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FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN



EXCONeWS

LONDON EXCO MEETING

A special report on the ExCo Meeting in London, 2-4 October 2023

The first in-person meeting of FICPI's Executive Committee after the changing of the guard at the Cannes World Congress in September 2022 took place in London at the start of October last year.

In this edition of **EXCONeWS** we bring you highlights from the London meeting





EXCONNEWS

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What is the FICPI ExCo?

The FICPI ExCo. What is it? 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 ExCo – or Executive Committee – meeting is FICPI's general meeting.

Full story on Page 04.



Report on the IGC on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore Special Session, Geneva 4-8 September 2023

The history of the Intergovernmental Committee (IGC) on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore stretches back to 2001 in an attempt to provide protection for genetic resources, traditional knowledge and traditional cultural expressions.

Full story on Page 10.



Photo credit: Elisabeth Ohm

The impact of Artificial Intelligence on IP and the legal profession

As Artificial Intelligence or AI continues to take the global centre stage, its impact on intellectual property and the legal profession accentuates with each subsequent development and hence it becomes imperative to critically analyse the impact as well as the pros and cons of usage of Artificial intelligence in the legal profession.

Full story on Page 14.

What is the FICPI ExCo?

Continued from Page 03

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 this year 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 standalone, 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



Resolutions

EXCO/UK23/RES/001: Complete Examination of Trade Mark Applications

This resolution urges Trade Mark Offices to avoid incomplete examination of applications and endeavour to conduct a complete and comprehensive examination of all substantive issues at initial examination.

This arises from the recognition (and our members' observation) that dealing with substantive issues one at a time due to an incomplete examination of a trade mark application can lead to prolonged prosecution and increased costs to the applicant. We passed a similar resolution in 2022 relating to patent applications, although this focused on the splitting of patent eligibility from other substantive issues.

However, we appreciate that there are some cases where new issues do need to be raised after initial examination. We urge that Trade Mark Offices limit such situations to inadvertent omissions or supervisor-level review.

EXCO/UK23/RES/002: Standard Formats for Design/Design Patent Applications

This resolution arises from considering the disadvantages of raster graphic formats (e.g. JPEG, GIF, TIFF, PNG, BMP) for representing designs which have limitations particularly when resizing or detailed views are required.

We urge IP Offices to allow the use of vector graphic formats (e.g. some PDF, SVG), which:

- Provide a stepless and lossless scalability of design representations;
- Reduce memory space compared to raster graphics formats; and
- Open the possibility for automated digital comparison of images.

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/UK23/RES/003: Work of IGC of Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore

Having been following the work of the IGC since 2001, we passed a resolution in 2004 (EXCO/IT04/RES/001) reflecting our views on the proposals at the time relating to disclosure of genetic resources in patent applications.

Given the plans to hold a Diplomatic Conference in 2024 and following the intensive discussions at the Special Session of the IGC 4 to 8 September 2023, we have reiterated our support for the proposed treaty. We have also restated three of our key requests from the 2004 resolution, i.e. that the provisions relating to genetic resources should:

- Clearly and precisely define the requirements for a declaration in a patent application of the source of any genetic material on which the invention is based;
- Require the applicant to identify in such a declaration only the source from which the genetic material was actually obtained by the inventor;
- Entitle the applicant to an opportunity to rectify any failure to comply properly with the declaration requirements and regulate that the consequence of any ultimate failure to meet such requirements shall not, in the absence of fraudulent intent, be invalidation or unenforceability of the patent.

As a refinement to our previous position regarding the retroactivity of any provisions, we agree with the proposed provision of Article 5 that contracting parties “shall not impose the obligations of this instrument in relation to patent applications which have been filed prior to that Contracting Party’s ratification of or accession to this instrument, subject to national laws that existed prior to such ratification or accession”.

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

<https://ficpi.org/ficpi-news/ficpi-resolutions-october-2023>

**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..."). Details of the Resolutions adopted by the ExCo in London can be found on Pages 5-6.

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.

Following is a list of the Position Papers that were adopted by the ExCo in London. In some cases, these papers had to be submitted urgently to an external body before the ExCo Meeting.

In such cases, they are submitted on a provisional basis, subject to subsequent ratification by the ExCo.

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

Position Papers (ratified at the EXCO)

EXCO/UK23/CET/1003

<https://ficpi.org/system/files/EXCO-UK23-CET-1003.pdf>

Response to Mapping of EUIPO User Association

EXCO/UK23/CET/1004

<https://ficpi.org/system/files/EXCO-UK23-CET-1004.pdf>

Response to USPTO Study on Non-Fungible Tokens and Related Intellectual Property Law Issues

EXCO/UK23/CET/1401

<https://ficpi.org/system/files/EXCO-UK23-CET-1401.pdf>

Comments on Draft Guidelines for Examination in the EPO 2023

EXCO/UK23/CET/1402

<https://ficpi.org/system/files/EXCO-UK23-CET-1402.pdf>

Comments on Draft Guidelines for Examination in the EPO March 2023 edition

EXCO/UK23/CET/1403

<https://ficpi.org/system/files/EXCO-UK23-CET-1403.pdf>

Response to EPO Observatory Survey



EXCO/UK23/CET/1404

<https://ficpi.org/system/files/EXCO-UK23-CET-1404.pdf>

Response to User consultation on proposed amendments to the Rules of Procedure of the Boards of Appeal to further enhance the timeliness of appeal proceedings

EXCO/UK23/CET/1501

<https://ficpi.org/system/files/EXCO-UK23-CET-1501.pdf>

Responses to request for comments on USPTO Initiatives to Ensure the Robustness and Reliability of Patent Rights

EXCO/UK23/CET/1502

<https://ficpi.org/system/files/EXCO-UK23-CET-1502.pdf>

FICPI Statement on the Patent Eligibility Restoration Act of 2023

EXCO/UK23/CET/1601

<https://ficpi.org/system/files/EXCO-UK23-CET-1601.pdf>

FICPI Comments: Artificial Intelligence and Inventorship in the US

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-UK23-EUC-301.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.

