

THIRD OPEN FICPI FORUM
BARCELONA
17-19 OCTOBER 1996

THURSDAY, 17 October

9.00 - 9.25

OPENING ADDRESSES

- Mr Knud Raffnsøe, President of FICPI
- Mr J Alvarez, Director General of the Spanish Patent and Trade Mark Office
- Mr J-C Combaldieu, President of OHIM
- Mr L-A Duran, Vice President of the EPI and Vice President of AGESORPI

9.25 - 11.00

First Plenary Session - Enforcement by Injunction

Recent international developments have regionalised and harmonised the laws relating to obtaining of intellectual property rights. Regionalisation and harmonisation of the rules relating to enforcement of those rights is another matter. The TRIPS agreement refers to enforcement but only in broad terms. We will look at some of the issues of enforcement including cross-border injunctions and preliminary injunctions. How is a cross-border injunction enforced? Why is it that I can get an interlocutory injunction in one country but not another when the facts are the same?

Moderator: Mr Knud Raffnsøe (DK)

Presenters:

"The Dutch Approach": Professor Jan Brinkhof (NL)

"A Scandinavian View": Örjan Grundén (SE), a lawyer

"A British Perspective": Mr Justice Jacob (UK)

"The US Approach": Mr Tipton D Jennings (US)

11.00 - 11.30

COFFEE BREAK

11.30 - 13.00

1.1 Provisional Patent Applications

The U.S. has now been operating the provisional application system for some time and experience is growing. What will an adequate provisional specification contain? What should be put in and what should be left out? The specification will be used to claim priority in many countries in addition to the U.S. Will the current procedure satisfy the requirements of those countries?

Moderator: Mr Malcolm Royal (AU)

Presenters: Mr Jack Chrystal (US)

Mr Gert Schmitt-Nilson (DE)

Mr Fred Pearson (UK)

11.30 - 13.00

1.2 Licensing and Technology Transfer

The European Union block exemption rules for Intellectual Property Licensors have now been changed. What does this mean to the IP practitioner. The rules as they apply to IP licensing will be explained.

Moderator: Mr T Johnson (UK)

Presenters: Mr D O'Connor (IE)

Mr Guttuso (EU Commission)

Mr H Ibbotson, Motorola

11.30 - 13.00

1.3 Trade Mark Infringement on the Internet - Super-Highway Robbery

The Internet is now widely used as a promotional tool for business but what of counterfeit products and fakes offered by mail order houses. Can the Internet be used to thwart the IP rights of others? It is ubiquitous yet concealing: omnipresent yet anonymous. Does a businessman behaving correctly in the home country become an innocent net-pirate internationally? What happens when the surfer comes a midship a pirate? What do highwaymen and pirates have in common? Where does the infringement occur? Is it at the location of the terminal used to put the material onto the Net, at the location of the computer storing the material and/or at the location the material is read? Who is the infringer? What if he hides behind a multitude of hubs. These and other important topics will be dealt with by a panel of experts.

Moderator: Mr Helmut Sonn (AT)

Presenters: Mr Jobst von Kirchmann (EU Commission)

Mr D Griffith (AU)

Mr I Kaufman (US)

13.00 - 14.30

LUNCH

14.30 - 16.00

2.1 Permissible Post Grant Amendments

The Patent has been obtained but perhaps all of the relevant prior art was not then known. Perhaps we have now discovered that something we have said is not fully correct. Is amendment or re-issue available and a practical option? What if the infringement has already begun? What are the limitations?

Moderator: Mr A Sugden (UK Patent Office)

Presenters: Mr A Schweizer (ZA)

Mr K Takami (JP)

Mr J Sutton (US)

14.30 - 16.00

2.2 Use of the Internet

For the price of a few dollars, you can purchase equipment to access the most sophisticated communications systems in the world. You too can have a HomePage. Practitioners must become increasingly aware of the modern forms of communication, the advantages and pitfalls. What are the uses of E-mail, the Internet and HomePage, and how can a computer illiterate cope? What are the possibilities for on-line searching and what are the limitations? How do I get the information I want, quickly and cost effectively? Could the information be better organised? What could or should the profession do to improve access to patent information?

