



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

FICPI Historic Event
11th Open Forum
Florence, Italy
8-11 November 2008

11th Open Forum

Florence, 8-11 November 2008

FICPI's 11th Open Forum opened and closed with a plenary session and maintained the well-tested multi-choice format of three series of five topics of current interest in PATENTS, TRADEMARKS and GENERAL issues during the two days of the Forum.

The session's subjects were chosen to be topical, practical and relevant to day-to-day practice. They were presented concurrently in English and delegates had a choice each day to attend the sessions which were of most interest to them.

Ample time was allowed for questions, comments and discussions.



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WORKING PROGRAM

Thursday 9 November 2008

DAY 1

PLENARY

1. STOP! - Injunctions in patents/trademarks and designs

Injunctions, especially preliminary injunctions are probably the sharpest and most effective weapons in the enforcement of IP rights. An injunction may save the IP owner from irreversible damage, but at the same time subject the alleged infringer to irreparable harm. Balancing the interests and risks is a challenge for the Court and Counsel. The presumed validity of the IP right (especially of a searched and/or examined IP right) and the evidences for infringement as well as the defences presented in counter by the alleged infringer are the bricks used to build the case for the Court.

How does the Court come to its decision on injunction? What are the legal boundaries? Where are the practical problems in presenting the case and in administering law in order to "dispense justice"? What risks are there for the client and how are these mitigated? Two experienced litigators will please their case before Judge Paul Michel, Chief Judge of the US Court of Appeal for the Federal Circuit (CAFC).

Moderator: Andrew Parkes (IE)

Speakers: Chief Judge Paul Michel (US Court of Appeals for the Federal Circuit)
Alan Aucoin (CA)
Leo Jessen (NL)

TRADEMARKS	PATENTS	GENERAL
Session 1.2 Managing Trademark Oppositions	Session 2.2 Inventive Step	Session 3.2 Privilege for patent attorneys
Opposition can rapidly become a lengthy and costly process yet settlement is not always the most favourable alternative. In this session we will consider how to prepare the strongest case on the	The determination of what is an invention is a core issue for patent practitioners. KSR in the US, Lockwood in Australia and the adoption of problem-solution beyond the EPO are recent developments	The ability to communicate fully and candidly with a client is of paramount importance in the IP profession. However, privilege is not universally available and even where it is recent Court



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<p>most cost effective basis. Hear "top practice tips" from counsel in various jurisdictions. Hear how the processes of choosing grounds, collecting evidence and preparing arguments might be made more manageable. The role of settlement including the opportune time to suggest this option will also be considered.</p> <p>Moderator: Lars Thyresson (SE)</p> <p>Speakers: Gabriella D. Modiano (IT) Coleen Morrison (CA)</p>	<p>that have tried to remove some of the subjectivity inherent in this evaluation. Nevertheless, each case has to be considered on its merits and it is left to the adjudicator, Examiner or Judge, to try to apply the criteria in an even handed manner. The person of ordinary skill in the art appears to be the touchstone, but who should determine that person, and is the same standard appropriate for each technology? Is ex poste facto definition of a problem any better than rummaging through the parts bin offered by the art?</p> <p>Moderator: Maxim H. Waldbaum (US)</p> <p>Speakers: Vittorio Faraggiana (IT) Wim van der Eijk (EPO) Michael Warnecke (US)</p>	<p>decisions have limited its scope. The lack of uniformity leads to distortion of economic systems, inadvertent loss of rights and a reduction in the quality of advice that can be given. Multi-jurisdictional litigation and the development of a European litigation system highlights these discrepancies. What are the issues, what should be done and what is being done?</p> <p>Moderator: John Orange (CA)</p> <p>Speakers: Eric Le Forestier (FR) Joan Van Zant (CA) Greg Chambers (AU)</p>
<p>Session 1.3 – Criminal Sanctions for Trademark Infringement</p> <p>Criminal proceedings are an attractive alternative for some situations, particularly to control counterfeit goods. How do criminal measures compare to more customary trademark procedures? Under what circumstances is criminal action justified? What are the advantages and disadvantages of each approach? What is the preferred balance? How does criminal enforcement</p>	<p>Session 2.3 – TRUST AND FAITH: The Credibility of a Patent System Depends on the Output</p> <p>A granted patent is a powerful economic tool, but poor quality patents destroy the credibility of the system. Quality is in the hands of the patent offices who seek to provide high quality but are under increased workload pressure. How is quality defined, how is it managed and does it mean the same thing to the practitioner and the examiner? What impact do quality assurance measures have</p>	<p>Session 3.3 – Research-related aspects of Intellectual Property</p> <p>Co-operation and pooling of experience makes business sense with speculative research. It also leads to complex issues that must be addressed before, during and after the research if the full benefits are to be achieved. Issues such as sharing of information, ownership of the results, management of the IP rights, co-inventorship, anti-transfer or anti-competition law</p>