EXCO/UK23/CET/1201

<https://ficpi.org/system/files/EXCO-UK23-CET-1201.pdf>

Resolution Briefing Paper // Standard Formats for Design Patent Applications

EXCO/UK/CET/1301

<https://ficpi.org/system/files/EXCO-UK23-CET-1301.pdf>

Client-Patent Attorney Privilege

EXCO/UK23/CET/1405

<https://ficpi.org/system/files/EXCO-UK23-CET-1405.pdf>

Briefing paper for proposed resolution on new objections in inter partes proceedings

EXCO/UK23/EUC/301

<https://ficpi.org/system/files/EXCO-UK23-EUC-301.pdf>

"The IP State of the Union" - EUCOF REPORT 2022

EXCO/UK23/PMC/2201

<https://ficpi.org/system/files/EXCO-UK23-PMC-2201.pdf>

PMC President's Report

Workshop Reports

EXCO/UK23/WOR/002

<https://ficpi.org/system/files/EXCO-UK23-WOR-002-1.pdf>

Report on Workshop 2 // Consideration of best practices when receiving offices receive only full text international applications

EXCO/UK23/WOR/003-1

<https://ficpi.org/system/files/EXCO-UK23-WOR-003-1.pdf>

Report on Workshop 3 // AI's Impact on IP and the Legal Profession



Complete examination of trade mark applications

FICPI's Executive Committee passed a very important resolution on the examination of trade mark applications during its last Executive Committee meeting in London, held on 2 to 4 October 2023.

The resolution deals with the issue of incomplete examination of trade mark applications and the issue of examination conducted and completed in different stages, which is a practice noticed in many jurisdictions.

With this resolution the Executive Committee urged the Trade Mark Offices to avoid incomplete examination of applications and endeavour to conduct a complete and comprehensive examination of all substantive issues at initial examination.

The Executive Committee further resolved that in case a Trade Mark Office wishes to allow new issues to be raised after initial examination, the latter is urged to limit such situations to inadvertent omissions or supervisor-level review. The full text of the resolution may be seen by following the link <https://ficpi.org/system/files/EXCO-UK23-RES-001-GB.pdf>

This resolution has been based on various discussions within the CET 1 on trade marks, where the members of the working group brought many examples into light, where incomplete examination in various forms and in many jurisdictions has created difficulties in trade mark attorneys' practice and has also caused significant delays for applicants.

One of the examples of such practice mentioned by the members was also concerning the European Union Intellectual Property Office (EUIPO), that had issued objections on absolute grounds, which were

followed by a second notification on objections related to classification deficiencies.

Another example of incomplete examination was referring to China National Intellectual Property Administration (CNIPA), which had issued a second notification on new grounds during the appeal phase of the procedure opened in connection with the first notification.

The working group also noted that incomplete examination may prolong prosecution periods excessively, especially in jurisdictions where Trade Mark Offices review trademark applications on various grounds, including formal deficiencies, classification issues and indefinite descriptions of goods and services, lack of distinctiveness and/or descriptiveness of the trade marks and other absolute grounds, as well as relative grounds such as similarity with prior trade marks and trade mark applications.

The resolution passed is deemed to be very significant for users and trade mark attorneys, because it is expected to improve the predictability and timeliness of the registration and it will help users and their attorneys assess correctly costs and timelines until trade marks registration. In addition to the above benefits, the resolution is expected to help avoid prolonged prosecution periods, which may create uncertainty to users with relation to their rights.



This resolution is part of a series of very important resolutions passed in the last few years by FICPI on trade mark matters, focusing on the efficiency of prosecution procedures and timeliness of trade marks registration.

Other important resolutions passed previously within this same scope were, inter alia:

The Cannes Resolution on Accessibility of Trade Mark Priority Documents and Removal of Legalization Requirement

<https://ficpi.org/system/files/EXCO-FR22-RES-003.pdf>

The Cannes Resolution on Guidance for Protecting NFTs as Trade Marks

<https://ficpi.org/system/files/EXCO-FR22-RES-008.pdf>

The Resolution on Expedited Examination of Trade Marks

<https://ficpi.org/system/files/EXCO-EB21-RES-004.pdf> which was passed by the Executive Committee that was held virtually in 2021.

Eleni Kokkini,
CET Executive
Vice President;
European Union
Members
Committee of
FICPI (EUCOF)
Appointed Vice
President (for
Trade Marks); and
Partner at PPT
Legal in Greece



Report on the IGC on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore Special Session held at WIPO in Geneva 4-8 September 2023

Continued from Page 03

Negotiations have been marked by deep divisions between what might be seen as developing and developed countries. An internationally binding legal agreement was proposed and has since formed the focus of the IGC. Very little progress in negotiations was made as consensus could not be reached.

FICPI has been following this initiative since its inception.

FICPI's attendance at the IGC led to a 2004 resolution on the proposed disclosure requirement for genetic resources.

It appeared unlikely that consensus could ever be reached due to the very disparate on this topic. It thus came as somewhat of a surprise when it was announced in 2022 that the General Assembly of WIPO had decided to hold a Diplomatic Conference ("Dip Con") by no later than 2024 to consider this issue.

