WITTEWELLER News II/2019

Client Information and News

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PATENTANWÄLTE

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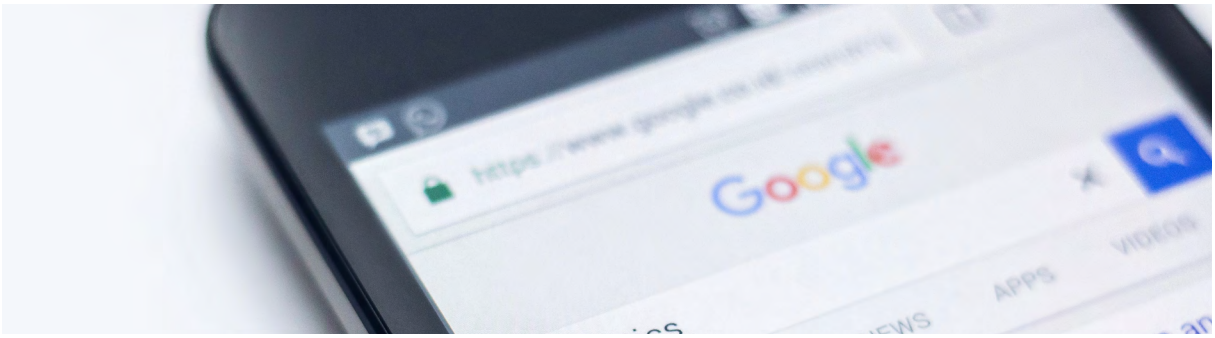
1. Trademark infringement also applies in relation to links to goods and services offered by third-party providers



In a recent decision, the German Federal Court of Justice (BGH) ruled on the question of how the use of a trademark should be assessed in the case the name of **a trademark is entered into an internet search engine** and the results displayed relate not only to the trademark proprietor's products but also to products of third parties who are competitors of the trademark proprietor (BGH decision of 25 July 2019 I ZR 29/18 – ORTLIEB II). The background was that the licensee of the trademark "ORTLIEB" had brought proceedings against two companies of the Amazon Group who had purchased from Google **AdWords** advertisements whose subject was the trademark "ORTLIEB". If the term "ORTLIEB" was entered into Google, the appearing results were (inter alia) advertisements which directed users to Amazon websites. These pages then featured equally alongside each other not only products offered by Amazon retailers which were original "ORTLIEB" products, but also products of third-party manufacturers who were competitors of ORTLIEB. ORTLIEB considered this to be a trademark infringement and brought an action for prohibitory injunction against Amazon.

In this context, the BGH focussed in particular on the question of what impression an average internet user gains when presented with the list of hits comprising advertisements relating to a search for a particular trademark. The BGH held that the average internet user does not assume that the appearing advertisements while searching for a particular trademark also include products from other providers if no particular indications are provided that this is the case. Since, in the present case, the products offered by ORTLIEB's competitors were not different from the original products and were placed alongside one another as equivalents,

the BGH assumed that consumers would be misled by this and that it is justified to grant a prohibitory injunction as issued against the Amazon companies. The BGH rejected Amazon's arguments that resellers also sold products of competitors alongside products of an original manufacturer and may also use the original manufacturer's trademarks in this context. In the court's view, the original manufacturer has justifiable reasons for bringing a claim if its trademark is used in a misleading way and customers are misdirected to third-party products.

It should be welcomed that the BGH has again strengthened the rights of trademark proprietors. It does not comply with the intention of trademark protection that customers searching for specific trademarked goods of one particular manufacturer are led to the offerings of other manufacturers without any further notification. Nor is this in the interests of the internet user who, by entering the search term, has in fact made a decision in favour of a particular trademark. However, it appears to be somewhat questionable whether the conclusion that average internet users really do not expect to find only advertisements of the original manufacturer, and no others, among the results of their internet searches is in fact in line with the actual habits and experience of internet users. It may possibly have become established that, when an internet search for a specific trademark is carried out, a certain proportion of "incidental hits" catching other suppliers will also always appear. For that reason, the decision appears to be somewhat ambiguous. Nonetheless, this is the judgment issued and it has to be respected by all providers.

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2. USA – Changes in relation to trademark applications

The US Patent and Trademark Office (USPTO) has announced significant changes in relation to trademark applications, which entered into force on 5 October 2019.

Of particular relevance are changes to the guidelines for the submission and examination of **proofs of use in the USA**. The changes strengthen the requirements for proof of use and constitute a response to the growing problem of fraudulent proofs of use.

