Expert evidence around the world

The issues of expert evidence and what role it plays in IP cases was debated by a panel of judges in yesterday’s lunchtime session.

Dr Massimo Scuffi of the District Court of Aosta and member of Italy’s Patent & Trademark Board of Appeals noted the role of experts in Europe is diverse, and can include acting as assistant to each party, being an expert witness, being sole representative of a party or being appointed by the court.

Judge Walter D Kelley Jr, a former judge for the Eastern District of Virginia, said that the US system is adversarial and that judges decide many civil cases. “As a consequence, you have to choose experts who not only have great expertise or technical sufficiency but you also have to choose experts who can talk to a jury and who can simplify things or dumb them down, if you will, sufficiently that a jury can understand what it is that each side is advocating,” he said.

To give a sense of how partisan the system is, Judge Kelley noted that US law recognises a privilege between a party’s lawyer and their expert witness. US judges under the Supreme Court’s 1993 Daubert standard have a duty to investigate the admissibility of witnesses’ testimony. “It serves as a gatekeeper function to prevent junk science getting in front of a jury,” said Judge Kelley.

Claim construction is one of the most common things experts testify about in the US but roughly half of district court claim constructions are reversed on appeal by the Federal Circuit. Moderator Denise DeFranco, global head of IP litigation at John sandbox?

In Australia, said Justice John Nicholas of the Federal Court of Australia, experts are generally chosen by the parties but judges are clamping down. “The way in which the system has developed in Australia is that it is based on common law model and adversarial in nature,” said Judge Nicholas. “This has given rise to what have been perceived to be problems. Because the view that has been arrived at by the court as a collective body over many years now is that this is an overly combative system of using experts as hired guns that too readily fall into the trap of acting as advocates for a party and whose objectivity and impartiality is left at the courtroom door.”

The court developed new procedures that are aimed at impressing on legal representatives and experts that their role in giving evidence to the court carries with it some special duties that are owed to the court and not to the parties they represent. These include the expert being expressly required to agree to be candid, not to withhold information and to make a full disclosure of any instructions given to the expert by legal representatives.

Chief Judge Ryuichi Shitara of the Intellectual Property High Court of Japan noted that a party can produce a declaration of an expert in evidence. “It is possible but very rare to hear live testimony from expert witnesses because it is not usually necessary to hear it,” he said.

Keep calm and be prepared for Brexit

Room Red in the MiCo was packed at 8.30 yesterday morning for a discussion on the implications of Brexit. The pan-European panel described the UK referendum vote as a “surprise” and a “shock” which had led to “chaos”. But chair Cesare Galli of IP Law Galli urged the audience also to consider positive possibilities: “Perhaps it can be an opportunity for all of us.”

Giving a view from the UK, Gordon Harris of Gowling WLG apologised on behalf of the 48% of people who had voted to stay in the EU. He said Brexit would have particular implications for the pharmaceutical industry, as supplementary protection certificates are based on EU Regulations, interpreted by the CJEU and implemented by the UK courts. “No SPCs in UK law is a very serious issue for the pharma industry.”

As a result, he said, the UK is likely to be under pressure to continue SPC protection post-Brexit and may even consider extending their scope, for example to medical devices or even aviation parts. “Brexit will be time-consuming and uncertain and for a long period of time industry would not know where it stood,” he concluded.

Francesca Giovanni of Osha Liang said there is “big uncertainty” about the enforcement and recognition of judgments post-Brexit. She discussed the possibility of the UK signing a reemergent Brussels Convention or (if it joined EFTA) signing the Lugano Convention. In the meantime, she said, litigants need to consider where and when to bring actions, bearing in mind their enforceability.

Tobias Dolde of Noerr set out the pros and cons of several options for EU trade marks and designs post-Brexit. “By the time of Brexit, there will be about 1.5 million EUTMs registered – what will happen to them? Nobody knows,” he said.

Dolde said the decision about which option to follow might be determined in part by financial considerations, but added: “We can hope that discussions will take account of interests of trade mark owners.”

All the panellists agreed that IP owners and practitioners need to monitor developments, and participate when the opportunity is available. “We need to be prepared and updated on the evolution of negotiations,” said Galli.
Contributory infringement: your questions answered

What is the framework for contributory infringement? Does the supplier need knowledge? Does the supplier need to direct the customer? Is an intention to supply sufficient? What is the position on supply of kits of parts? And how are damages calculated? These were just some of the questions addressed in yesterday’s panel on contributory infringement, which offered perspectives from China, Germany, the UK and US.

