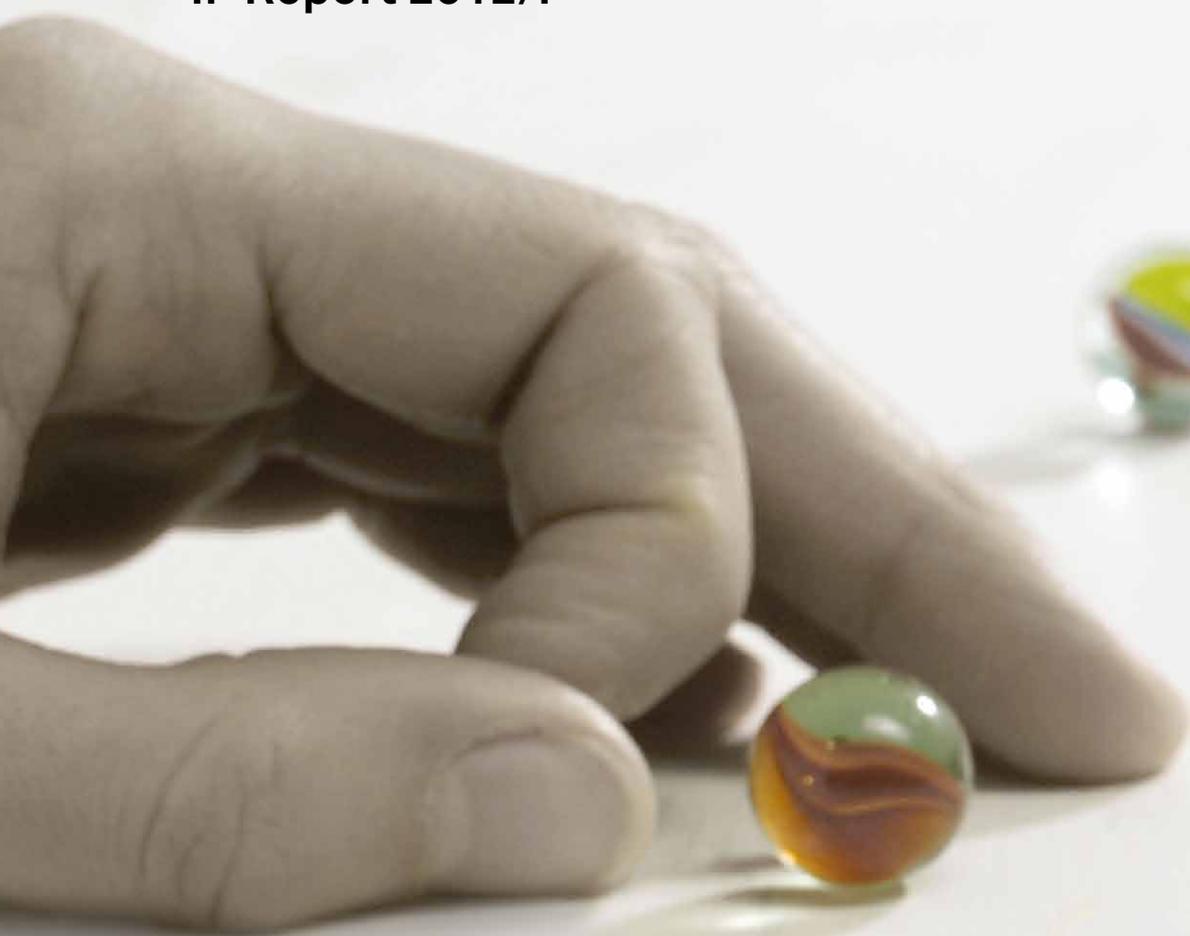




IP Report 2012/I

**BARDEHLE
PAGENBERG**



Patent Law

- 3 1. German Federal Supreme Court on the consequences of omissions and mistakes in the translation of a foreign-language patent application (decision of July 18, 2011 – Case X ZB 10/10 – Polierendpunktbestimmung/Polishing End Point Detection)
- 5 2. German Federal Supreme Court on the patentability of a claim depending on a non-patentable claim (decision of September 29, 2011 – Case X ZR 109/08 – Sensorenanordnung/Sensor Arrangement)
- 6 3. German Federal Supreme Court on obviousness of improvements of data structures provided in an international standard (decision of November 22, 2011 – Case X ZR 58/10 – E-Mail via SMS)
- 9 4. European Patent Office: Enlarged Board of Appeal addresses the substance of the right to be heard in review proceedings (decision of September 29, 2011 – Case R 3/10 – SALMON BRANDS AS)
- 11 5. European Patent Office: Procedure preceding the grant of the patent – amended Rule 71 and new Rule 71a EPC enter into force – translation and fees no longer required before agreement on text has been reached (notice of December 13, 2011)

Design Law

- 12 6. Court of Justice of the European Union: Registration of later conflicting design as Community design is no defence (decision of February 16, 2012 – Case C-488/10 – Celaya SA v Projectos SL – Celaya)

Domain Name Law

- 14 7. German Federal Supreme Court: Administrative contact person of domain name proprietor liable for infringement if domain names are registered on the basis of an automatic procedure (decision of November 9, 2011 – Case I ZR 150/09 – Basler Haarkosmetik/Basler Hair Cosmetics)

1. German Federal Supreme Court on the consequences of omissions and mistakes in the translation of a foreign-language patent application (decision of July 18, 2011 – Case X ZB 10/10 – Polierendpunktbestimmung/Polishing End Point Detection)

Reported by Dr. Christian Haupt

Omissions and mistakes in the German translation of a patent application filed in a foreign language can be corrected anytime and do not lead to a loss of the filing date.

At the German Patent and Trademark Office (GPTO) patent applications can be filed that are not written in the German language. The applicant thus saves the filing date for the technical disclosure content of his foreign-language application. However, a German translation must be filed within three months after the filing of the foreign-language application which then becomes the basis of the further examination procedure. In the present case, the Federal Supreme Court decided on the consequences which omissions and mistakes in the German translation may trigger.