Since consensus has traditionally been required for WIPO decisions, on the face of it move appeared to denote that finally consensus had been reached and that the of the proposed agreement would be fairly straightforward to agree as these had been formulated in the 35th meeting of the IGC in 2018.

It transpires, however, that the decision to hold a Dip Con was not achieved by consensus.

The Russian invasion of the Ukraine prompted the USA to propose that the WIPO General Assembly express its condemnation of Russia. As Russia and its allies would clearly not agree to such an action, the USA proposed that, in a break with the tradition of decisions, the General Assembly vote on the matter. This move was almost immediately seized upon by the developing countries of the IGC who insisted that since voting had become accepted for decision taking in the General Assembly, that it could be used to reach a decision on the GR issue. This ultimately led to agreement that a Dip Con be held. This background is important as it indicates that there still exists the deep divisions that have always existed.

The text for the proposed treaty, to be ratified by the Dip Con, was drafted by the then Chair of the IGC after the general terms had been formulated at the 35th IGC meeting. The Articles attempt to capture both sides' positions, often through use of notes by the Chair. The draft text thus does not represent a document in need of some "polishing", but rather one which is still contested.

In order to try settle the text for the Dip Con, the IGC on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore met in a Special Session in Geneva from 4-8 September 2023. The purpose was in fact more to "further close any existing gaps to a sufficient level" than to attempt to settle the text.

The meeting was marked by the deep divisions that have historically existed. In the plenary session lasting 3 days, very little progress was observed in "closing the gaps".

With little consensus being apparent, the Chair called for a smaller "Contact Group" to be held. This group included representatives from the major regional groups and a facilitator.

Other than mainly cosmetic changes, no agreement could be reached on most of the proposed amendments to the draft text. The current version of the draft text is available [here](#).

This leaves a draft text, which is in most part not agreed, to go through to the Dip Con. The Dip Con will now have to negotiate and settle the terms of the proposed treaty. It remains to be seen whether the deep divides can be bridged by the politicians in attendance.

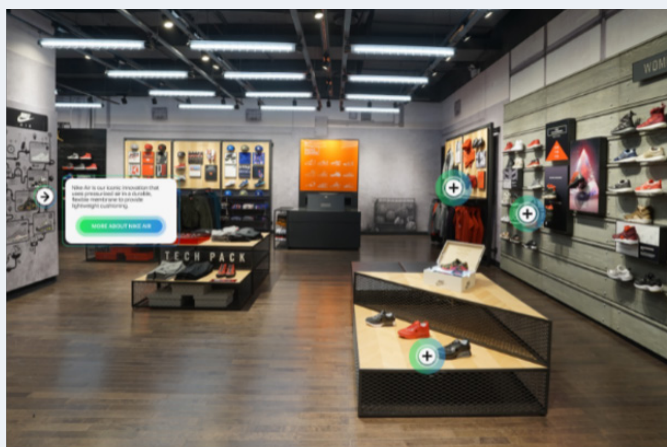
If a treaty is achieved, signed by 20 nations and comes into force, and one of those nations has a leading patent office, it will affect most applicants for major inventions which are filed in all the leading patent offices. However, the likely disclosure requirements of such a treaty do not appear to be so onerous as to be unpalatable. At its 2023 Open Forum in London, FICPI passed a further resolution which can be found [here](https://ficpi.org/ficpi-news/ficpi-resolutions-october-2023):
<https://ficpi.org/ficpi-news/ficpi-resolutions-october-2023>

Rowan Joseph, Chair of FICPI's Study & Work Group on Biotechnology and Pharmaceuticals and Partner at Von Seidels in South Africa



Contemporary file formats for design patent applications

We visit websites and move around in virtual showrooms; we browse online catalogues and chat in networks. And your new product in the newly-developed design? It appears perfectly positioned in 3D, with high-resolution graphics, in brilliant colours, innovatively animated with movement, and in a coordinated play of colours.



Design and reproduction of the new products have been carried out using state-of-the-art graphic tools allowing any view from arbitrary angles, in any desired size and resolution, including animated presentations and interactions. The representations of the new design are already available in modern file formats, and thus we are perfectly equipped for filing a new design patent application.



Sorry, my mistake!

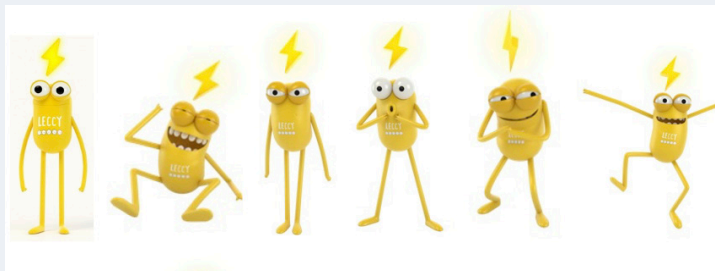
Numerous national and international offices responsible for registering designs do not allow modern file formats such as vector graphics, three-dimensional graphics, and video files.



What is required are raster graphics, usually in JPEG or PNG format, with a maximum resolution of 300 dpi and a maximum size of 16x16 cm.

In addition, there are different requirements for the representations of the design. Some authorities stipulate a certain number of specific views or even a maximum number of images.

Animated designs must be reproduced in a sequence of two-dimensional representations, which is often problematic with a maximum permitted number of 7 representations.



And on top of that, with most Offices, the total size of all files must not exceed a specified storage capacity limit, e.g. no more than 20 MB. With 15 models, each with 7 images in a resolution of 300 dpi, this is not feasible.

