



EXCONNEWS

GOA EXCO MEETING

A special report on the ExCo Meeting held in Goa, 15-20 March 2024

This in-person meeting of FICPI's Executive Committee took place in Goa, India in March 2024, following the previous ExCo held in London, which coincided with the October 2023 FICPI Open Forum

In this edition of EXCONNEWS we bring you highlights from the Goa meeting





EXCONNEWS

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Editor: Catherine Dhanjal catherine.dhanjal@ficpi.org



What is the FICPI ExCo?

Apart from being the marquee FICPI event, often in wonderful locations and venues that are too small to hold the larger Open Forum or World Congress meetings, the Executive Committee meeting, or ExCo, is FICPI's general meeting. Full story on Page 04.



Artificial Intelligence and patenting pharmaceuticals

FICPI's Study & Work Group on Biotechnology & Pharmaceuticals (known as CET 5) is currently considering the effect of libraries of virtual compounds on patentability, and also AI and its effect in the drug development process.

While AI has the potential to save huge amounts of time and money in drug discovery, many questions arise.

Full story on Page 14.



An insight into the FICPI nominations process

Drawing up a slate of candidates for election to the senior roles in FICPI is the task of the Nominating Committee, chaired by the Immediate Past President.

However, anyone can put themselves forward for election with the support of at least one current member of the Executive Committee and at least one other FICPI member.

Full story on Page 22.

What is the FICPI ExCo?

While day-to-day management of FICPI is handled by the Bureau (or Board – the French names are part of FICPI's more-than-a-hundred-year-old tradition), the ExCo is responsible for setting FICPI's strategic direction, setting its policies and revising its governance, and admitting new members. It also has the power to elect the president and other Bureau members and officers every three years.

FICPI is a federation (or *fédération!*) of member national IP associations and special FICPI sections. Some of these associations were amongst the original founders of FICPI in 1906, as a federation of national IP associations. Others have been joined since then, or even been formed specially to provide a national group of FICPI.

Each member association or section sends a delegate and a substitute delegate to ExCo meetings to represent their group. Each association and section gets one vote, regardless of its number of members and for this each group pays an annual group subscription, which is the same for all groups in addition to a smaller fee for each individual member of the group.

For many years, the ExCo met twice a year (sometimes more), but in recent years the meeting has been held annually. It has also been shortened. Whereas previous ExCo meetings would sometimes last a full week, nowadays, they are typically held across three-and-a-half days with an excursion before the last day, to give the Bureau and others time to draft up resolutions based on the earlier discussions. They are normally held at the same time as the triennial World Congress, when the elections occur, but separately from the Open Forum. However, the London ExCo was held back-to-back with the 21st Open Forum in London in 2023, to satisfy contractual commitments entered into prior

to the disruption to meetings during the Pandemic by the ban on travel and meetings imposed by governments around the World.

In addition to the Bureau and delegates, ExCo meetings are also attended by the heads of FICPI's committees (or commissions) including the CET – the Study & Work Committee (Commission d'Étude et de Travail) – and the PMC – the Practice Management Committee. The CET is responsible for all substantive IP law topics that are put before the ExCo, and both groups organise a number of workshops for delegates during the ExCo. The workshops provide delegates an opportunity to share experience, consider areas of difficulty for the profession or its clients, and brainstorm possible solutions. Often the outputs from workshops form the basis for formal resolutions passed by the ExCo later in the meeting.

ExCo meetings also include an attractive social programme, which allows delegates and the guests to get to know each other better and to deliberate on possible decisions away from the formality and time pressure of the meeting itself.

By tradition, ExCo meetings, when they stand alone, conclude with a gala dinner at which the Secretary General gives a speech, often in multiple languages, which is primarily aimed at the delegates' guests, who are and remain important members of the FICPI Family.

Julian Crump,
President of FICPI
2018-2022, and Partner
at Abel+Imray, UK



FICPI ExCo Meeting 2024 15-20 March 2024 Goa, India

Thank you to all who participated in the programme of the 2024 FICPI Executive Committee Meeting in Goa, India, which began with an opening reception at the Poolside Lawns, Taj Exotica, on Saturday, 16 March 2024.

On Sunday (17 March) and Monday (18 March), meetings were scheduled for Delegates, while guided tours are organised for Delegates' Guests (DGs). Dinners were also included on these days.

On Tuesday (19 March), both Delegates and Delegates' Guests were invited to join the full-day excursion around the town and the Gala Dinner in the evening at the beach lawns, Taj Exotica.

The ExCo meeting ended on Wednesday (20 March) with the last ExCo working sessions in the morning.



Resolutions

EXCO/IN24/RES/001: Procedural Rules for Ex-Officio Objections in Contentious Proceedings

FICPI has recognised that in various jurisdictions around the world, IP Offices and competent IP courts have procedural rules in contentious proceedings which avoid the raising of new ex-officio objections, thereby restricting the subject-matter to the submissions of the parties at least for the second instance of such contentious proceedings. As FICPI is convinced that such an approach procedure has proven to be fair and effective without compromising the quality of decisions, and ensures fair and efficient proceedings in a reasonable period of time, such practice should be continued or procedures should be aligned with such practice.

