

IP Report

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1. German Federal Supreme Court allows intermediate generalisation in amendments of a patent application (Case X ZR 226/02 – Sammelhefter II/Stappler II)

In contrast to the established case law of the Boards of Appeal of the EPO (cf. for example T 0470/05), the German Federal Supreme Court considers an intermediate generalisation of a specific embodiment described in a patent application, at least in some situations, not to be an inadmissible amendment. The underlying legal doctrine applied by the German Federal Supreme Court fundamentally differs from the requirement of the EPO of a direct and unambiguous disclosure of the claimed subject matter in the application as filed.

The decided case relates to a German patent on a stapler which was attacked by a nullity action. Nullity plaintiff raises the nullity reason of an inadmissible amendment (Section 21 [1] No. 4 German Patent Act) with respect to a functional feature in the attacked claims. In the underlying application, this feature is disclosed only in the context of a preferred embodiment but not in any of the dependent claims. It describes a technical effect obtained in the claimed stapler – the parallel movement of the same internal parts of the stapler – without limiting the claims to the specific constructional details which provide for this effect in the preferred embodiment. Constructional alternatives for achieving this effect are not disclosed in the description of the application as filed.

Nevertheless, the Federal Supreme Court considers the generalisation of the specific embodiment by including only the resulting technical effect or function, respectively, but none of the constructional features in the amended claim 1 to be admissible. According to the Court, the amended claim was directed to a subject matter which the person skilled in the art would consider as being comprised by the initial claims of the application. It would be the free choice of applicant to decide which features of a specific, preferred embodiment shall be added to a claim, provided that they would contribute individually and together to the invention, and the new feature combina-

tion would not present an aliud compared to the initial claims.

This is a strikingly different approach than the test applied by the EPO for such an amended feature combination. Whereas the latter, in a case where the amendment is not disclosed in any of the original dependent claims, focuses exclusively on the question of what the person skilled in the art can derive from the description of the application as filed, the German Federal Supreme Court applies considerations somewhat similar to the requirement of Article 123 (3) EPC, namely whether the amendment is a real limitation, i.e., whether it leads to a claim still encompassed by the scope of protection of the original claims of the application.

The liberal standpoint taken by the German Federal Supreme Court will be more familiar to many US-applicants, who are often surprised by the very strict application of Article 123 (2) EPC by the EPO. When it comes to a claim amendment based on a disclosure which exists only in the description, many EP applications based on US priority applications face difficulties either during examination or during post-grant opposition proceedings. The reason for this often is that the description is typically drafted from a US perspective where intermediate generalisations of the preferred embodiment(s) are allowed and do not need to be explicitly described. The recent decision of the German Federal Supreme Court may therefore be a reason to file applications, for which this problem is foreseeable, nationally with the German Patent and Trademark Office (and other national patent offices in Europe) rather than with the EPO.

Reported by Dr. Hans Wegner



2. EPO considers software for simulation of circuit behaviour to be patentable subject matter (Technical Board of Appeal 3.5.01 decision T 1227/05 – Computer-implemented method for the simulation of circuit behaviour)

Applying its established legal doctrine for the assessment of computer-implemented inventions, the Technical Board of Appeal 3.5.01 confirms both the technical character of a computer-implemented simulation method and the technical contribution of the involved mathematical steps.

Over the last years, the Technical Board of Appeal 3.5.01 has developed a consistent way of how to assess software related inventions concerning both the exclusion of Article 52 (2) EPC and their inventive step. With respect to the first hurdle to patentability, namely the exclusion of “programs as such” under Article 52 (2) EPC, the present decision follows the earlier case law. A software-related invention is not excluded if it involves technical means. In the present case, the generic term of the two independent method claims of the application explicitly refers to a “computer-implemented method”. Claiming the implementation on a computer is, in accordance with the case law of the Board, sufficient to provide the technical character which takes the invention out of the excluded field of programs as such.

