



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

FICPI Historic Event
9th Open Forum
Lisbon, Portugal
2-5 November 2005

9th Open Forum Lisbon, 2-5 November 2005

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.



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WORKING PROGRAM

Thursday 3 November 2005

DAY 1

TRADEMARKS	PATENTS	GENERAL
<p>1.1 – Trade Mark Registration in Europe</p> <p>Madrid Agreement, Madrid Protocol, Community Trade Mark, National registration – which is to be preferred or is a combination the best course? What circumstances dictate the decision? What are the respective costs? How does one search for conflicting marks? Can a watch be placed on filings for similar marks? The protocol/CTM link has been available for one year now. What is the experience so far?</p> <p>Moderator: Hans-Peter Lieck (DE) Speakers: Petter Rindforth (SE) Elia Sugranes (ES)</p>	<p>2.1 – Secret Prior Art</p> <p>This situation sometimes arises where there is an application or patent that has a priority date earlier than a similar application or patent under consideration but is not published at the priority date of the record. Is the second applicant entitled to a patent in any form? What rules apply in relation to novelty and inventive step? What if the earlier is an international application under the PCT but which is in time to but has not yet entered the National Phase? We seem to have moved from the old prior claim situation. What does "whole contents" mean? What is meant by "expanded novelty" in this context? This topic will be explored by experts from the major jurisdictions.</p> <p>Moderator: Gert Schmitt-Nilson (DE) Speakers: Arild Tofting (NO) David Merryless (BR)</p>	<p>3.1 – Strategic Planning</p> <p>Do you believe your prime focus is servicing domestic clients but spend all your business development budget on international conferences? Do you make a decision at one meeting and a contrary one at the next? Do you hire a new practitioner and then look for clients that match his skill set? Maybe a strategic plan is the answer. When used properly, such a plan will set a road map to ease the day to day management and provide consistency in decision making. The panel will describe the process of developing a plan and how it may be used.</p> <p>Moderator: Mike Kirk (US) Speakers: Markus Hossle (DE) Ed Wesemann (US)</p>
<p>1.2 – Trade Mark Opposition Practice/Outcomes</p> <p>Should one oppose or seek revocation of a mark once registered? The position may vary throughout</p>	<p>2.2 – Nanotechnology</p> <p>Small but potentially powerful, nanotechnology may be the next evolution in patentable subject matter.</p>	<p>3.2 – Career Development</p> <p>Professionals are more mobile than in the past. Firm first, family second is no longer an acceptable</p>



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<p>Europe and North America. Does it depend on the basis of the complaint? Our panel will discuss the wisdom of alternative courses of action. What if you will be infringing on registration? Is there a difference between first to file and first to use countries?</p> <p>Moderator: Petter Rindforth (SE) Speakers: Gonçalo de Sampaio (PT) Robert Rippe (US)</p>	<p>What is it about? What different issues arise? What range of traditional technology is involved? Eg. polymers, electronics. Who are the experts?</p> <p>Moderator: Eric Le Forestier (FR) Speakers: Patricia Rae (CA) Alexander Esslinger (DE) Adelhart Kruger (ZA)</p>	<p>mantra for the young professional. How do you meet this new reality and set an attractive but realistic career path. Are flexible hours and work at home viable alternatives? What selection criteria do you apply for recruiting and how do you maintain an environment where the grass on your side of the fence is always greenest.</p> <p>Moderator: Leon Allen (AU) Speakers: Peter Perry (GB) Hermann de Haan (NL)</p>
<p>1.3 – Trade Mark Enforcement in China</p> <p>It is one thing to register a trade mark but another to enforce it. China is a huge and somewhat diverse country. Many believe it is difficult to trace the source of counterfeit goods and also difficult to enforce rights without the manufacture moving elsewhere very quickly. Is this true? An expert and experienced panel will explain the position and help us to advise on the issue of counterfeiting in China.</p> <p>Moderator: Ai Ming Lee (SG) Speakers: Ge Bo (CN) Vivien Chan (CN)</p>	<p>2.3 – Medical Use Claims</p> <p>It is not uncommon that a pharmaceutical substance developed for one use is found to have another important use. Can a patent be obtained for this? Does it depend on whether this second use is unexpected or could be anticipated given experience with other pharmaceuticals. Can one obtain protection for the separated isomers? Is a pro-drug patentable? How can these be claimed? Many millions are spent in developing new diagnostic methods and equipment. Equipment such as ultrasound, magnetic resonance imaging (MRI) can be patented but what of techniques for diagnosis that do not require new equipment? Are these patentable and should they be?</p>	<p>3.3 – Partnership Structures and Management</p> <p>Managing a group of professionals has been likened to herding cats. Each partner is an owner, highly entrepreneurial and self motivated. Ultimately difficult decisions must be made to determine relative remuneration, recognition of success, balancing contributions, retirement and even which office to allocate. Different firms deal with this in different ways. Benevolent dictatorship works for some, consensus for others, rigid formulas for yet others. The panel will discuss different approaches to meet this onerous task.</p> <p>Moderator: Danny Huntington (US) Speakers: Nick Dougan (GB)</p>