The panel also considered questions written down by members of the audience on issues such as kits of parts, consumables and skinny labels. It discussed scenarios involving technologies as diverse as pharmaceuticals, coffee capsules and even pianos.

Emily O’Neill of Spectris moderated the panel and provided a UK perspective, while Matthias Leitner of the University of Bonn explained the position in Germany, describing the difference between indirect infringement and contributory infringement under the general principles of tort law. On many questions, he said, German law is “particularly complicat-ed” and in some recent pharmaceutical cases it is “dangerous for generic manufacturers”.

MaryAnne Armstrong of Birch Stewart Kolach Birch said US law distinguishes between inducing infringement and contribu-
tory infringement, and described the broad territorial reach of the latter. In China, said Yanzheng Xiong of China Patent Agent (HK), there is little case law, but the law is developing and in some ways US practice is followed. Without discovery, said Xiong, damages for contributory infringement in China are hard to calculate – but will be distributed evenly between infringers if they cannot be properly split. Amendments might be made in the next revision to the Patent Law, expected soon. “There might also be room for further interpretation either by case law or by judicial interpretation,” he added.

The panel discussed recent developments regarding skinny labelling (where generic manufacturers indicate which indications their products are or are not approved for). The challenge of establishing liability for contributory infringement in these cases is compounded by the overlaps between patent law, public law and competition law, said Leitner: “The problem is the patent system is confront-ed with a multitude of different health finance systems.”

Further questions concerned the possibili-

ty of taking action against intermediaries, such as telecoms operators and shipping compa-

nies, and practical enforcement issues. “It’s not always practical to go after the party commit-

ting direct infringement. It may be thousands of private end users, it may be a doctor. In those cases you have to go after contribu-

tory infringement,” said Armstrong.

Attendees were treated to a concert at the world-famous Teatro alla Scala last night, as one of the Cultural Evening choices.

A short guide to San Marino
It is one of the world’s smallest states, and also one of the oldest, but did you know that San Marino has an IP office where you can register patents, trade marks and designs? Or that it is a member of the Madrid System and the European Patent Organisation?

Under a reciprocal agreement with Italy dating back to 1939, the landlocked state recognises Italian national IP rights – but not international rights or EU trade marks or registered Community designs (San Marino is not an EU member).

That means, as Silvia Rossi, head of the San Marino office told the Congress News, that “you have to validate expressly in San Marino” to ensure protec-
tion in the state, which has a popula-
tion of 33,000. “Many people do not realise this,” she added. The office receives about 200 national trade mark applications each year, and about 1,500 designsations under the Madrid System.

You can find out more about the Office at its booth in the exhibition area.

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Different perspectives on GIs

The Geneva Act of the Lisbon Agreement, adopted last year, was the focus of yesterday’s panel session on developments in geographical indications (GIs).

The Act has now been signed by 13 countries and covers both appellations of origin and GIs. “At the highest level, the Geneva Act is an updating of the Lisbon System … and an attempt to make it more open and more flexible,” said David Muls of WIPO. “The Lisbon System is quite a small system in terms of registration numbers,” he added, “but it cannot be judged just on those numbers. The value goes beyond that.”

Despite the high-level reform, attitudes to the protection of GIs remain divided, as Miwako Takimura of Sewa Patent and Law in Japan reminded the audience. “The degree of global harmonisation of the GI protection system still seems insufficient,” due to cultural differences, she said. Some countries and producers see GIs as essential for protecting cultural assets, but others see them as restricting competition.

In Japan, a GI Law was introduced in June 2013 to overcome the limitations of the collective trade mark system. Federico Desimoni of the Consorzio Tutela Aceto Balsamico di Modena said Japan’s initiative was a “perfect example” of a country providing a special rule in the trade mark system to protect GIs: “I have experienced it and the system works very well.”

Desimoni added that his role on the panel was not to defend GIs, but to share some ideas. “We must avoid being dogmatic or ideological,” he said, adding: “The question is what we have to defend, how and why.” He said the priority should be to protect producers, consumers and the public interest.