EXCO/IN24/RES/002: Standard Requirements and Handling of Full-text Patent Applications

In most countries, full text filing of patent specifications has not yet been made mandatory, although there are some countries, such as Korea and Japan, where full text filing has been mandatory for years. CNIPA and EPO are both running projects to facilitate the filing and processing of international applications in full-text format and the USPTO has recently implemented full text filing for new utility non-provisional applications filed under 35 U.S.C. 111(a). A move towards full text processing of filing international applications is inevitable, and FICPI expects that more Offices will move in this direction over the next few years.

The Resolution, which was drafted following a questionnaire, as well as two workshops considering the matter, aims to address Applicant concerns about IP Office-generated errors created by the full-text conversion systems, by providing for a back-up document to serve as a basis for corrections; allow the Applicant/Proprietor to correct IP Office-generated errors at any time, with no fee or impact on filing date; and for there to be

In addition, we urge IP Offices to work towards permitting the use of standard three-dimensional representations and standard video formats in design/design patent applications, as these will provide applicants appropriate ways to protect three dimensional designs without the need for incomplete two-dimensional representations and will provide applicants appropriate ways to protect new types of designs.

EXCO/IN24/RES/003: The Registration of the Unitary SPC for Medicinal Products must be under the Control of the UPC

Following the release of four SPC Regulations by the EU Commission in April 2023, this resolution relates to the most urgent issue and the proposal which is the most straightforward to be enacted: the proposal for a centralised procedure for medical SPCs.

The central issue in the resolution is to urge the relevant EU bodies to foresee the UPC as the appropriate appeal body for any decisions the EUIPO takes as the authority responsible for the registration of the UP-SPCs. This follows from the UPC already being the (exclusively) competent court to deal with all the SPC questions (SPCs for UPs and EPs), the EUIPO has to decide in the planned SPC registration regime as provided in the SPC Regulations proposed by the European Commission. In addition, the UPC is highly competent (legally and technically) and this approach would avoid representation issues for patent attorneys at the General Court.

EXCO/IN24/RES/004: Third Party Observations on Patent Applications and Patents under Opposition

This resolution arises out of the results of two questionnaires aiming to ascertain the availability of opposition procedure of a patent and/or of third-party observations. Previous resolutions on the same subject matters urged the Patent Offices to adopt opposition proceedings and third-party observations during the examination proceedings. However, enquiries run among the National Sections of FICPI shown a certain

dissatisfaction among the stakeholders with the available means to challenge the patentability of patent applications and the validity of patents. It must be further noted that many Patent Offices do not have an examination system and consequently they do not have an opposition system and neither schedule to have them because they do not have the necessary resources and/or know-how. Further, the number of patents or UMs that do not fulfil the patentability requirements either for lack of examination or other reasons increasing worldwide causing a distortion of the market.

This resolution allows the public at large contributing to define the relevant prior art by filing observations for the entire life of the patent and appreciating the strength of the granted patent on the base of the additional prior art filed through third-party observations. In this way, the patent owner can better assess the strength of its patents before enforcing them, and the public is facilitated in executing FTOs or initiating invalidation proceedings.

EXCO/IN24/RES/005: Replacement of Single Gender References in IP Laws, Rules and Guidelines

This resolution arises out of a joint project between FICPI's DEIA Committee and the Study and Work Committee (CET), and a survey of FICPI's National Sections and Associations carried out in 2021. This survey asked about whether IP laws, rules and guidelines contained references to single genders and for examples of these references. Although the results showed that efforts have been made in some jurisdictions to amend IP laws, rules and guidelines to move towards gender neutral language, there is a great deal more work to be done. This is particularly the case for IP laws which tend to be harder to amend.

The survey did highlight the issue that some countries don't have appropriate gender neutral language either at all, or suitable for all jurisdictions. We believe that encouraging all jurisdictions to move towards gender neutral language in IP laws, rules and guidelines (where

available), will be one small step in addressing the disparity in the use of the IP system by women and in the number and progression of female attorneys in the IP profession.

The Resolutions passed by the Executive Committee may be found here:

<https://ficpi.org/library/resolutions/4994>

Robert Watson,
President, Study & Work
Commission (CET), and
Partner at Mewburn Ellis,
UK



Get involved with FICPI's Committees and Working Parties

Make the most of your FICPI membership and develop your intellectual property and practice management skills by becoming involved in one or more of FICPI's Committees and Working Parties.

The Study & Work Committee (known by its French acronym, CET), is one of the largest and most active of FICPI's committees. We have specialised committees dealing with trade mark matters, industrial designs and copyright, international patent questions, European, Community and other regional patent systems, patent issues arising in specialist subject matter areas such as computer-implemented inventions and biotechnology, IP litigation, including alternative dispute resolution, customs procedures etc., and national IP issues.

<https://ficpi.org/organisation/committees>

FICPI Resolutions and Position Papers - what's the difference?

The ExCo is responsible for FICPI policy. Comprised of delegates from all member associations and sections, decisions of the ExCo are binding on the Federation and its organisational units, like the Bureau and working committees. Key policy questions are thus brought to the ExCo at its meetings for discussion and decision through a formal vote. The Statutes specify what kind of majority is needed to pass resolutions on different kinds of issues.

A FICPI Resolution is a formal text, adopted by the ExCo, that addresses a specific issue, situation, or problem and often calls for action, expresses the ExCo's stance on an issue, or makes recommendations ("FICPI urges....").