Against this background, the expectations and wishes of FICPI can be focused as follows:

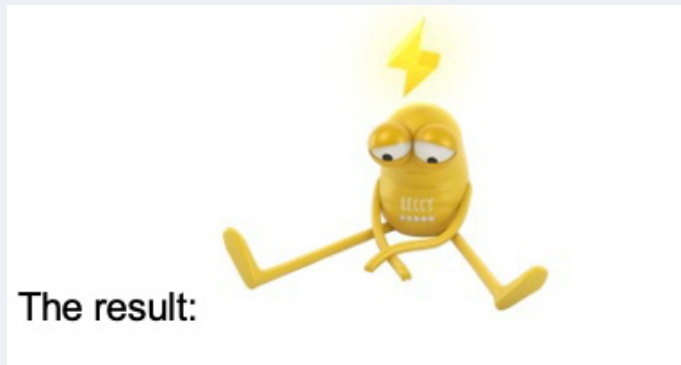
- a) We wish to have a uniform standard for the digital representation of a design within a design application.
- b) We wish to have a uniform approval of at least one standard vector graphic for the digital representation of a design.
- c) We wish to have the possibility to file a design application with a three-dimensional representation or in a video format, independent of a particular number of views, specific views, and a low maximum number of views.

All this would neither influence the individual preferences for the processing of design applications, nor the formal and substantive examination of a design application.

On the contrary, a uniform standard based on vector graphics could simplify the work on both sides (for applicants and offices).

Pictures: Innowise Group; Fiverr International Ltd; Audo; Vitra; Packhelp; RCD 002592063

This article is based on FICPI Resolutions [EXCO/FR22/RES/006](#) and [EXCO/GB23/RES/002](#).



- A single three-dimensional representation could completely replace the need of 6 + X two-dimensional views of the design, and the discussion about the perspective view to be used.
- A single video file could completely replace a sequence of two-dimensional representations of an animated design, e.g. an animated logo or a Graphical User Interface.

Compared to raster graphics, vector graphics can be stored with smaller space requirements. Moreover, they have a stepless and lossless scalability.

Most important would be the avoidance of a media break when a design application prepared and filed for a selected country is to be filed in other countries, whether simultaneously or by claiming a priority.



Jürgen Buchhold, Chair of FICPI's Study and Work Group on Designs (CET2) and Partner at Olbricht Patentwälte in Germany

Scenes from the FICPI 21st Open Forum 2023



The impact of Artificial Intelligence on IP and the legal profession

Continued from Page 03

The subject attracts dichotomous opinions from legal professionals across the globe and our workshop on the topic “Impact of Artificial Intelligence on IP and the Legal profession”, during the FICPI ExCo 2023, drew some intriguing feedback on use of AI tools by law firms, such as, whether use of AI should be seen as a sign of potential threat or opportunity, whether use of AI will increase the productivity of the firms and ethical and accountability issues that may emerge on account of use of AI tools in the legal profession.

The real-time feedback generated from the workshop indicated a general inclination to explore use of AI in legal profession and majority of professionals viewed it as an opportunity than a threat.

Use of AI tools by law firms

Technology is deeply embedded in day-to-day processes of majority law firms and technological processes have been integrated by law firms for work efficiency and productivity. We can safely state that in the last two decades most law firms have developed an information management system on which they heavily rely for accomplishment of legal tasks.

However, when we deliberate about generative AI then the entire scenario becomes crucial and while some law firms are already using AI, many are genuinely considering its use in their respective law firms.

A report released by Thomson Reuters on ChatGPT and Generative AI by Law Firms, revealed some insightful and glaring facts, which reflected that almost 51% of the respondents confirmed that ChatGPT or

generative AI should be applied to legal work and that 59% of partners and managing partners felt generative AI should be applied to legal work. The report also studied the potential risks of use of AI, such as accuracy of responses generated by AI, handling of confidential data, and ownership of private data and the security of the AI tool.

Real time feedback on Impact of AI on IP and legal profession

A few snippets from the workshop which demonstrate the global perspective on the concerns emanating from use of AI in legal profession are as shown in the screenshots in this article.

Recently, in March 2023, DLA Piper announced that it will be using an AI legal assistant, namely, CoCounsel, for rendering legal services. The law firm also claims that the AI tool will be deployed for tasks such as, legal research, document review, deposition preparation, and contract analysis, while keeping data private and secure. Similarly, Latham & Watkins LLP had in the year 2017 announced the use of AI-based Kira Systems' for review of documents for M&A and other transactions.

Will AI replace lawyers?

Since, the advent of AI tools, specifically the revolutionary ChatGPT, there has been a cacophonous debate about replacement of associates and para legals by AI tools. A Goldman Sachs Report of 2023 also suggests that generative AI could replace 44% of legal tasks.

Undeniably, AI appears to be alluring in terms of eliminating billable hours and staffing problems as well as enhancing work efficiency and less time consuming while reviewing bulky documents and transactions, transcription services etc. However, the potential risks and ethical issues emanating from replacement of lawyers by AI tools needs to be critically analysed and studied.

