

## Landmark Decisions

### A selection of the everyday practice of rospatt osten pross

This is a collection of published judgments from Germany's Federal Supreme Court and other important tribunals, with which case law has been given a guiding stimulus. As attorneys of the prevailing or defeated party, the lawyers of rospatt osten pross evolved the arguments or counter-arguments in at least one instance, and thus contributed to further development of the law.

### General IP Topics

Steroidbeladene Körner (steroid loaded granules) – Federal Supreme Court 2011 Mitt 100

The verdict deals with damages claims founded on the execution of a first instance verdict which is subsequently overruled. If the patent owner poses a security after the release of a favourable first instance verdict for the purpose of the execution of this verdict, he is generally liable for damages caused by this execution. This can be avoided only if and insofar as the patent owner clearly undertakes not to deduce any rights from the verdict against the debtor.

Hubkippvorrichtung (Stroke-Tilt Lifter) – Düsseldorf Regional Appeal Court 2006 Mitt 129 = 5 InstGE 251

In this decision, the Düsseldorf Regional Appeal Court emphasizes the importance of the causal relationship between the infringement action and the infringer's profit. It is necessary, in each individual case, to establish the proportion of the infringer's profit that can actually be attributed to the infringement of the intellectual property right. While the Düsseldorf Regional Appeal Court has held that the Supreme Court's decision on overheads (see below) also applies in principle to patent law, in practice this judgment means that the consequences of the Supreme Court's ruling are moderated, so that excessive damages are not awarded.

Abstreiferleiste (cleaning strip) – Federal Supreme Court 2003 IIC 818

To begin with, the Federal Supreme Court confirms the rule that a res judicata effect not only applies to the contractual basis of a claim, which was actually introduced into legal proceeding (here: invalid know-how contract), but also expands to a competing claim basis such as, e.g., unjustified enrichment. However, the court allows for an exception if it is unambiguously clear that the verdict shall not contain a decision on the competing claim basis.

Gemeinkostenanteil (Share of Overheads) – Federal Supreme Court 2001 GRUR 329 = 2002 IIC 900

Germany's Federal Supreme Court relinquishes its previous case law regarding the calculation of damages on the basis of an infringer's profits. By adding in overheads, infringers were frequently able to show a loss on infringing sales. Now overheads can be deducted only in exceptional cases. This greatly increases an infringer's risk of being found liable for damages.

Druckbalken (Pressure Beam) – Federal Supreme Court 1985 GRUR 512 = 1987 IIC 108

Germany's Federal Supreme Court grants the holder of an intellectual property right an opportunity to demand from an alleged infringer an inspection of the alleged object of infringement under Section 809 of the German Civil Code. With its "Faxkarte" ("Fax Card") decision in the year 2002 (2003 IIC 331), the Federal Supreme Court further clarified the rulings on this subject by loosening the strict requirements that had been in effect until then.

## **Patent Law**

Rohrschweißverfahren (Tube welding process) – BGH 2007 GRUR 773 = 2008 ICC 106

This decision on indirect patent infringement deals with a situation in which a patented multi-stage process is carried out on different commercial levels, where those carrying out the first part of the process possess a licence, while those marketing a means for carrying out the second part do not.

Haubenstretchautomat (Hood-stretching automat) – Federal Supreme Court 2007 GRUR 679

In this further decision on indirect patent infringement, the Federal Court of Justice sets out in detail the requirements regarding the obvious nature of the fact that an article is intended to allow a third party to use it in accordance with a patent. In addition, the decision deals with the limits to the entitlement to a cease and desist order regarding articles which can also be used without infringing a patent. Finally, the Federal Court of Justice explains the principles to be applied in determining the compensation to be paid by an indirect infringer and the scope of the corresponding entitlement to a rendering of account and provision of information.

#### Antriebsscheibenaufzug (Traction Sheave Elevator) – Federal Supreme Court 2005 GRUR 848

Following the Air Heater ruling (see below), this is another landmark decision regarding indirect patent infringement. First of all, it provides a more precise interpretation of the objective and subjective facts mentioned in section 10 of the German Patent Act, according to which the supplier should know – or it should be obvious from the circumstances – that the means is “suitable and intended for making use of the invention”. The decision goes on to explain the requirements which have to be met in order to prove these facts if it is also possible to use the means without infringing the patent. Secondly the Supreme Court lays down the losses for which the infringer must compensate the patent proprietor.

#### Schneidmesser II (Cutting Blade II) – Federal Supreme Court 2002 GRUR 519

The decision is one of five simultaneous rulings handed down by Germany’s Federal Supreme Court (including Cutting Blade I – 2002 IIC 873) containing fundamental statements on patent protection under the doctrine of equivalence and regarding the scope of protection as regards numerical and dimensional data.