FICPI Committees are often called on to draft more detailed Position Papers to convey FICPI's viewpoint on specific topics to a wider audience, including members, IP Offices, intergovernmental organisations, or participants in a debate or conference, such as a colloquium on a particular issue. The Study & Work Committee (known by its French acronym: CET) is usually responsible for presenting a number of Position Papers to the ExCo, which then votes to adopt them (perhaps with some amendments). These papers typically cover issues of IP law or practice.

There were no Position Papers adopted by the ExCo in Goa.

Information papers

Between ExCo meetings, the CET and other FICPI committees often produce information papers on specific topics for the benefit of members. Generally, these are published directly onto the website, but some are presented first to the ExCo, for example the European Members' Committee (EUCOF) regular information paper on the "EU State of the Union".

<https://ficpi.org/system/files/EXCO-IN24-EUC-301.pdf>

Workshop Reports

Please note that some of the papers are restricted to FICPI members only and will require you to login to view them.

EXCO/IN24/WOR/001

Workshop 1 // PMC - Discussion on "Fully loaded operating costs"

<https://ficpi.org/system/files/EXCO-IN24-WOR-001.pdf>

EXCO/IN24/WOR/001-3

Workshop 1 // Report // PMC - Discussion on "Fully loaded operating costs"

<https://ficpi.org/system/files/EXCO-IN24-WOR-001-3.pdf>

EXCO/IN24/WOR/002

Workshop 2 // CET - Consideration of best law and practices about provisional patent applications

<https://ficpi.org/system/files/EXCO-IN24-WOR-002.pdf>

EXCO/IN24/WOR/002-1

Workshop 2 Report // CET Workshop Consideration of best law and practices about provisional patent applications

<https://ficpi.org/system/files/EXCO-IN24-WOR-002-1.pdf>

EXCO/IN24/WOR/003

Workshop 3 // PMC – Business Intelligence in IP firms: how to take decisions based on data

<https://ficpi.org/system/files/EXCO-IN24-WOR-003.pdf>

EXCO/IN24/WOR/004

Workshop 4 // CET – Questions on SPLH

<https://ficpi.org/system/files/EXCO-IN24-WOR-004.pdf>

EXCO/IN24/WOR/004-2

Workshop 4 // Report // Questions on SPLH

<https://ficpi.org/system/files/EXCO-IN24-WOR-004-2.pdf>

EXCO/IN24/WOR/005

Briefing Paper // CET Workshop Classification divergence in International TM applications
<https://ficpi.org/system/files/EXCO-IN24-WOR-005.pdf>

EXCO/IN24/WOR/006

Workshop 6 // CET - AI and patenting pharmaceuticals
<https://ficpi.org/system/files/EXCO-IN24-WOR-006.pdf>

If you have any questions on any FICPI papers, or wish to draw FICPI's attention to a specific issue, please get in touch.



Workshop 1: Comprehensive analysis of Fully Loaded Operation Costs (FLOC) and their impact on business strategy

The Practice Management Committee (PMC) of FICPI organised a workshop on Fully Loaded Operating Costs at the Goa ExCo within the context of the work being done by the Committee on Profitability and Pricing of our IP services. This workshop was led by Louis Lagler (CH) and Niti Dewan (IN).

Introduction

The Fully Loaded Operation Cost (FLOC) workshop highlights a burgeoning interest in the strategic management of operational costs among business professionals.

With a reasonable attendance of 25 people, the discussions revealed a significant gap in awareness and expertise in handling these costs effectively. This gap underscores a broader challenge within the profession: optimising operational efficiency to enhance profitability and strengthen competitive market positions.

Detailed findings

While the general awareness of FLOC among the participants was low — with only two attendees having used analytical tools like Power BI — the need for a deeper understanding and strategic control of these costs is evident. The initiative aims to equip professionals with the knowledge to manage these costs effectively, focusing on both immediate impacts and long-term benefits.

Key operational costs

Several critical operational costs have been identified, which businesses must manage meticulously:

- Salaries and benefits: a major part of operational expenses, directly linked to employee satisfaction and productivity.
- Office expenses and insurance: these include day-to-day operational costs and protective measures against business risks.

- Professional fees: costs associated with external consultants, which can influence the quality of business solutions and compliance.
- Marketing and development: essential for business growth, brand positioning, and market penetration.
- Legal research, subscriptions and continuing education: crucial for staying updated with industry standards and regulatory requirements.
- Travel and entertainment: often overlooked, these costs contribute to networking and client relations.
- Technology and cybersecurity: critical in today's digital age, where efficient operations and data protection are paramount.
- Administrative and other overheads: these encompass a wide range of miscellaneous expenses that can subtly drain resources if not monitored closely.

Financial ratios and factors for consideration

Understanding and maintaining healthy financial ratios are essential for assessing a firm's operational and financial health. Key ratios include: profit margin ratio, utilization rate, realization rate, collection rate, leverage ratio, operating margin ratio, current ratio

Insights from group discussions

The discussions among the participants revealed that the approach to managing FLOC varies significantly with the size and structure of the firm.

Larger firms generally have dedicated departments for managing budgets and costs, whereas smaller firms are more agile but may lack structured processes.

