AI: transforming lives and law

At the packed artificial intelligence panel yesterday morning, Sean Murphy, CEO of US software company PingThings, shared disheartening news: “Most experts can’t even agree what AI is,” he said, adding that patent attorneys supposedly to make headway?”

AI already matches or exceeds many measures of human intelligence – such as IQ tests, image recognition and video games – and the algorithms are only becoming more sophisticated with time. Murphy said the best way to look at AI as a prediction tool. Fundamentally, it takes data you have and outputs information you don’t have.

Xiaoli Wu of Baidu shared that his company’s AI-powered facial recognition platform has helped unite separated families. Many children have been lost in China, and Baidu’s program can connect adult children whose faces have changed with their parents who wouldn’t have been able to recognise them on the street.

Sam Kherat of Bradley University shared that a person’s AI-powered facial recognition platform has helped unite separated families. Many children have been lost in China, and Baidu’s program can connect adult children whose faces have changed with their parents who wouldn’t have been able to recognize them on the street.

Vincent Spinella-Mamo, IP counsel at self-driving car startup Zoox, assured the audience that autonomous vehicles solutions are underway, though patenting improvements in the technology is a slower struggle. Specifically, he cited Sections 101 and 112 in the US as common grounds he has encountered for refusal and invalidation.

As counsel for a company that files AI-related patent applications, Spinella-Mamo had some pointers for the process. “Yes you have to give away your algorithm in your application, but I think we can have our cake and eat it too, because you don’t have to go into detail about the entire network architecture,” he said.

On the other hand, Bea Koempel-Thomas of Lee & Hayes cautioned against leaving too much out of the specification, at least in the US. “The USPTO is looking for more detailed patent applications, because examiners need to see how things are done. It’s not enough to say ‘machine learning does it’, or ‘AI does it’,” she said.

What a person skilled in the art is reasonably expected to know is constantly changing, so Koempel-Thomas encouraged applicants to include as much detail in the specification as possible, just in case. “At least cite a paper to get known technology on the record, so that you can then really focus on the novelty aspect,” she said. If you’re not ready to disclose that much information, consider keeping it in a trade secret.

Hei Pihlajamaa of the EPO stressed that AI is not likely to change the patent system drastically, as some at the World Economic Forum have proposed. “Patent law has survived three industrial revolutions so far,” she said, “and now we’re talking about the fourth.” Of course there are some unique considerations with AI. Can AI invent? Who is liable for AI’s mistakes? But Pihlajamaa expressed confidence that they could be dealt with case by case, and without any kind of special designation for AI-related patents.

Spinella-Mamo at Zoox agreed, saying: “It’s just like any other tool.”

For now, the biggest hurdle is getting AI-related inventions patent-eligible. Kherat said: “I would like to see an improvement in software being patentable, rather than just the apparatus. Right now we hide behind patenting the apparatus features – the physical part of the idea – and this is a loophole we will use until the law is changed.”

Spinella-Mamo recommended that patent applicants really emphasise the inventive aspect of their invention, and downplay the role of AI. If the invention is a genuine improvement and that improvement is framed in the right way, it will not necessarily be ineligible just because AI is involved. This is especially true in China. Bin Chen at the Shanghai Patent & Trademark Law Office explained: “Years ago we did not protect computer programs, but currently we are more open and it’s easier to get patent rights for AI in China. As usual, the practice is slower than the technology, but at least the Chinese government is more open in this area.” He concluded with the phrase: “If you face any problems in other jurisdictions, try China!”

The final issue the panel discussed was copyright. On one hand, copyright protection can be a great option to protect AI algorithms because it is cheap, fast and they can overlap with patent rights seamlessly.

On the other hand, establishing that AI is unique and eligible for copyright protection is tricky because so much development uses open source technology. Murphy at PingThings concluded: “All of the best stuff is open source. By using open source, you’re expanding your workforce 1,000 times. Some companies develop something independently for a very specific task that is core to their business, but the general wave is going to remain open source. This has played out in every space AI has touched so far.”

The band who must not be named

Lunch with the Slants got off to a rockin’ start yesterday afternoon. The group performed several songs while appetisers were served, and continued intermittently through the meal and the presentations.

Simon Tam, Asian-American bass guitarist and trade mark rock star, told the story of his band, who they are, and how they got to the Supreme Court last year. “It all began in 2011,” Tam started, “in a maximum security prison.”

