, wherein the patentee granted a license to the manufacturer of the devices.

After the infringement litigation proceedings, the parties got into dispute again regarding the question whether or not a license fee has to be paid for devices which have been manufactured within a patent protected country, but which have been sold to countries in which no patent protection is given. The settlement agreement did not have a clear wording in this respect. However, in case of a contributory



infringement the patentee can only claim that the defendant ceases and desists from offering and selling of an infringing product, because Section 10 German Patent Act does not forbid manufacturing of such a product.

Therefore, the licensee filed a counter lawsuit against the patentee to declare that a license fee has only to be paid for devices which are sold in patent protected countries, however, not for devices which are sold in other countries.

The Federal Supreme Court held that even if the license agreement is also directed to devices which are sold in countries without patent protection, such an agreement would not be in line with German antitrust law, and would thus be invalid. As a result, it was confirmed that the licensee does not have to pay a license fee for acts which could not seriously be regarded as a patent infringement.

Reported by Dr. Frank Peterreins

4. Definition of "Design" clarified by OHIM

In an Examination Practice Note 2/2005, the Design Department of the Office for Harmonization in the Internal Market (OHIM) has now provided clarification regarding the definition of a "design" as set forth in the Council Regulation on Community Designs ("CDR"). Art. 3 (a) CDR sets out in broad terms the definition of a "design", thus leaving room for interpretation. Examination Practice Note 2/2005 now specifies in detail the types of elements which do not correspond to the definition of a design.

According to the OHIM Design Department, the following types of subject matters do not fall under the definition of a "design":

– Colours per se, since, if unrelated to a product, they do not constitute the appearance of a product;
– fragrances and smells, as they clearly do not relate to the appearance of a product;
– mere word sequences of letters per se in standard letter type, unless they include a particular style which can be seen as a figurative element, such as a particular styling, calligraphy or typeface, jumping lineation or colour;
– blueprints, plans for houses or architectural plans and interior or landscape designs if design protection is sought for a finished product. However, if the indication of products is given as "architect's plans", the view of the appearance of the finished product would fall within the definition of "designs";

In contrast, according to the Examination Practice Note 2/2005, photographs as such comply with the definition of a design and would, as a rule, be classified as "writing paper, cards for correspondence and announcements" or "other printed matter".

Reported by Claus M. Eckhartt

Imprint
The "BARDEHLE PAGENBERG IP Reoprt" is published by

Patent- und Rechtsanwälte
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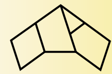

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