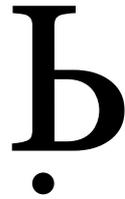
In the case to be decided by the Federal Supreme Court the GPTO had ruled that a foreign-language patent application was to be deemed as not filed if later (after the three months period) the translation showed any omissions. The omissions became manifest in that only 12 of the 26 claims of the foreign-language application were entirely translated. The legal fiction of the non-filed application – that is the denial of the filing date – is provided for by the law (Section 35 (2), p. 2 German Patent Act) in case of a translation not duly filed within the three months period. The GPTO had therefore equated an incomplete translation with a missing translation.

In the reported decision the Federal Supreme Court found that such conduct was contrary to the spirit and purpose of the law, since by Section 35 German Patent Act the non-German applicant was explicitly given the possibility to safeguard the disclosure content of his foreign-language application. The foreign applicant should not be forced to file a priori in the German language, because in this case, he would expose himself to the danger of losing technical disclosure content which could be missing later, if the case may be, for delimitation vis-à-vis the prior art. On the other hand, it would not make sense to first give the possibility to the applicant to save his filing date for his foreign-language application, and to then deny that filing date if the subsequently filed translation is faulty. Consequently, according to the Federal Supreme Court, an incomplete or faulty translation is not to be equated with an entirely missing translation.

The Federal Supreme Court does not find the minimal requirements for the translation to be higher than for the foreign-language application itself. These minimal requirements are: the name of the applicant, an application for grant and – at least the appearance of – a description. The law does not require any patent claims for the granting of an application date. If the above preconditions for a translation are fulfilled, the legal fiction of the non-filed application does not apply, which means that in the case to be decided by the Federal Supreme Court the claims missing in the translation did not result in the loss of the application date.