Moderator: Mr John Orange (CA)

Presenters: Mr Rodney Cruise (AU)

Mr Chris Scott (CA)

(Rodney Cruise will also be available to demonstrate the systems throughout the Forum. Practitioners will be able to obtain hands-on guidance and advice on how to use the available systems.)

14.30 - 16.00

2.3 The Community Trade Mark and Madrid

The Office for the Harmonisation in the Internal Market has now been open for a number of months. The Madrid Protocol is now in operation also. What is the experience so far? What major faults have been found? Who are using the systems? In what circumstances should these routes be followed? What of the links between them? What are the hidden costs or benefits?

Moderator: Mr A Elzaburu (ES)

Presenters: Mr A von Mühlendahl, (OHIM)

Mr Francois Curchod (WIPO)

Mr Van Kam (Philips, NL)

16.00 - 16.30

COFFEE BREAK

16.30 - 18.00

3.1 The Prior Art Base

What constitutes prior art?

- (a) Does it include prior possession or public accessibility?
- (b) Is the sale of a product that does not disclose the invention (a black box sale) novelty defeating either against the manufacturer of the product or third parties? Are prior use rights an equitable solution?
- (c) Is material on the Internet prior art? What if it is only on the Net for a short time? How do I prove publication and the date of it? Is putting your patent specification on the Net to send to an associate or a Patent Office in itself a prior publication?
- (d) What are the standards and standards of proof in various countries?

Moderator: Mr Chris Everitt (UK)

Presenters: Mr Simon Thorley Q.C. (UK)

Mr M Meller (US)

Japanese speaker

16.30 - 18.00

3.2 EPO Jurisprudence

What is the relevance of EPO jurisprudence to decisions at the national level? The EPO is handing down many decisions which involve rules of interpretation and inventive level but are national courts guided by the principles of those decisions? Will they follow EPO jurisprudence? If not, what are the consequences?

Moderator: Mr P Puchberger (AT)

Presenters: Mr G Modiano (IT)

Dr U Dreiss (DE)

Mr K Vingtoft (DK)

? Ms. Gabriella ?

16.30 - 18.00

3.3 Design Infringement

How is design infringement assessed? How do I avoid infringing the rights of others? Do I get what I pay for in my application? What of the unregistered right and copyright that may exist after the registration expires?

Moderator: Mr A Hansmann (DE)

Presenters: Mr M Hawkins (NZ)

Mr P Orton (UK)

Mr D Ohlgart (DE)

FRIDAY, 18 October

9.00 - 10.30

4.1 Equivalence

Is there a doctrine of equivalence in a process claim and when can it be applied, be it called "Pith and Marrow" or mere colourable variation? If there is, how can the competitor tell what is an infringement from what is not?

Moderator: Mr F Ahner (FR)

Presenters: Mr R Nott (UK)

Mr J Van Gennip (NL)

Mr W Schuurman (US)

9.00 - 10.30

4.2 Presumption of Validity - Examined and Unexamined Rights

Should a patent be presumed valid? Should the onus be placed squarely on the person seeking revocation to show that the patent is bad? What are the rules in Europe, the United States and other countries, and how does this affect the rights of a third party who believes that a patent is bad? Do the same principles apply to other intellectual property rights especially unexamined utility models?

Moderator: Dr J F Leger (CH)

Presenters: Mr V Gil Vega (ES)

Mr M Waldbaum (US)

Mr D Deeth (CA)

9.00 - 10.30

4.3 Well-known Trade Marks

The concept of well-known trade marks has been recognised for many years. It is now enshrined in the Paris Convention, the TRIPS agreement and the Community Trade Mark Regulations. But what additional protection is (and should be) available because a mark is well-known in the relevant sector. What of a mark well-known internationally but not known in a particular sector of the public in a

country? Are there different concepts for well-known, famous notorious and other (highly) renowned trademarks?