The prison asked his band The Slants to perform there, and at first they were excited for their “Johnny Cash at Folsom Prison moment”. But they were an all-Asian band going to a prison with one of the highest populations of neo-Nazis in the country, the danger of which didn’t sink in until Tam was approached by a group of shirtless, tough-guy prison guards.

Continued on page 3
Resolution ahead of diplomatic session

The Standing Committee on Enforcement passed a resolution yesterday on judgments. The issue of interest because AIPI has been invited to provide input on an important project. The Hague Conference on Private International Law is working to develop a convention on the recognition and enforcement of foreign judgments. The most recent text of the draft Convention contains important intellectual property issues. With input from the Standing Committee on Enforcement, AIPI wants to develop a detailed position in order to be able to contribute to the debate on this important topic, including at the Diplomatic Conference anticipated to take place in 2019.

Reporter General Sarah Matheson made the case why it was urgent for a resolution to be passed. “It is a credit to AIPI and its standing that we are being invited to participate in this process, and the outcome from this process is being closely watched,” she said. “We have timing issues around this process because there will be a diplomatic conference, and our most recent information as of a week ago is that it is expected in the middle of next year.”

She added: “So in order to honour the trust that has been put in AIPI in relation to its participation in this process we are making sure we have this debate here in the hope we can pass this resolution and ensure that AIPI has a position to take forward to the diplomatic conference next year.”

The draft resolution under discussion had three parts. The most important is the first part, which states: “Intellectual property should be excluded from the scope of the Convention.”

This part was ultimately passed 61% in favour, 31% against and 8% abstaining. This was after some debate, however. The UK group came out strongly in favour. But the French group asked to amend the statement to say IP should be “within” the convention, with support from the German group. The French group commented that complete exclusion of IP is not a good message from AIPI to the Convention.

The second part of the draft resolution was eventually voted in with 80% in favour, 15% against and 5% abstaining. It recommends a wording of 2(c)(m) of the Draft Convention as well as removing the wording “analogous matter” from the section.

The third part of the resolution assesses what would happen in the event that IP is included within the scope of the Convention. Committee Chair Kenneth Adamo explained: “The way it is set up is that paragraphs one and two go together. Part three is there to provide a backstop if indeed the Convention decides to go in a different direction.”

The Australia group commented that the third part is pragmatic, and that AIPI can exert greater influence by stating what is acceptable in the event that it does not get what it would like in the first instance. The UK group said it was also persuaded that part three has a role to play, although it is not as vital as the first two parts.

The third part includes stating that a judgement ruling on validity and infringement of an IP right should only be relevant for recognition and enforcement if given by a court of a contracting state in which protection is claimed. The third section included seven subsections. After removing one subsection and a slight wording change to another, the third part of the resolution was passed 60% in favour, 31% against and 3% abstaining.

Standing Group Vice Chair Peter Damerell gave some more details of the Convention. It states that a judgement given in one state (the state of origin) should be recognised and enforced in another contracting state (the requested state).

“If IP is included, the May 2018 draft has various provisions to provide safeguards to take into account territoriality of IP rights,” said Damerell. “Judgments relating to infringement of IP rights will only be recognised and enforced under the Convention if given by a court of a contracting state and judgments related to validity will also only be recognised and enforced under the Convention if given by contracting state.”

He noted that the vast majority of disputes relating to IP rights are determined by national courts, and there are often specialised tribunals with differing procedures.

“There is great concern that the territorial nature of IP rights causes particular complications with these sorts of issues of international law,” he said, such as issues of jurisdiction, what laws should be applied, as well as the question of cross border enforcement. “A number of groups also made the point that the Convention is drafted as a matter of general application. Various attempts have been made to try and adapt it to the particular circumstance to IP rights. But a number of groups have expressed concern that there will still be loopholes that lead to unintended consequences and undesirable effects.”

At the end of the session the overall resolution was passed, with 63% in favour, 36% against and 1% abstaining.
Is quality or quantity best for SEPs?

A panel yesterday assessed how to maximise the value of standard essential patents (SEPs).

Judge James Roberst of the US District Court for the Western District of Washington, discussed whether quality or quantity was more important for SEPs.

"I don't think the debate is closed yet," he began. "One of the most fundamental principles in this area is that FRAND royalty rate needs to be connected to the value of the patent. That's the basic building block. It also one I think most people are in agreement with. When I say the value of the patent, I would measure that based on the contribution it makes to the applicable standard. What the patent does, either inside the standard or outside the standard, ought to be what determines the appropriate royalty."

