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Federal Court of Justice vs. Federal Patent Court I –
the “Druckstück” judgment

Federal Court of Justice vs. Federal Patent Court II –
the “Schokoladenstäbchen” ruling

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M I C H A L S K I



H Ü T T E R M A N N

P A T E N T A N W Ä L T E

Federal Court of Justice vs. Federal Patent Court I – the “Druckstück” judgment

In two recently issued judgments, the Federal Court of Justice had the task of examining the (alleged) infringement of constitutional rights, where the German Federal Patent Court was the lower court in each case.

The first of these judgments, “[Druckstück](#)” (pressure piece)¹, concerns the (since amended) provision in Art. 14 of the Patent Ordinance (PatV), which required translations of application documents to be certified by an attorney-at-law or patent attorney. Alternatively, an officially certified translator could prepare the translation, although their signature also had to be certified by a notary.

In the underlying case, an applicant had initially filed an application in English and later filed an uncertified German translation. The application was rejected after the German Patent and Trade Mark Office requested a certification, but the applicant did not respond.

The applicant then appealed, and the President of the German Patent and Trade Mark Office joined the action. In a startling decision², the Federal Patent Court categorized Art. 14 of the Patent Ordinance as outdated – the headnote even includes the notorious quotation “*fiat justitia et pereat mundus*”³ – and characterized it as “*disproportionate, contrary to the rule of law, and therefore invalid, not least on account of a manifest lack of necessity*”. Apart from that, the application was referred back to the German Patent and Trade Mark Office.

Nonetheless, the court granted the appeal that was filed by the President as well.

In its judgment, the Federal Court of Justice has now made it clear that it does not remotely consider the original version of Art. 14 of the Patent Ordinance to be invalid.

According to the judgment, it may be the case that the applicant incurred costs for a certification of this nature, but this is not disproportionate, and moreover is covered by the guarantee of ownership pursuant to Art. 14 of the Basic Law. This guarantee

*“does not [...] require granting the entitled party the rights deriving from a patent application without it being possible to establish certain minimum prerequisites, the fulfillment of which may mean that the applicant incurs costs under certain circumstances.”*⁴

Simply applying for a patent confers certain rights on the applicant, for example the right of priority and a claim to a grant.

*“This justifies demanding that certain quality standards be maintained for the documents that must be submitted to achieve this legal status and requiring the applicant to discharge the duty of making the necessary expenditures for this purpose.”*⁵

The provisions of Art. 14 of the Patent Ordinance, original version, were held here to be a practicable and appropriate way to establish these quality standards, and consequently Art. 14 of the Patent Ordinance, original version, was held to be consistent with Art. 14 (1) and Art. 20 (3) of



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Dr. Aloys Hüttermann will speak at a session of the (virtual) [IPO Annual Meetings 2020](#) on the topic “Understanding the German Inventor Law”.

¹ Federal Court of Justice, judgment of 14 July 2020 - X ZB 4/19 – Druckstück

² See discussion of the decision by Köllner, Mitt. 2019, 278

³ See headnote of Federal Patent Court decision of 11 October 2018 – 10 W (pat) 23/17 Mitt. 2019, 278, translates as: “Let justice be done, though the world perish,” the motto of Ferdinand I (1503-1564), Holy Roman Emperor

⁴ paragraph 39 of the judgment

⁵ paragraph 39 of the judgment

the Basic Law. The decision of the Federal Patent Court was thus reversed, and the remainder of the matter, in particular concerning the question of apportionment of costs, was remanded.

After the Federal Patent Court had rejected a section of the patent application ordinance with strong language, the Federal Court of Justice has set things straight again here from its point of view.

Naturally, it remains to be seen here whether the applicant will in the end appeal to the German Federal Constitutional Court. This cannot be ruled out; after all, both the Federal Patent Court and the Federal Court of Justice discussed questions of constitutional law at length. In view of the divergence of the decisions, the applicant might, if the matter is sufficiently important to it, ask for an evaluation from the court that actually has jurisdiction.

A constitutional complaint has already been filed recently by Haier⁶ against the *Sisvel vs. Haier* judgment of the Federal Court of Justice⁷.

If the Federal Constitutional Court were to accept both appeals, then it would decide four cases concerning patent law in a very brief period of time, when these are counted together with the judgment already issued on the Unified Patent Court⁸ and the still-pending appeal concerning the European Patent Office⁹. This is a large number, especially considering that the Federal Constitutional Court usually does not accept even one appeal in the patent field in a given decade.