Moderator: Mr Basile Catomeris (SE)

Presenters: Mr A de Sampaio (PT)

Mr F Curhead (WIPO)

Curhead

Mr E Horwitz (US)

10.30 - 11.00

COFFEE BREAK

11.00 - 12.30

5.1 Sufficiency of Disclosure

The terms sufficiency, best mode and fair basis are used to describe requirements of the patent specification. The concepts are seen in a different light from country to country. Yet under the PCT a single specification must be lodged. Is a PCT application drafted to local standards fatally flawed when it enters the national phase in other countries or regions? Does this mean that the PCT results in harmonisation of specification requirements at too high a standard? What are the requirements in the important countries and can one specification really do it all? What is the "best mode" requirement in the US?

Moderator: Mr J J Joly (FR)

Presenters: Mr C Elderkin (US)

Mr G Gall (AT), EPO

Mr W Dost (DE)

11.00 - 12.30

5.2 The Client/Attorney Relationship

An increasing number of clients require services at approved standards and will only brief a patent attorney who has the appropriate certification. Corporations now require that the Patent Attorney systems are compatible with the Corporations' requirements. What standards are necessary and desirable? What should associates expect of each other? Is there a call for a special

standard for patent attorneys? How do I present a safe yet useful opinion or are these incompatible aims? Should I give no practical views and offend the client or should I give my candid views and offend my insurer?

Moderator: Mr Ray Stewart (US)

Presenters: Mr M Parup (SE)

Dr C M Mayr (DE)

Mr P Bonner (UK), Legal Protection Group

11.00 - 12.30

5.3 Border Control

How effective can border controls be? Can this limit counterfeiting? Customs Officers cannot be experts in trade mark law. What can be expected of customs authorities? How should the laws and rules be framed to maximise the probability that goods will be seized but only the counterfeit goods? What of grey goods?

Moderator: Ms E Cheong (HK)

Presenters: Ms A Wordsall (UK)

US Counterpart

Customs Authority (Brussels)

12.30 - 14.00

LUNCH

14.00 - 15.30

6.1 Patenting of Life Forms

Should patents be granted for life forms? If so, will the day come when a patent really speaks for itself as the judiciary has expected them to do for generations? A team of experts will examine the issue of patenting of life forms from the Harvard Mouse on.

Moderator: Mr David Bannerman (UK)

Presenters: Mr Danny Huntington (US)

Mr J Leschly, MD of SmithKline Beecham (DK),

Mr P Kelly (IE)

14.00 - 15.30

6.2 Changes and Trends in Industrial Property Law in Spain

What are the changes occurring in Spanish Patent and Trade Mark Law as a result of the new Spanish legal provisions such as the Penal Code, the Law concerning the Legal System of Public Administrations, and the national regulation of PCT? What are the overruling effects of various supranational provisions such as the Treaty of Rome and TRIPS? Can further changes be expected as a result of harmonisation (or amendment) trends resulting from the EC First Directive on Trade Mark Laws, from the EC Regulations on the Community Trade Mark, or from the Trade Mark Law Treaty (TLT)?

Moderator: Mr M Curell-Sunol (ES)

Presenters: Mr Diego Carrasco, Spanish Patent and Trade Mark Office

Mr Luis Torrents (ES)

Mr Luis-Alfonso Duran (ES)

14.00 - 15.40

6.3 Community Trade Marks - Seniority

The conflict with prior national trade marks will be examined

The seniority of national trade marks in Europe can be critical to obtaining rights in the EU over others interested in the mark. Can the mere existence of prior national trade marks or a specific claim to seniority prevail against owners of younger national marks at Community level? What are the benefits of claiming seniority with the application? Should cancellation actions be filed throughout Europe? How can a national conflict be dealt with in opposition and invalidity proceedings before OHIM? Businesses in "first to use"

countries may not appreciate the problems that exist and the difficulties are increasing as Europe moves from national to regional thinking.

Moderator: Dr F de Benedetti (IT)

Presenters: Mr A von Mühlendahl, OHIM

Mr Chr. Levin Nielsen (DK)