“The degree of global harmonisation of the GI protection system still seems insufficient”

Moderator Giulio Sironi of VanZetti & Associates and panellist Alexandra Graziosi of WIPO took part in a discussion about protecting GIs in practice under the Lisbon Agreement and some of the questions arising from it.

Greentech resolution passed

A draft resolution on patent rights and green technology/climate change was passed overwhelmingly yesterday, with the final vote 34-0 in favour. The resolution must now be approved at the ExCo II meeting on Tuesday.

The resolution, which grew out of a report published in 2014 by the Standing Committee on IP and Green Technology, concerns the role of IP in relation to the development of, dissemination and implementation of green technologies.

It states that there is insufficient basis to support any fundamental changes to patent law to differentiate between green-tech and other areas, but says that procedures enabling applicants to elect for accelerated examination should be supported and online patent resources should be improved.

The resolution also backs initiatives such as WIPO GREEN, and the development, adoption and use of international standards for green technology. It favours strengthening the “innovation infrastructure” in developing and emerging countries and says that tax and other incentives should be available to encourage the dissemination of new technologies.

Bertram Huber, chair of the Standing Committee, said the clear vote was “a very positive sign and feedback to our Committee … to continue working on their topic.”

Speaking to the Congress News, Huber said it will be helpful for AIPPI’s work in this area to have its position clearly stated in a resolution. The work of the Committee will go on, though Huber will be standing down as chair at the end of this year, to be replaced by Guillaume Henry.

One of the Committee’s priorities is for AIPPI to be officially accredited by the UN Framework Convention on Climate Change (UNFCCC), which is expected to happen soon.
There are many challenges facing the IP system, WIPO Director General Francis Gurry told Congress attendees at the Opening Ceremony on Saturday, where he discussed in some depth five of them. Speaking to the AIPPI Congress News afterwards, he talked of the impossibility of WIPO having the “pretension” to direct intellectual property in today’s world: “It’s such a complex subject matter now and so central to the operation of the economy and there are so many major players – countries, companies and professional associations.”

In this context, Gurry said it’s vital to ask: “What is the value that WIPO adds?” The answer he says is that “it’s international and therefore universal and therefore has a certain legitimacy.” But he adds: “That legitimacy is also the source of the greatest difficulties because you have to deal with diversity. The diversity is extraordinary – we have as major users of our services all the major corporations in the world, but we also have the 48 least-developed countries.”

Looking back over the development of the global IP system, Gurry (who has been Director General since October 2008) says that historically the diversity was accommodated in the Paris and Berne Conventions, which allowed special agreements between states. “That got rolled out the door with the TRIPs Agreement, which is no longer an a la carte system but a menu du jour … You need to buy into TRIPs as a ticket to entry to the world trading system.”

Allied to this challenge is the trend towards bilateral and multilateral agreements, many of which address IP – including TTP, TTIP and RCEP. “It would be a pretension to think you can impede that,” says Gurry, but adds: “It raises the question of coherence. Things should fit like Russian dolls. If one is square and not round, you’re in trouble.”

Looking ahead to this year’s WIPO Assemblies which take place at the beginning of next month, Gurry is optimistic that a Design Law Treaty will finally be approved, saying that though it may not be world-shattering, “it is a good addition in the interest of designers”.

He also welcomes the progress made on ratification of the Marrakesh Treaty on access to copyright works for visually impaired people and the development of the Accessible Books Consortium (ABC). “The vehicle we use for the Consortium will cover the whole word and will become an international book exchange.” WIPO is now cooperating on a project that aims to give every blind person under 30 access to books by the year 2030, he says: “I think we can do that.”

The WIPO Assemblies grow each year and over 1,000 delegates are expected to attend in 2016. “It’s become the networking event for officers so many people spend their whole time in bilateral discussions in technical assistance programmes and so on, which is a great thing, and we also have more and more cultural activities. It’s a sign of buy-in and that there’s something to celebrate about IP that is not just about enforcement but about creativity,” says Gurry.

The complexity of the IP system today begs the question: what role can IP professionals, and associations such as AIPPI play, given that there are now some 350 accredited observers at WIPO. Gurry acknowledges it is a challenge: “It’s a complex task for an association like AIPPI because of the multiplicity of forums – where do you make your voice heard?” But he adds: “We do need to hear from professionals. The majority of delegates are diplomats. It’s important to hear what professionals who are active on a daily basis think. And AIPPI has this national group structure, so if they can lobby at the national level they have enormous soft power. That is quite extensive.”
The questions that will be discussed at next year’s Congress in Sydney were outlined yesterday. Only three of the four topics were covered in the session because subject of patentability of computer inventions is being covered in a panel session today at 11.00.