Christian Haupt



Remarks

The decision is very welcome since it clarifies that omissions or mistakes in the translation of patent applications not filed in the German language are not legally detrimental. Such omissions and mistakes do not lead to a loss of the application date and can be corrected at any time during the application proceedings. The decision is also in line with an earlier judgement of the Federal Supreme Court. In its decision “Nabenschaltung II” (Gear Hub II) of March 18, 2010 – Case Xa ZR 74/04 – the Court had determined that omissions in the German translation of a European Patent do not lead to the patent not having effect for the Federal Re-

public of Germany – a legal consequence which the law provides for the case that no translation whatsoever was filed with the GPTO. Some instance and appeal courts had decided earlier that even marginal omissions in the translation lead to ineffectiveness of the European Patent. Fortunately, the Federal Supreme Court has stopped this practice with the afore-said decision, ruling that omissions are to be regarded as mistakes which do not lead to the legal consequence of ineffectiveness – a view which the Court consequentially holds with the presently reported decision concerning application procedures before the GPTO.

2. German Federal Supreme Court on the patentability of a claim depending on a non-patentable claim (decision of September 29, 2011 – case X ZR 109/08 – Sensorenanordnung/Sensor Arrangement)

Reported by Michael Platzöder

If the subject-matter of a claim in a patent turns out to be not patentable, this does not automatically also render the subject-matter of a claim depending on that claim not patentable.

In the decided case the defendant was the proprietor of a European Patent (“patent-in-suit”) that was granted also with effect for the Federal Republic of Germany and which related to a sensor arrangement for crash detection in automobiles. The plaintiff had filed a nullity suit at the Federal Patent Court and requested a declaration of nullity of the patent-in-suit in its entirety based on an alleged lack of inventive step. During the nullity proceedings the patent-in-suit was defended in an amended version, which contained an amended main claim 1 and claims 2 and 3 depending therefrom, as well as claims 4 – 7 depending directly or indirectly from claim 3. The Federal Patent Court maintained patent claims 1 and 2 as defended and

declared the patent-in-suit null and void beyond these claims.

The Federal Supreme Court confirmed the Federal Patent Court’s finding. However, it found that the Federal Patent Court, while achieving the same result, had erroneously justified the nullity of dependent patent claims 4 – 7 merely with the nullity of patent claim 3 to which they refer. According to the Federal Supreme Court’s decision, if the subject-matter of a claim (here claim 3 in a (granted) patent turns out to be not patentable, this does not automatically also render the subject-matter of a claim depending from it (here claims 4 – 7) not patentable. However, the patent is to be declared null and void also with respect to the attacked dependent claim (here claims 4 – 7), if it is neither asserted nor otherwise apparent that the additional features would lead to a different judgment regarding patentability.



Michael Platzöder

Remarks

The present decision is a good example of the established practice in German patent nullity proceedings according to which the invalidity of a particular claim does not already by implication also render a related dependent claim

invalid. However, the proprietor is nevertheless well advised to expressly assert and argue in sufficient detail the patentability of relevant dependent claims.

3. German Federal Supreme Court on obviousness of improvements of data structures provided in an international standard (decision of November 22, 2011 – Case X ZR 58/10 – E-Mail via SMS)

Reported by Dr. Stefan V. Steinbrener

A skilled person concerned with selectively improving a data structure provided in an international standard normally feels compelled to make recourse to mechanisms already envisaged by the standard for solving the technical problem. If an assessable number of possible problem-solving approaches arise from the standard, each of which has specific benefits and drawbacks, as a rule good cause is given to take each of these approaches into consideration.

The patent in suit, EP-B-1243107, was granted by the European Patent Office for Germany as a designated state and related to a method for transmission of electronic mail messages using an SMS short message service. According to the GSM standard, such transmission of internet e-mails via SMS is already foreseen by adjusting a protocol identifier in the header information of the SMS in order to indicate that an internet e-mail is transmitted by the SMS. The data portion of the SMS then starts with the destination address of the e-mail which is separated from the e-mail contents by a blank. As an option, the standard supports the designation of plural destination addresses separated by commas and the data fields “subject” for indicating the title of the e-mail, and “real name” for indicating the actual name of the sender. These data fields are separated by parentheses or special characters. However, not all header data fields used for e-mails and specified in the internet standard RFC 822 for text messages can be reproduced with the data fields provided in the SMS standard. For instance, in the SMS standard there is no counterpart for the header data field “cc” (carbon copy) used in e-mails for informing additional addressees. The patent in suit therefore

proposes a method allowing the transmission of further data fields provided in RFC 822 via SMS and thus facilitating transmission if different service providers for e-mails and SMS are involved.