AI Initiatives from the Indian Judiciary

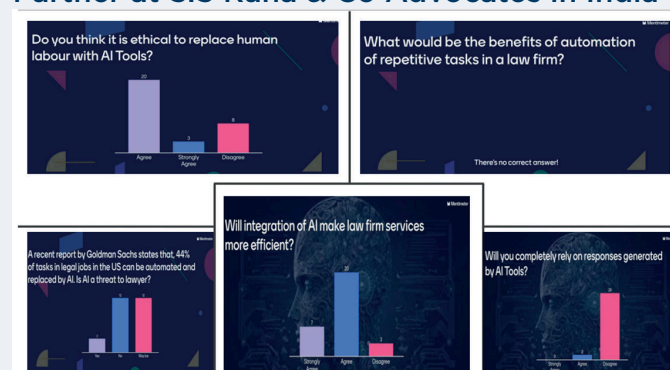
The Indian Judiciary has also delved into use of AI tools, such as use of AI tools to transcribe proceedings. In February 2023, the Supreme Court of India used AI to transcribe its proceedings in a hearing, and a screen displaying the live transcription of the proceedings was placed in the Court of Hon'ble Chief Justice of India Dr. Justice D.Y. Chandrachud.

Another remarkable AI initiative by Indian Judiciary was launch of Supreme Court Portal for Assistance in Court's Efficiency (SUPACE). The AI based Portal- SUPACE was launched to assist Judges in legal research. It is not designed to take decisions, but only to process facts and to make them available to judges.

Issues and potential risks emanating from use of AI in the legal profession

While appreciating the benefits of use of AI tools in legal profession, one cannot sideline, the potential risks that emanate from its use in the legal profession. The issues that need to be pondered upon and addressed are ethical issues, IP infringement issues, accountability, and reliability issues. One of the intrinsic concerns is the accountability of responses generated by AI, which encompass within it critical aspects, such as, verification of content/ response generated AI, as well as reliability issues.

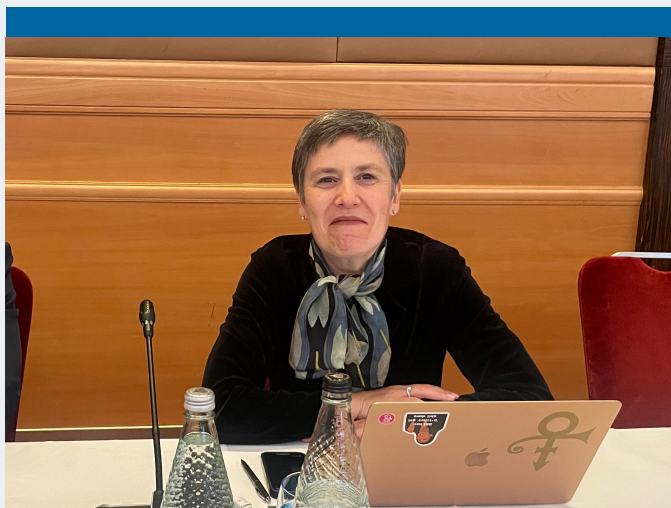
Vikrant Rana, Member of FICPI's Study & Work Group on Trade Marks, and Managing Partner at S.S Rana & Co Advocates in India



FICPI unveils new branding for training initiatives

Some months ago, we became aware that the various names that FICPI uses to label its education initiatives were confusing, both to members and interested outsiders. Find out about the actions we took to remedy this.

Full story on Page 17.



The recent evolution of FICPI's Practice Management Committee (PMC)

Anne Lévy was elected President of the PMC at the 2023 World Congress in Cannes. She highlights progress made since and explains how you can get involved.

Full story on Page 19.



FICPI Country Report 2023

Michael Caine discusses how FICPI gathers information from each national/regional group annually, and how the information is used to help shape FICPI committee work in a way that best helps its members.

Full story on Page 20.

FICPI unveils simplified branding for training initiatives

Some months ago, we became aware that the various names that FICPI uses to label its education initiatives were confusing, both to members and interested outsiders. We constantly referred to TEC – which understandably many people understood to be something to do with technology, when in fact we intended it as the abbreviation of the Training & Education Committee.

Then there is our flagship and much-admired patent drafting course, SEAD – the acronym for Southeast Asia Drafting Course– but confusingly the courses are held all over the world. And SEAD was organised by yet another differently named entity, the FICPI Academy of Education.

I am delighted to say we have created a much more elegant and simple approach to the branding of FICPI's education activities, which will help us to extend awareness, understanding and participation in our initiatives.

The sharp eyed among you may have already spotted the application of the new naming approach on our website!



In future, all communication and publicity concerning the delivery of education and training activities by FICPI, the names Training and Education Committee and the FICPI Academy of Education are replaced by a single 'master' brand for all initiatives:

THE FICPI ACADEMY: Supported by the FICPI Training & Education Committee

The shorthand version is simply, 'The FICPI Academy'.

Meanwhile, the SEAD courses, which have a valuable legacy, awareness and appreciation among stakeholders, will continue to be known by that name.

However, while doing so, all references to the fuller version of SEAD's name, with its reference to the course's roots in Southeast Asia, will be removed from FICPI's communications and not used going forward.

The formal new version of the SEAD brand is: SEAD: A drafting curriculum by The FICPI Academy



The SEAD name can also be presented as a play on the word 'Seed' – perfect for a drafting course that helps develop and grow talent. By the way, the commercial world is full of examples of brands that evolved from their roots to embrace a larger meaning with just the initials

You probably have never heard of the Government Employees Insurance Company

– but you may well have heard of the insurance company it became, GEICO. Similarly, Queensland and Northern Territorial Aerial Services became a global airline brand known by the snappier name of QANTAS.

This is an important step forward for FICPI's education initiatives – it all begins with communication, and I believe the new branding helps us to reach and engage members much more effectively to help grow and expand our projects.