#### Luftheizgerät (Air Heater) – Federal Supreme Court 2001 GRUR 228

Germany’s Federal Supreme Court formulates the criteria currently in effect for ascertaining a contributory patent infringement, especially for determining the subjective facts (intent) and for taking into account experience from everyday life.

#### Spannschraube (Tension Screw) – Federal Supreme Court 1999 GRUR 909 = 1999 IIC 932

This decision essentially clarifies the test for determining the scope of protection afforded by a patent. Citing the problem and its solution, the court emphasizes more strongly than before the special importance of the way in which an object is viewed in functional terms. Moreover, it finds that the meaning of terms used in a patent is to be determined from the patent itself and may differ from the common understanding of them (a patent specification as “its own dictionary”).

Befestigungsvorrichtung II (Fixing Device II) – Federal Supreme Court 1991 GRUR 436 = 1992 IIC 111

The decision contains the delimiting criteria still in effect today of what constitutes a dependent invention and when a patented infringing embodiment does not fall within the scope of a patent's protection even under the doctrine of equivalence.

Ethofumesat (Ethofumesate) – Federal Supreme Court 1990 GRUR 997 = 1991 IIC 541

Germany's Federal Supreme Court deals with the question of whether the user of a patent was entitled to a testing privilege prior to the introduction of Section 11 of the Patent Law of 1981. From the standpoint of eliminating the consequences of a continuing infringement of rights under Section 1004 of the German Civil Code, the Court approves an extension of the time of the patent protection in the case of patent-infringing preparatory actions intended to permit immediate marketing after expiration of the period of patent protection. This is a precursor decision to the Court's later rulings "Klinische Versuche I und II" ("Clinical Tests I", 1997 IIC 103, and "Clinical Tests II", 1997 Mitt 523) and to the decision of Germany's Federal Constitutional Court "Clinical Tests" (2001 GRUR 43), in which rospatt osten pross was also involved.

Befestigungsvorrichtung I (Fixing Device I) – Federal Supreme Court 1987 GRUR 280 = 1988 IIC 243

Germany's Federal Supreme Court holds that the rule whereby only the prior art mentioned in the patent specification may be taken into account in interpreting the patent does not apply in determining the scope of protection under the doctrine of equivalence.

Schiessbolzen (Projectile of a Bolt-Setting Gun) – Federal Supreme Court 1979 GRUR 149

With this decision Germany's Federal Supreme Court makes it clear that just providing information about the intended purpose in a device claim does not have the effect of limiting the scope of protection.

Metronidazol – Federal Supreme Court 1975 GRUR 425 = 1976 IIC 407

In a basic decision Germany's Federal Supreme Court defines the requirements for implementing process claims by equivalent means.

## Trademark Law

audison – Federal Supreme Court 2009 GRUR Int. 257

The Federal Supreme Court answers a number of open questions in relation to the unlawful agent trade mark. He notes, inter alia, that the claims based on Art. 11, 17 Trade Mark Law also exist if the principal, as yet, has only applied for a foreign trade mark at the time of the agent's national application. Any marketing intermediary who has at least a secondary obligation vis-à-vis the principal to regard his interests can be regarded as an agent in the sense of these provisions.

Das Prinzip der Bequemlichkeit (The Principle of Comfort) – ECJ 2005 GRUR Int 224

For the first time the European Court of Justice deals with the matter of the registrability and distinctiveness of advertising slogans. The Court of First Instance upheld the applicant's suit for registration (2002 IIC 970) and found that no stricter criteria were called for in the case of slogans than in relation to other marks. The European Court of Justice dismissed the appeal of the Office for Harmonization in the Internal Market and confirmed in principle the registration of advertising slogans as trademarks.

stüßy/stüßy II – Federal Supreme Court 2000 GRUR 879 and 2004 GRUR 156 = 2004 IIC 699

In this dispute the trademark holder sued to block the sale of original merchandise which, as he represented, had been imported into the EU or EEA without authorization. After a submission decision by the European Court of Justice (2003 GRUR 512 = 2003 IIC 654), Germany's Federal Supreme Court laid down new principles for the distribution of the burden of proof in such cases.

Companyline – ECJ GRUR 2003, 58

With this second decision on the distinctiveness of community trademarks, the European Court of Justice gives up its generous line from the "Baby-Dry" decision of 2001. In so doing, it makes it clear that the appreciation of facts is open to review by the European Court of Justice only in the exceptional event that the lower court's appreciation distorts the presentation of the facts.

1, 2, 3 im Sauseschritt (“Quick as a wink”) – Federal Supreme Court 2002 GRUR 1083

Germany’s Federal Supreme Court initially finds that the distinctiveness of registered dictums as a trademark should not be judged differently from the distinctiveness of other identifiers. At the same time, a specific semantic content associated with the dictum can eliminate any danger of confusion if the semantic content of the attacked identifier differs from it.