According to the invention, the SMS data structure is modified in that

- the presence of plural data fields in the data portion, comprising the address and/or identification data, is indicated in a user data header information;
- the presence of the user data header information is indicated in a “second” header information;
- the plural data fields are transmitted within the data portion of the SMS, but outside of the user data and second header information, and
- the presence of plural data fields is indicated by means of an identifier in the user data header information, specifying a value which is allocated in compliance with an allocation table for RFC 822 addressing, according to which the address and/or identification data are given in the data portion.

The Federal Supreme Court (Bundesgerichtshof) confirmed the revocation of the patent in first instance by the Federal Patent Court (Bundespatentgericht) in a nullity case.

In its opinion, the subject matter of claim 1 as granted only differed from the SMS standard by providing user data header information indicating the presence of plural data fields and “second” header information indicating the presence of the user data header information. In the SMS standard, the data used for e-mail addressing are not transmitted within the user data



Stefan V. Steinbrener

header information and its associated structure, but within the following payload. Furthermore, a value indicating the presence of RFC 822 address data is not defined in the SMS standard.

A skilled person, an engineer in telecommunications, would have realized that the data structure defined in the SMS standard was not suitable to reproduce all data fields provided in the RFC 822 standard. This fact would have prompted a skilled person to look for ways to transmit this information, or at least part of it like the frequently used “cc”-field, in a structured form within an SMS.

For achieving this goal, it was obvious to use the mechanisms already provided in the SMS standard. In accordance with these mechanisms, three alternatives came into consideration:

(i) further data might be introduced into the data portion ahead of the blank indicating the beginning of the payload;

(ii) the user data header information optionally provided in the SMS standard could have been used by expanding the list of indicator values; and finally,

(iii) a distribution of the data between the user data header information and the payload was conceivable as already suggested in the SMS standard in a slightly different context.

None of these alternatives was distinguished as preferable by the prior art since all approaches had specific benefits and drawbacks. Hence, it would have been obvious to expand the arrangement of address and identification data in the data portion of the SMS so that further data fields provided in RFC 822 could be included, thereby using the approach adopted in the SMS standard for the fields “subject” and “real name”, *i.e.* arranging the data at the beginning of the payload and separating them by specific special characters.

When pursuing this approach, the remaining task only amounted to distinguishing a short message of the newly defined type from one using conventional addressing. For the solution of this partial problem, an assessable number of possibilities were also available from the SMS standard. Theoretically, a further value indicating an “RFC 822 mail” might have been included in the header data of the short message. As an equivalent alternative, the standard classification as an “internet electronic mail” could be retained and a distinguishing criterion could be added at a logically lower layer, obviously in the user data header information principally allowing the definition of any data fields.

Since similar objections were raised against the auxiliary requests, the patentee's appeal was dismissed for lack of inventive step.

Remarks

The revocation of the patent was confirmed by the Federal Supreme Court on the basis of a lengthy and somewhat involved argument in respect of obviousness. It is, however, remarkable that issues of “technical character” and/or “statutory exclusion” were neither raised by the parties nor by the Federal Supreme Court.

Although the claimed subject matter relates to a method of transmitting e-mails via SMS, it in fact concerns the modification of a data structure (or preferably a “data format”) provided in the SMS standard, *i.e.* the provision and allocation of data fields in the binary header/payload configuration of a standard short message so

that further addressing options become feasible and transmission between different service providers is facilitated. In the present case, this has explicitly been accepted by the Court as the “technical problem” without any further qualification. Of course, the SMS and e-mail formats are specifically adapted to the properties of the respective telecommunication systems and re-

flect those properties which ultimately structure any transmittable piece of information. In this sense, such formats are certainly of a technical nature, they contribute to the solution of the “concrete technical problem” of electronic information exchange among separate networks and should thus be patent-eligible subject matter in Germany.