More difficult is the question, which features of a method claim contribute to the technical character of an invention. Only such a feature can be taken into account for the assessment of the inventive step, according to the case law of the Board. The new decision gives some guidance, when it says in section 3.1. that a method step can only contribute to the technical character, if it serves a well-defined technical purpose of the method. In a side remark, it is explicitly noted that general objectives such as improving the overall processing speed cannot be considered to be a sufficiently well-defined technical purpose.

In the present case, the mathematical method steps, i.e. the algorithm, were found to have a well-defined purpose, namely the simulation of so-called 1/f

noise in a circuit. Such a simulation of the behaviour of a chip is considered to be more than only a mental act or an algorithm as such but rather an established technical tool which is an increasingly important alternative to experimental research and development. Accordingly, the Board reached the conclusion that all mathematical features of the independent claims served this concrete technical purpose and are therefore to be taken into account for the assessment of the inventive step.

When evaluating the nature of simulation, the Technical Board referred to an earlier decision of the German Supreme Court relating to a similar case (BGH Logikverifikation, English translation published in IIC 2002, p. 231), where the simulation of a circuit was also found to be patentable subject matter. However, it should not be taken for granted that all national patent offices and courts of the member states of the EPC will reach the same conclusions as the EPO, even though the statutes in the national patent acts and the EPC have been harmonized and are almost literally identical. For example, the UK patent office has taken a very restrictive approach following the Aerotel/Macrossan decision of the Court of Appeal (Court of Appeal for England and Wales 27 October 2006 – Case No. [2006] EWCA Civ 1371, Aerotel/Macrossan) basically rejecting any patent application wherein the difference of the claimed subject matter compared to the prior art concerned software, regardless of its technical contribution. Whether a recent decision of the England and Wales High Court ([2008] EWHC 85 [Pat]) provides more flexibility and consistency with EP case law, remains to be seen.

Reported by Dr. Hans Wegner





3. Düsseldorf Appeal Court broadens responsibility of forwarding agents for the handling of goods, increasing requirements to verify compliance with German patent law (Case I-2 U 51/06 – Störerhaftung des Spediteurs/Liability of an international forwarding agent)

The plaintiff was an exclusive licensee of patented mp3-player technology. The defendant, an international forwarding agent (i.e. a carrier or transport agency), had imported patent infringing mp3-players from China which were confiscated on the plaintiff's request by the German customs authority. The plaintiff then requested to have the infringing goods destroyed.

The defendant objected to this request, arguing that forwarding agents would have no obligation to verify the compliance of the goods with German patent law, and thus no responsibility for the patent infringement would have occurred by any acts of the defendant in his function as forwarding agent. Furthermore, the defendant asserted that the plaintiff would not be in a position to request from the defendant to agree to the destruction of the goods, since after confiscation by customs the defendant would no longer be the possessor of the goods.

As a general rule, due to the great amount of handled goods, forwarding agents are usually not obliged to verify the compliance of the goods with German patent law. However, if the forwarding agents are informed about existing issues, they are – on a case by case basis – obliged to check the compliance of the handled goods separately. If they do not comply with this obligation, the forwarding agents will, as the case may be, become legally responsible for a patent infringing import of the infringing goods and will have to agree to a destruction of the goods.

According to earlier German case law, it was not clear whether and in which situations a forwarding agent would be obliged to verify the legitimacy of the handled goods. On April 19, 2007, the Federal Supreme Court decided in an internet auctioning case (trademarks) that the provider would only be obliged to verify the legitimacy of the goods in case of an obvious infringement (Federal Supreme Court Case I ZR 35/04 – Internet

Versteigerung II). On August 15, 2007, the Hamburg Appeal Court decided in a trademark case that a forwarding agent would only have to check the goods, if there is a definite acknowledgement of falsification (Hamburg Appeal Court Case 5 U 188/06 – YU-GI-OH!-Karten). In this respect, the Hamburg Appeal Court decided that the mere confiscation by the German customs authority would not be sufficient to cause such a definite acknowledgement. A preliminary decision of a Court would be required to constitute the definite acknowledgement.