Common challenges include the difficulty of assigning costs accurately to specific projects or partners and integrating cost management into daily operations without disrupting current practices.

Strategic recommendations and closing thoughts

The analysis and management of FLOC are critical yet challenging tasks that require comprehensive strategies and tools. Businesses are encouraged to invest in technology and systems that enhance data retrieval and analysis, such as AI and digitalisation initiatives. These technologies can lead to significant improvements in operational efficiency and decision-making processes.

In conclusion, managing Fully Loaded Operating Costs is not merely a financial necessity but a strategic imperative that can dictate the long-term success and viability of a business. The discussions and findings from the FLOC workshop highlight the need for enhanced skills, tools, and awareness among professionals to navigate this complex landscape effectively.

PMC will keep investigating this issue within its Finance group focusing on profitability. If you are interested in getting more involved, whether you are knowledgeable about this topic or want to learn more, we can only recommend that you get involved and contact us: <https://ficpi.org/organisation/committees/practice-management-committee>

Dr Niti Dewan, Head of Patents and Business Development at R.K. Dewan & Co, India

Louis Lagler, Vice President of FICPI's Practice Management Committee, and Partner at Rentsch Partner in Switzerland



Workshop 3: Leveraging Business Intelligence in IP firms

As for the FLOC workshop, this meeting was organised under the Practice Management Committee (PMC) umbrella. It is actually a brand new topic for PMC and this workshop was used as an opportunity to assess the level of interest of FICPI membership and the level of knowledge in the IP profession.

Introduction

A recent workshop held during the Goa ExCo focused on the pivotal role of business intelligence (BI) in IP firms, demonstrating how data analysis can profoundly influence decision-making processes. The event brought together IP professionals to discuss the utilisation of BI tools like Power BI, explore methodologies for effective data collection and analysis, and share strategies for communicating insights to key stakeholders.

Workshop goals and discussions

The primary objectives of the workshop were to:

- **Analyse the impact of data on decision-making:** participants discussed how data-driven insights can transform business strategies and operational efficiency in their firms.
- **Discuss data collection and interpretation:** methodologies for gathering relevant data and interpreting it to unearth business insights were central themes.
- **Share data management practices:** experiences in data collection, analysis, visualisation, and data-driven decision-making were exchanged among the participants.
- **Highlight examples of BI applications:** concrete examples of how BI tools have informed decisions relating to revenue growth, cost control, project staffing, and marketing strategies were showcased.

- Improve communication of insights: strategies to effectively convey data insights to the appropriate stakeholders were discussed to enhance decision-making.

Key topics and insights

The discussions underscored the importance of leveraging data to aid decision-making, with a particular emphasis on the need for effective visualisation tools in BI. Participants shared personal experiences and specific examples where BI significantly impacted decision-making processes.

Internal Business Intelligence

"Internal BI" focuses on measuring various metrics within the firm, such as costs, revenue, taxes, market share, and financial figures. The use of dashboards and other visualisation tools helps communicate these insights effectively within the firm, guiding strategic decisions.

External Business Intelligence

Some firms extend their BI services externally, offering data analytics to clients. This includes competitor monitoring, landscape analysis, and access to proprietary databases, enhancing traditional intellectual property services.

Software and tools

Discussion also touched on the various software solutions available in the market, including



customised software. Tools that integrate different databases into a unified dashboard were highlighted, allowing for more streamlined data management.

Artificial Intelligence and data security

The use of AI tools for BI purposes was noted, particularly for automating processes. Data security emerged as a significant concern, especially regarding client access to IP firms' databases, underlining the need for robust security measures.

Conclusion

The workshop highlighted the transformative potential of Business Intelligence in IP firms, illustrating its critical role in enhancing business decisions and operational strategies. As firms continue to adopt and integrate advanced BI tools and methodologies, the ability to harness data effectively will increasingly serve as a cornerstone for success in a competitive legal landscape.

Interested in BI?

Want to share experience with colleagues? Do not hesitate to join PMC:

<https://ficpi.org/organisation/committees/practice-management-committee>

Laura Mannering is a member of FICPI's CET 3 Study & Work Group on International Patent



Matters and an European Patent Attorney at Bryn Aarflot AS in Norway

Martín Bensadón is a member of FICPI's Practice Management Committee, a member of FICPI's CET 3 & Partner at Marval O'Farrell & Mairal in Argentina

Workshop 4: Substantive Patent Law Harmonization (SPLH)

At the ExCo in Goa, the delegates considered two issues which are part of the Substantive Patent Law Harmonization (SPLH) discussion. These discussions were conducted to solicit the views of delegates from different countries. The results of the debate will assist the continued work of FICPI to evaluate its position on these issues and determine whether it may be appropriate to revise its position on one or both of these issues.

Grace period

The first, which was the simpler issue, is whether the grace period runs from the priority date of an application or the filing date of the application. The current position of FICPI is that the grace period may run from either the priority date or the filing date of an application.

With respect to the grace period, it was noted that the term of a patent may expire up to 12 months later if the priority date is used as a reference date for commencing the grace period. For example, if a priority application is filed just prior to the 12-month period subsequent to a disclosure, and an applicant conducts foreign filings at the end of the convention priority period, then the 20-year term of a resulting patent will commence later. However, if the grace period runs up to the filing date, the applicant will have to conduct foreign filings sooner to take advantage of the grace period and therefore, the term of a resultant patent will expire sooner. Further, the CPTPP requires that the grace period run up to the filing date and not the priority date.

