



Client Information | January 2018

## **“PATENT PENDING” – STILL MISLEADING**

**CJEU CONFIRMS REQUIREMENT FOR CROSS INDUSTRY  
INNOVATION IN DESIGN LAW**

**JOHANNES TRAPP JOINED THE PARTNERSHIP**

**KRISTINA BREUNIG STRENGTHENS TRADEMARK  
DEPARTMENT**

Tim Hülshager and Dr. Adrian Kleinheyer

### **“Patent pending” – Still Misleading**

In its judgment of 1 June 2017 (6 U 3973/16), the Higher Regional Court of Munich ruled that the term “patent pending” could be understood as an indication of a granted patent and is therefore unlawful under competition law if no granted patent is involved.

Specifically, the Higher Regional Court of Munich had to decide whether the indication “patent pending” on the packaging of oral and dental care products constitutes a misleading advertisement if a patent application is pending.

The Higher Regional Court of Munich came to the conclusion that the indication “patent pending” could be erroneously understood by a majority of the addressed average consumers in Germany as a reference to a granted patent and is thus misleading, even if “patent pending” correctly refers to a pending patent application in English-speaking countries.

The Higher Regional Court of Düsseldorf had already ruled in 1996 that the indication “Pat. Pend.” is misleading. The Higher Regional Court of Munich has taken up the earlier decision and explicitly pointed out that even today the indication “patent pending” could still be misunderstood by the average consumer, since the term “pending” is not part of the basic vocabulary. In the view of the Higher Regional Court of Munich,

the English language skills of average German consumers have apparently not improved in recent years.

With regard to a secondary aspect, the Higher Regional Court of Munich pointed out that the indication “patent pending” could even be contrary to competition law if it is visible only after the purchase (for example, if it is applied within an outer packaging) as it would have an influence on future purchasing behavior.

### Practical Tip

In Germany, reference to a pending patent application should be made in German, either in the form of “Patent angemeldet” (“Patent applied for”) or in the form of “Deutsche Patentanmeldung 1234567890” (“German patent application ...”). If the patent application has not yet been published, it must not be used for advertising purposes at all, since no rights can be derived from a patent application that has not yet been disclosed.

A reference to a granted patent may continue to be made in English. A respective notice is advisable particularly for products distributed worldwide, since in case of patent infringement proceedings in the USA, damages may otherwise be claimed from an infringer only as of a warning letter or a reference to the existing patent protection.



### QUESTIONS?

If you have any questions regarding this topic, please feel free to get in touch with your personal contact or Tim Hülshager at (t.huelsheger@prinz.eu).

## CJEU confirms requirement for cross-industry innovation in design law

*CJEU, Judgment of 21 September 2017, C-361/15 P and C-405/15 P – Shower drainage channel*

The examination of the novelty of a design shall be carried out irrespective of the type of product the design is applied to, found the Court of Justice of the European Union (CJEU) recently and confirmed the EUIPO's established practice.

The Community Designs Regulation stipulates that each design application shall contain an indication of the products in which the design is intended to be incorporated or to which it is intended to be applied. The use of the plural “products” takes account of the fact that a design can be applied to several different kinds of products. Illustrative examples hereof include chewing gums looking like tennis balls or lighters in the shape of a pistol.

However, the Regulation states explicitly that the indication of the products shall not affect the scope of protection of the design as such.

Despite this provision, which appears to be clear at first sight, it was debated for a long time whether earlier designs of other product types (e.g. pistols) – i.e. designs from other industries – should also be taken into account when examining the novelty of a design with a particular product specification (e.g. lighters). One of the arguments raised against the consideration of prior art from other industries was that, according to the Regulation, the circles specialized in the sector concerned operating within the Community would have had to reasonably become aware of the design.

The CJEU, however, has now ruled that “the sector concerned” is not to be interpreted narrowly and is therefore not limited to the specific industry to which the product in which the design is incorporated belongs. The validity of a design should rather be verified on the basis of the entire prior art and, thus, cross-industry. This is all the more true as the protection of a design extends to every other design which does not create a different overall impression for the informed user.

From the applicant's point of view, this means that the mere transfer of an existing design (e.g. a pistol) to a new product class (e.g. a lighter) is not eligible for protection.

Design owners should know that the protection of a design goes beyond the indication of products entered in the register. Thus, the owner of a design (e.g. for tennis balls) does not have to tolerate if a third party uses the design for another type of product (e.g. chewing gum).

The provisions of the Community Design Regulation on which the Court's decision is based are almost identical with the corresponding provisions of the German Designs Act. Consequently, the Court's findings on EU designs shall apply to national designs accordingly.



### QUESTIONS?

If you have any questions regarding this topic, please feel free to get in touch with your personal contact or Dr. Adrian Kleinheyer at ([a.kleinheyer@prinz.eu](mailto:a.kleinheyer@prinz.eu)).

### Johannes Trapp joined the partnership

Effective January 1, 2018, Prinz & Partner admitted Johannes Trapp as another partner from its own ranks. He is a patent attorney and European Patent and Trademark Attorney. Johannes studied physics at the Technical University of Munich and joined Prinz & Partner in 2012.

His professional activities include patent examination, opposition and appeal proceedings. Johannes Trapp's specialties are freedom to operate searches and in-depth analysis of patent portfolios. He also supports many successful start-ups in patent matters.



## CONTACT DETAILS

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## Kristina Breunig strengthens trademark department

On December 1, 2017, Kristina Breunig, LL.M. joined Prinz & Partner as an attorney.

Ms. Breunig studied law at the University of Mannheim and Ludwig-Maximilian-University Munich. After her legal clerkship with stages in Munich and Los Angeles, she obtained her "Master of Laws" in San Diego (California, USA). Returning to Munich, Ms. Breunig worked as an attorney in a law firm specialized in copyright law. Afterwards she worked for an international IP-law firm specialized in trademark law.

Ms. Breunig advises in all aspects of trademark, design, copyright and competition law.



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