Now, the Düsseldorf Appeal Court decided in a patent infringement case that the mere information of a patent infringement (e.g., a confiscation by the German customs authority) already constitutes an obligation of the forwarding agent to check the legitimacy of the goods. The way of how this verification can be achieved has to be decided by the forwarding agent, but after being notified about an infringement, the forwarding agent will be responsible for this infringement and will therefore be obliged to agree to a destruction of the infringing goods, irrespective of any differing instructions by his client. Furthermore, and differing from the decision of the Cologne Appeal Court of August 18, 2005 (Case 6 U 48/05 – “Lagerkosten nach Grenzbeschlagnahme”/storage costs after border seizure), the Düsseldorf Appeal Court also confirmed the requirement that the forwarding agent has to be at least the indirect possessor of the goods, although the goods were concretely in the realm of the German customs authority.

With this decision, the Düsseldorf Appeal Court strengthens the position of owners of protective rights, as they are now entitled to also sue a forwarding agent which directly assists in putting infringing goods onto the German market. Since this decision, however, differs from the opinion of the Cologne Appeal Court, it is hoped that the Federal Supreme Court will decide on this question in the near future.



Reported by Thomas Schachl



4. London Agreement enters into force on May 1, 2008

On January 29, 2008, France has deposited its instruments of ratification of the London agreement with the Government of Germany. To enter into force, the London Agreement must be ratified by at least eight contracting states of the European patent convention, including France, Germany and the UK (Article 6 of the London Agreement). Since Germany and the UK as well as nine other contracting states had already ratified or joined the agreement by accession, France was the last state to ratify.

According to its Article 6 (1), the Agreement enters into force on the first day of the fourth month after deposit of the last instrument of ratification or accession. This is May 1, 2008. It has to be applied to European patents in respect of which the mention of grant was published in the European Patent Bulletin after the agreement entered into force.

What does this mean for the applicants? The London Agreement, concluded on October 17, 2000, aims to reduce the costs for European patents and in particular the translation costs. The states adhering to it agree that no translation of the specification of European patents granted for these states into their respective national language is required any more, if the national language is one of the three EPO official languages (German, English, French), or that a translation in one of the three official languages is required if the national language of the state is not one of the three official languages. Only translations of the claims into the national languages can be required.

This means that translations of the patent specification for Germany, France, the UK, Switzerland/Lichtenstein, Luxembourg and Monaco are no longer necessary. Only the claims have to be translated into English, German and French and will be published with the granted patent.

The other countries adhering to the London Agreement (i.e., Croatia, Denmark, Iceland, Latvia, Netherlands and Slovenia) will require a translation of the claims into their respective national language. Croatia, Iceland and the

Netherlands will require a translation of the patent specification into English. Sweden has not ratified the London Agreement but will apply it. Sweden will require a translation of the patent specification into English and a translation of the claims into Swedish, respectively.

In case of patent litigation, all countries adhering to the London Agreement can require a full translation of the patent into the national language (Article 2 of the London Agreement). All other twenty contracting states of the EPC who have not (yet) signed the London Agreement will still require translations of the patent specification and claims after grant.

How will the London Agreement be implemented in practice? Translations of the patent description no longer have to be made for all European patent applications for which the communication under rule 71 (3) EPC 2000 (formerly rule 51 [4]) announcing the intention to grant a European patent is sent out now, setting a four months deadline for filing a translation of the claims in the other two EPO languages which are not the language of the proceedings, since the grant of the EP will then be later than May 1, 2008.

Most of the states adhering to the London Agreement have not yet published how the requirements of the London Agreement will be implemented into their respective national law. However, the UK and Switzerland have already announced that they will no longer require any translation of the patent description for patents with a publication of grant after February 1, 2008. For the other countries, applicants who have received a communication under rule 71 (3) EPC 2000 before February 1, 2008 always can try to slow down the publication of grant by requesting slight amendments to the claims or description with their reply to the communication under rule 71 (3) EPC 2000.

In general, it is expected that in most states adhering to the London Agreement no formalities for validating a European patent will be required anymore.