Tiffany II – Federal Supreme Court 2002 GRUR 1079

Germany’s Federal Supreme Court substantiates the merchandise likeness / similarity of jewelry on the one hand and ophthalmic products (eyeglasses frames) on the other. The ruling is one of a series of decisions which, after the “Canon” decision of the European Court of Justice, marks a move by the Federal Supreme Court toward an absolute similarity concept for goods and services.

Fabergé – Federal Supreme Court 2002 GRUR 340

Following the Chevy decision by the ECJ, the BGH (Federal Court of Justice) does not require, for a mark to be known, that the mark should be familiar to a particular percentage of the relevant public. Instead, all the relevant circumstances of the individual case (market share, use and investments) must be taken into consideration when weighing up the overall merits.

EuroHealth – CFI 2001 GRUR 835 = 2002 IIC 216

The Court of First Instance recognizes the registration of the mark “EuroHealth” as a community trademark for financial services. It thus opposes the view that combining a descriptive word or phrase with the mark “Euro” renders the combination unprotectable as a trademark.

Drei-Streifen-Kennzeichnung (Three-Stripe Mark) – Federal Supreme Court 2001 GRUR 158 = 2002 IIC 770

Germany’s Federal Supreme Court broadens the scope of protection of the adidas stripes to include a 2-stripe design. It takes the position that, because the adidas stripes are so well-known, the consumer will recognize the trademark even in such differing versions. The “adidas/Fitnessworld” decision of the European Court of Justice of 2003 (2004 IIC 65) is along the same lines.

Aral/Blue I – BPatG 1999 GRUR 61 = 1999 IIC 812

Several senates of Germany's Federal Patent Court had initially rejected the registration of abstract-color trademarks. This decision modified those prior rulings. Meanwhile in its "Libertel" decision (2004 IIC 56) the European Court of Justice confirmed the registrability of color trademarks and thereby clarified one of the most contentious issues in trademark law.

### **Design Protection/Copyright Law**

Holzstühle (Wooden Chairs) – Federal Supreme Court 1996 GRUR 767 = 1998 IIC 105

Germany's Federal Supreme Court establishes basic rules for the differentiated testing of the novelty and uniqueness of a registered design.

Cartier-Armreif (Cartier Bracelet) – Federal Supreme Court 1994 GRUR 630 = 1995 IIC 121

For the first time in performance protection under competition law also, Germany's Federal Supreme Court grants the claim, which had been rejected in the first instance, to information about the origin and distribution channel of imitations, which was introduced with the Product-Piracy Law of 1990 for intellectual property rights. The claim is extended to include foreign suppliers and buyers.

Beschlagprogramm (Line of Dress Plates) – Federal Supreme Court 1986 GRUR 673

Germany's Federal Supreme Court grants complementary protection under unfair competition law to recurrent characteristic features of a product line.

Stahlrohrstuhl II (Steel-Tube Chair II) – Federal Supreme Court 1981 GRUR 820

Anyone contesting copyright-law protection for an art work based on prior art must explain and demonstrate the specific appearance of that known geometric shape.

Leuchtenglas (Lamp Glass) – Federal Supreme Court 1981 GRUR 273

Germany’s Federal Supreme Court reaffirms its own decisions to the effect that a discrete part of a complex design shape can be accorded separate protection under registered-design law (known as element protection).

Haushaltsschneidemaschine I + II (Household Slicing Machine I and II) – Federal Supreme Court 1978 GRUR 168 = 1978 IIC 495; 1981 GRUR 269

In a lawsuit which had gone through five levels, involving two appeal judgments on points of law, Germany’s Federal Supreme Court recognized the protection, under registered-design law, of a housing proportioned in a certain way, with a cuboid shape. In so doing, it confirmed its rulings to the effect that protection against imitation of design shapes can at most only be refused if their basis is objectively and exclusively technical.

Dreifachkombinationsschalter (Triple Combination Switch) – Federal Supreme Court 1975 GRUR 81

Germany’s Federal Supreme Court adheres to the principle that, while the requirements applicable to the creative uniqueness of registered designs must not be too low, they are nevertheless much lower than in the case of a work of art protected under copyright law. The court makes it clear that this principle also applies when the design shape consists of a combination of previously known elements.

Elektroschalter (Electric Switch) – Federal Supreme Court 1974 GRUR 406

Germany’s Federal Supreme Court clarifies the “Strassenleuchte” (“Street Light”) decision of 1961 to the effect that concordance with a registered design indicates the presence of subjective imitation even when the imitator had no knowledge of the protected original. The court makes it clear that such indication does not exist if there is doubt as to whether the original was already being marketed at the time when the contested product was created.

Stahlrohrstuhl I (Steel-Tube Chair I) – Federal Supreme Court 1961 GRUR 635

Germany’s Federal Supreme Court recognizes the hind-leg-less (free-swinging) chair by Mart Stam as an aesthetic creation that ranks as a work of art. Whether it is judged as qualifying as a work of art depends solely on the situation and viewpoints prevailing at the time of its creation.

