



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE
INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS
INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

FICPI 14th Open Forum
Sorrento
2-5 October 2013

WORKING PROGRAMME

Programme Chair: Coleen Morrison			
Programme Committee: David Bannerman, Jan Modin, R. Danny Huntington, Alain M. Leclerc, Luis-Alfonso Durán, Peter Huntsman and John Orange			
Stream Leaders:	Patents: Jürgen Schmidtchen	Trade Marks/Designs: Toni Ashton	General: Alain Leclerc

Thursday 3 October 2013				
Day 1				
Time	Session	Patents	Trade Marks/Domain Names/Designs	General
09:00-10:30	1	<p>Plenary Designing and Maintaining a Profitable Firm that will have a Future</p> <p>Today's IP practitioners must maintain the legal and technical expertise and skills forming the core of an IP practice while other revenue generating tasks such as renewal payments and translations have been commoditized and outsourced. Responsibility for "the file" remains with the practitioner. As a result, the profession is largely defined by small firms with more limited revenue generation capability. The viability of machine translations, the profitability of renewals, and need for staff to handle largely clerical tasks efficiently will be discussed, as well as the impact of reduced revenues on transition planning.</p> <p>Moderator: Francesco Paolo Vatti (IT) Speaker: David Bannerman (GB) Speaker: Patrick Erk (DE) Speaker: John Orange (CA)</p>		
10:30-11:00	Morning tea			
11:00-12:30	2	Unity and Restriction Requirements in Different Jurisdictions	Are Goods and Services Specifications Inflation Proof?	Communications Between Offices of Associate Firms
		It would be expected that all major patent offices would accept claims that satisfy	Speakers will consider some of the issues associated with descriptions of	Our speakers will explore the possibilities for efficient electronic



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		PCT Rule 13 criteria for assessing unity of invention. Many jurisdictions handle unity rather differently. In particular, the USPTO, the EPO and the JPO view unity from different perspectives, resulting in different legal situations in each region. These differences and their consequences will be discussed, and different approaches to achieve the desired result will be pointed out.	goods and services in the Americas, Europe and Asia. Current legislation and practice, and recent developments, will be explained. The question of whether rules are consistently applied will be answered as will the consistency of judicial and quasi-judicial determinations. Presenters will explain how well or poorly a particular register reflects the actual businesses of Registrants. The use of class headings and other issues arising out of the IP Translator case, as well as possible future developments, will be studied.	exchange of docket information between patent firms, and show how the risk of errors in the interchange of critical docket information, such as deadlines and application numbers, can be reduced. The possibility of exporting formatted data files from one firm's docketing system into another firm's docketing system will be discussed. Has the time come to establish a standard format that will enable safe and reliable export/ import untouched by human hands? Could FICPI take a lead role in this and establish and maintain a FICPI standard?
		Moderator: Jan Modin (SE) Speaker: Alexander Wyrwoll (DE) Speaker: Hiroaki Murase (JP) Speaker: Steve Beyer (US) Speaker: Robert Stoll (US)	Moderator: James Fish (GB) Speaker: Ho-Hyun Nahm (KR) Speaker: Susan Weller (US)	Moderator: Ivan Poli (AR) Speaker: Alan Kasper (US) Speaker: Arild Tofting (NO)
12:30-14.00	Lunch			