It was generally agreed that the grace period in a particular country for pre-filing disclosures should run for 12 months from the filing date of a patent application in that particular country.

Michael Caine is Vice President of the FICPI Bureau and Principal of Davies Collison Cave in Australia

Pre-filing disclosure

The second question was whether a declaration must be filed in order for a pre-filing disclosure to be graced. FICPI's current position is that such a declaration may be voluntarily filed but that it should not be mandatory for a declaration to be filed in order for a pre-filing disclosure to be excluded from the prior art if the disclosure occurs during the grace period.

Overall, it was acknowledged that there is a difference between disclosures in a fixed form, e.g. journal articles and YouTube videos, and disclosures which are not in a fixed form or disclosures which may be transitory, e.g. a written presentation such as a PowerPoint presentation provided at a trade show.

A majority of the delegates were in favour of requiring a mandatory Declaration for disclosures that are in some type of fixed form. However, further discussion is required to flush out all of the issues related to mandatory Declarations.

These include:

1. What constitutes a fixed disclosure? Besides printed articles and YouTube videos, what other forms of disclosures should be the subject of a mandatory Declaration.
2. When should a mandatory Declaration be filed? Should it be filed before the publication date of an application, the grant date or possibly post grant.
3. What penalty should apply if a Declaration is filed late? One option is a monetary penalty, such as a late filing fee. However, there was no support for the patent owner suffering any loss of rights.



Philip Mendes da Costa is a member of FICPI's Practice Management Committee, of FICPI's CET 3 Group on International Patent Matters & Partner at Bereskin & Parr in Canada

Workshop 6: AI and patenting pharmaceuticals

One of the topics that FICPI's Study & Work Group on Biotechnology & Pharmaceuticals (known as CET 5) is currently considering is that of the effect of libraries of virtual compounds on patentability, and also that of artificial intelligence (AI) and its effect in the drug development process. As these issues would benefit from the collective wisdom of practitioners, they were proposed as a topic for a workshop.

While AI has the potential to save huge amounts of time and money in drug discovery, many questions arise.

Apart from inventorship issues, many questions surround utility and enablement:

- Is AI "guess" at therapeutic effect enough? Is testing required?
- Are AI-produced methods of synthesis sufficient?
- What about AI-generated dosages? Also, would they affect patentability of later tested dosages?
- Different AI models will produce different outcomes, is disclosure of the AI model required?
- Can AI replace animal/human testing to prove effects (good and bad)?



Danny Huntington provided valuable insights into the use of AI in drug development and set the tone for the discussions.

Except for India, it appears that libraries of virtual compounds will not have a serious effect on the patenting of compounds for a specific therapeutic use. Also, AI will not replace the need for a drug development team, at least not in the near future, and it will always be required of the team to provide inventive input into the development process. This contribution must be carefully considered and captured in the specification in order to address inventorship issues.

Finally, consensus in the workshop was that it will mostly be business as usual in the drafting and prosecution of patent applications which incorporate AI-produced data, including therapeutic indications.



Rowan Joseph is Chair of FICPI's Study & Work Group on Biotechnology & Pharmaceuticals (known as CET 5) and Partner at Von Seidels in South Africa

Deepa Tiku is Reporter for the CET 5 group and Partner at K&S Partners in India

CET: The WHO pandemic waiver

In late 2023 FICPI-Sweden brought to the CET's attention a proposed WHO Pandemic Agreement. This issue had arisen from a meeting which they had with the Swedish government in mid-December 2023.

In essence, an international negotiating group aiming at creating an international framework for improved prevention, preparedness and response to future pandemics was established in 2022. One aim seemed to be to strengthen and expand the role of WHO, another aim was to achieve equity in, for and through pandemic prevention, preparedness, and response.

The negotiations are run according to a very tight schedule and the aim was to have an agreement ready by April 2024.

Article 11(3)a of the proposed agreement states:

3. During pandemics, each Party shall, in addition to the undertakings in paragraph 2 of this Article:

(a) commit to agree upon, within the framework of relevant institutions, time-bound waivers of intellectual property rights to accelerate or scale up the manufacturing of pandemic-related products to the extent necessary to increase the availability and adequacy of affordable pandemic-related products.



It will be recalled that the FICPI ExCo passed a resolution during the COVID-19 pandemic that argues against IP waivers as a tool to deal with health emergencies. The [resolution can be found here \(members only\)](#).

The Secretary General thus asked all sections and associations to contact their IP Offices or governments to remind them of the resolution in connection with this proposed agreement as a matter of urgency.

Replies were received from the national section in Greece, South Korea, South Africa, Spain, Australia, Argentina, Finland, France and the United Kingdom. Encouragingly, a number of favourable responses to our request were received from some of the IP Offices.

The national sections are thanked for their active participation in this debate and are encouraged to further engage with the relevant authorities in their countries to ensure that IP waivers are not used as a tool to deal with health emergencies.