4. European Patent Office: Enlarged Board of Appeal addresses the substance of the right to be heard in review proceedings (decision of September 29, 2011 – Case R 3/10 – SALMON BRANDS AS)

Reported by Dr. Rudolf Teschemacher

Since the entering into force of the European Patent Convention in its revised version (EPC 2000) on December 13, 2007, decisions of the Boards of Appeal of the EPO are subject to review by the Enlarged Board of Appeal (EBA) on the grounds that a fundamental procedural defect occurred in the appeal proceedings. Before case R 3/10, fifty-two petitions for review had been disposed of. Only one petition was successful and in that case (decision R 7/09 of July 22, 2009) the procedural violation was the consequence of the fact that the EPO was not in a position to prove the notification of a brief of a party to its adversary. In decision R 3/10, the EBA held for the first time that a fundamental violation of right had occurred in oral proceedings before a Technical Board of Appeal.

The opposition division had decided that the patent could be maintained on the basis of an auxiliary request of the proprietor of the patent. The proprietor and three of the five opponents appealed. In its communication accompanying the summons to oral proceedings, the Board of Appeal addressed the opposition ground of lack of novelty. In addition, it was said that in case novelty would be established it might be necessary to discuss inventive step.

In the oral proceedings, novelty was argued by both sides. After the parties had declared that they had no further comments, the Chairman closed the debate and informed the parties that the Board would decide on the patentability of

the main request. After deliberation and upon resumption of the oral proceedings, the Chairman announced the decision that the claimed subject-matter was novel but lacked an inventive step. This was uncontested among the parties to the proceedings. In respect of the exact use of words by the Chairman, different information can be taken from the original minutes, the petitioner's request to correct the minutes, the decision on this request for correction and from the declarations by participants produced by the petitioner.

Notwithstanding such details, the EBA concluded that there was a "very unfortunate misunderstanding", because it had not been made clear to the parties that novelty and inventive step would be discussed together and decided together by the Board. The question whether or not there was a fundamental procedural violation had to be determined on an objective basis and the necessity to respect the right to be heard was absolute. It was neither relevant what the Board's intention was, nor whether the considerations related to inventive step were close to the discussion on novelty, nor whether any arguments of the petitioner might have convinced the Board, nor to which extent the matter had been previously discussed in writing. The crucial point was that the proprietor had not been given the opportunity to present its arguments orally on the decisive issue of the presence of an inventive step. Thus, the decision under review was set aside and the proceedings before the Technical Board of Appeal were re-opened.



Rudolf Teschemacher

Remarks

Many of the so far unsuccessful petitions are based on submissions which show that the Board's perception of the state of discussion in oral proceedings and the parties' perception may be quite different. This is no surprise because the Boards of Appeal know quite well how they conduct proceedings whereas for the parties and their representatives the course of oral proceedings before a Board may be a rare and sometimes unique experience. This puts the obligation on the Boards to make a break which is evident and unambiguous when oral proceedings come to an end. The pre-printed sentence in the form for the draft minutes "the Chairman declared the debate closed" is not sufficient for this purpose, because it does not make clear that the debate is closed for the case as a whole. Rather, it should be made clear beyond any doubt that the parties have no further requests and submissions, or they should be expressly invited to submit their final requests.

The reported decision is in remarkable contrast to other decisions in review cases which took the closure of the debate as indicated in the minutes as a fiction that the parties had been given the opportunity to comment on all relevant points and to file all appropriate requests. An example is decision R 7/11 of October 5, 2011

in which the Board stated that "the necessary meaning of the expression 'the debate is closed', which corresponds to an important procedural step, is not open to multiple or relative interpretations." This does not correspond to what sometimes happens in reality. Oral proceedings are often interrupted and resumed several times and it is not always made clear to the parties that an interruption might be the last one. However, the statement "the Chairman declared the debate closed" is always found in the minutes notwithstanding the actual conduct of proceedings in the individual case.