Robart was the judge in the landmark Microsoft v Motorola FRAND rate-setting case in 2013. He advised the audience to read the lengthy opinion if they "want to be put to sleep easily". He added: "In terms of portfolio valuation, what we saw when looking at those 40-plus patents is there was in actuality a very limited number that had much relevance."

He explained one of the favourites of the Motorola patents was described by its engineer as one of the most significant advances that has ever been made. But then another expert from Google described it as worthless because it was out of date.

"That was the clearest example that throwing in a bunch of low quality patents and making a claim for a large royalty based on them, if anything, undermines your credibility with the court," Robart said. "So absolutely there is no question that it ought to be the quality of the patents."

Robart says of the elements that go into FRAND, the first one – fairness – "seems to be the battle ground". He continued: "What is a fair royalty? I think we need to frame a question of what does fair mean in that context. If it means are you getting fair value, a fair royalty for the contribution your patent is making, then that is one issue. If you define fairness as you are not going to invest in R&D unless you get paid back for it, that's a different question. I think that particular issue underlines the discussion."

Adrian Howes of Nokia in the UK discussed his company's strategy for maximising the value of SEPs.

"In developing a portfolio we consider is number of things," said Howes. "Probably the most foundational is: which standards do you invest in? Frankly speaking, you want to invest in a standard that is going to succeed because there are competing standards."

One consideration is when to declare a patent essential. Howes said some companies decide it is a good idea to declare earlier when it is not clear what the claims in the patents are. "That can potentially lead to more patents being declared essential than might have been the case. They might see that as a numbers game or as when they think it is appropriate to do so. We take a slightly different approach. We take a little more time before we declare because we want to make sure we are not declaring too much."

There is always going to be some over declaration because it is hard to tell which patents might be essential. The recent Core Wireless decision is also causing the company to rethink a little bit, said Howes. "We have to take it on board in our declarations. It is likely to lead to many more declarations [generally]," he said.

Another vital influence is having management support – licensing SEPs is a huge investment, both of time and money. "It's a 10 or 20 year exercise if you are going to generate any revenue off SEPs, and that's just a fact," said Howes. "It is an expensive exercise. It has cost us a lot of money in research. It has cost us a lot of money in getting the patents in the first place, a lot of money trying to negotiate licenses and even more money sometimes when unfortunately we have little choice but to enforce those patents."

"It has taken us well over a decade to start seeing any real licensing revenue returns. It hasn't stopped us because we believe in standardisation. We think it is extremely important, and it is definitely where technology is going."

Howes said Nokia is trying to put itself at the forefront of 5G because the technology hurdles are enormous, and the hopes for it are vast. "If it all works completely, it will change the way we deal with technology, and how the technology deals with itself."

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Partial designs’ rights in various jurisdictions are not currently harmonised. A Study Question on partial designs being debated today will consider the scope of protection for partial designs. One of the Responsible Reporters for this is Ari Laakkonen, AIPPI Assistant Reporter General and partner at Powell Gilbert. He says the idea of the resolution is to set out a regime for the protection of partial designs that provides for symmetry between infringement and validity, and therefore provides “more predictability for businesses”.

Partial designs are a natural evolution from AIPPI’s 2016 Milan Resolution on designs, Laakkonen explains. Laws on partial designs take different approaches in different jurisdictions, and in some jurisdictions there is less case law on specific aspects. This “suggests the need for harmonisation,” Laakkonen says. Forty countries responded to AIPPI’s Study Question.

Partial designs seek to protect the design of a part of a larger product. For example, just the handle of a pan could be claimed as a partial design, while the pan itself would be unclaimed and provides context. Questioned whether partial designs should be independently registrable, the vast majority of national and regional groups (95%) agreed that they should.

If they should be independently registrable, how can applicants identify them as partial designs? The most important part is to agree on an international standard to avoid confusion. AIPPI recommends using broken lines for the unclaimed part, and solid lines for the claimed part. Illustrations can also include circling, blurring, or colours showing the unclaimed part.

Laakkonen identifies the main issue that arises from the responses of the national and regional groups: “whether or not to take the unclaimed part into consideration” when determining validity and infringement. In Europe, designs must have “distinctive character” to be valid, and infringement is found when the “overall impression” of the accused product and the claimed design are not different.

If the unclaimed part is not taken into consideration and the piece – the handle, in this example – is protected as a partial design entirely on its own, infringement could easily be found in the multitudes of handles that are used in different types of products, but it also follows that the design could be invalidated by the multitude of handles in the prior art in various fields.

