



FÉDÉRATION INTERNATIONALE DES CONSEILS  
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF  
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION  
VON PATENTANWÄLTEN

FICPI Historic Event  
8<sup>th</sup> Open Forum  
Venice, Italy  
6-9 October 2004

## 8<sup>th</sup> Open Forum Venice, 6-9 October 2004

The session subjects have been chosen to be topical, practical and relevant to day-to-day practice.

Three series of seven topics of current interest in Patents, Trademarks and General Issues will be presented concurrently in English. You, the delegate, will have the choice to attend during each session the seminar which is of most interest to you.

Less than a half of the time in each session will be devoted to formal presentation. Ample time will be available for questions, comments and discussions.

The Forum will conclude with a short Session on "What is FICPI?".



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## WORKING PROGRAM

### DAY 1

THURSDAY, 7 October 2004

TRADEMARKS	PATENTS	GENERAL
<p>1.1 – Official Searching There is a trend for Governments to legislate against official searching by examiners before registration. The Community Trade Mark is an example. What does this do to the trade mark registration system in the countries concerned? What might work in a first to file country may not work in a common law jurisdiction. What would motivate a trade mark owner to apply when the registration has no presumption of validity - why not rely on common law rights? This issue will be debated by international trade mark owners and professionals. Moderator: David Griffith (AU)</p>	<p>2.1 – Reach Through Claims What are they? When are they be used? In what circumstances are they valid? Moderator: Leonard Svensson (US) Speakers: Michael Caine (AU) Dr J C Gaal Marian Flattery (GB)</p>	<p>3.1 – Discovery In many countries, a Court may order discovery of documents. What documents are discoverable? What is the purpose? When is it required and how broad can it be? How does one go about a discovery process? What of national borders? How can one limit the potential damage? Are fishing expeditions possible? Moderator: Terry Johnson (GB) Speaker: Hon. Justice James Allsop, Federal Court of Australia Brian Buss (US)</p>
<p>1.2 – Logos The searching of logos can be most difficult and time consuming. Our team of experts will provide guidance on the system for classifying aspects of logos and designs. Moderator: William Stonehouse (GB) Speaker: Rodney Cruise (AU)</p>	<p>2.2 – Covering the Invention in the New EC Countries A number of new countries have now joined the EPC but when national patents are granted, how will the Courts handle litigation? Will it be a similar struggle as experienced in the past with Courts trying to hold on to existing doctrine? Experts from a representative group of these countries will provide insight to this question.</p>	<p>3.2 – Privilege What is the difference between privilege and confidentiality? What documents do they cover and in what circumstances? Can privilege and confidentiality extend beyond national borders? Is there a use in trade mark litigation? What adverse inferences arise when privilege is invoked by a party? What is proposed for Canada? France has now introduced a new law providing privilege. How</p>



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	Moderator: Josef Smola (CZ) Speakers: Jüri Käosaar (EE) Eva Somfai (HU) Marek Lazewski (PL)	does it compare with that in other countries? and to whom does it extend? Moderator: Bill Edgar (CA) Speakers: Greg Chambers (AU) Eric Le Forestier (FR)
1.3 – US State Trademarks A trademark can be registered in some States of the United States. But in what circumstances? How useful is such a registration? Is there a use for this system? Moderator: to be advised	2.3 – Impact of PCT Changes Amendments to the PCT were implemented earlier this year. What were the amendments and how do they affect the professional and his client. What is the next stage in the development of the PCT? What future amendments can we expect? Moderator: J. Modin (SE) Speakers: Francis Gurry, Deputy Director General, WIPO Larry Welch (US) Nathalie Tremblay, CIPO	3.3 – Compensation for Creators In some countries, there are provisions to compensate inventors but not in all. What is the fair and equitable position? Similar considerations might well apply to the creators of copyright and trade dress/marks. Moderator: Robert Mitchell (CA) Speakers: Daniel Alge (AT) Mamoru Takada (JP) Anna-Lena Wolfe
1.4 – US and Madrid The US is now a member of the Madrid Protocol. What is the experience to date? What use is being made of it by the larger corporations? Moderator: Coleen Morrison (CA)	2.4 – Information Disclosure Statements A form of disclosure of Information or of search results is required in several major countries. What is required in the United States of America, Japan and Australia, and how can this be managed properly? What are the deadlines and what must be given? Moderator: Kazuaki Takami (JP) Speakers: Jon P Santamauro (US Attaché to the WTO) Dr Daniel Coughlin (US)	3.4 – Searching in the Computer Age The existence of Electronic Data bases should make prior art, infringement and registrability searches much easier and more reliable, but is this the case? An experienced panel of searching experts will explain the new problems, deficiencies and pitfalls. What onus does the profession bear? Do the warnings in your letter qualify the advice such that the opinion is meaningless? How do you report in a manner acceptable to both client and insurer? Moderator: Rodney Cruise (AU)