The bad faith question will cover situations where trade marks are used in one or more jurisdictions but not registered in other jurisdictions or where a person other than trade mark owner applies for a similar or identical trade mark in a jurisdiction where the mark is not registered.

Elenore Gaspar of Duclos Thome Mollet-Viéville & associates in Paris gave an overview of the topic, with some famous examples such as Yakult claiming Malaysia Dairy had registered a trade mark in Malaysia and a shape mark in Denmark similar to its small plastic bottle for a milk drink in bad faith. The CJEU in 2013 determined that the applicant’s knowledge of a third party is using a conflicting mark is not in or of itself bad faith. It said that in order to establish bad faith it is necessary to take into account all relevant factors at the time of filing the application.

In the US, bad faith is where one intentionally selects a mark to trade upon the goodwill associated with another’s mark. It is not an independent ground for opposition or cancellation of a subsequent trade mark. In Japan, bad faith is touched upon in a provision covering when the trade mark is identical or similar to another person’s well-known trade marks and used for unfair purposes (even if the trade mark is only well known abroad), whether the trade mark is filed fraudulently, and trade marks filed by agents.

John Brunner of Carpmaels & Ransford in London introduced the question on graphical user interfaces (GUIs). User experience (UX) design is improving usability and accessibility of electronic devices through innovative design. “What is notable about all of this is IP legislation has been found ed many years ago in many cases, and we have seen many advances in how we interact with computer devices over the years,” said Brunner.

GUIs touch upon a number of types of IP protection. It used to be easy to get a patent in this area in the US but since Alice a big question mark looms over whether GUIs are abstract methods. In Europe, there are statutory exclusions against protection of “programs for computers” and “presentations of information” as such but patents have been granted.

A number of questions arise over designs such as whether GUIs are “product design”, can they be protected independently from the design of the electronic device, can a part or an element of a GUI such as icons or slide buttons be protected, and can a design right cover movements and screen transitions. There are also questions about whether, and how, copyright, trade marks and trade dress can protect GUIs. “One thing that will be difficult is the breadth of topic,” noted Brunner.

Kenneth Adamo of Kirkland & Ellis in Chicago introduced the question on monetary relief.

“Every country has damages rules and they are all different country to country, and I mean they are ALL different,” he said. Some of these are by statute, while others are judge-made law or decisions such as lost profits under Panduit or reasonable royalties under Georgia-Pacific in the US.

AIPPI Bureau member Ari Laakkonen noted the topic needs more detailed principles and criteria for calculating monetary relief, which is unclear in some jurisdictions. The “same” IP right can be infringed in many jurisdictions yet the damages award can vary significantly, even if the commercial situation in each country is similar.
Mapping the future of AIPPI

Secretory General Laurent Thibon and AIPPI Executive Director John Bochnovic discuss plans to develop the World IP Congress and the AIPPI membership

Just over a year into his role as AIPPI Executive Director, John Bochnovic says his priority for the coming months is improving the administration of the association, particularly communications between members and groups. “We want to bring our operation closer to the membership,” says Bochnovic, who is based at the International Bureau in Zurich. “It should be about ‘us and us’ not ‘us and them’.”

At the ExCo meeting on Saturday, Bochnovic presented a preview of Strategic Plan for the next few years of AIPPI. Laurent Thibon, AIPPI Secretary General, says the introduction of the Executive Director role and the proposed plan will make his life (and that of his successor) much easier. “The Secretary General has in the past spent a lot of time on the daily organisation of work. That task should be considerably reduced or disappear in the future.”

That will enable the Secretary General and his team to devote more time and resources to dealing with the relations with groups and members, says Thibon. One focus he has is to encourage the creation of more national groups, such as that announced this week in Jordan. “The creation of the Jordan group is a very good achievement and we hope to create more national groups in the Gulf regions,” he says.

Jordan is the 67th AIPPI group: there are 65 national groups and two regional groups (covering Central America and the Caribbean and the Middle East and North Africa respectively). “I would like to see five more national groups in the next five years,” says Thibon.

Along with that initiative though will come more support from AIPPI International. “Many groups and individual members would welcome greater support,” says Bochnovic. “Historically, we’ve operated too much like my tennis club!”