On the other hand, if the unclaimed part is taken into account and the claimed part is seen as the handle of, say, a pan rather than just a handle on its own, there would be less relevant prior art if that context is taken into account in relation to the prior art.

The idea that the unclaimed part should be relevant when assessing the overall impression is supported by a good majority of respondents. However, incorporating unclaimed parts into the consideration also makes it more difficult to establish infringement.

In the EU, there are several design constraints: must fit, must match, and technical function. Pieces of products that must fit or match the larger product, or that perform a technical function, are excluded from design rights’ protection. Laakkonen explains the logic: “It must fit, therefore you shouldn’t get design protection for that part of the design because there was no creativity involved in making it fit.”

In the pan handle example, the interface between the claimed part and the unclaimed part – the attachment mechanism that joins the handle with the pan – might not be covered by the handle’s partial design in the EU.

While these constraints are defined in the EU, Laakkonen says that similar constraints are not universally applied. These are just some of the many aspects to be hammered in today’s session. Laakkonen says the objective of a resolution would be “to suggest a possible harmonised model which is internally consistent and takes a symmetrical approach to validity and infringement”. He adds: “The goal is to harmonise a common approach so that one can file a design everywhere without having to modify the design registration for each individual country.”
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A busy year of changes for the Secretary General

“Much has been done, but in my view much more is to be done.” That is how Olga Sirakova sums up her first year as AIPPI Secretary General. “This year has been one of changes.”

Bulgarian attorney Sirakova serves as partner at Interius in Sofia. She has been involved with AIPPI for more than 20 years, and has held a range of positions at national and international levels in that time.

“If I had to define my time with AIPPI I would probably say it has been exciting and often challenging,” she reflects. “Now that I am Secretary General it is much more than that. It is actually my everyday life. Before and, of course, during the Congress it fills my every minute!”

Sirakova praises the work of all the Bureau members, and highlights the fact that they are all volunteers for the organisation. “We come from 15 different countries from almost all continents. You must really love AIPPI to dedicate all the time and effort that the Bureau members invest.”

She is quick to point out that she receives a lot back from AIPPI too. “It is a truly global organisation aiming to improve and promote the protection of all objects of intellectual property on both a national and international basis.”

Sirakova has an important job. Laurent Thibon served three years as Secretary General before she assumed the role. “We are constantly changing. I wouldn’t say it has substantially changed yet from my predecessor,” she says.

Siraková has implemented some changes in the past year and is continuing with them.

“One of my first tasks as Secretary General was to develop the teamwork and to further increase transparency and openness of the Bureau’s activities,” she says. “The Secretary General team including the Assistants are fully dedicated and committed to AIPPI members. We decided to assign concrete tasks for which the respective member is the primary contact and has the responsibility for the respective project.”

Sirakova is also focused on the development and improvement of AIPPI’s position, visibility and influence at a national and international level. “We ask international and regional groups to share their activities so that their best practices can encourage other AIPPI members. Although there is still a lot to do in this regard, it has been an encouraging new beginning.”

One challenging change during the year, reports Sirakova, was the increase of the subscription membership fees – the first increase in 10 years. “This opened discussions among the national groups including how best to use the financial resources we have, how to increase the membership, how to best promote AIPPI and what we could and should do. The Bureau welcomes and encourages these discussions,” she says.

Another important development was the hiring of the Executive Director. “The process of hiring Dr Arno Hold was a really exciting one,” says Sirakova. “We had more than 50 candidates from all over the world, from all different continents. He is an expert. His energy and qualifications will be a valuable asset to the organisation, we are quite confident about that.”

Looking to the year ahead, much is to be done. Sirakova says a focus will be to “look for new possibilities to make us more influential and attractive.”

She says: “I will keep developing the teamwork, and the improvement of the communication with the members and those who might become AIPPI members. There is rich potential in the national and regional groups. We all want to reveal it and to use it for the best of the IP community and not only. The special attention both AIPPI International bodies and its groups pay to the Young members needs to be further developed. We see a lot of potential in attracting more in-house members and make the best of their valuable input.”

The in-house counsel committee is making its first steps towards full operation. Sirakova also points out that one of the Bureau Assistants is an in-house lawyer.

Sirakova anticipates a number of other changes, following the amendment of the regulations. They include, among others, clear statement of the term of office of Bureau members.

“We will use all known possibilities and look for new ones to make AIPPI even more influential and attractive. This is a daily task in this dynamic technological development century.”

Interview

Doctrine of equivalents drift

Yesterday’s doctrine of equivalents session included an overview of how different countries treat this controversial topic.