Eric Le Forestier,
course coordinator for
The FICPI Academy,
and IP lawyer at Le
Forestier Conseil in
France



The 2024 FICPI SEAD Patent Drafting Course takes place at IPOS Singapore for two weeks, plus correspondence assignments in drafting.

Tutoring is delivered by experienced practitioners from jurisdictions including Europe, USA, and Canada.

The tutors represent technical fields from electrical engineering, mechanics, biology, and chemistry and all have experience in teaching and tutoring FICPI patent drafting courses.

New trainee exchange programme under consideration

Members of the FICPI Academy met during the FICPI Forum in London to discuss possible parameters for an exchange program, in which FICPI member firms would send one or more of its professionals to another country for a period of time in which to study the national/regional IP laws of that jurisdiction. The Academy sent a questionnaire to FICPI members, to which an excellent response was received.

Members from Australia, Brazil, Canada, China, Dubai, Ecuador, Egypt, France, Germany, Greece, Haiti, India, Italy, Japan, Mexico, Nigeria, Portugal, South Africa, Spain, Sweden, Switzerland, Turkey, the UK and the US indicated interest in sending a professional trainee to another jurisdiction. Likewise, members from Australia, Brazil, Canada, China, Ecuador, Egypt, France, Germany, Haiti, India, Israel, Italy, Japan, Nigeria, Portugal, South Africa, Spain, Sweden, Switzerland, Turkey, the UK and the US indicated interest in accepting a professional trainee in the programme. Some respondents indicated preference for a bilateral exchange, while others indicated preference for a unilateral exchange, or no preference. Members also indicated preferences for years of experience of the trainee, ranging from just half a year to as many as ten years. Language spoken by the trainee and the hosting firm will be other parameters to be considered in the exchange process.

The Academy will be meeting in the coming months to adopt a set of guidelines for the exchange, as well as a platform for connecting member firms interested in the exchange. As worldwide IP training is one its priorities, FICPI looks forward to providing this platform for its member firms and current or future FICPI members.

The recent evolution of FICPI's Practice Management Committee (PMC)

Since I had the honour of being appointed President of the PMC at our last forum in Cannes in 2023, we have made significant progress. Our committee has metamorphosed into five specialist groups, each with a dedicated leader.

1. **Finance (André Werner, CH):** Focusing on the profitability of IP companies, with surveys underway.
2. **Human Resources and Wellbeing (Bastiaan Koster, ZA):** A popular webinar on emotional intelligence, with bright prospects despite the need for more members.
3. **Technology (Vikrant Rana, IN):** A group bursting with energy, tackling a variety of topics and producing captivating articles, including one on ChatGPT.
4. **Governance and Compliance (Eduardo Mello e Souza, BR):** Emerging new themes, with general correspondence survey results underway.
5. **Business Development and Marketing:** In search of a leader, but shone brightly at the London Forum.

Membership: we have experienced a slight increase in our numbers, enhanced by dynamic new members.

Website improvements: We have made dramatic improvements here with visual embellishments, enriched content,

Publications: Committee members have published case studies and an article on ChatGPT and patents that won over our readers.

Webinars: PMC has had notable participation in the FICPI Focus 45 series, with exciting new perspectives in the pipeline.

The PMC is thriving, with a growing membership and dynamic activities.



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



PROFIT GENERATION IN IP FIRMS // SURVEY RESULTS

Posted By Anne Lévy 18 Jan 2024

The survey conducted by Walker Clark LLC for the FICPI revealed insights into the profitability of intellectual property practices, particularly in the context of recent global events and changing market dynamics.

[READ MORE](#)

Membership fees

At the proposal of the Bureau, at the 2023 ExCo meeting, the ExCo members decided by a majority to increase membership fees for national associations and sections by 6.5% initially and by 30% for individual members from 1 January 2024 due to high inflation in recent years. This was preceded by significant savings in expenditure, particularly travel costs. The Bureau will continue to work on reducing expenditure even further and using it more effectively. These measures should gradually bring the finances back into positive figures.

Uwe Borchert, Treasurer General of FICPI, and Managing Partner of Puschmann Borchert Kaiser Klettner Patentanwälte Partnerschaft mbB in Germany

FICPI Country Report 2023

A “Country Report” survey was sent to FICPI delegates and alternate delegates on 7 July 2023 with a request for responses by the end of July 2023. The regular annual survey aims to obtain up to date information in relation to the activities of each national/regional group (Section A), as well as changes of law/practice (Section B) and other IP development of general interest (Section C)



The information gathered is designed to be of assistance to FICPI committees, helping them to carry on their work in a way that better suits our members. The information supplied in Section A will be kept confidential on FICPI’s website, while the information supplied under Sections B and C will be published on FICPI’s website and will be available to the public.

We are particularly thankful to delegates or alternate delegates from the following countries/region who sent responses: Andean Section, Argentina, Australia, Austria, Brazil, Canada, Chile, China (partial only), Czech Republic, Finland, France, Germany, Greece, India, Ireland, Italy, Japan, Mexico, New Zealand, Portugal, Romania, Singapore, South Africa, South Korea, Spain, Sweden, Switzerland, Turkey, and United Kingdom. Most of the larger national/regional sections managed to have meetings during the year.

The Australian, Italian and South African associations have all taken steps to amend, or consider amending, their statutes to open up membership or to make it easier to join FICPI.

Relationships with local IP authorities

Most national/regional groups report good or cooperative relationships with local IP authorities, while three regions report that the IP Authorities are generally uncooperative. In this case it would appear that the local IP Authorities do not appear to understand or appreciate the extent to which local IP practitioners could assist local businesses, making lobbying work in those regions even more important.