Reported by Johannes Lang



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5. European Court of Justice gives ruling in “Parmesan” case – not proven that “Parmesan” is generic in Germany – not proven that Germany failed to provide the due protection to geographical indications and designations of origin (Case C-132/05 – European Commission v. Germany)

“Parmigiano Reggiano” is a protected designation of origin (PDO) under Regulation (EC) No. 2081/92 which protects geographical indications and designations of origin Community-wide (Regulation No. 2081/92 has in the mean-time been replaced by Regulation No. 510/2006).

The EC Commission had initiated proceedings under Article 226 EC for failure to fulfil obligations against Germany upon complaints of “participants of the trade” that German authorities were not instructed to interfere when products are brought to the marketplace as “Parmesan” which were not in line with the specification of the PDO “Parmigiano Reggiano”.

The Commission was supported by the Czech Republic and Italy while Germany was supported by Denmark and Austria.

In its defence, Germany argued that “Parmesan” had become generic in Germany to designate hard cheeses of diverse origins, grated or intended to be grated, but not necessarily from regions in Italy. Germany also argued that the designation of origin is only protected as it is registered, and that “Parmesan” is not a translation of “Parmigiano Reggiano”, and, as regards enforcement, Germany is not bound to proceed on its own motion against infringements of Article 13 of Regulation No. 2081/92.

The judgment concludes that Germany has failed to prove that “Parmesan” is a generic term. The Court did not decide whether “Parmesan” is a translation of “Parmigiano Reggiano”, but applied Article 13 (1) lit b of Regulation No. 2081/92 providing that a designation of origin is protected against “any misuse, imitation or evocation”. The Court concludes that the designation “Parmesan” is, in any event, to be considered an evocation of “Parmigiano Reggiano”.

The judgement further concludes that the Commission has failed to prove that Germany was obliged to enforce the Regulation ex officio. Germany had argued that German legislation provided for all the necessary means to protect PDOs in its country. The action of the Commission, therefore, was dismissed in its entirety.

Reported by Peter J.A. Munzinger





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6. German Federal Supreme Court on the relation of Community trademark rights to company name claims (Case I ZR 33/05 – THE HOME STORE)

graphical indications into their national trademark acts.

Reported by Dietrich Beier



The Federal Supreme Court decided against the plaintiff, the proprietor of the community trademark “the home depot”, which was enforced against the use of the designation “Bauhaus the home store”, whilst the element “the home store” was a more recent addition to the company name designation “Bauhaus”, being the company name of the defendant.

Whereas the lower courts granted the injunction against the company name use on the basis of the Community Trademark for all countries of the European Union, the Federal Supreme Court decided that the mere use of a company name cannot be considered as use in the sense of Article 9 of the Community Trademark Regulation which comprises the use for goods and services and not the use of a company name as the designation for a business. The Community trademark can, accordingly, not be used against the mere use of a designation in a company name manner.

Consequently, the Federal Supreme Court, only in charge for legal and not factual questions, referred the case back to the Court of Appeals to clarify whether the use in question occurred also or additionally in a trademark manner, which is possible, in particular in catalogues or in an internet appearance of the company. Insofar, the court considered it being well possible that the addition “the home store” can be considered as a second, additional use in a trademark manner added to the company name, in consequence infringing the Community Trademark of the plaintiff.

With this decision, the Federal Supreme Court confirmed that the Community Trademark Regulation has harmonised European trademark law and not necessarily European designation law, in a broader sense, which is not always observed by the practice of the German instance courts, not least because certain European countries such as Germany have included (nearly) all designations such as company names, title rights, designations for establishments or even geo-



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7. German Federal Supreme Court on acquiescence in parallel import matters (Case I ZR 147/04 – Aspirin II)

The case concerned a typical parallel import matter: The defendant purchased in Greece original packages of “Aspirin” pills to resell them in Germany. The defendant prepared the original Greek twenty-a-piece packages for sale in Germany by putting the blisters into one “Aspirin” box containing one hundred pills.

The plaintiff argued that the sale of its re-packaged “Aspirin” pills in Germany would infringe its rights in the trademark “Aspirin”. Although the pills originally had been put on the market in the European Union with the trademark owner’s consent, its trademark rights were not exhausted because of the modification of the package by the defendant.