In this respect, R 3/10 also diverges from decision R 15/09 of July 5, 2010 concluding that it was not appropriate to take evidence on the actual course of oral proceedings held in the decision under review. Decision R 3/10 shows that considering the submissions from both parties including declarations from participants to the oral proceedings may result in a picture which is much more detailed than the mere statement in the minutes "the debate is closed". The provision on taking of evidence in Article 117 EPC applies to review proceedings as well as to any other proceedings before the EPO.

5. European Patent Office: Procedure preceding the grant of the patent – amended Rule 71 and new Rule 71a EPC enter into force – translation and fees no longer required before agreement on text has been reached (notice of December 13, 2011)

Reported by Dr. Rudolf Teschemacher

By decision of October 26, 2010 (OJ EPO 2010, 637), the Administrative Council of the European Patent Organisation amended Rule 71 EPC as to the procedure to be followed after the Examining Division has informed the applicant of the text in which it intends to grant the European patent pursuant to Rule 71 (3) EPC, and added a new Rule 71a EPC as to the conclusion of the grant procedure. These amendments will enter into force on April 1, 2012. The notice of December 13, 2011 gives information about these amendments. Corresponding amendments are foreseen for the revised Guidelines which are envisaged to enter into force in June 2012.

1. The core element of the amendment to the Rules is the introduction of an additional step into the proceedings if the applicant disapproves of the text communicated to him under Rule 71 (3) EPC on the basis of which the Examining Division intends to grant the patent, because

- he files reasoned amendments or corrections to the text,
- he disagrees with amendments or corrections made by the Examining Division on its own initiative, or
- he disagrees with the grant proposed by the Examining Division on the basis of an auxiliary request.

In these cases, the applicant is not obliged to fulfil the formal requirements for grant (translation of the claims and fees) and the examination will be resumed.

2. The examination may be continued by

- issuing a second communication under Rule 71 (3) EPC if the Examining Division is prepared to allow the applicant's main request,
- refusal of the application if the Examining Division is not prepared to allow the applicant's main request and the respective grounds have already been communicated to the applicant,
- issuing an examination report if the Examining Division is not prepared to allow the applicant's main request and the respective grounds have not yet been communicated to the applicant.

3. The time limit for fulfilling the formal requirements for grant set in the communication under Rule 71 (3) EPC remains 4 months. It is fixed in the Rule, thus it cannot be extended. If the applicant fails to fulfil the formal requirements for grant in due time although there is none of the situations listed in pt. 1 (above) applies, the application is deemed to be withdrawn in accordance with Rule 71 (7) EPC. Further processing is available.

If the applicant simply disapproves of the text communicated under Rule 71 (3) EPC, the application will be refused without giving substantive reasons because there is no text agreed by the applicant in accordance with Article 113 (2) EPC.

6. Court of Justice of the European Union: Registration of later conflicting design as Community design is no defence (decision of February 16, 2012 – Case C-488/10 – Celaya SA v Proyectos SL – Celaya)

Reported by Dr. Henning Hartwig

Guidance from the Court of Justice of the European Union (“ECJ”) on substantive Community design law is still rare. This includes Article 19 (1) Sentence 1 Community Design Regulation (“CDR” or “Regulation”) on the “rights conferred by the Community design”, which, in case of a registered Community design, provides a true monopoly: “A registered Community design shall confer on its holder the exclusive right to use it and to prevent any third party not having his consent from using it.”

In an infringement action pending before the Juzgado de lo Mercantil nº1 de Alicante y nº1 de Marca Comunitaria, the court decided to stay the proceedings and referred to the ECJ, for a preliminary ruling, the question whether – in a nutshell – the right under Article 19 (1) CDR (i) extends to any third party irrespective of whether such party likewise is the owner of a later registered Community design and (ii) whether the answer to the first question is connected with the intention or conduct of the third party.