Post script

On 19 April 2024, the World Health Organization (WHO) released an updated draft proposal of an international agreement on the global response to future pandemics. On a 1 June 2024 newsletter the WHO website stated: "WHO's Member States decided to extend the mandate of the Intergovernmental Negotiating Body, established in December 2021, to finish its work to negotiate a Pandemic Agreement within a year, by the World Health Assembly in 2025, or earlier if possible at a special session of the Health Assembly in 2024."

The pandemic agreement looks likely to be concluded by 2025.

Rowan Joseph is Chair of FICPI's Study & Work Group on Biotechnology & Pharmaceuticals (known as CET 5) and Partner at Von Seidels in South Africa

Deepa Tiku is Reporter for the CET 5 group and Partner at K&S Partners in India

Workshop 2 / CET: Provisional applications

This workshop was held on Sunday, March 17, 2024. There were 20 people in attendance, representing 14 countries.

Background:

The survey launched 5 February 2024. As of the date of the workshop 25 answers were received. As such, the results are somewhat preliminary and more responses are needed.

Summary of results and proposed focus for resolution:

It was noted from the IL member, that IL will have a provisional system soon. However, the Issue is IL is promoting provisional applications as a good option for a quick and dirty filing, with no cautions for adequate support for the invention when the PCT or convention application is filed on year later. This is expressed by several attendees as a common problem with other IP offices as well.

It was considered that a resolution should focus on urging IP Offices to not just promote provisional filings, but also clearly educate Users as to the risks/requirements for a provisional application with regard to meeting the support requirements with a later filed application. In addition, IP Offices should clearly convey that ultimate cost is the same if the User pursues a full application.



Future work:

- 1) Address the question of what is the objective of filing a provisional application/first filing and how do countries address this objective?
- 2) Further address concerns that IP Offices should not promote provisional applications without educating applicants with the associated requirements for support in a later filed application, both locally and abroad.



Katsumori Iseki is Chair of FICPI's Study & Work Group on International Patent Matters (known as CET 3) and Head of CP Japan IP Attorneys

MaryAnne Armstrong is Reporter for FICPI's Study & Work Group on International Patent Matters (known as CET 3) and Partner at Birch, Stewart, Kolasch & Birch, LLP in the US

CET: The Amicus Curiae Brief in re G 1/23

FICPI was invited as one of recognised and valued organisations to submit an Amicus Curiae Brief to the referral of the Enlarged Board of Appeal, (G 1/23 "Solar Cell"), which deals with the question of prior art from public domain.

The announcement from the EPO BoA was:

In accordance with Article 112(1)(a) EPC, Technical Board of Appeal 3.3.03 has referred the following points of law to the Enlarged Board of Appeal by interlocutory decision of 27 June 2023 in case T 438/19:

1. Is a product put on the market before the date of filing of a European patent application to be excluded from the state of the art within the meaning of Article 54(2) EPC for the sole reason that its composition or internal structure could not be analysed and reproduced without undue burden by the skilled person before that date?

2. If the answer to question 1 is no, is technical information about said product which was made available to the public before the filing date (e.g. by publication of technical brochure, non-patent or patent literature) state of the art within the meaning of Article 54(2) EPC, irrespective of whether the composition or internal structure of the product could be analysed and reproduced without undue burden by the skilled person before that date?

3. If the answer to question 1 is yes or the answer to question 2 is no, which criteria are to be applied in order to determine whether or not the composition or internal structure of the product could be analysed and reproduced without undue burden within the meaning of opinion G 1/92? In particular, is it required that the composition and internal structure of the product be fully analysable and identically reproducible?

The text of the referral in English is available on the EPO website under [new.epo.org/en/boards-of-appeal/decisions/t190438ex1.html](https://www.epo.org/en/boards-of-appeal/decisions/t190438ex1.html)

Communication from the Enlarged Board of Appeal:
<https://www.epo.org/en/legal/official-journal/communication-eba-case-g-123>

FICPI's position

The position of FICPI had in mind that legal certainty and harmonization of law is in the interest of and to the benefit for all FICPI members, considering:

- Already available case law of G 1/92 dealing with the question of public domain prior art,
- Avoidance of a (new) further legal test (i.e. the test of what is an "undue burden"),
- The benefits of clear and predictable rules for all IP users regarding as to whether a subject-matter belongs to the prior art as already done by the EPO with the principles of G 1/92.

The filed Amicus Curiae Brief (filed date November 30, 2023) can be found here, together with other Amicus Curiae Briefs of other organisations:
<https://register.epo.org/application?number=EP11830390&lng=en&tab=doclist>

The Enlarged Board of Appeal considering the referral G 1/23 will be composed as follows: C. Josefsson (Chairman), I. Beckedorf, T. Bokor, M. Teppey, Y. Rüedi, P. Gryczka, G. Pricolo.

A decision is expected by the end of 2024.

Christian Wende is Chair of FICPI's Study & Work Group on European Patents (known as CET 4) and Partner at DTS Patent- und Rechtsanwälte in Germany



CET: Third-party observations on patent applications, patents and utility models

The FICPI Executive Committee meeting in Goa, India, from 15 to 20 March 2024 passed a Resolution to allow the filing of third-party observations for the entire duration of patents and utility models. Normally, third-party observations, when available, can be filed during the pendency of examination or opposition proceedings and, in very few Patent Offices, throughout the entire life of patents.

