

Right up-to-date, right up to speed: all you will ever need to know about intellectual property

IP Focus 2/10

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Dear Readers,

The end of our anniversary year is approaching – gosh, how fast time flies! In our IP-Focus 1/10, you can read about the 50 years history of our law office once again (see also www.schneiderfeldmann.ch) and we, too, shall enjoy a few memories of our anniversary party and our works outing ... Well, soon this will be history, so let us deal again with your protection rights!

In this issue of IP-Focus, the main topic is the protection of products with expired protection by patent. We show you ways how to **extend the monopoly** for your product in excess of the 20 years' protection period by patent, be it by new patents for new development (whether genuine or not), or the attempt to protect it as a three-dimensional trademark.

Your IP Focus Team of
Schneider Feldmann AG

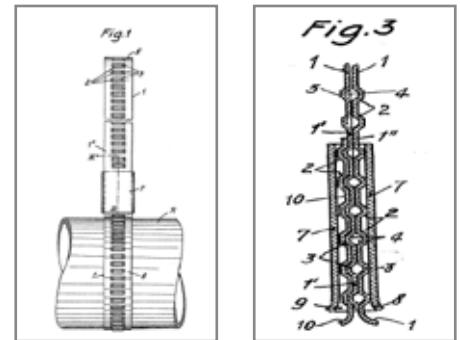
Patent protection for longer than 20 years? The Rebirth of an Invention

Recently, we received a call, «Hello Mr Feldmann, our patent for our paper cutting device is about to expire. This is a disaster, the product is so successful! – Can't we extend the patent in some way?» «Dear Sir,» I said, «the maximum term of a patent is 20 years; you must improve your product! Only a new, not obvious solution can be protected.»

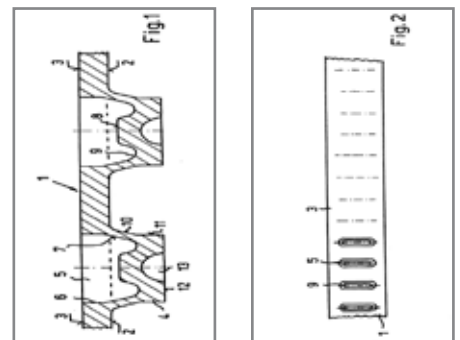
Such **calls for help** are not rare and, in most of the cases, the solution is not far to seek. Let me demonstrate this on the following **example** from the foundation time of our office:

In 1965, the company ASR acquired the Swiss Patent CH-435 881 from its inventor, which was for a **stamped suspension band for pipes** which is curved to a suspension loop at one end, and to a strap encircling the pipe to be suspended, at the other end, and has a high loading capacity. This is achieved, among other means, by having a plurality of interleaving impressions along the entire length of the band which are designed in such a way that the elevations on the front side of the band are capable of **fitting in a tightly locking manner** in the depressions on the rear side.

Patented old suspension band



Patented new suspension band



Short before the expiry of the patent, the company ASR contacted us, and we were contemplating what could be done. Indeed, the new development seemed to be nothing

new, as it still looked like the old patent. However, when we looked closer at the invention, with the help of a magnifying glass, we could recognise how the elevations (4) and impressions (5) were really designed. Contrary to the old patent, in which the gearing had sloped flanks, the flanks 6 and 11 in the new solution were designed in vertical direction. This significantly improved the outcome, because, under traction, the vertical flanks trigger a resulting force which pushes the overlapping ends of the band apart and so increases the loading capacity. The European Patent Office granted the patent EP 269 565 to this new development, to be used successfully on the market for many years to follow.

In this example, we were dealing with a **genuine new development**, which satisfied the requirements to the **inventive step**. Sometimes, however, if an improvement of the product is simply not possible, a novelty in terms of patent law can be derived from a **side issue** which, if presented in a smart way in the patent specification, may be considered sufficiently inventive by the patent examiner to grant a patent. Experience shows that a registered patent, and be it ever so weak, has a big impact on the market and is suitable to give the **aura of protection by patent** to successor products, too.

If you are facing a similar problem – we are here for you! Our patent lawyers are not just lawyers, but also **engineers with ideas!**

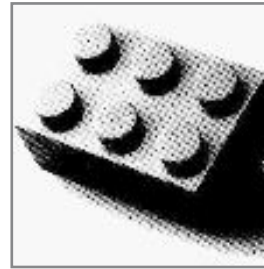
Protection of (previously) patented products by trademark law?

Jurisdiction: ECJ – No trademark protection for the Lego brick

As we all know, also shapes of goods and packagings can be protected under trademark law. This protection possibility was introduced to Swiss trademark law in 1992, and it is, if nothing else, very interesting for products which's protection by patent has expired, as a registered trademark can be extended over and over again, which means, it may so-to-say provide eternal protection.

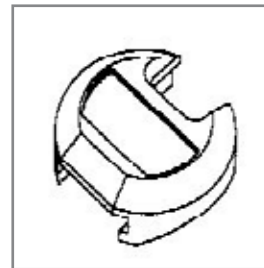
In the past, the registration practice of the Swiss Institute for Intellectual Property (IGE) was relatively liberal and so, many examples of successful **three-dimensional trademark** registrations can be found in the trademark register.

Trademark No. P-433'265 (20.12.1996)



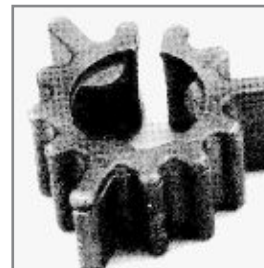
Cl. 28: Fun bricks (Lego)

Trademark No. P-410'298 (18.11.1993)



Cl. 6, 9, 20: (Kaba) Key

Trademark No. P-430'347 (29.2.1996)



Cl. 1, 5, 9: Catalyst for lens cleanser (Ciba-Vision)

Even if those trademarks were mostly registered as so-called enforced trademarks, the trademark owners did not really mind, quite the opposite: The trademark was even stronger due to its enforcement and with that, better enforceable.

A while ago, the Danish Lego Group had to suffer a tough setback. Their patents for the Lego fun blocks have expired already in the 70-ies, but by now Lego has been often successful in stepping up against imitators, on the basis of trademark and competition law. This has now probably come to an end: On 14 September 2010, the European Court of Justice has decided that the Lego **tri-dimensional trademark is not protectable**, as the presented shape is **technically necessary** for a fun brick in order to achieve the desired outcome. Despite this juridical rebuff, Lego will appreciate in the final account that the Lego tri-dimensional trademark has extended the monopoly that had once been secured by a patent, for many more years.