The Federal Supreme Court confirmed the plaintiff’s point of view, referring to its own previous case law based on the principles of the ECJ. According to the principles found in this earlier case law, the parallel import company, when modifying the packages, must choose a modification that least affects the interest of the trademark owner (principle of minimum interference). The re-packaging of products in a bigger box, according to this case law, does not respect this principle since the same result may be achieved by bundling the original packages instead, which would affect the trademark less.

The trademark owner’s case was nevertheless dismissed on the basis of reasons that might be regarded as a new principle in the field of “parallel import law” completing previous case law:

According to the rule already set out by the European Court of Justice in 1996, trademark rights in parallel import or re-import cases are exhausted if five conditions are met (ECJ, GRUR Int 1996, 1144 – Bristol Meyers Squib/Paranova). One of these conditions is that the importing company must inform the trademark owner about its intention to sell repackaged products before putting them on the market, in order to enable the trademark owner to verify whether the new package is correct, or whether it affects any aspect of the product or the trademark. The defendant in the case before the Federal

Supreme Court had respected this condition and sent a sample package to the plaintiff. The plaintiff, however, had not replied to this informing letter and had not raised any objections against the sample.

The Federal Supreme Court found that the plaintiff has therefore lost its rights. The parallel import company may trust in the trademark owner’s reaction on its information letter. If the trademark owner does not raise any objections against the sample without delay, the parallel import company has reason to believe that the sample, in the view of the trademark owner, is correct. The trademark owner thus acts in bad faith and loses its right to prevent the marketing of the re-packaged products bearing its trademark.

By this decision the Federal Supreme Court clarifies yet another issue in the field of exhaustion of intellectual property rights and parallel import matters, where German courts have already established detailed case law on various topics.

Reported by Dr. Stefan Abel





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8. German Federal Supreme Court holds that the transit of goods, bearing an identical sign, through the territory of a Member State in which the mark enjoys protection does not per se infringe the holder's rights on the trademark (Cases I ZR 246/02 – DIESEL II and I ZR 66/04 – Durchfuhr von Originalwaren/Transit of Genuine Goods).

In “DIESEL II”, the claimant was the holder of various “DIESEL” trademarks with protection inter alia in Germany and Poland for clothing, footwear and headgear in class 25. However, the claimant did not hold any trademark rights on the designation “DIESEL” in Ireland. The defendant distributed jeans in Ireland, bearing the designation “DIESEL”. For producing the jeans, the defendant first produced single parts of the jeans in Ireland, then shipped them for joining seams to Poland, and afterwards transferred the finished jeans back to Ireland for distribution purposes.

In “Transit of Genuine Goods”, the claimants were trademark holders and licensees of trademarks with protection for perfumery and cosmetics. The defendant purchased goods in Russia to ship them to the USA, thereby crossing parts of the European Community. These goods had been brought onto the Russian Market with the trademark holder's consent.

Before finally deciding on the cases, the German Federal Supreme had put forward to the European Court of Justice (ECJ), for preliminary ruling, questions on the main issues of the above cases. In line with the ECJ's decision (Case C-281/05; see *IP Report 2006-VI*), the Court ruled that the holder of a trademark cannot stop the transfer of goods bearing an identical sign through the territory of a Member State in which the mark enjoys protection, because the mere transit of the goods does not necessarily mean that the goods are placed on the Member State's market. Consequently, there have to be concrete facts that substantiate the suspicion that the goods will be placed on the market of that Member State. In principle, and unlike in the ECJ's earlier “ROLEX”-decision (Case C-60/02), a trademark holder can only stop the transfer if it is subject to a third party's activi-

ties that inevitably will lead to a placing of the goods on the market of the Member State while the goods undertake the common EEC/EFTA T1 transit procedure. The mere possibility or risk that the goods may be placed on the market of a Member State, for instance by the driver of the forwarding company, is not considered to be sufficient to put at risk the main functions of the trademark and, therefore, will not suffice to fulfil the preconditions for trademark infringement.

Furthermore, and again in accordance with the ECJ's decision, the Federal Supreme Court held that the question of whether the goods were produced legally or unlawfully is irrelevant when it comes to judging whether their transit through Germany infringes any trademark rights or not.