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<p>of trademark violations differ from criminal enforcement of patent, or other IP violations? The speakers and moderator will consider these and other issues surrounding trademark matters at criminal law.</p> <p>Moderator: Gabriel Leonardos (BR)</p> <p>Speakers: Ge Bo (CN) Quang-Minh Lepescheux (UNIFAB) Dr. Maria Ludovica Agrò (Italian Patent & Trademark Office)</p>	<p>on preparation and filing? Have attempts by the offices to improve perceived quality placed an unfair burden on the practitioner, whose principal responsibility is to his client?</p> <p>Moderator: Daniel Alge (AT)</p> <p>Speakers: Julian Crump (GB) Wim van der Eijk (EPO) John Doll (USPTO)</p>	<p>consequences, and right to exploitation.</p> <p>Moderator: Francis Ahner (FR)</p> <p>Speakers: Mark Wilson (US) Teri F. Willey (Cambridge University)</p>
<p>Session 1.4 Search Strategies</p> <p>Trademark searching and clearance is becoming increasingly important in today's world of crowded registers. How does one search efficiently and effectively? How can one make the best use of available on-line trademark databases and search products? How are potentially conflicting unregistered use-based rights best located and assessed? In this session we will discuss the most current search and clearance strategies as well as how to give a client what it wants or needs.</p> <p>Moderator: Ignacio D Rivera Elzaburu (ES)</p> <p>Speakers: Keith Hodkinson (GB)</p>	<p>Session 2.4 Continuing to divide</p> <p>Last year's proposed US Rule Changes were a heavy handed attempt to reduce the number of continuing applications. Other offices have considered restricting divisional applications and recent cases, such as the US Pfizer case, have highlighted double patenting objections as an Achilles heel for the applicant. In this hostile environment the applicant still needs to be able to protect the multiple aspects of the invention disclosed, but is affected by high excess claims fees, inflexible amendment and rigorous unity objections. This session will review the public policy behind the hostility toward divisional applications and examine new ways to address claim preparation and viable</p>	<p>Session 3.4 Intellectual property insurance</p> <p>Sometimes it seems that the only winners in IP law suits are the lawyers. The costs of litigation are so high that the right holder may choose not to assert the rights, or the defendant may abdicate for purely financial reasons. Policies are offered that appear to provide the necessary resources, but do they? The panel will discuss the desirability of such policies, whether they achieve the desired result and whether alternatives are available.</p> <p>Moderator: Doug Deeth (CA)</p> <p>Speakers: Grahame Marshall (GB)</p>



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Steve Stolfi (CT Coresearch)	prosecution. Moderator: Francesco Paolo Vatti (IT) Speakers: Jason Cooper (US) John Doll (USPTO)	Sophie Yana (Gras Savoye)