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Time	Session	Patents	Trade Marks/Domain Names/Designs	General
14:00-15:30	3	Patent Workshops	Trade Mark Workshops	What do large clients and in-house advisors expect from an IP attorney by way of strategic advice
		<ol style="list-style-type: none"> 1. The Effect of Priority under the Paris Convention 2. Update on Computer Related Patent Issues 3. Non-Pooled and Non-FRANDED Standard essential Patents 4. The UPC and its Rules of Procedure 	<ol style="list-style-type: none"> 1. What's New in the EU? 	<p>This session will explore current requirements of large clients and in-house advisors for strategic advice. In a fast-paced and competitive environment, optimal IP protection and defence strategies are key elements to an overall business strategy, and can impact on growth and bottomline success. Large clients and in-house advisors are increasingly seeking strategic advice from outside advisors. This session will focus on the kind of strategic advice that is helpful and timely. Data gathering, business intelligence, market watch, report preparation and strategic recommendations will be discussed.</p>
		Workshop Leaders Workshop Reporters	Workshop Leaders Workshop Reporters	<p>Moderator: Huw Hallybone (GB) Speaker: Bobby Mukherjee (GB) (IP Federation, BAE Systems) Speaker: Tony Tangena (NL) (epi)</p>
15:30-16:00	Afternoon Tea			



Thursday 3 October 2013

Day 1

Time	Session	Patents	Trade Marks/Domain Names/Designs	General
16:00-17:30	4	Protecting Inventions Quickly	International Developments in Designs Law	Internal Audit Committees – Quality Control in a Fast-Moving Environment
		During this session, speakers will explore some of the different options available throughout the world for protecting an invention as quickly as possible. Options ranging from accelerated examination and innovation patents to utility models will be contemplated.	Two design-related milestones have recently been achieved – the 10 year anniversary of the registered European Community Design Right and the implementation of the Hague Agreement for Industrial Designs by the United States. Some aspects of design law under both the EC Design Right and the Hague Agreement have been decided over the last decade; some remain uncertain. Procedural and strategic aspects of using the Hague agreement as a filing tool, and filing strategies to maximize protection and avoid pitfalls in the United States, will be discussed.	As the pace of work accelerates, how can quality control measures be put in place without creating impediments to operations? This session will explore various ways to introduce quality control measures within an IP firm environment. This session will particularly focus on Internal Audit Committees. Should firms have such committees? What are typical duties of such committees? Can these committees effectively manage risk and improve client-service?
		Moderator: Antonio Pizzoli (IT) Speakers: Markus Hössle (DE) Speaker: John Knox (CA) Speaker: David Cheng (CN)	Moderator: Jon Heggstad (NO) Speaker: Henning Hartwig (DE) Speaker: Gregoire Bisson (WIPO) Speaker: Robert Katz (US)	Moderator: Peter Huntsman (AU) Speaker: Ivan Ahlert (BR) Speaker: Alain Leclerc (CA)



Friday 4 October 2013

Day 2

Time	Session	Patents	Trade Marks/Domain Names/Designs
09:00-11:00	5	Enablement/Disclosure Across the Scope of the Claims - What Does it Mean?	Mock Trial – Necessary Geographic Extent of Use and Use of a Translation of a Mark
		The requirements for enablement/disclosure across the scope of the claim may be interpreted quite differently in the EPO and some of EPC member states like Germany, and the US differs again in respect of enablement and disclosure requirements across the scope of the claims. This session will look at the requirements in various jurisdictions using a single example with comments from three speakers and assessments by two judges.	Presenters will consider a fact situation involving a fictitious cancellation action brought by ABC Inc. against the trade mark TINY ELEPHANT owned by DEF Corporation, an Italian company able to show use only of the mark ELEFANTE PICCOLO in the country of Nervana, which has recently left the EU. Speakers posing as experts appearing before the International Court will consider the question of use limited to one country no longer part of the EU as well as the effect of use of a translated version of a mark.
		Moderator: Eric le Forestier (FR) Judge: Judge Rader (US) Judge: Judge Meier-Beck (DE) Speaker: Leo Jessen (NL) Speaker: Greg Chambers (AU) Speaker: Yoshikazu Tani (JP)	Moderator: Toni Ashton (CA) Judge: Daniel Alge (AT) Speaker: Susie Arnesen (DK) Speaker: Lena Shen (CN) Speaker: Naresh Kilaru (US)
11:00-11:30	Morning tea		



