



FICPI

What has the Federation Accomplished Lately?

Why be an Active FICPI Member?



Past and Present

- Established 1906
- Origins in Europe but now 86 countries
- Membership restricted to Attorneys in private practice (distinguishes us from other organizations)
- However corporate/academic attendees welcome at meetings



FICPI Structure



Bureau

President Bastian Koster (ZA)

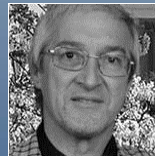
Vice President Coleen Morrison (Ca)

Secretary General Julian Crump (UK)

Treasurer General Marc Chauchard (Fr)

Assistant SG Francesco Paolo Vatti (It)

Assistant SG Mark Wilson (US)





ExCo



+ Advisory Council

ACTING FOR THE IP PROFESSION WORLD WIDE



National Sections and Associations

What do National Groups Offer Members?

- ✓ Meet and Greet Patent & TM Officials, Judges etc.
- ✓ Provide Policy/Practice Feedback to National Patent and TM Offices
- ✓ Provide Training /Education for New Members, Not So New Too!
- ✓ Social-Educational Functions Enhance Collegiality
- ✓ Advocate for User/Representative Driven Practices
- ✓ Prepare and File Amicus Submissions



FICPI Commissions

- CET - Work and Study
- Admissions
- Communications
- Contact
- Deontology
- FAB
- Membership
- PEC
- Statutes
- Tec



CET - WORK and STUDY

Group 1 Trade-marks (GIs and DNames)

TM SubGroups:

- ✓ European Issues
- ✓ Int'l Matters
- ✓ Domain N. Issues

44 members + 5 Exec.
~ 30 countries

Group 2 Designs

29 members
+ 2 Exec
22 Countries

Group 3

International Patents

- 48 members + 2 Exec
- 21 Countries



CET - WORK and STUDY

Group 4 Regional Patents Europe

36 members + 2
Exec.
~ 17 countries

Group 5 Specific Field Inventions

- ✓ Life Sci
- ✓ Computer Tech
- ✓ Business
- ✓ TK
- ✓ Green Pat.

80 members + 4 Ex.
28 Countries

Group 6

IP Litigation/Enforcement

- 46 members + 2 Exec
- 21 Countries



CET - WORK and STUDY

Group 7 IP Office Practice

- ✓ Prosecution
- ✓ Work sharing
- ✓ PPH
- ✓ Quality
- ✓ Backlogs
- ✓ Fees
- ✓ Restoration
- ✓ E-comm

Nat. Group Support

15 members + 2 Exec.
- 13 countries

Group 8

- ✓ IP Asset Mgmt
- ✓ Licensing
- ✓ Tech transfer
- ✓ M&A
- ✓ Due diligence
- ✓ Freedom to operate,
- ✓ IP ownership,
- ✓ Insurance

23 members + 2 Ex.
15 Countries



FICPI International Official Visits

- Establishing Channels of Communication
- Building Respect
- Influencing Policy



Official Visits

- EC -Brussels - DG Trade, DG Research, Cabinet Barnier, DG Internal Markt, DG Enterprise
- WCO
- WIPO, WTO, WHO -Geneva
- JPO- Tokyo
- KIPO-Seoul
- SIPO- Beijing
- EPO-Munich
- USPTO-Washington
- IPO-Delhi
- OHIM-Alicante
- CJEU

Include:

Receiving updates regarding ongoing work, processing/pendency, anticipated changes

Giving user feedback and discussion of important issues, suggested procedural changes,



Official Visits



What Have We Been Discussing Recently? IP5-Global Dossier

- Single global portal for patent holders, reps, examiners, interested parties, public at large
- DB -all file histories of patent families in one electronic location (passive).
- Facilitate work (cross-filing, prosecution, portfolio management) on patent files in multiple jurisdictions (active).
- Facilitate work sharing/exchange of citations (examiners)
- Proposed by US in Nov 2011
- Concept developed with JPO for intro June 2012 to other offices who then endorsed
- Effect - Provide cost saving through efficiencies and improve patent quality through worksharing.





IP5

Global Dossier

- Industry  Repts 
- Business Europe, AIPLA/IPO, JIPA, KINPA, PPAC Want:
 - (1) multiple country electronic patent filing through single interface
 - (2) machine-translation -i.e. relax requirement for description translation
 - (3) automatic provision of references from one country to others to satisfy IDS and other prior art citation requirements
 - (4) view multiple country dossier in single portal



Global Dossier

- (5) electronic multi-country revision of assignees
- (6) no requirement to provide translated priority documents from one country to another
- (7) single publication in the original filing language that would satisfy publication requirements globally,
- (8) access to the search strategy
- (9) other business friendly features