Hummel-Figuren I-III (Hummel Figures I-III) – Federal Supreme Court 1952 GRUR 516; 1961 GRUR 581; 1970 GRUR 250

In this series of decisions, Germany's Federal Supreme Court lays the foundation for protection of the design of artistic child figures under copyright law and registered-design law, with complementary protection under unfair competition law. It also establishes the principle that religious congregations have exclusive rights of use with regard to copyrights belonging to their members.

### **Unfair Competition Law**

Umsatzsteuererstattungs-Modell (VAT Reimbursement Model) – Federal Supreme Court 2006 GRUR 511

With this ruling, the Federal Supreme Court continues the moves to relax the requirements under Unfair-Competition Law in connection with advertising articles. In future, it will only be assumed that enticements are excessive for the purposes of Competition Law if the benefit offered by the advertiser is likely to exert such a powerful influence on the consumer that the latter's free will in decision-making is impaired. In addition, the Supreme Court makes a clear distinction between loan transactions under Banking Law, for which a permit is required, and the concept of credit according to other provisions.

Preiskampf (Price War) – Federal Supreme Court 1990 GRUR 371 = 1990 IIC 256

To protect competitors, Germany's Federal Supreme Court prohibits mutual price undercutting by two companies with significant market power through offering below-cost prices ("loss leaders").

Metro I-III, V – Federal Supreme Court 1978 GRUR 173 = 1978 IIC 250; 1979 GRUR 411 = 1980 IIC 103; 1990 GRUR 617; 2001 GRUR 846

With these decisions Germany's Federal Supreme Court sets the permissible limits for wholesalers selling goods for private consumption and indicates the organizational steps they must take to prevent such purchases.

## **Antitrust Law**

Standard-Spundfass (Standard-Bung Barrel) – Federal Supreme Court 2004 GRUR 966

In this decision, the Federal Supreme Court for the first time established an entitlement to a compulsory license outside the scope of the exceptional provision of Section 24 of the German Patent Act. The ruling is particularly important in cases in which the teaching of a patent has been reflected in an industrial standard.

Polyferon (Polyferon / Compulsory License) – Federal Supreme Court 1996 GRUR 190 = 1997 IIC 242

This is the German Federal Supreme Court's only decision to date on the subject of compulsory licenses according to Section 24 of the Patent Act.

## **Procedural Law**

Magnetowiderstandsensor (magneto resistance sensor) – Federal Supreme Court 2011 GRUR 359

In this case plaintiff in a nullity action was supported by a side-intervient. In the appeal proceedings plaintiff and defendant settled the case out of court. Side-intervient was not involved in this settlement. The Supreme Court had to decide whether side-intervient had the right to continue the nullity action on its own after plaintiff had withdrawn his appeal. The Supreme Court assumes such right of side-intervient only if he has joined the proceedings before the expiry of the appeal term and lodged his own appeal.

Mykoplasmenachweis (Mycoplasma detection) – Federal Supreme Court 2008 GRUR 280

This decision sets out the prerequisites for a reinstatement in the status quo ante in nullity proceedings after the deadline for filing the statement of grounds for appeal has lapsed. It also specifies the due diligence of an attorney using professional software for monitoring deadlines.

GAT v. LuK – ECJ 2006 Mitt 361 = 2006 IIC 742

According to this decision, a court within the EU cannot decide on the validity of a patent in another Member State of the EU, not even in connection with a patent infringement action. Together with the judgment in the Roche v. Primus case, this decision effectively will put an end to cross-border patent infringement actions, because the defendant merely has to raise the defense that the patent in suit is invalid in order to show that the court seised of the case lacks jurisdiction.

Euro-Einführungsrabatt (Euro-Introduction Rebate) – Federal Supreme Court 2004 GRUR 264

Germany's Federal Supreme Court ends a dispute that has continued for decades in lower-court cases concerning administrative fines for non-compliance with a court ruling after settlement of the main proceedings. The court makes it clear that violations of a restraining order are no longer punishable by execution procedures when the parties have mutually declared the main proceedings to have been settled and the settlement has not been limited to the time after the punishable violation.

Unzulässige Verletzungsklage (Inadmissible Infringement Action) – BVerwG 2001 Mitt 136

By filing patent-infringement actions with the Administrative Court, rospatt osten pross had developed a defense against so-called torpedo suits. The pendency of an infringement action in Germany was thus brought forward to the moment of the filing of the action. This measure has withstood being contested before Germany's Federal Administrative Court. The European legislature recognized the problem involved and came up with a sensible solution in an amendment to Article 30, Point 1, of the EuGVO (European Regulation on Place of Jurisdiction and Enforcement)