Friday 4 October 2013

Day 2

Time	Session	Patents	Trade Marks/Domain Names/Designs	General
11:30-12:30	6	<p>Cross-border patent infringement litigation in the EU - Revival via Interim Injunctions</p> <p>The ECJ decision in the Solvay v. Honeywell case has cleared the way for cross-border patent infringement litigation in the European Union using interim injunctions. In the same decision, the Court upheld the GAT v. LuK decision essentially preventing ordinary infringement suits. What has to be expected as a result? A run on interim crossborder litigation with forum shopping? Or nothing? Speakers will delve into these and related issues.</p> <p>Moderator: Jürgen Schmidtchen (DE) Speaker: Ian Kirby (GB) Speaker: Richard Ebbink (NL)</p>	<p>Social Media – When Legal Risks Go Viral</p> <p>Social media such as Google, Facebook, Twitter, You Tube, LinkedIn and Instagram have become important business tools. During this session, speakers will consider how social media is being used as a marketing tool, changing customer relations, and sometimes reinventing old business models. Best practices for monitoring and dealing with legal risks such as privacy, and managing user generated content that may adversely affect a trade mark will be debated. Speakers will give tips to avoid social media pitfalls that might affect a company's trade mark rights or reputation.</p> <p>Moderator: Elia Sugrañes (ES) Speaker: Gabriel Leonardos (BR) Speaker: Ana de Sampaio (PT) Speaker: Petter Rindforth (SE)</p>	<p>The Internet as a practice development tool</p> <p>This session will provide suggestions for using the internet to improve workplace efficiency, and firm marketing and outreach. The use of the internet by other professions for marketing and outreach towards profit generation will be reviewed. A recent survey on this topic shows that few IP firms have a defined marketing plan, and most spend only a very small percentage of their revenues on marketing. Reasons for the late adoption of the internet by IP firms, and suggestions for change will be discussed.</p> <p>Moderator: R. Danny Huntington (US) Speaker: Marc Chinoy (US) Speaker: Doug Deeth (CA)</p>
12:30-14:00	Lunch			



Friday 4 October 2013

Day 2

Time	Session	Patents	Trade Marks/Domain Names/Designs	General
14:00-15:30	7	Extending the Monopoly	Lost and Found – Reclaiming Trade Mark Rights	Multiple Locations: development opportunity or source of headache?
		Supplementary protection certificates and other extensions to terms of protection for pharmaceutical patents are available in different jurisdictions. During this session speakers will explore the rationale behind these extensions and discuss whether they are justifiable in today's world. Speakers will also consider how current laws may be amended to improve the situation.	Speakers will discuss the ramifications of trade mark owner's failure to use a mark for a lengthy period of time, perhaps resulting in a deemed abandonment, and the effect of renewed use shortly before or during a cancellation challenge. Recovery and damage mitigation strategies will be discussed. The situation when use by others has led to allegations of genericism, and methods to reclaim rights will also be studied, as will the effect of improper licensing. Finally, options for reassuming rights previously assigned will be looked at.	Traditionally, IP firms have opened branch offices to improve relations with and to provide better services to clients, to optimize revenues, and to increase in size. In an increasingly virtual world, with faster and more efficient communications, are these reasons still valid? Our speakers will explain how a multi-location strategy can cope with constraints of the IP profession, avoiding conflicts of interests and complying with potentially conflicting national regulations? How can practices be harmonized in a thought based profession? How can one build efficient business models?
		Moderator: Robert Watson (GB) Speaker: Roberto Pistolessi (IT) Speaker: Dr. Christopher Brückner (DE) Speaker: Michael Caine (AU) Speaker: Tom Irving (US)	Moderator: Coleen Morrison (CA) Speaker: Aurélie Marie (FR) Speaker: John Pickerill (US) Speaker: Hiroichi Aoki (JP)	Moderator: Didier Intès (FR) Speaker: Marie-Hélène Rochon (CA) Speaker: Keith Hodgkinson (GB) Speaker: Jan Nilsson (SE)
15:30-16:00	Afternoon Tea			