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Friday 10 November 2008

DAY 2

TRADEMARKS	PATENTS	GENERAL
<p>Session 1.5 Territorial Reputation</p> <p>Does a trademark have to be known widely in the relevant territory for it to be recognised as a well-known mark or for it to enjoy protection against dilution? Can a reputation in a particular area be protected in that area? In the EU, does a reputation in one Member State constitute a "reputation in the Community"? Speakers will refer to recent cases before the European Courts including the FINCAS TARRAGONA case and compare the situation with other jurisdictions, for example the U.S.A.</p> <p>Moderator: Gonçalo de Sampaio (PT)</p> <p>Speakers: John Hardaway (US) Elia Sugrañes (ES)</p>	<p>Session 2.5 PATENT PROSECUTION HIGHWAY: Stairway to Heaven or Highway to Hell?</p> <p>"Patent Prosecution Highways" have been constructed between the USPTO, the JPO and the Canadian, German, UK and Korean Patent Offices. The objective is to reduce duplication, but is this a reality? Will a reduction in work lead to a reduction of fees and risk for applicants? Will "forum shopping" be a new tool for the practitioner? What is the perception of the users of the current pilot projects? How is quality of search and examination maintained and controlled "on the highway"? In this session, patent office's officials and early users of this "highway net" discuss and analyse the current projects, the drawbacks thereof and the future implications on the world-wide patent system.</p> <p>Moderator: David Bannerman (GB)</p> <p>Speakers: Ron Marchant (GB) Kazuaki Takami (JP) Mike Gnibus (General Electric, US)</p>	<p>Session 3.5 FULL SPEED AHEAD - Europe at its best: the future integrated European patent litigation system</p> <p>An integrated approach for the future patent litigation system uses the best of the European Patent Litigation Agreement (EPLA) and Community Patent Court (CPC). What will the future patent enforcement system look like? Qualified Patent Attorneys must play a central role but what does this role look like and what are the new responsibilities for our profession?</p> <p>Moderator: Eric Le Forestier (FR)</p> <p>Speakers: Oliver Varheyli (European Commission) Rainer Beetz (AT)</p>



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<p>Session 1.6 The scope of registered design protection</p> <p>The protection afforded by a registered design is a hot topic in Europe with the increasing success, but also uncertainty, surrounding the European Community Design. The scope of protection includes "any design which does not produce on the informed user a different overall impression" (art. 10.1 CDR). How should infringement be assessed? This issue is also at the forefront in the United States where attention is focused on cases relating to two separate tests for design patent infringement. Speakers will focus on these geographic areas, offering an in depth consideration of the current status of design protection as well as analyses of the recent cases and decisions.</p> <p>Moderator: Mike Hawkins (NZ)</p> <p>Speakers: Robert Katz (US) Robert Watson (GB)</p>	<p>Session 2.6 Third party intervention</p> <p>Third parties have a number of different tools available to clarify or restrict the scope of a patent. These range from simply watching the competitor's activities and filing third party observations, through to formal proceedings such as filing oppositions, requests for re-examination and revocation. Each has benefits and pitfalls that cannot be used without considering the possible impact in other jurisdictions. How do you select the appropriate tool and use it without inadvertently strengthening your competitor's hand? Can an action in one country leave the competitor weakened in another and is it wise to put your faith in the patent office rather than the Court?</p> <p>Moderator: Ena Pugatsch (IL)</p> <p>Speakers: Barry Graham (US) Axel Stellbrink (DE) Leon van den Broek (Schering-Plough)</p>	<p>Session 3.6 Update on Alternative Dispute Resolution in intellectual property</p> <p>The costs of litigating intellectual property issues is skyrocketing. A panel of experts will provide a global review of less expensive and more expedient means for settling such disputes. The experts will review Alternative Dispute Resolution in IP matters various jurisdictions, discuss the success of such alternatives and recommend where, when and how to resolve IP disputes with mediation and other ADR opportunities.</p> <p>Moderator: Dan Collopy (US)</p> <p>Speakers: Erik Wilbers (WIPO) Kenji Yoshida (JP)</p>



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PLENARY

7. POWER AND BALANCE: The First Four Years of the European IP Enforcement Directive

The EU Enforcement Directive 2004/48/EC has been a milestone for harmonisation of IP litigation in the EU. It delivers efficient and uniform tools for the IP owners throughout the whole European Union and - on the other hand - balances these tools against the right of defendants in an IP court dispute. How has the legal breakthrough made its way to (the court's) practice, especially for patents, trademarks and designs? Has the Directive made the enforcement easier in the EU? Or at least improved possible strategies or predictability in IP enforcement?

This panel will discuss the "real life" impact of the Directive in Europe's courtrooms and projections on the possible future developments of this topic. With Judge Michael Fysh as the top expert, this session will highlight the most prominent issues for the practitioners with the IP Enforcement Directive and analyse how this has already affected and will further affect Europe's IP arena.

Moderator: Daniel Alge (AT)

Speakers: HH Judge Michael Fysh (QC, SC, UK County Court)
Jochen Pagenburg (DE)