One specific task that the International Bureau takes on is the organisation of the Congress, which is now an annual event. A proposal to coordinate more of the work centrally was presented at the ExCo meeting on Saturday. Thibon says this would reduce the burden on national groups and organis- ing committees, but adds: “There will still be an important role for the national group hosting the Congress. It is important to have the national connection when planning the cultural activities and inviting local authorities from the judiciary and industry.”

Bochnovic adds that in practice much of the work is already done centrally but with the growth of the Congress “we’ve moved into a different era” and the proposals are designed to recognise that. AIPPI’s next six Congresses are already confirmed, and follow the established Europe-Asia-Americas pattern. But the association is also hoping to run more national and regional events, as well as joint meetings with other associations, such as the Designs Forum held in Singapore jointly with INTA earlier this year. It is also looking at whether changes are needed to the format of the Congress, for example making it more flexible.

Another initiative that AIPPI is considering is to encourage new categories of member, such as young members, full-time academics, judges and IP officials. In addition, says Bochnovic, “We need to listen to our current in-house counsel members” about what they want from AIPPI. To this end, a closed meeting of in-house members was held at the Congress on Saturday.

In total, AIPPI has some 9,000 members including members of national groups and independent members. “We are sometimes seen as an old association and also as patent-dominant. That is no longer true these days,” says Thibon, who adds that one of the under-appreciated benefits of membership is the access to the in-depth work done by more than 50 national groups on a
variety of IP topics – work that can be useful in day-to-day IP practice.
That work is and will remain at the core of AIPPI’s mission, and represents a unique achievement says Bochvaric. “We value
highly our neutrality, so we are not a plat-
form for industry positions. We are broadly
in favour of strong, even-handed IP pro-
tection and enforcement. Of all the
NGOs, we may be the most neutral. We
don’t represent any particular industry or
group.”
Thibon agrees, but adds that the chal-
lenge is making AIPPI’s voice heard and
understood: “The most important thing is
the harmonisation of IP law and protection.
We need to increase the viability of the edu-
cational work done by AIPPI.”

IP news in brief

ITALY The International
Anti-Counterfeiting Coalition (IACC) and
the Guardia di Finanza (GdF) signed a
Memorandum of Understanding (MOU)
that will build upon their existing collab-
oration on anti-counterfeiting initiatives and programmes in Italy. It will allow
them to share information and best practices on brand protection, with a focus on identifying and fighting online counterfeiting.

UNITED STATES A jury in the
Eastern District of Texas has found
Apple willfully infringed a wireless tech-
nology patent, and awarded $22.1 mil-
lion to Acacia subsidiary Cellular
Communications Equipment.

INDIA The Delhi high court has
authorised Delhi University to issue pho-
tocopies of textbooks, in a case brought
by Oxford University Press, Cambridge
University Press and Taylor & Francis.
The Court said that students could get
books copied from the University’s
library or its authorised photocopy shop
under Section 52 of the Copyright Act.

TWEETS

Albright IP Excellent
discussion with our trusted
Israeli #attorney Rona, from
Rona Zango & Co at the
#aippi2016 judges lunch

Sanderson & Co. Cor blimey
guv’nor, AIPPI’s only bleedin’
comin’ to London, innit!
#aippi2016

Novagraaf UK Has anyone
been brave enough to walk
around #aippi2016 wearing
the Mexican wrestler mask?

Natalie Raffoul Resolution
by Aippi2016 #patent rights
#greeninnovation should go

Pete Fellows Tempted to go
back to a Magnum Store
again. #aippi2016

Gualtiero Dragotti Keep
calm and be prepared for
Brexit: the panel session
on Brexit implications on IP just
started #AIPPI2016

Managing Intellectual Property
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up copies of our latest issue, the IP Stars
directories and other IP publications.
A new area for AIPPI

This year’s study question on security interests over intellectual property represents “a significant broadening of the scope of AIPPI’s work”, says Assistant Reporter General Ralph Nack. “AIPPI is normally focused on the harmonisation of laws at the international or bilateral level, but not so much on regarding IP rights as a monetary asset with a financial value that can be traded.”