Federal Court of Justice vs. Federal Patent Court II – the “Schokoladenstäbchen” ruling

While the Federal Patent Court may not have been affirmed in the matter of the previous “Druckstück” ruling, the Federal Court of Justice saw nothing wrong with the fundamental approach of the decision, including that the Basic Law was concerned here (or showed no sign of that in the ruling). In contrast, the tone in the „[Schokoladenstäbchen](#)” (chocolate twigs)¹⁰ ruling is considerably more stern. In this case, a headnote of unsurpassed brusqueness was even added after the fact.

This ruling concerns the extension of the protection of an IR trademark to Germany, wherein application was made for a three-dimensional trademark for a chocolate stick having a roughly serpentine appearance. After the German Patent and Trade Mark Office denied the extension of protection, there were multiple appeal proceedings in this matter.

An important factor in this judgment was that the Federal Court of Justice remanded the appellant’s subsequent appeal to the Federal Patent Court a second time after having already having remanded the proceedings to the Federal Patent Court once, but this time remanded to the 29th Board instead of to the 25th Board as in the first proceedings.

The decision of this 29th Board denying the applicant’s appeal was then appealed on a point



⁶ See: <https://www.juve-patent.com/news-and-stories/cases/haier-files-constitutional-complaint-over-frand-judgment/>

⁷ See our [Newsletter 6/2020](#)

⁸ See our [Newsletter 3/2020](#)

⁹ Constitutional complaints 2 BvR 2480/10, 2 BvR 421/13, 2 BvR 786/15, 2 BvR 756/16, see also <https://www.juve-patent.com/news-and-stories/legal-commentary/germanys-top-court-holds-the-future-of-the-european-patent-system-in-its-hands/>

¹⁰ Federal Court of Justice, ruling dated 19 December 2019 -I ZB 37/19 -Schokoladenstäbchen

of law, namely on grounds including the deficient staffing of the 29th Board as well as infringement of the guarantee of access to the courts under Art. 101 of the Basic Law.

This appeal was denied by the Federal Court of Justice.

The court held, firstly, that an objection relating to the guarantee of access to the courts was not possible in the first place with the appeal that was lodged, namely the appeal on a point of law not requiring approval pursuant to Art. 83 (2) of the Trade Mark Act, and referred to a ruling from 2014¹¹.

Secondly, the court also held the involvement of a different Board to be appropriate:

*"As a rule, it can indeed be presumed that the initial court will follow the principles of law laid down by the courts of appeal and will proceed in an impartial manner in the reopened proceedings."*¹²

But:

*"Remand to a different panel of judges comes equally into consideration in all of these proceedings, but especially when it appears advisable for a different panel of judges to deal with the renewed handling of the matter on account of an accumulation of factual errors or a lack of impartiality on the part of the initial court."*¹³

A court could hardly express its disapproval of another panel of judges more strongly than with these words. It remains to be seen whether and how the Federal Patent Court will respond to this.

It likewise remains to be seen whether this matter, too, will ultimately be decided by the Federal Constitutional Court; after all, this case touches on the Basic Law, as well. In view of the rigor with which the applicant has thus far endeavored to register its trademark, an appeal to the Federal Constitutional Court in this matter would come as no surprise.

Federal Court of Justice on three-dimensional trademarks – the “Quadratische Tafelschokoladenverpackung II” ruling (Ritter Sport)

In the [„Quadratische Tafelschokoladenverpackung II“](#) (square chocolate bar packaging II)¹⁴ ruling, the Federal Court of Justice likewise had the task of ruling on a three-dimensional trademark, but this time on the merits.

Three-dimensional trademarks are fundamentally recognized as trademark forms, but – since the product as such is then involved – more stringent requirements apply, and such marks can almost never be brought to registration without evidence of distinctive character. However, distinctive character was not the subject of the present matter, but rather the other prerequisites for rejection or cancellation, in particular whether the trademark

a) consisted exclusively of a form that was necessary to obtain a technical result

¹¹ Federal Court of Justice GRUR 2014, 1132 paragraph 17 Schwarzwälder Schinken

¹² Paragraph 20 of the judgment

¹³ Paragraph 20 of the judgment and second headnote

¹⁴ Federal Court of Justice, ruling dated 23 July 2020 - I ZB 42/19 –
Quadratische Tafelschokoladenverpackung II



- (which would result in exclusion pursuant to Art. 3 (2), No. 2 of the Trademark Act, which cannot be overcome by any amount of distinctiveness, no matter how great);
- b) consisted exclusively of a form that resulted from the nature of the good itself (exclusion pursuant to Art. 3 (2), No. 1 of the Trademark Act);
- c) consisted exclusively of a form that lent substantial value to the good (exclusion pursuant to Art. 3 (2), No. 3 of the Trademark Act).