The Resolution urges Patent Offices to extend the deadlines for filing third party observations for the entire patent term, both during examination proceedings and during unexamined patent and utility model registration proceedings, or to adopt the third-party observations system when it is not available. The Resolution aims to make the intellectual property system more transparent in view of the increasing number of unexamined patents and utility models and to improve the quality of examined patents. For this reason, the Resolution urges Patent Offices to make third-party observations available to the public throughout the life of patents and utility models.

This Resolution allows the public at large contributing to define the relevant prior art and appreciating the strength of the granted patent on the base of the additional prior art filed through third-party observations. In this way, the patent owner can better assess the strength of its patents before enforcing them, and the public is facilitated in executing FTOs or initiating invalidation proceedings.

Previous resolutions urged the Patent Offices to adopt oppositions proceedings and third-party observations during the examination proceedings. However, enquiries run among the National Sections of FICPI shown a certain dissatisfaction among the stakeholders with the available means to challenge the patentability of patent applications and the validity of patents. In

this respect, it must be further noted that many Patent Offices do not have an examination system for patent and utility models and consequently they do not have an opposition system and neither schedule to have them because they do not have the necessary resources and/or know-how to implement them.

This Resolution also aims to overcome this problem in a simple and straightforward manner, since the sole task of Patent Offices is to collect prior art documents filed through the observations and make them available to the public.

The Resolution is also in line with WIPO: *“Theoretically, it is possible to introduce a third-party observation system in a patent office that does not conduct substantive examination. The prior art information submitted by a third party will be made available to the public upon the publication of the patent, and it can be used by any party during the post grant revocation proceedings. For that reason, in some countries, third parties may also submit prior art information to the patent office anytime during the post grant phase. The submitted information will be included in the official file (dossier) which is accessible to the public.”*

In conclusion, we believe that the present Resolution is beneficial to the patent system and its credibility.



Mauro Eccetto is Chair of FICPI's Study & Work Group on IP Enforcement and Alternate Dispute Resolution (known as CET 7) and Partner at Studio Torta in Italy

Member-only profitability symposia with the Practice Management Committee

Law firm performance expert Norman Clark leads quarterly symposia. Each session is run twice, thus offering times to suit Europe/America, as well as AU/NZ/Asia.

Numbers are capped at 30 delegates per session.

Full story on Page 21



FICPI Open Forum 2024

Join FICPI members and all those with an interest in IP matters in Madrid in September 2024 for this celebration of intellectual property topics, IP practice management challenges and tips, and the celebrated FICPI top tier social events.

Full story on Page 24



FICPI and FICPI-Korea Symposium 2025

This will take place in the stunning surroundings of Jeju Island, South Korea, famous for its unique cuisine, stunning coastline and sculptures crafted from the island's volcanic rock.

Full story on Page 25.

Unlock the secrets to enhancing your firm's profitability with FICPI's Practice Management Committee (PMC)

In the competitive landscape of intellectual property law, mastering the business aspects of your practice is just as crucial as staying updated with legal developments. The Practice Management Committee (PMC) of FICPI is here to guide FICPI members on enhancing firm operations across five key areas: Finance, Human Resources and Well-being, Business Development & Marketing, Governance & Compliance, and Technology.

This year, we are advancing to phase two of our profitability project, which has been a focus since its introduction. Insights from this ongoing initiative were first unveiled at last year's Open Forum in London, with continued research supported by renowned consultants.

Exclusive Online Symposia: Learn, Interact, and Grow

Join us for our quarterly online Symposia, each dedicated to different profitability topics. These sessions are designed with a 90-minute presentation followed by a 30-minute segment for personalized questions, allowing in-depth exploration of complex issues. Attendance is limited to 30 FICPI members per session, ensuring a focused and interactive environment.

Get involved and make an impact

We welcome your contributions and ideas. If you're interested in participating or have insights to share, please contact the PMC executives. Stay connected through FICPI's LinkedIn page to follow our updates and secure your spot at our events.

Join the PMC's mission to drive profitability and operational excellence in IP law practice. Together, we can forge a path to greater success for your firm!.



Watch our Year Ahead video at:
<https://ficpi.org/on-demand/1616>

Don't hesitate to join us to bring even more resources and energy.

[Click to find out more about PMC](#)

Anne Lévy, President of FICPI's Practice Management Committee and Partner at Brandon IP in France

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Online Symposium: Pricing Legal Services for Competitive Advantage and Profitability - part 3



6th September 2024 // 15:00-16:30 CET Central European Time for Europe & America

13th September 2024 // 12:00-13:30 Singapore Standard Time for Asia, AU & NZ

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I wanna be elected! Nominations for FICPI elections now open



"Respected, selected, call collected." So said Alice Cooper, but how? Sometimes people ask me how they can join a FICPI committee or get elected to a certain position. They suggest that the FICPI "ladder" is shrouded in secrecy, and you must be in some kind of clique to advance. In fact, nothing could be further from the truth and, to be brutally honest, if the person asking has been a FICPI member for some time, it probably means they haven't been very involved to date. FICPI loves volunteers and will always find a home for someone who is willing to give their time. The best way is just to ask someone in the current leadership and let them know you are interested. Believe me, you won't need to ask twice.

