



## Newsletter 5/2017 Edition

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### EPO makes it more difficult to submit data to support inventive step

It used to be common practice before the EPO that it was allowed to submit experimental data after submitting an application, and even required by the Office in prosecution, in order to prove an inventive step.

In 2005, the decision [T 1329/04](#) illustrated that this generosity has its limitations. The submission of data to gain an advantage which was in contradiction to the result of the specification was not accepted by the Board of Appeals. According to the Board, it should already be plausible from the originally submitted application that an alleged advantage does, in fact, exist.

In subsequent decisions, the Boards of Appeal then regularly tested the extent to which data submitted subsequently was in line with the disclosure of the specification. In the decision [T 415/11](#), the Board of Appeals went a step further. It came to the conclusion that the definitions in the claims procedure were so far removed from the general disclosure in the specification that it was no longer plausible that the alleged effect existed over the entire breadth of the claim on the basis of the application submitted. The submission of experimental data subsequently collected to verify the alleged effect was rejected by reference to [T 1329/04](#).

Recently, Boards of Appeal have distanced themselves further from this originally generous stance of the European Patent Office by reference to [T 1329/04](#), as indicated by the recent decision [T 488/16](#).

In the case in question, the patent applicant claimed that a multiplicity of different substances (over 500) were suitable for use as kinase inhibitors, without, however, specifying experimental data in the application.

### Ferrari loses the “Testarossa” trade mark at first instance

In trade mark law, the risk of losing one’s own mark in proceedings against third parties has become apparent again in a recent first instance decision of the Düsseldorf Regional Court (File no.: 2a O 166/16)

In this decision, the well-known sports car manufacturer, Ferrari had opposed against registration of a “Testarossa” trade mark by a Nuremberg entrepreneur whose portfolio includes a toy company.

The entrepreneur defended himself against the appeal at the Düsseldorf Regional Court with a cancellation action on the grounds of expiry.

In fact, the Ferrari Testarossa has not been manufactured since 1996, although there is no doubt that the name Testarossa, derived from the red valve flap on the cylinder heads, is still familiar to many people.

In the cancellation action, Ferrari referred to the fact that although the Testarossa has not been manufactured for twenty years, there was a still a trade in spare parts and thus, the Testarossa trade mark was still being used.

However, this did not convince the Regional Court. Ferrari was found guilty at first instance of consenting to cancel the trade mark. It remains to be seen how the Higher Regional Court will deal with the matter.

In every case, this action makes it very clear that there is an obligation of use for trade marks, and that even significant brand familiarity, which no doubt exists in the case of Testarossa, is no protection from loss of a trade mark.

The trade mark system in Europe is often criticised by the USA on the grounds that the obli-

### And in our own affairs...

Michalski Hüttermann & Partners has once again been recommended in the [MIP Handbook 2017](#) in the patents field. The MHP partners Dr. Dirk Schulz, Guido Quiram, Dr. Stefan Michalski und Dr. Cersten Bethke received a special mention. Dr. Ulrich Storz and Dr. Aloys Hüttermann were listed under “IP Stars 2017”.

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Dr. Aloys Hüttermann will be giving a lecture on the subject of “Practical Aspects of the European Unitary Patent and Unified Patent Court” on 18 September 2017 at the [IPO Annual Meeting 2017](#) in San Francisco.

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Dr. Aloys Hüttermann will also be contributing to the [Mannheimer Patenttage](#) on 12 October 2017 on the subject of “Preparations necessary for the Unitary Patent”.

In the appeals procedure, the applicant then limited himself to a single substance and for this referred to data submitted in the audit procedure, which verified the inhibitory effect.

However, this was not accepted by the Board of Appeals by reference to [T 1329/04](#), as it was established case law to apply the inventive step to the date of application / the priority date. No “inventive” data existed at this time and the activity described was not demonstrated “plausibly”. Consequently, an inventive step was thus rejected and the patent revoked.

This decision follows a very similar decision from last year, i.e. [T 1791/11](#). In this case, the Board of Appeals did not consider as plausible the general statement in the specification “All these varieties showed ...activity”. Data collected subsequently was not taken into account by reference to [T 1329/04](#).

It remains to be seen whether this will be the general stance of the Office or whether these more recent decisions will merely be the exception to the general rule which, on the whole, permits the submission of comparative tests and experimental data in the audit process.<sup>1</sup>

It will also remain to be seen to what extent these kinds of generic applications are state of the art for subsequent, special applications. If there are references to a kind of quasi “ownership of invention” or “plausibility”, this would mean that older applications could only be invoked to a very limited extent for subsequent applications.

Applicants should be aware of the risk that the previous generous stance of the EPO is now potentially subject to a gradual revision, and take account of this in their patent strategy, e.g. in the event of the existence of hard data, by incorporating it into their initial application or by submitting more subsequent applications than previously.

<sup>1</sup> A more detailed article on this issue is being drafted.

gation of use does not have to be actively demonstrated, but only on application, and that there is thus a risk of cancellation with regard to the majority of all registered trade marks.

Nevertheless, the obligation of use should also not be underestimated in Europe, and it can be seen that even well-known manufacturers are not exempt from it.

Thus, when there is an intention to launch proceedings against third parties, either by lodging an opposition or by an infringement claim, there should first be thorough scrutiny of the extent to which the trade mark is used.

## Proposals and Questions

If you have any proposals or questions, please don't hesitate to contact us [here](#).

[Impressum](#): Michalski · Hüttermann & Partner Patentanwälte mbB

Speditionstrasse 21 - D-40221 Düsseldorf, Germany - Tel +49 211 159 249 0 - Fax +49 211 159 249 20  
Perchtinger Strasse 6 - D-81379 Munich, Germany - Tel +49 89 7007 4234 - Fax +49 89 7007 4262

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