Specifically, the case involved a trademark that protected the packaging of “Ritter Sport” chocolate (without contour) as a three-dimensional trademark. A tubular plastic bag package was shown from the front and back. This trademark was registered in 1996 based on sufficient distinctive character.

In fact, a request for cancellation of this trademark was filed with the German Patent and Trade Mark Office as early as 2010, initially with the reasoning that the opposed trademark fell under the cancellation prerequisite a) listed above, which is to say that it consisted exclusively of a form that was necessary to obtain a technical result, and in addition that the illustrations were of such a nature that the protected subject matter was not unambiguously identifiable.

However, this cancellation prerequisite was abandoned in the appeal proceedings; instead, the cancellation prerequisites b) and c) listed above were adduced, which is to say it was argued that the trademark consisted exclusively of a form that resulted from the nature of the good itself and that gave substantial value to the good.

Initially, the request for cancellation was granted based on cancellation prerequisite 2), but in the approved appeal on a point of law, the Federal Court of Justice determined that cancellation prerequisite b) (= a form that results from the nature of the good itself) did not apply, and remanded the matter again.

In the second proceedings before the Federal Patent Court, now only concerning the remaining cancellation prerequisite c), the trademark holder now prevailed, whereupon the plaintiff in the cancellation proceedings once again appealed on a point of law – and this proceeding is the subject of the present judgment.

However, before turning to the question of which grounds for exclusion would apply, the Federal Court of Justice first examined whether the fact that initially only cancellation prerequisite a) was used as a basis, and cancellation prerequisites b) and c) only came into the matter later, could itself be grounds for remand.

This was decided in the negative, however. Even though in principle the individual cancellation prerequisites were to be considered independently of one another, it was still held to be permissible – applying the relevant Section 263 of the German Code of Civil Procedure – to introduce new grounds into the proceedings if the opponent did not object or if the court viewed this as appropriate.¹⁵

Since cancellation prerequisite a) had already been abandoned, and cancellation prerequisite b) had already been denied in the previous proceedings, it was now only necessary to decide on cancellation prerequisite c), which is to say whether the trademark consisted exclusively of a form that gives substantial value to the good.

This was ultimately denied. Instead, it was first explained that cancellation prerequisite c) *“[relates] not only to the form of goods that have a purely artistic or decorative value, but also to forms of goods that also have essential functional characteristics in addition to a substantial aesthetic element.”*¹⁶

An especially sophisticated aesthetic design of the packaging, which indeed is only a simple

¹⁵ See paragraph 16 of the judgment

¹⁶ Second headnote of the judgment

tubular plastic bag, was denied.¹⁷ Thus, cancellation prerequisite c) would in principle come into question here.

However, it was also determined that cancellation prerequisite c) depends on objective and reliable perspectives, and not so much on the value (specifically from a marketing standpoint) that the trademark has to the trademark holder:

"The bar to protection under Art. 3 (2), No. 3 of the Trademark Act is present if objective and reliable perspectives produce the result that the decision of the consumer to purchase the relevant product is determined to a high degree from the fact that the form lends substantial value to the good. It does not matter whether the form of the good has particular commercial value to the trademark holder because it has established distinctiveness as an indication of the origin of the good"¹⁸

Even the prevailing public understanding is of little importance:

"In deciding whether this bar to protection is present, the prevailing public understanding is not a deciding factor. Instead, the determining factors are criteria for judgment such as the nature of the category of goods in question, the artistic value of the form in question, its differentiation in comparison to other forms generally used in the relevant market, a substantial price difference relative to similar products, and the development of a marketing strategy that primarily emphasizes the aesthetic characteristics of the good in question."

Ultimately, it was thus determined that the trademark (which is to say the characteristic packaging of "Ritter Sport" chocolate) did not lend it any substantial value, and therefore cancellation prerequisite c) was denied.

As a result, this judgment puts an end to a dispute that has lasted for several years, and underscores the difficulties – and, of course, the possibilities as well – of three-dimensional trademarks. Not only is it necessary here to overcome the hurdle of public recognition, itself no small matter, so that the trademark can be registered and remain legally valid in the long term, but the other prerequisites for exclusion also cannot be overlooked. In concrete terms, this judgment is especially significant on account of the clear and detailed reasoning of cancellation prerequisite c) (which is to say trademarks that consist exclusively of a form that lends substantial value).

¹⁷ Paragraph 42 of the judgment

¹⁸ Third headnote of the judgment

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We wish all the best to your family, staff members, colleagues, and of course to you yourself, in these difficult times.

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