Nack says it is more and more common for IP rights to be used as a tool to secure financing, with IP either pledged or transferred to a credit provider. Unfortunately, however, as the 45 reports submitted by AIPPI groups and independent members show, there is little harmonisation. “It is a legal vacuum,” says Nack. “One of the most critical issues is: which law is applicable? Every country thinks their own law applies!” A further complication is that in many cases this topic involves the overlap of IP law and commercial law.

The reports from AIPPI groups and individuals shows that while the majority of jurisdictions provide for the possibility of creating security interests over IP rights, in many cases the types of security available are not defined – and where they are defined, there are more than 15 different security interests identified, ranging from contractual agreements to mortgages to fixed or floating charges to fully assigned IP rights.

Groups also report differences in whether the security provider is restricted in their right to use their IP right after providing a security interest or, if not whether a restriction can be contractually stipulated. Other contentious questions include whether encumbered IP rights can be assigned to third parties, what rights the security taker has before default and what happens if the IP right expires or is revoked.

Many of these are practical questions, involving issues such as control over the IP and responsibility for payment. If these can be addressed, says Nack, then academic and nationalistic debates about “applicable law” become less relevant, and progress is possible.

The group reports indicate that while current laws generally provide a degree of certainty and predictability, there is a need for more case law and potential to have comprehensive rules specifically applicable to IP rights. All but five groups stated that there are aspects of their laws that could be improved, and all but six groups said that harmonisation would be desirable. The OECD has undertaken some work in this area, and UNICTRAL has published a draft legislative guide on secured transactions, but little progress has been made so far on substantive harmonisation.

This year’s question has been deliberately limited to patents, registered trademark and registered designs, even though there have been notable developments in securitising other IP rights (such as the famous Bowie Bonds backed by copyright royalties). The limitation was simply to make the topic manageable, says Nack – and he doesn’t rule out further work through the AIPPI Standing Committee on Commercialisation of IP. Possible future topics for discussion are what happens to IP rights in the event of a default, how can portfolios be sold and does the creditor have to hold an auction for the assets?

Security interests over intellectual property will be discussed in the Plenary Session starting at 09.00 today.

Yesterday’s Women in AIPPI reception at Café Trussardi.

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Gulf, Middle East, South & East Asia and African Offices

DUBAI (UAE)
Suites 401-402, Al-Hawai Tower
Sheikh Zayed Road, Dubai
Tel : +971-4-3437 544
Fax: +971-4-3437 546
Email: Dubai@UnitedTm.com

OMAN
Suite No. 702, 7th Floor
Oman Commercial Centre, Ruwi
Tel : +968-24-787555, 704788
Fax: +968-24-794447
Email: Oman@UnitedTm.com

QATAR
Villa # 40, Al Amir Street
Al Mirqab Area, Doha, Qatar
Tel : +974-444 3083, 444 3093
Fax: +974-444 7311
Email: Qatar@UnitedTm.com

SAUDI ARABIA
Behind Maktaba Al Shawkaf
30th Street-Olaya, Riyadh 11444
Tel : +966 -11- 4616157, 4655477
Fax: +966 -11- 4616156, 4622134
Email: SaudiArabia@UnitedTm.com

SHARJAH (UAE)
Suite 203, Al Buhaireh Building
Buhaireh Comiche, Sharjah
Tel : +971-6-5722742
Fax: +971-6-5722741
Email: UAE@UnitedTm.com

SRI LANKA
105, Hunupitiya Lake Road,
Colombo 02,
Sri Lanka.
Tel : +94 11 4322790-1
Email: srilanka@UnitedTm.com

TANZANIA
Shaari Moyo Area,
Pugu Road
Dar-Es-Salaam
Tel : +255-222862900
Email: Tanzania@UnitedTm.com

SUDAN (Khartoum)
Flat No.1, 3rd Floor, Al Hurriya St.
Shaik Al Deen Brothers Bldg.
Tel : +249-183-740634
Fax: +249-183-796031
Email: sudan@UnitedTm.com

TUNISIA
6th Floor
Ideal Clinic Building
Hadda Street, Sana’a, Yemen.
Tel : +962 151 9642
Email: yemen@UnitedTm.com

LEBANON
6th Floor, Burj Al-Ghazal Bldg.,
Tabaris, Beirut, Lebanon
Tel : +961-1-21 5374
Fax: +961-1-21 5374
Email: Lebanon@UnitedTm.com

YEMEN
Having designs on harmonisation

Michael Loney previews today’s study question that will focus on the role of functiona

lity in the protection of designs

With the United States Supreme Court soon to hear Samsung’s appeal of $399 million in design patent damages awarded to Apple, it is an apt time to discuss the role of designs. Fortunately this year’s AIPPI Congress has that covered with its study question “Requirements for protection of designs”.