In a dogmatic sense, this matter was about whether an accused infringer was allowed to raise – further to the codified, substantive defences of non-infringement (Article 10 CDR) and invalidity of the asserted design (Articles 85, 90 CDR) – a third defence *sui generis*, *i.e.*, to be the owner of a valid (*i.e.*, not yet invalidated) IP right conferring “the exclusive right to use it” (Article 19 [1] CDR). While such a defence may be valid against third parties without any better right, the ECJ rightly confirmed that such a defence is not valid where prior rights are asserted:

39 It should be noted (...) that (...) the provisions of the Regulation must be interpreted in the light of the priority principle, under which the earlier registered Community design takes precedence over later registered Community designs.

40 It follows in particular from Article 4 (1) of the Regulation that a design is to be protected by a Community design to the extent that it is new and has individual character. However, where two registered Community designs are in conflict with each other, the design that was registered first is deemed to have met those conditions for obtaining protection before the design that was registered second. Thus, the holder of the later registered Community design may be afforded the protection conferred by the Regulation only if he can demonstrate that the earlier registered Community design fails to meet one of those conditions, by seeking a declaration of invalidity, where appropriate by way of counterclaim.

In addition to that, the Court looked at the wording of the CDR to support its position:

33 (...) the wording of Article 19 (1) of the Regulation does not make any distinction on the basis of whether the third party is the holder of a registered Community design or not.

34 Thus, that provision states that a registered Community design is to confer on its holder the exclusive right to use it and to prevent “any third party” not having his consent from using it.



Henning Hartwig

35 Similarly, Article 10 (1) of the Regulation provides that the scope of the protection conferred by a Community design is to include “any design which does not produce on the informed user a different overall impression”.

36 It is apparent from those provisions that the Regulation does not preclude the holder of a registered Community design from bringing infringement proceedings to prevent the use of a later registered Community design which does not produce on the informed user a different overall impression.

As a consequence, the Court found that “Article 19 (1) of the Regulation must be interpreted as meaning that, in a dispute relating to infringement of the exclusive right conferred by a registered Community design, the right to prevent use by third parties of the design extends to any third party who uses a design that does not produce on informed users a different overall impression, including the third party holder of a later registered Community design”, this finding being “unconnected with the intention or conduct of the third party”.

Remarks

After the ECJ decision on standards of infringement under Article 10 CDR (cf. BARDEHLE PAGENBERG IP 2011/V), this new decision provides further – helpful but not surprising – guidance on the scope of defences against infringement. We now know that being proprietor of a later registered Community design does not provide a defense to an infringement action brought by the proprietor of the earlier design.

This result corresponds to the grounds of invalidity in Article 25 (1) CDR. A later design which conflicts with an earlier design right is susceptible to be declared invalid. The ground of invalidity exists even if the earlier design right was not yet made available to the public at the time the later design was applied for (Article 25 (1) lit d CDR). It would be incongruous in such a situation to provide the proprietor of the later design with a defense against infringement, or require the proprietor of the earlier design right first to obtain a declaration of invalidity of the later design.

What is the situation in the reverse situation: Is the proprietor of a later design allowed to bring an action for infringement against the use of a design protected by an earlier design right? Can the proprietor of the earlier design raise, as a defence, that he has an earlier right? The CDR does not provide a clear answer. However, it corresponds to the principle of priority which governs conflicts between IP rights that the proprietor of a later right cannot bring an action against the proprietor of an earlier right. Also, in this hypothetical situation the proprietor of the earlier right could seek a declaration of invalidity of the later design by way of counterclaim.

The same problems can arise under Community trademark law, where the Community Trademark Regulation does not provide for a defense when the contested use is itself subject to a – later – trademark registration, and where there is no specific provision precluding an action against the proprietor of an earlier right.