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	Stephen Krouzecky (AU)	Speakers: R. Danny Huntington (US) Erin Dunston (US) Mr Alan Talboys (EPO)

## Day 2

### Friday 8 October 2004

TRADEMARKS	PATENTS	GENERAL
<p>1.5 – Prior Use in a First to File Jurisdiction</p> <p>A client familiar with the first to use trade mark systems may well ignore the dangers of failing to register in a first to file country. Is there a remedy when a competitor registers or tries to register the mark in such a country.</p> <p>The position will be explained in circumstances where the mark is a well known mark or not so well known and not used in that country and where it has been used in that country.</p> <p>Moderator: Andrew Parkes (IE)</p>	<p>2.5 – Drafting Claims for the United States</p> <p>What form of claiming is best for the different circumstances that exist such when the invention is a process, product by process, composition, substance, new use of a known substance or device, mechanical contrivance, combination of known integers, business method, electronic circuit and so on. What should the claim look like for these various aspects of invention?</p> <p>Moderator: Leon Allen (AU)</p> <p>Speakers: Ray Stewart (US) The Hon. Paul R Michel, Circuit Judge (US)</p>	<p>3.5 – IP Auditing and Due Diligence</p> <p>Clients must include IP in any due diligence. More and More patent professionals are required to analyse an IP portfolio and advise on it. This is made easier if the company has a sound IP policy. Patent professionals are also being required to provide an IP Audit. How does one go about an IP Audit or due diligence investigation? What liabilities are there?</p> <p>Moderator: John Orange (CA)</p> <p>Speakers: Petter Rindforth (SE) Paola Cirone (ZA)</p>



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<p>1.6 – Domain Names</p> <p>The expansion of the country code system and its implications should be understood by all practitioners. Dispute resolution procedures have developed. What is the recent experience? What do we expect the system to develop into? Are things going in the right direction?</p> <p>Moderator: Jonathan Cohen (CA)</p>	<p>2.6 – Drafting Claims for the United States – Workshop</p> <p>Moderator: David Carmichael (AU)</p> <p>Panel: The Hon. Paul R Michel, Circuit Judge, Court of Appeals for the Federal District (CAFC), (US) Willem Schuurman (US)</p>	<p>3.6 – Tendering for Patent Attorney Services – a view from Industry</p> <p>Forming new relationships and maintaining the old, in particular in recent times, more and more clients are opening their IP work to tender, sometimes generally but more often to selected associates. How does one go about responding to such an offer? Either from an existing client or someone you have not dealt with before. What questions should you ask someone you have not dealt with before? Is price the governing factor? What role does quality play?</p> <p>Moderator: Malcolm Royal (AU)</p> <p>Speakers: Ron Myrick (US) C. Gregory Gramenopoulos (BE) Richard Summersell, Astra Zeneca</p>
<p>1.7 – Graphical Trademarks and Designs</p> <p>There is a potential overlap between graphical trade marks, designs and copyright. Does this bring problems to creators and third parties. What is the position? Who benefits? Who is harmed?</p>	<p>2.7 – Equivalence</p> <p>The Festo case has been decided. What has happened since? What is the situation in Europe and other countries? Does Pith and Marrow or purposive construction provide the same result as</p>	<p>3.7 – Traditional Knowledge</p> <p>WIPO is very active in promoting traditional knowledge issues. What inter-relationship is there with standard forms of IP? What does the practitioner need to be aware of in day-to-day</p>



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<p>Moderator: to be advised</p> <p>Speakers: Robert Katz (US) Imogen Wiseman (GB)</p>	<p>equivalence?</p> <p>Moderator: Arild Tofting (NO)</p> <p>Speakers: Judge Alfred Keukenschrijver, Federal Supreme Court (DE) Judge Michael Fysh (GB)</p>	<p>practice?</p> <p>Speakers: Francis Gurry, Deputy Director General, WIPO Bastiaan Koster (ZA)</p>
		<p>Session 3.8</p> <p>What is FICPI?</p> <p>Moderator: Malcolm Royal, Convenor of Council</p> <p>Presenter: Philip Coyle, President of Admissions Commission</p>