Several national/regional groups were active in making submissions to local IP authorities or law makers, particularly in Australia, Austria, Canada, Germany, India, Spain and Sweden. One country reported that mechanisms for providing such input are not available. It was pleasing to see that many national/regional groups have provided copies of FICPI resolutions, or at least relevant resolutions, to the local IP authorities. There might be an opportunity for some national/regional groups to use the resolutions as a means for improving engagement, even in circumstances where the resolutions are not directed to that particular authority.

Fuelling future FICPI resolutions


Some good suggestions were provided for potential future resolutions which will be considered by the CET, for example in connection with compulsory licences, incremental pharmaceutical inventions, patentable subject matter, amendments after requesting examination, divisionals after non-final rejection, and non-qualified practitioners.

Membership numbers have remained relatively static or have slightly decreased. Argentina, Australia and Ireland have reported increases. The reasons given for membership reductions include retirements, rationalisation of expenses and high membership fees. As ways to attract more members, some national/regional groups suggest direct contact, conferences, seminars, webinars and training courses to attract new members. Austria appears to be the only country that restricts membership of trade mark attorneys.

With regard to smaller national groups, there appears to be a difficulty in organising local activities, in common with other voluntary organisations. It is also noted that without local activities it can be difficult to attract new members. The New Zealand group recently invited a US member, **Robert Katz**, to give a presentation at the NZIPA AGM in an effort to promote FICPI and attract more members. Respondents provided a good range of topics of interest to their members that could be the subject of seminars or presentations that could be used to raise the profile of FICPI.

A suggestion from Sweden was that FICPI should provide all national/regional groups with a summary of the answers provided to the various questionnaires they are asked to complete.

1 EXCO/UK23/BUR/007-1



2023 COUNTRY REPORT QUESTIONNAIRE

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October 2023

STRENGTHENING THE PRACTICE OF THE INDEPENDENT IP ATTORNEY
www.ficpi.org

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Recent law and practice changes

In Sections B and C of the questionnaire the national/regional groups provided summaries of recent law and practice changes, as well as of recent case law. This information will be made available on the FICPI website shortly. One development of particular concern is in Romania where there is draft legislation that would allow a lawyer who is not specialised in IP to act as a patent attorney.

IP Offices and advisory services

Unfortunately many countries/regions still report that IP Offices do not promote the use of IP professionals to users, with some offices suggesting to users that they do it themselves.

Some IP Offices provide advisory services to users that goes beyond the provision of

information. Only Canada, Finland, India, Ireland and South Africa report that their IP Offices do not provide such services. It is concerning that many IP Offices allow practitioners who are not qualified to practice in the jurisdiction to represent applicants, local and/or foreign, to obtain IP rights. This highlights the ongoing importance of FICPI meetings with IP Offices, resolutions and position papers that are shared with IP Offices.

Impact of the Covid-19 pandemic

Most national/regional groups report that the Covid-19 pandemic has resulted in permanent changes to daily professional practice, particularly with respect to working from home and hybrid work patterns, which appear to have become the norm.

Use of Artificial Intelligence

From the responses to the questions relating to AI, it appears that there has not yet been significant uptake in relation to AI-based technologies that help practitioners service the needs of their clients. However, in Brazil there is a report of its use to assist translations and the Andean region mentions its use in translations and checking grammar. China reports some attempts to use AI technology but the quality of output has not been satisfactory. Korea reports extensive development and trial of AI technologies by KIPO, and the use of AI-based search systems.

FICPI members may read the full report online at: <https://ficpi.org/node/21155>

Michael Caine, Vice President of FICPI International, and Principal at Davies Collison Cave in Australia



The reasons for the incorporation of FICPI and recent changes to the Statutes

FICPI is presently an unregistered association under Swiss law and its seat is Basel in the canton Basel-Stadt. FICPI wants and needs to remain a Swiss association and maintain the seat for several reasons. The status of being an unregistered association wasn't a significant problem 20 years ago, but being an unregistered association is now causing FICPI increasing challenges to allow it to act and fulfil its tasks nowadays due to money laundering laws and other requirements.

Therefore, FICPI needs to achieve the status of a registered association, and in order to fulfil the requirements for registration, the Statutes had to be adapted to nowadays Swiss law and practice.

The amended Statutes were adopted at the London ExCo in 2023, and these Statutes are considered to be acceptable for registration by the relevant Commercial Register of Basel-Stadt except for one issue, namely that the threshold for requesting a meeting of the Executive Committee needs to be lowered. The corresponding amendment will be put before the ExCo in Goa for adoption to pave the way for registration.

Additionally, proposed amendments of the Statutes regarding shortening the deadline for presenting amendments of the Statutes and adapting the Code of Conduct to current practice will be presented in Goa.

Jürgen Schmidtchen, Elected President of FICPI-International Statutes Committee, and Partner at Kramer Barske Schmidtchen Patentanwälte PartG mbB in Germany





Interview with ExCo first timer: Sini-Maaria Mikkila

How long have you been involved with FICPI?

I'm not completely sure, but I believe I've been a FICPI member for around five years. I joined the Practice Management Committee and the Study & Work Group CET 3 (International Patent Matters) in Spring 2022 and became the Finnish alternate delegate at the start of 2023.

How did you get involved initially?

I was a member of The Association of Finnish Patent Attorneys. Active FICPI members in our group shared how FICPI works and about its various committees at a meeting. Kim Finnilä was seeking Finnish participants for CET 3 preparations, but somehow I ended up joining CET 3 directly. I'm someone who gets interested in many things, and the Practice Management Committee's work resonated with me, especially as someone experienced in Process, SW Tool, and Quality Management. When our previous alternate delegate stepped down, she recommended me for the role, and the Association of Finnish Patent Attorneys chose me.