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	Moderator: Len Svensson (US)	Claes Pantzar
<p>1.4 – Trade Mark Use</p> <p>What extent of use is necessary to maintain a trade mark? Is there a need for a geographical spread? Does use by a licensee count? What if an infringement continues unchecked over a period of time? Does it make any difference whether this was known or unknown to the proprietor?</p> <p>Moderator: Andrew Parkes (IE) Speakers: Toni Polson Ashton (CA) Fabrizio de Benedetti (IT)</p>	<p>2.4 – Loose Lips may prejudice Patents. Estoppel - does Privilege protect you?</p> <p>What is said in the USPTO prosecution is clearly relevant but how relevant is what is said in prosecuting the equivalent application in other countries or in litigating an equivalent patent. Can what you say in other applications, in the same technical area, be taken into account (such as admissions of prior art)? Reporting office activities in other jurisdictions.</p> <p>Moderator: Raymond Stewart (US) Speakers: Michael Caine (AU) Christof Keussen (DE)</p>	<p>3.4 – Staffing an IP Practice</p> <p>The IP practice is driven by procedures and paperwork. Appropriate staffing levels and skill sets are required to maintain control of the mountain of paper. What is the role of paralegals, how many secretaries are needed for a professional, how can new technologies help and how does the human resource manager provide training, mentoring and skill upgrading.</p> <p>Moderator: Claus-Michael Mayr (DE) Speakers: Geraldine v Gagyi (AT) Mark B Wilson (US)</p>



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DAY 2

TRADEMARKS	PATENTS	GENERAL
<p>1.5 – Trade Mark Licences, and Exhaustion of Rights in Licensed Goods</p> <p>What are the essential elements to include in a trade mark licence? Should there be inspection on quality? A specified term? An ability for the proprietor to cancel the arrangement? Joint or sole or exclusive use? Can a common law trade mark (unregistered) be licensed? Can the licensee's territory really be limited or will the licensed goods be free to travel into other territories? What is the current state of the law on exhaustion of rights ("grey goods"), within the EU and internationally?</p> <p>Moderator: Miguel O'Farrell (AR)</p> <p>Panel: Judge Michael Fysh, QC SC (GB) John Hardaway (US)</p>	<p>2.5 – Comparative Claim Drafting</p> <p>What are the different techniques in drafting claims for the US and Europe? What are the requirements and how strictly are they enforced? What is meant by the jargon terms "two part claims", "Jepson", "Markush" for example? How would the same language be construed for infringement in the two jurisdictions?</p> <p>Moderator: Axel von Hellfeld (DE)</p> <p>Speakers: Len Svensson (US) Leo Jessen (NL) Robert Katz (US)</p>	<p>3.5 – Financial Structures</p> <p>Ultimately the cost of providing a service must be related to the fees charged. What is the realistic cost of sending a reminder and where is it recouped? How do you analyse expenditures and equate them with revenues? What information is hidden within the balance sheet and what forensic techniques are available to assist in this analysis?</p> <p>Moderator: Frédéric Gaillarde (FR)</p> <p>Speakers: Keith Beresford (GB) Michael Roch</p>
<p>1.6 – Certification Marks and Appellations of Origin</p> <p>Is there a difference? What is required for a certification trade mark. What is necessary to maintain the registration. Is it necessary to have competition authorities examine the conditions? What is an appellation of origin? Under what</p>	<p>2.6 – Exemplary Damages/Wilful Infringement</p> <p>Exemplary damage awards in the US are a significant burden. What can be done to limit the risk? How are they determined? How should negative advice be given? Is the advice discoverable in an action claiming exemplary damages? What interferences can be drawn if</p>	<p>3.6 – "The IP Boutique is dead, long live the IP Boutique"</p> <p>Multidisciplinary practices have been heralded as the future for IP but it seems as many fail as succeed. What are the challenges in integrating an IP practice within a larger firm? How do IP firms differ from general law firms, what</p>



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<p>conditions is use allowed? Is this a form of traditional knowledge protection? Are wine making techniques, such as champagne, traditional knowledge and also an appellation of origin? Are cheese or wine making techniques, passed from generation to generation, traditional knowledge? Moderator: Francis Ahner (FR) Speakers: Bastiaan Koster (ZA) John Sutton (US)</p>	<p>privilege is claimed? Moderator: Daniel Alge (AT) Speakers: Willem Schuurman (US) Roderick McKelvie (US) Frank-Erich Hufnagel (DE)</p>	<p>challenges exist with multi jurisdictional firms to resolve conflicts of ethics and culture? What steps can and have been taken to ensure success in these arrangements? Moderator: Udo Preuss (DE) Speakers: George Fisk (CA) Nachman Cohen-Zedek (IL)</p>
<p>1.7 – Spare Parts How does one protect spare parts? Use of trade marks? What about coverage for original products also capable of being spare parts? What of inferior parts, product liability and warranties? Moderator: Robert Mitchell (CA) Speakers: Greg Chambers (AU) Gerhard Bauer (DE)</p>	<p>2.7 – International Treaties The US has entered into Free Trade Agreements with a number of countries such as NAFTA, US-Australia Free Trade Agreement and US Singapore Free Trade Agreement. Also TRIPS is relevant. What are the enforcement mechanisms to ensure compliance of the parties? To what extent can a country's obligations under International Treaties be used in actions before National Offices where practice is contrary to the Treaty obligations of that country? Moderator: Bill Edgar (CA) Speakers: Adrian Otten, WTO Jeff Kushan (US) Dr. José Luis Arnaut (PT)</p>	<p>3.7 – Risk Management Internal operations can create profitable and efficient practices but also introduce potential liabilities. IT is a growth industry requiring continuous supervision and management. File management, or lack thereof, can cause major inefficiencies and email has compounded the problem. How is quality maintained and is a structured quality control system, such as ISO, the answer. What do insurers look for in best practices to mitigate risk? Moderator: Noel Brett (AU) Speakers: Paul-Alexander Wacker (DE) Alan Senior (GB)</p>