Patrick Coyne of Finngan Henderson Farahow Garrett & Dunner in the US provided a whistle-stop tour through how it is treated in different jurisdictions. He noted that some countries’ approaches are based on peripheral claiming systems and some are based on central claiming systems.

“I would say that Germany and Central Europe tend to have more of a central claiming system: the judge decides what is infringement,” he said. “Whereas countries like Japan, the UK and the US tend to be more peripheral, the claims are supposed to define the fence, where the border is.”

Coyne then namechecked the Tokyo Drift installment of the Fast & Furious movie franchise, and how it applies to the doctrine of equivalents: “I would say Tokyo has drifted over the years, and it has gone more to a peripheral system. In contrast, the US has become much more central.

These differences present some issues. “There’s a problem when you go from a central claiming system and you take those claims and then put them in a peripheral claiming country. The judge in the peripheral claiming country then thinks you have defined the outer limits when you’ve just decided what the core was.”

The session also featured Judge Klaus Grabinski of the German Supreme Court, Richard Miller QC of Three New Square IP in the UK and Hideki Takaishi of Nakamura & Partners in Japan giving the perspectives from their countries. The doctrine of equivalents is an especially hot topic in the UK following last year’s AstraZeneca v Eli Lilly decision.

Takaishi also noted that Japan had recently had a case involving this issue at the Supreme Court. In March 2017, the court affirmed infringement under the doctrine of equivalents for a medicinal compound’s manufacturing process patent.

Given all the variance on how the doctrine is viewed, Miller was asked whether it comes down to just what someone in their gut thinks is fair. “There is something in it being an area where different judges would come to different conclusions,” he said, “but that is why we have judges.”
The Study Question “Conflicting patent applications” being debated today will examine what rules should apply when a patent application conflicts with an earlier application that has been filed, but has not yet been published.

In the majority of jurisdictions, patent applications are published 18 months after filing or the earliest priority date. During these 18 months, a conflicting patent application can be filed. As a result, according to the summary report: “The examining patent office must determine if and to what extent the first patent application may preclude patentability of the claims in the second patent application.” As the first application has not been published it is called secret prior art. In some circumstances, the same applicant (or partly the same applicant) files both the earlier and later application. If the earlier application blocks patentability of the later application by the same applicant, this is referred to as self-collision. Anti-self-collision rules stop self-collision.

Jonathan Osha, Responsible Reporter for this study question, explains: “The issue is treated differently in different jurisdictions. Currently a party might be able to obtain protection in one jurisdiction, but not the same scope of protection in another jurisdiction. It is quite a significant international issue.”

The majority of the participating groups (85%) were in favour of global harmonisation.

Improvements on current law
More than half of the participating groups stated that the law in their jurisdiction concerning the applicability of secret prior art did not need improvement. The other groups suggested improvements such as removal of requirements for applicability of secret prior art tied to publication in a particular language, clarity on the laws around same applicants and further information on PCT applications.

Most of the groups (70%) did not think that the patentability standard used to differentiate the secret prior art and later filed application needed improvement in their countries. The groups who did feel that their systems could be ameliorated suggested some of the following: utilising the same novelty standard for published and secret prior art, using secret prior art only for novelty but not for inventive step and employing terminal disclaimer.

A minority of the groups (30%) felt that the rules on international applications as secret prior art in their jurisdictions required improvement.

Different applicants
In cases where the applicants are not the same, 95% of the participating groups believed that secret prior art should be considered in the context of novelty. Furthermore, 90% of the groups said that the full contents of the secret prior art should be available, though Belgium, Portugal and Hungary were in favour of everything but the abstract being available. Paraguay and Belarus stated that the claims alone should be available. The majority of the groups said that they did not believe secret prior art should be used to show the absence of inventive step. Some groups such as the US, Ecuador and Panama, thought that it should be used for inventive step.

Most of the groups (65%) felt that national phase entry matters. The report says: “Generally, these groups believe secret prior art should enter the prior art only in jurisdictions where the national phase has been entered and the application has been published. The groups that believe entry into the national phase does not matter consider that secret prior art should enter the prior art globally once published, regardless of national phase entry and of where the publication occurred.”

Same applicant
In circumstances where the applicants are the same, 75% of the participating groups felt secret prior art should be available against a patent application filed afterwards in the context of novelty. The majority also said that the full contents should be available. Most of the groups (75%) disagreed with having an anti-self-collision time period. Four groups who were in favour of such a time period put forward a suggestion of 12 months. Osha explains: “Anti-self-collision deals with whether secret prior art should be prior art against yourself. It provides some protection. One argument in support is that the applicant would have the chance to file on incremental inventions. An argument against is that it makes patent law more complex when maybe it makes more sense to treat everyone the same.”