The question concerns the definition of and the requirements for the protection of designs, with a particular focus on the role of functionality. This deals with design rights only, and not other rights for protecting visual appearance.

“Designs as a right are becoming increasingly important,” says Anne Marie Verschuur, head of NautaDutilh’s Dutch IP/IT group and AIPPI deputy reporter general. “I think they have been undervalued for a long time. Nothing has really changed on designs as such, but more and more companies see the value of them.”

AIPPI has no recent resolutions on the requirements for and scope of design protection in general, nor functional objects in particular. “There has been no specific resolution,” says Verschuur. “We have had questions on the interplay between designs and copyright and designs and trade marks, and even going a bit older on protection of designs as such. But there have not been questions on functionality in particular and certainly not recently.”

Purely functional designs are excluded from design protection. But the precise parameters of such exclusion are not clear. “Potentially, protection could be available so long as functionally equivalent alternatives are available,” said the summary guidelines for the question. “Alternatively, it could mean that protection is not available at all. A further issue is how the presence of a functional feature of an otherwise valid design should be treated in the context of validity and infringement. For example, should that functional feature be left alone as it is part of the overall design, should it be disregarded, or should it somehow play a reduced role in an overall comparison? Should the same approach apply both to determining validity over prior art and to determining infringement?”

Generally, the overall appearance of the claimed design, which is shown in solid lines, is what is protected. To disclaim a portion of a design, the portion must be shown in dotted lines. While the outward appearance of the design is protected, any underlying abstract functional qualities, concepts, or characteristics of the design are not protected. “The issue is how to assess whether or not a design or a feature thereof is functiona,” says Verschuur. “Just to give a couple of examples, do we look at whether or not there are alternative appearances that obtain the same functional result. Do we look at what the designer has in mind? It really proves quite difficult to decide how exactly to assess it.”

Seeking common ground on harmonisation

Forty-three reports were received for this question. The groups generally agreed that harmonisation is desirable regarding the definition and meaning of a design, the requirements for protection of a design, and the treatment of functionality. Only six reports disagreed with this. The challenge, however, is working out how to find common ground on how harmonisation should be achieved.

There is no clear preferred definition, but the summary report for the question noted that probably “registered design” has the most chance of being acceptable to a majority. It recommended neither the word “patent” nor “industrial” be included in the definition given the explicit objections made by a number of groups.

All but three groups believed that design protection should be denied to a design with an appearance that is dictated solely by its function but there was a split over what the relevant factors should be. “I do think that the groups generally agree that if a design is basically solely
functional – if the appearance is dictated by technical function – then protection should not be available,” says Verschuer. “Another point will be how to assess it. It may take a bit of time to get to an agreement but I hope we get there. I think if there is no alternative way to get to the same functional result then appearance of a design may be considered solely dictated by its technical function. Other factors may also be considered though. That will require some discussion.”

The reports show a struggle over the pros and cons of what the relevant factors are in this respect. The multiplicity-of-forms test was mentioned in about 40% of the reports. The factor of whether or not the overall appearance is dictated solely by technical function received support in about 40% of the reports, with others mentioning alternative approaches that differed only slightly.

Some reports noted that in any event clarification on what the various factors would exactly entail is needed.

The summary report said that, taking all positions into account, it is probably best to include wording in the draft resolution to the effect that when assessing functionality, in each case several factors need to be considered.

A slight majority believe that design protection should be denied to any portions of the overall design that are deemed functional. The summary report recommended including wording in the draft resolution to the effect that any portions deemed functional can play a role in the overall comparison but may carry less weight.

No uniform approach
So far, the correct interpretation has not been confirmed by the CJEU, and national courts do not seem to take a uniform approach.

In the US, the “functionality” issue fairly breaks down into two separate distinct inquiries. The first issue is a matter of statutory compliance asking whether the claimed design is entitled to protection. If it is not compliant, the claimed design is not patentable/invalid. A design will be deemed to be “ornamental”, so long as the design is not dictated solely by its function.

VOXPOP
What’s your favourite thing about Italy?

