

A chronological circle for interpreting G2/98

Years ago, T665/00 took a brave interpretation of G2/98 and set the stage for the discussion on this issue. The situation: the priority document discloses an example in which microspheres are used with a specific mass of 0.04 g/cm³; the subsequent application claims microspheres with a specific mass of < 0.1 g/cm³. Thus, a single point value (0.04 g/cm³) is used to claim priority for a whole range which contains an infinite amount of possible values (< 0.1 g/cm³): how limited and clearly defined is that?

Strictly speaking and according to the G2/98 test, such priority claim is invalid. Consequently, the subsequent application would get the filing date, rendering the priority document toxic as Article 54(3) EPC prior art. Despite the priority claim being invalid in T665/00, the Board decided that the example in the priority document could not be used as an anticipation against the claim in the subsequent application. The Board has fit the issue into the EPC's legislative framework by saying that there would have been a valid priority claim only for this exact example. In the context of G2/98, the Board reasoned that the ensemble of microspheres with a specific mass of < 0.1 g/cm³ is to be seen as a claimed genus, a pool of embodiments out of which only the single point value of the 0.04 g/cm³ species would enjoy priority because it was disclosed in (the example of) the priority document. All other microspheres with a specific mass of < 0.1 g/cm³ (but ≠ 0.04 g/cm³) would thus be entitled to the filing date. It gave rise for some discussion at that time, but it seemed all was settled.

Time has shown that little was true. A whole line of case law has been created on this point, and Boards appeared divided on the issue. Some Board of Appeal decisions (such as T1127/00, T1443/05, T1877/08, T0476/09) rather followed a narrow interpretation of the G2/98 test, requiring an explicit disclosure of alternatives in order to successfully claim partial priority (e.g. disclosing 'A-B-C-D' is acceptable for claiming all these embodiments, while 'A to D' would only allow priority for explicit embodiments 'A' and 'D'. Or, if in the case of ranges, a range from the priority document (say 1 to 10) would overlap with the subsequently claimed range (say 5 to 15), it would not be possible to claim priority for the overlapping portion (of 5 to 10), because these ranges would be continuums of values and thus not correspond to distinctive alternative embodiments).

That is, until more recently in T1222/11 a Board of Appeal broke with this line of previous case law decisions. It has taken its own, broader, approach to assess partial priority, allowing for the subject-matter of a claim to be fragmented theoretically into the bits from the priority document and extensions upon filing, without even requiring for an explicit identification of every single embodiment in the priority document (e.g. 'A to D' would now also allow priority for all

embodiments 'A-B-C-D'). For establishing whether G2/98's 'limited number of clearly defined subject-matters' is disclosed in the priority document, the Board advocates using the well-known 'directly and unambiguously derivable' test from G3/89, resulting in a more context driven assessment rather than an assessment based on the literal text. Decision T571/10 has then adopted and endorsed this broader approach. So are we going back to taking the 'original' T665/00 perspective which is more in favor of the patentee? One thing is for sure: an inconsistency in the EPO jurisprudence was created.

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The safe road to China

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In our contact with clients, we find a great deal of scepticism where trademark protection in China is concerned.

Apparently, protection is not enforceable. But we see that a bit differently. It's not just about enforceability, but particularly about accessing the market in an uncomplicated way. Here are three key conditions:

- Without protection, production in China can be stopped and exports banned if a third party has laid claim to your trademark in China.
- Without protection, you may not sell your products on the Chinese market if a third party has laid claim to your trademark in China.
- Chinese webshops often demand trademark registration.

These key values are sufficient reasons to protect your trademark – even defensively. However, you have to do it properly.

In China, the "first-to-file rule" applies. First come, first served. An accurately conducted registration in the national register gives the best chance of the strongest possible registration. This is because the Chinese procedure differs considerably from that in Europe. If you already have registrations in China, you should investigate whether your trademarks are sufficiently protected.

What do you need to look out for?

Is the trademark also registered in the right Chinese translation? This prevents hijacking of the trademark in Chinese characters. Are the right products or services included in the application? Besides the familiar classification, China also has sub-classes of products and services. It is very important that these descriptions comply with national regulations: a faulty classification can lead to the entire application being rejected. The examination only has one modification round. If the classification is then judged not to be satisfactory, the whole application fails. It is therefore recommended that you apply for a separate registration per class instead of several classes in one application.

Use of the trademark

Three years after registration, the registration may expire if it is not used in China. So make sure you systematically record the use of the trademark as proof of use. How is the trademark used in business? If capital letters are used, the registration must also be in capitals, otherwise there is also a risk of expiry due to lack of use. You must therefore be extra alert with regard to both applying for registration and using your trademark in China and you must continue to monitor how the Chinese public pronounces your trademark. Does this correspond with your chosen Chinese translation?

In practice, we see that Western companies often become involved in legal proceedings aimed at cancelling the registration of their trademarks by Chinese companies. These western companies do so with varying success.

The famous basketball player Michael Jordan was unfortunately unsuccessful. Michael Jordan discovered that his surname, the name of his sons, his Jumpman logo and his back number 23 had been registered as a trademark by a Chinese company selling sports products. Beijing Higher People's Court rejected Jordan's claims, among others because the Chinese company had been using the trademarks for many years. Jordan had acted too late.

Fortunately, positive results are achieved in increasing numbers of cases. Heinz, known in China for baby food, opposed an application by the Chinese equivalent of its trademark for feeding bottles. Eventually Beijing Higher People's Court was convinced of the familiarity of the Chinese brand HEINZ based on the big market share, extensive sales area and the long-term promotion of HEINZ baby food.

Kate Moss was also able to terminate the trademark registration of her name by a third party. Although Kate Moss has not proved that her name was well known in China, Beijing Higher Court felt that her name had been used unfairly for commercial purposes.

In recent years, there have been many developments in trademark legislation in China. The Chinese authorities are doing a great deal to bring an end to the reputation that protection is not enforceable.

Taking into account the do's and don'ts, the road to China is becoming much safer. Registration of a trademark, its use, monitoring the market and taking swift and effective action in the case of violation are the key conditions.