However, no one in FICPI can know everyone, and we understand that some people are better at coming forwards than others. So, to make the FICPI election process better and more widely understood, and to leave no stones unturned in our search for enthusiastic volunteers, the Nominating Committee was established by the Executive Committee (ExCo) in 2018, at the World Congress in Toronto, under the presidency of Doug Deeth

The Nominating Committee, comprising the immediate past president as Chair, the current president, the heads of the CET, PMC and FICPI Academy, and two past or present ExCo delegates

designated by Council, is charged with identifying suitable candidates for those positions within FICPI that are to be filled by election by ExCo. To this end, it collaborates with the Bureau and must submit to the Secretary General a slate of candidates for election no later than three months prior to the ExCo meeting at which the elections are to be held. It is also the job of the Nominating Committee to apprise members of the opportunities and responsibilities involved in holding elected positions in FICPI.

There are no pre-requisites for any of the elected positions in FICPI, other than that the nominee must be a member. Anyone can put themselves forward for election for any position, but they must have two proposers, both of whom must also be members, and at least one of whom is an ExCo delegate, or a person holding an elected position in FICPI. [A copy of the Nominations Form can be downloaded from FICPI.ORG.](#)

Nonetheless, it is preferred that candidates should have experience in the operations of the Federation, and [Guidelines laid down by the ExCo](#) to assist the Nominating Committee and candidates specifies the preferred amount and kind of experience that is recommended for each elected position. For example, a candidate for president of FICPI should ideally have served at least two terms as a participant at ExCo meetings

as a delegate or otherwise and at least one term as a member of the Bureau. Without this experience, it is difficult to see how someone could successfully carry out the role of president, for example.

Current holders of elected positions are canvassed by the Nominating Committee to find out if they wish to continue in their role or whether they wish to try something different. They are asked to think about who should succeed them, either at the next election or further ahead and, importantly they are also asked who in their committee(s) should be put forward for a more advanced position.

There is a significant advantage in FICPI's 3-year terms in allowing elected officers time to learn the job and to "get stuff done" before they move on, but FICPI also recognises the importance of continually refreshing the elected positions. While the Statutes do not prescribe term limits for any of the elected positions, apart from the President (who is limited to a single 3-year term), the Nominating Committee should endeavour to identify and nominate new candidates for any roles where, by the time of the election, the incumbent will have held the position for two or more terms (more than about six years).

So, if you are interested in an elected position in FICPI, please contact me or any other member of the Nominating Committee for an informal chat or submit a Nominations Form with the signatures of two proposers. The Nominating Committee is now hard at work with the Bureau on preparing a list of candidates for election at the next World Congress, which will take place in October 2025, in Naples.

Please rest assured that the deliberations of the Committee are confidential and, unless special circumstances arise, the Committee will not publish the name of any candidate who was considered for any position in FICPI. [Further information can be found in the Guidelines.](#)

Julian Crump,
President of FICPI
2018-2022, and Partner
at Abel+Imray, UK



Celebrating Rowan Joseph's birthday in Goa

Rowan enjoyed a wonderful birthday surprise in Goa.

[Click to watch the video!](#)



FICPI 2024 Open Forum 25-28 September 2024 Madrid, Spain

The technical programme

FICPI's working programme for the 22nd FICPI Open Forum will deliver an intellectual feast. Plenary sessions include "Primal Leadership", helping you uncover the hidden drivers of great performance; "Unmasking the Mirage" to help navigate the landscape of fake evidence; and "Pricing Legal Services for Competitive Advantage and Profitability", following last year's popular IP profitability session.

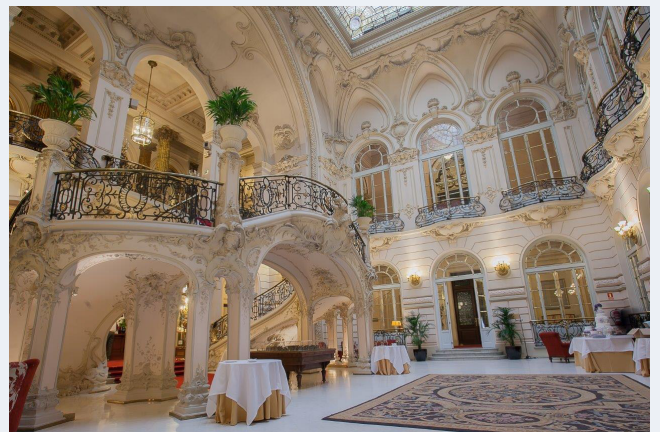
The FICPI Open Forum promises a journey through the cutting edge of intellectual property – an opportunity not to be missed!

The hotel: The Riu Plaza España

Situated in the heart of the city, we've chosen a hotel for the accommodation and conference sessions that combines luxury with wonderful views of Madrid. For leisure you'll find a seasonal outdoor pool on the 21st floor plus a gym.

The classic building is known as the Edificio España and houses the hotel itself, plus plenty of opportunities for shopping on the lower three floors. It's located on Madrid's famous and bustling Gran Vía street, known as the 'Spanish Broadway'.

The Open Forum is fully sold out. You can find the programme, full information and wait list at: <https://ficpi.org/ficpi2024>



AUGUST 2024

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& ExCo,
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Save the date!



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Editor: Catherine Dhanjal catherine.dhanjal@ficpi.org