Reported by Philippe Kutschke





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9. Office for Harmonization in the Internal Market: Invalidation Division declares Community design protecting the design of the “Crocs” clog invalid (Case ICD 0000003010 – Holey Soles Holdings Ltd. v Crocs, Inc.)

On December 12, 2007, OHIM’s first instance, the competent Invalidation Division, decided that the contested Community design No. 000257001-0001 lacked individual character over the prior designs disclosed by the right holder – Crocs, Inc. – more than a year before the priority date. Consequently, the Invalidation Division found that the ground for invalidity of Article 25 (1) lit b Community Design Regulation (CDR) prejudiced the maintenance of the contested Community design. Crocs, Inc. appealed to OHIM’s Board of Appeal, for suspensive effect pursuant to Article 55 (1) CDR.

Firstly, the Invalidation Division held that evidence concerning sales of the footwear and mainly the sales in the North American market were to be taken into consideration, especially if they referred to the broad use in trade of the designs of the clogs. This was because the North American market was considered to be an important part of the market in which the circles specialised in the sector concerned, operating within the Community, were operating as well and which they were monitoring in the normal course of business (Article 7 [1] CDR).

Secondly, according to the Invalidation Division, a printout from the holder’s website containing its address and the date of printout, was considered to be publicly disclosed on the specified date of the printout despite the holder’s argument that the fact that the website exists does not mean that its contents would reasonably become known in the normal course of business to the circles specialised in the sector, operating within the Community.

Thirdly, the Invalidation Division decided that the informed user (Article 6 [1] CDR) was familiar with the clog footwear to which the challenged Community design related. The informed user was aware of the requirements which such a type of footwear must fulfil in order to perform its function as a clog, and of the prior art

known to the circles specialised in the sector concerned.

Fourth and last, according to the Invalidation Division, the informed user took into account that the degree of freedom of the designer (Article 6 [2] CDR) was limited by the requirement that such a clog must have a sole and an “upper”, and may also have a strap, which all serve to protect the foot and provide stability to it. All these parts must be adapted to the shape of the human foot and its instep. In consequence, the informed user would pay more attention to the features where the designer was not so limited in his creativity, such as the shape of the sole and the heel as well as the shape and configuration of the upper part of the upper, inclusion of a strap and especially to their decorative elements.

Interestingly, Crocs, Inc. was partly or at least preliminarily successful in enforcing its rights conferred by the contested Community design against alleged acts of infringement, e.g., against UK Clobber Limited in the UK. This case, it was said, demonstrated the effective use of rights in a Community design (including a customs seizure based thereupon). It remains to be seen how potential infringers and addressed Community design courts will continue to handle “Crocs proceedings” if they became aware of the fact that – and for what reasons – the underlying design-in-suit has been declared invalid (even if only preliminarily).

Reported by Dr. Henning Hartwig





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10. ICANN approves the Czech Arbitration Court as a new UDRP provider

ICANN, the internet corporation for assigned names and numbers managing the administration of the IP addresses and the domain names in the Internet, has approved the application of the Czech Arbitration Court to become the third arbitration provider for domain name disputes in accordance with the UDRP (uniform dispute resolution policy).

UDRP providers are the basic legal body for such disputes for most of the generic top level domain names such as .com, .info, .net, .pro, .biz amongst others. So far, the World Intellectual Property Organization (WIPO), the National Arbitration Forum (NAF) and the Asian Domain Dispute Resolution Centre are providing domain name dispute resolution proceedings.

To-date the Czech Arbitration Court (CAC) is the – so far – sole provider for domain name dispute resolution for the recently introduced .eu domain name and successfully has issued over 700 decisions since June 2006, with panellists from all European countries. Against some resistance of its competitors, the CAC succeeded now in obtaining the general approval to expand its activities also to the UDRP following the special meeting of the ICANN board of directors of January 23, 2008. The next months will show which approach the CAC will follow to establish a serious alternative for international trademark owners to enforce their rights against domain name grabbers in the heart of Europe.

Reported by Dietrich Beier

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