7. German Federal Supreme Court: Administrative contact person of domain name proprietor liable for infringement if domain names are registered on the basis of an automatic procedure (decision of November 9, 2011 – Case I ZR 150/09 – Basler Haarkosmetik/Basler Hair Cosmetics)

Reported by Tiffany Zilliox, LL.M.

In general, a person who is designated by a foreign domain name proprietor to be the administrative contact person at the German domain name registry (hereafter “Admin-C”) is not liable, because of his mere appointment, for infringement of third parties’ rights occurring through domain name registrations. However, the Admin-C is exceptionally liable if he has an obligation to verify the domain name registrations due to special circumstances. This can be the case if the Admin-C declares that he is using his administrative position for an undefined number of future domain name registrations and knows that the registration of these domain names is made by the applicant on the basis of an automatic selection and registration procedure.

In the present decision, the Federal Supreme Court ruled that an Admin-C is generally not liable for potential infringement for the following reasons: First, the domain name applicant has an own responsibility of verifying that the registration and the use of the domain name does not infringe third parties’ rights. In fact, the Admin-C is merely a registered person authorized to accept service for a domain name proprietor who is established abroad. While the guidelines of the German domain name registry confer to the Admin-C the authority to make decisions in the

name of the domain name proprietor, the Court concluded that it would be unreasonable to expect the Admin-C to verify all domain name registrations made by the proprietor.

Nevertheless, the Court found the Admin-C to be liable in the present case, finding exceptional circumstances leading to a duty to verify the domain name application, which the Admin-C had not fulfilled. The domain name proprietor was established in the U.K., trading with registered domain names. Free domain names were identified and registered via an automatic system. Thus, the proprietor of the domain names was not verifying whether third parties’ rights were infringed. The Admin-C, who was aware of the situation, agreed with the proprietor to be registered as Admin-C for a large and undefined number of future domain name registrations.

While the Court confirmed that the business model of “domain grabbing” was not in itself illegal, it found that the Admin-C had created a risk of infringing domain names being registered by having consented to act as Admin-C for all future domain name applications. Given the fact that the Admin-C was aware of the automatic registration system, he should have verified the applications. As he had failed to do so, the Court found the Admin-C to be liable for damages due to the registration of an obviously infringing domain name.



Tiffany Zilliox

Remarks

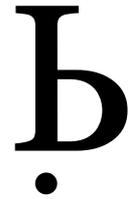
The decision by the Federal Supreme Court confirms previous decisions rendered by German lower instance courts, in so far as there is no general liability of the Admin-C for registrations of infringing domain names. However, this decision admits a far-reaching liability of the Admin-C on the basis of exceptional circumstances. In practice, circumstances which could lead to such liability of the Admin-C can be assessed by German Courts on the following grounds:

It has to be taken into consideration whether the Admin-C has the intention and a personal interest in realizing profits by being appointed as Admin-C. The person might take on the position for the mere reason that the domain name proprietor is established abroad and that the German domain name registry requires an inland Admin-C in order to facilitate enforcement. In this case, the role of the Admin-C amounts rather to a public interest than to a private interest in gaining profit. In consequence it is less likely that a liability will be found.

In addition, courts have to assess the degree of independence of the Admin-C vis-à-vis the

domain name proprietor. If the proprietor has given his Admin-C a contractual authority to make independent decisions regarding registrations, the likelihood of liability of the Admin-C rises.

Finally, courts will also assess to what extent the infringement of third parties' rights by registration of a specific domain name is obvious and easily detectable. In case the infringement is only identifiable on the basis of an extensive research and an in-depth analysis of the factual and legal parameters, a liability of the Admin-C is unlikely. However, if the infringement is so obvious that a simple internet research would clarify the situation, the Admin-C is more likely to be found liable. Indeed, in the case reported above, the Federal Supreme Court took its decision on the assumption that the infringement would have been obvious to the Admin-C if it would have conducted a basic internet research. Therefore this seems to be an important additional assessment criterion regarding the liability of an Admin-C for infringing domain name registrations.



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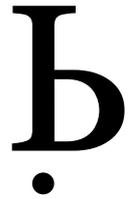
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