A large proportion of the groups (85%) did not believe that secret prior art should be considered for inventive step. Over half of the groups (55%) did not think there should be an anti-self-collision period. For those groups that did think an anti-self-collision period should apply, 40% stated that additional measures such as a terminal disclaimer or a stipulation that patents must be litigated together would be suitable.

More than half of the groups (55%) said that national phase entry is important. Osha concludes that the goal of this question is “to try to produce a harmonised approach that reflects best practices internationally.”

Aiming for conflict resolution

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Book on use of trade marks published

Attendees can keep up with all the latest from the Congress with this very useful book. But those with an appetite for longer-form reading will be interested to learn of the publication of a new book called “Genuine Use of Trademarks”. It is the latest from a collaboration that AIPPI started with Wolters Kluwer in 2015 to publish innovative work that would appeal to practitioners, other users of IP systems and academicians.

This is the fourth book in the series, but the first on trade marks. It was edited by Eleonore Gaspar, partner at Duess Thorne Mollet-Vieville & Associates in Paris and Chair of AIPPI’s Standing Committee on Trademarks.

Court worldwide do not always assess the manner a trade mark is used in the same way. Consequences for trade mark owners of lack of use include revocation of marks or a refusal of registration.

“This subject is crucial for trade mark practitioners everywhere in the world,” says Gaspar. “Other countries may have similar principles but they also approach them very differently; you can find very different solutions from one country to another. Some countries request evidence of use, for example, and the way a trade mark is used can differ a lot.”

The book provides insight and guidance on the legal issues and practical implications of genuine use of trade marks in 26 jurisdictions. It was developed within the framework of the AIPPI, and the topic was the subject of a study and subsequent resolution in Hyderabad in 2011.

Gaspar says the book provides a good start for anyone interested in the topic. “It is very practical,” she says. “It is not just something that is legally interesting but that you can use in practice. This is a day-to-day topic. I think it is important to have at least an idea of what the law is in each country.”

The issue will also be discussed in this morning’s panel session “Use or it lose it – genuine use of trademarks”, which Gaspar will moderate. Several of the book’s authors will also be on the panel. “The session will give everyone an idea of what is inside the book. If people have already bought the book, we would be very happy to sign them!” Gaspar says.

Congress attendees can use the discount code AIPPIANCUN2018 to get 30% of the price.
<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
</tr>
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<tbody>
<tr>
<td>07:30-08:30</td>
<td>RGT, PC, SCs Leadership Breakfast</td>
<td>Coba</td>
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<tr>
<td>09:00-12:30</td>
<td>Study Question: Conflicting patent applications</td>
<td>Cozumel</td>
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<tr>
<td>09:00-10:30</td>
<td>Pharma 1: Patent term extensions</td>
<td>Gran Cancun 1 &amp; 2</td>
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<td>09:00-10:30</td>
<td>Panel Session VIII: Communication to the public</td>
<td>Gran Cancun 3 &amp; 4</td>
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<tr>
<td>11:00-12:30</td>
<td>Pharma 2: Access to medicines</td>
<td>Gran Cancun 1 &amp; 2</td>
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<td>11:00-12:30</td>
<td>Panel Session IX: Genuine use of trademarks</td>
<td>Gran Cancun 3 &amp; 4</td>
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<td>12:30-14:00</td>
<td>Lunch 2: Briefing: IP5 Panel</td>
<td>Coral Gallery Ballroom</td>
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<tr>
<td>14:00-17:30</td>
<td>Study Question: Partial designs</td>
<td>Cozumel</td>
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<tr>
<td>14:00-15:30</td>
<td>Pharma 3: Big Data and Big Pharma</td>
<td>Gran Cancun 1 &amp; 2</td>
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<tr>
<td>14:00-15:30</td>
<td>Panel Session X: Free Trade Agreements &amp; IP</td>
<td>Gran Cancun 3 &amp; 4</td>
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<tr>
<td>16:00-17:30</td>
<td>Pharma 4: Biosimilar litigation</td>
<td>Gran Cancun 1 &amp; 2</td>
</tr>
<tr>
<td>16:00-17:30</td>
<td>Panel Session XI: Market survey evidence</td>
<td>Gran Cancun 3 &amp; 4</td>
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