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ARTIFICIAL INTELLIGENCE IN THE PATENT SYSTEM

STUDY CONFIRMS PRINZ & PARTNER'S GREAT
EXPERTISE IN SECRET PATENTS

ECG CONFIRMS THE REQUIREMENTS FOR PROOF OF
USE OF A TRADEMARK

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Artificial intelligence in the patent system

The buzzword "artificial intelligence (AI)" is on everyone's lips, as "artificial intelligence" is already used across all industries. Even politicians have recognized the importance of this topic. For example, both the German government and the European Union have been promoting the development of "artificial intelligence" for various areas of application for years.

There is often the view that "artificial intelligence" is generally not patentable because it is essentially software that cannot be protected by patents. However, this assessment is wrong.

The exponentially increasing number of patents granted for "AI" proves that methods and systems in which "artificial intelligence" plays a central role are patentable in many cases. For example, the German and European Patent Offices alone have meanwhile granted more than 800 patents on applications filed since 2016 that not

only have an abstract reference to "artificial intelligence", but name "artificial intelligence" prominently or at best superficially concealed in claim 1. Thus, "artificial intelligence" is a central part of the inventions protected by these patents.

From our experience we can confirm that the practice of the patent offices and also the case law in this respect have changed in the recent years.

In theory, the "artificial intelligence" would have to make a technical contribution to the claimed invention if "AI" shall lead to the inventiveness with respect to the prior art. Therefore, it should not be sufficient for a patentable invention to claim an "artificial intelligence" formed as a so-called black box instead of a classical sensor or a classical data processing. Nevertheless, our experience shows that several of such patents already exist which have been filed by applicants eager to experiment and have been granted by the patent offices with a broad scope of protection. It seems that some applicants are systematically trying to occupy technical fields with their own "AI" patents.

In an interdisciplinary seminar, we have developed strategies with which our clients can strengthen their own patent portfolio with "AI" patents. If you need advice on this, please feel free to contact us at any time. In our view, "AI" patents are more than just a short-lived trend that you could sit out. Your competitors may have already left the starting block behind them.



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 or +49 (0) 89 / 59 98 87-142.

Study confirms Prinz & Partner's great expertise in secret patents

In the January 2022 issue of the "Bulletin of the German Patent Attorneys", published monthly by the Board of the Chamber of Patent Attorneys, patent attorneys Thomas Kimpfbeck and Stephan Roider have published an essay providing new and interesting insights into the topic of secret patents.

If an invention for which a patent application is filed relates to a state secret, the Patent Office (in consultation with the German Ministry of Defence and the German Ministry of Economics) orders that the application and any patent subsequently granted on the basis of the application shall not be published. Such secret patents

may relate to various technical fields, such as radar systems, direction finding devices, radio technology, or coding and/or decoding systems.

An order of secrecy is issued for only a very small proportion of patent applications in Germany. The effort that is expended both on the part of the applicant/representative and on the part of the Patent Office with regard to applications to be kept secret and secret patents is, however, considerable. For all persons (including patent attorneys) who have access to the documents of patent applications and patents requiring secrecy, the Federal Office for the Protection of the Constitution carries out an extended security check in advance. In addition, very high requirements apply to the storage of the files and the IT infrastructure.

One result of the analysis by Kimpfbeck and Roider was that Prinz & Partner leads by a wide margin in Germany among the law firms that serve clients holding secret patents. In one of the samples considered in the study, Prinz & Partner is responsible for about 45% of the German secret patents represented by patent law firms.

These figures confirm our commitment to work at the highest level in every respect. All areas of our firm, and therefore every client, benefit from the standards that have to be maintained and regularly documented for secret patents with regard to process flows, security and the qualifications of our staff.

We treat every invention as your personal state secret.



QUESTIONS?

If you have any questions regarding this topic, please feel free to get in touch with your personal contact or Jochen Sties at j.sties@prinz.eu or +49 (0) 89 / 59 98 87-103.

EuG confirms the requirements for proof of use of a trademark

The General Court (ECG) recently provided trademark owners with further guidelines for the proof of genuine use (judgment of September 8, 2021, T-493/20):

In response to the plea of non-use raised in the opposition proceedings, the owner of the opposition mark submitted screenshots of photos of the goods, a screenshot of its own website, as well as an overview of the turnover of the corporate group.

In its ruling, which confirmed the decision of the European Union Intellectual Property Office (EUIPO), the ECG found that these documents were not sufficient to

prove genuine use of the mark. In particular, the Court criticized that the screenshots did not contain any further information about the distribution of the goods (such as prices) and the exposure of the website to the public. The Court also did not accept the turnover overview as proof of use, since it lacked an allocation to the products marked with the trademark.

This ruling illustrates once again the importance of establishing a connection between turnover figures and products. Besides providing an affidavit, the Court emphasized that this connection can be established inter alia by delivery notes, order confirmations and invoices. The submission of catalogs is also sufficient as proof of use, if they show that the trademark was used for a sufficient number of products and that these products were actually available on the market of the European Union. If screenshots meet these requirements, they can also serve as proof of use.

In another judgment, the ECJ specified the requirements for use of a three-dimensional mark (T-796/16):

The opposition mark was registered as follows:



The proprietor of the opposition mark submitted the following images as proof of use:



The ECG did not allow this evidence because it considered the registered mark to be a bottle with a diagonal line on the glass. The use of a bottle with a blade of grass inside of it cannot be considered genuine.

This decision illustrates that the scope of protection, particularly in the case of figurative and three-dimensional marks, is determined solely by the graphical representation of the trademark in the register. Use of a deviating design may only be genuine if the distinctive character of the trademark is not altered.



QUESTIONS?

If you have any questions regarding this topic, please feel free to get in touch with your personal contact or Sebastian Kroher at s.kroher@prinz.eu or +49 (0) 89 / 59 98 87-129.

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