Which special roles do you have within FICPI e.g. sit on committees, EXCO delegate, etc?

I began as the Finnish alternate delegate at the start of 2023. I'm also deeply involved in the PMC, which I find extremely engaging.

Additionally, I'm a member of CET 3. I've had some technical issues, so my participation there hasn't been very active yet, but I expect this to improve now that I should be on all the distribution lists.

How was your experience of your first ExCo?

It was incredible. I'm interested in both the big picture and the details, including the business aspects, and I found the ExCo discussions very engaging. Initially, I was a bit nervous sitting at a large table with members from so many different countries, but also very excited. I learned a lot about FICPI and the state of IPRs in various countries. The best part was meeting colleagues from all over the world. I feel very fortunate and honoured to have been part of it.

What were the highlights/what did you find particularly interesting?

The discussions about FICPI's work and committees were the best part. The resolution discussions were also fascinating. But the absolute highlight for me, apart from meeting colleagues in person, was the AI workshop. This is a topic I find incredibly intriguing, and I believe we're in a very exciting era of technological development. I also thoroughly enjoyed the Open Forum after the ExCo, with its interesting presentations, topics, panel discussions, and the opportunity to meet more international colleagues. I must say I loved every part of it.



<https://ficpi.org/join-ficpi>

FICPI - GLIPA MoU signed at the London ExCo

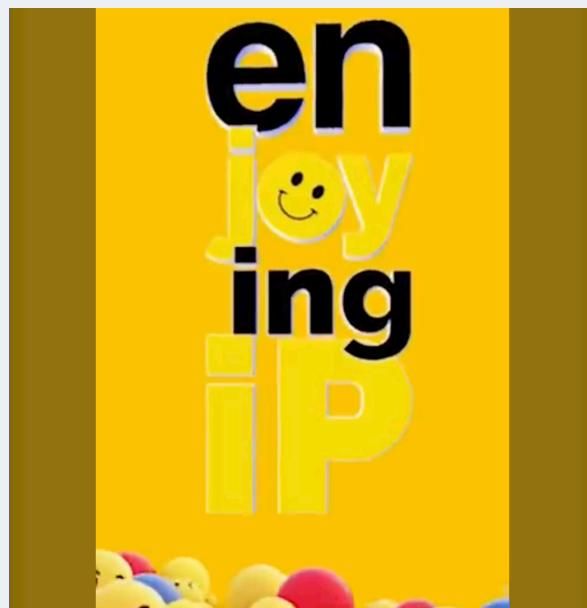
On October 3, 2023 during the FICPI London ExCo, the Global Intellectual Property Alliance (GLIPA) took a significant step forward by signing a Memorandum of Understanding (MoU) with FICPI.

The Global IP Alliance was formed in October 2022 and is an independent, non-profit, diverse group of collaborative volunteers united in their belief in the power of IP to transform everyone's lives, everywhere. GLIPA now has over 300 active volunteer members from more than 63 countries.

At the signing ceremony, GLIPA Executive Director, Maria Fernanda Hurtado, joined hands with FICPI President, Roberto Pistolessi, to formalise the collaboration.

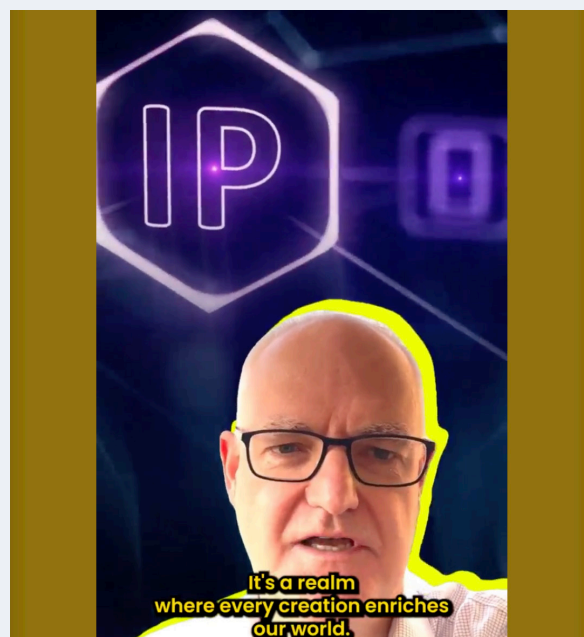
Maria said, "This partnership opens up exciting possibilities to strengthen the global IP community and expand the network of collaboration opportunities around the world. Together, we're set to embark on a journey of innovation and excellence!"

<https://www.glipa.org>



The GLIPA video series "Enjoying IP" can be found on LinkedIn. The series recently featured Julian Crump, President of FICPI 2018-2022 and the GLIPA Board Member from the United Kingdom and European Region Vice Chair.

Julian is actively seeking colleagues from the IP "ecosystem" in Europe who would like to give something back and take a lead in their own countries. Do get in touch with him if you are interested in getting involved!



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

The programme of the 2024 FICPI Executive Committee Meeting in Goa, India, begins with an opening reception at the Poolside Lawns, Taj Exotica, on Saturday, 16 March 2024.

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

On Tuesday (19 March), both Delegates and Delegates' Guests are 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 ends on Wednesday (20 March) with the last ExCo working sessions in the morning.



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'.

Pre-register at: <http://eepurl.com/iBffsU>



MARCH 2024

FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN



EXCONEWS

Scenes from the 21st Open Forum in London, 2023



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