Lauren Pick, The PCT Network, New York, USA

I love Italy – it has incredible culture, art, history and the best food anywhere in the world. I think my favourite cities are Florence and Rome.

Simon Tao, Venner Shipley, London, UK

I think the cinnamon cappuccino in the café across the road from the Convention Centre has to be one of my favourite things. It’s true to say I’ve had a few so far!

Hua Xiao, Water & Band Shanghai, China

Italy has my favourite soccer team, which is AC Milan. It was the first team I learned about when I was young and I have seen them play in China. My favourite player was Paolo Maldini.

Alma Alvarez, Breakthrough IP, Mexico City, Mexico

It’s hard to say. I think in general it is Italian design which you see throughout the culture. It’s always really creative but also very precise.

Alfred A Macchione, McCarthy Tétrault, Toronto, Canada

For me Italian cars are a powerful combination of engineering and aesthetic design. Alfa Romeo is my favourite and I hope to visit the Alfa Romeo Museum before I leave.

Coralie Deavernay, Clery Avocats, Paris, France

It’s the way of life – la dolce vita! You can see it in how people look and the way they live. Earlier this year I was on holiday in Puglia so I got to experience it then.
**TODAY’S SCHEDULE:**

**MONDAY 19 SEPTEMBER 2016**

<table>
<thead>
<tr>
<th>Time</th>
<th>Event</th>
<th>Location</th>
</tr>
</thead>
<tbody>
<tr>
<td>07.30 - 08.30</td>
<td>RGT, PC, SCs Leadership Breakfast</td>
<td>Green 1-2</td>
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<tr>
<td>07.30 - 08.30</td>
<td>SGT Breakfast</td>
<td>Meeting 5</td>
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<tr>
<td>09.00 - 10.30</td>
<td>Plenary Session II: General (RN)</td>
<td>Red 1-2</td>
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<tr>
<td>09.00 - 10.30</td>
<td>Pharma Session I: Patenable subject matter (SM/AL)</td>
<td>Blue 1-2</td>
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<td>09.00 - 10.30</td>
<td>Panel Session V: IP &amp; fashion (AMV/KA)</td>
<td>Yellow 1-3</td>
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<td>10.30 - 11.00</td>
<td>Coffee break</td>
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<tr>
<td>11.00 - 12.30</td>
<td>Plenary Session II: General (RN)</td>
<td>Red 1-2</td>
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<tr>
<td>11.00 - 12.30</td>
<td>Pharma Session 2: Biosimilars (SM/AMV)</td>
<td>Blue 1-2</td>
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<tr>
<td>11.00 - 12.30</td>
<td>Panel Session VI: Computer implemented technologies (JO/YI)</td>
<td>Yellow 1-3</td>
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<tr>
<td>12.30 - 14.00</td>
<td>Networking Lunch</td>
<td>Level 0</td>
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<td>12.30 - 14.00</td>
<td>Lunch 2: IP officers (title TBC) (SGT)</td>
<td>Silver</td>
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<tr>
<td>12.30 - 14.00</td>
<td>Lunch: IP officers (title TBC) (SGT)</td>
<td>(ticketed event)</td>
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<td>14.00 - 15.30</td>
<td>Plenary Session III: Designs (AMV)</td>
<td>Red 1-2</td>
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<td>14.00 - 15.30</td>
<td>Pharma Session 3: Skinny labels (SM/RN)</td>
<td>Blue 1-2</td>
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<tr>
<td>14.00 - 15.30</td>
<td>Panel Session VII: Digital Single Market (AL/YI)</td>
<td>Yellow 1-3</td>
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<td>15.30 - 16.00</td>
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<tr>
<td>16.00 - 17.30</td>
<td>Plenary Session III: Designs (AMV)</td>
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<td>16.00 - 17.30</td>
<td>Pharma Session 4: Antitrust (SM/RN)</td>
<td>Blue 1-2</td>
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<td>16.00 - 17.30</td>
<td>Panel Session VIII: Priority rights (JO/AL)</td>
<td>Yellow 1-3</td>
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<tr>
<td>16.00 - 17.00</td>
<td>Independent members' meeting</td>
<td>Green 3</td>
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<tr>
<td>19.00 - 21.00</td>
<td>Cocktail and dinner: Bureau, in-house and guests</td>
<td>Melia Hotel - Aurora Restaurant</td>
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