In future, the depiction of the proof of use has to demonstrate specifically a **clear connection between the goods or services and the trademark**. In addition, the depiction must not raise any suspicion of falsification. A clarificatory description of the use specimen should be submitted as well.

In detail this means that, for example, **the submission of mere labels, tags, or photographs of product packaging will no longer be sufficient**. Labels and tags must be associated with the product and this must be clearly identifiable on submitted photographs. Product packaging has to be translucent to show the goods inside or, alternatively, the goods must be visible in unpackaged form on the photograph. Thus, when the packaging is photographed, the goods should therefore be removed from the packaging and placed next to it in order to be visible. A screenshot of a website which shows the trademark, for example in connection with services that are claimed, must contain information such as the internet address (URL) and the date of the screenshot.

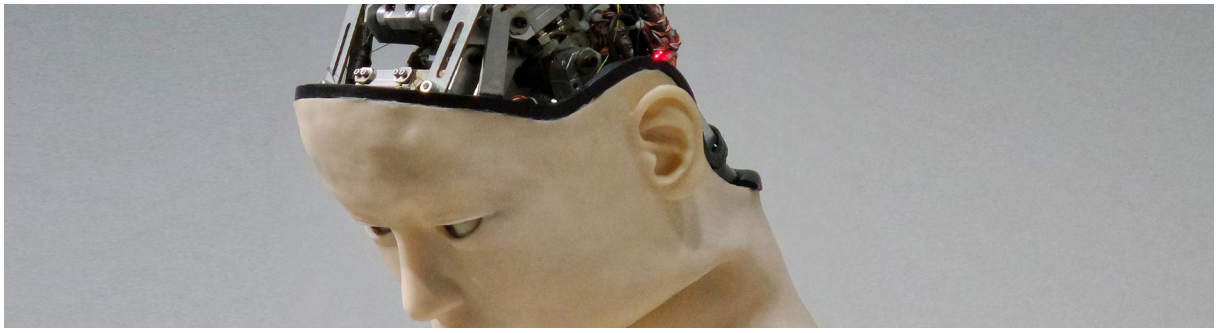
In addition, applicants should expect that digital proofs of use submitted will be examined more strictly in order to identify potential falsifications. This applies in particular if the

proofs are based on items that have been altered, for example where photographs have been digitally retouched. The examiner can reject such a proof of use as being invalid.

We therefore recommend that no digitally altered photographs or other professionally produced photographs should be filed as proofs of use. Instead, it is better to submit amateur photographs which were taken on a mobile phone camera, for example, and which display the trademark on the product or in connection with the service.

For more detail, please see the „Examination Guide 3-19“:
WWW.USPTO.GOV/TRADEMARK/GUIDES-AND-MANUALS/TRADEMARK-EXAMINATION-GUIDES

3. In Brief:



a) EPO study on inventorship and artificial intelligence (AI)

The EPO has published a “Study on inventorship in inventions involving AI activity”. The study was carried out on the occasion of a conference at the EPO and focuses on questions such as: **Can AI be an inventor**? How can the requirements for patentability be applied to inventions in the field of AI? Will the concept of the person skilled in the art change with the emergence of AI technologies?

The aim of the study is to familiarize with the subject and the resulting problems, to provide better understanding and to increase legal certainty in the field of AI patenting.

A STUDY ON INVENTORSHIP IN INVENTIONS INVOLVING AI ACTIVITY (PDF)
WWW.EPO.ORG/NEWS-ISSUES

b) 2018 Annual Report of the GPTO

The German Patent and Trademark Office (GPTO) has published its 2018 Annual Report which features up-to-date statistics and also reports on technical trends and property rights.

It is clear from the Annual Report that applications relating to the Internet of Things (IoT), in which machines and devices communicate with each other in houses and apartments („Smart Home“) or in industry („Smart Factory“), are becoming more and more important.

The highest increase recorded by the Office related to applications in the field of computer technology, the technological field which also includes a large proportion of developments relating to Artificial Intelligence. Almost one quarter more applications were received than in the previous year.

WWW.DPMA.DE

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c) Chinese court prohibits the sale of a Range Rover copy

A Chinese court has recently passed a remarkable judgment, being the first judgment by a Chinese court to find in favour of a global car manufacturer in unfair-competition proceedings. Jiangling Motor has to cease construction and sale of the Landwind X7 as it is too similar to the Range Rover Evoque and, in addition, has to pay compensation to the manufacturer of the Range Rover Evoque (Jaguar Land Rover).

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