Global Dossier

- Result
 - Formalities work gone
 - Local attorneys doing substantive work only
- Not considered
 - Effect on profession (Hungary, Belgium)
 - What that does to SMEs and applicants other than industry
- ?Balanced system reflecting needs of all users?
- When? Work finished within a year
 - Simultaneous access to all office databases for patent family. Japan's one portal dossier avail beyond offices
 - EPO filing facility to designate US with EPO tailoring app for submission to USPTO



Tegernsee

- Denmark, France, Germany, Japan, UK, US
- Multinational substantive patent harmonization
- ID'd Issues of Interest:
 - grace period, 18-month publication of applications,
 - the treatment of conflicting applications (previously filed and subsequently published applications)
 - prior user rights
- Compared laws of these countries
- Questionnaire for Users



Other International Harmonization Efforts

17

- Vancouver Group (AU, CA, UK)
- Constant discussions TM, Patent
- Working with WIPO on CASE (centralized access to search and examination) pilot
 - Client info and a central portal for these offices
- Japan reported it intended to broaden its One Portal Dossier Product melding it with WIPO-CASE



Other Points of Discussion With National Offices/Directorates

- Country specific - Obama's position that AIA "half way there" - more patent reform to achieve innovation not litigation
- China - Sufficiency of disclosure/post filing data. Goods serv. spec.
- WHO SANCO -Plain Packaging
- WCO -Counterfeit enforcement issues
- EU DG Trade - ACTA, CETA
- EU DG Enterprise-IP valuation, Tech Transfer
- DG Internal Market - Privilege
- OHIM - reestablishment of rights
- CJEU - Specialized Patent Court



FICPI Colloquia

- Privilege - Paris June 2013
 - Experts, official from IPOs
 - 22 countries
 - Agreed upon continued work
 - Good result in Canada
- Patent Quality
- Backlog
- Grace Period (planned)



Amicus Briefs

US Supreme Court

Teva v. Sandoz

De Novo claim construction as a matter of fact and not reviewable on appeal

Supreme Court of Canada (leave to intervene granted)

Sanofi- Aventis case (Plavix)

Disclosure requirements to disclose utility or industrial applicability



Amicus Briefs

Myriad

- Patent eligibility of isolated DNA
- FICPI focused on difference between naturally/not naturally occurring DNA, also advocated case by case evaluation of DNA patents
- Also - Follow-up in form of excellent FICPI paper available on how to draft biotech patents post Myriad comparative to Euro



Amicus Briefs

EU - Enlarged Board of Appeal

Case G 1/13

*Company dissolution before an Opposition decision issues.
Call for consideration of national law under which
company was created.*

No creation of a new legal remedy



Amicus Briefs

INTERMUNE Case EU

- Information relating to clinical and non-clinical research no longer considered commercially confidential and can be disclosed to the public. Could be disclosed after marketing authorization decision has issued but not done until 2010 when started issuing decisions to disclose
- FICPI's brief was that further analysis of the data from non-clinical studies and clinical trials may lead (and frequently does) to inventions, such as new methods of use or new dosage regimens for such medicines, that could be patentable per se. Disclosing prematurely causes the info to prematurely become part of the prior art. Therefore contrary to regulations that prevent patenting of these secondary inventions



Other Submissions

Draft Rules on European Litigation Certificate

- aimed at ensuring our members retain the right to engage in European patent litigation



Resolutions 2012-2013

- General Co-operation between Profession and IP Authorities
 - Requesting FICPI be invited to make submissions, comments and to allow sufficient time to do so
- Cooperative Patent Classification - Support and encourage adoption by National Offices
- Establishment of Specialize TM & Design Tribunal - EU SUPPORT FOR



Resolutions 2012-2013

- Paris Convention Article 4(c) 12 month priority period. Support for removal of restrictions to reset the priority period
- IP5 Observer status. Encouraging acceptance of FICPI as Observer
- Search Tools of Patent Offices - Urges making internal search tools widely available to users.



Resolutions 2012-2013

- Restoration of Priority Rights
- Legal Advice by IP Authorities
- Subject matter eligibility for patents
- Confidentiality in IP practice
- Privilege before UPC
- National phases of PCT applications



Resolutions 2014

- Mailbox patents
- Sequence listing
- Protection of GIs for non-food products in EU
- Industrial applicability requirements in pharma patents



Other FICPI Networking Opportunities

29

- Regional Meetings (ABC - Next in UK then Canada)
- Symposia like recent joint FICPI China ACPAA Symposium Xi'an
 - Utility Models
 - Enforcement



Why Should You Be a FICPI Member?

1. FICPI represents practitioners...exclusively... worldwide
2. Authority with authorities!
3. Promotes essential role of qualified IP practitioners
4. Professionals motivated and highly trained - you want to be part of this group!
5. FICPI promotes credibility of members/ profession
6. Applies a code of conduct
7. Helps provide tools and information needed to survive the future



Thank You FICPI Australia!!