



INFORMATION

MARCH 2005

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LETTER FROM THE PRESIDENT

FRANCIS AHNER – PRESIDENT, FICPI

The Commission of the European Communities pointed out that professional services are omnipresent in our economy of today, as they are generating almost 70 % of GNP and are offering a considerable potential for job creation.

This is the reason why the Commission ordered a study from the Institute for Advanced Studies in Vienna on the economic impact of regulation in the field of liberal professions in different Member States. The results of this study which are available on the Directorate General for Competition's website, led the Commission to propose a draft directive on services in the internal market [COM(2004) 2 final/3, 5.3.2004]. There is no doubt that this proposal covers all the activities of our profession.

One of the main purposes of this text is to ease cross-boarder provision of services and in this regard, the Commission designed a legal framework ruling out all the obstacles to freedom of establishment of service providers and to free movement of services between Member States.

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LISBON FORUM

The 9th Open Forum will be held in Lisbon, Portugal 2-5 November, 2005.

Three parallel streams dealing with practical topics will be presented by experts in their fields.

Topics in the trademark stream include enforcement in China, and TM licensing.

The Patent stream includes discussions on nanotechnology, wilful infringement, and comparative claim drafting.

The General stream has been dedicated to Managing the IP Practice and has presentations on strategic planning, partnership and financial structures and risk management.

Full details and registration will be on the website shortly.



U.S. APPEAL COURT GIVES THUMBS DOWN FOR RIM

Dedicated Blackberry users are infringing patents owned by NTP if they send messages within the United States according to the Court of Appeal. The decision rendered by the Court is interesting in two particular aspects. In determining the claim construction to be applied to the patent owned by NTP the U.S. Court appeared to adopt the principals of a purposive construction by noting that the "the meaning of the words used in the claims must be discerned not merely from relative dictionaries but from the context of the written description as examined through the viewing glass of a person skilled in the art."

The other aspect relates to the nature of the infringing act. The claim was directed to system for transmitting information and included a requirement for an "interface switch." The interface switch used in the RIM



system was located outside the U.S. Therefore RIM argued that there was no infringement as all elements of the claimed system were not within the U.S. The Court however found that the benefit of the claimed system was obtained when two users communicated within the U.S. even though the messages exchanged between them may be transmitted outside the U.S. at some point along there journey. The Court concluded that the location of the beneficial use and function of the whole operable assembly is in the U.S. and upheld the finding of infringement by the lower Court.

Following the decision, the Canadian government has filed a petition for review of the finding by the Appeal Court en banc in view of the alleged extra territorial application of a domestic law.

BUSINESS TO BUSINESS

IP PRACTICE IN THE UNITED STATES - FORMS, FORMS AND MORE FORMS: IP LEGALFORM® PRO AND ITS RELATIVE MERITS

Form filling is an onerous and necessary part of IP prosecution. Notwithstanding the many technological advances such as electronic filing of applications, there remains in IP practice a heavy reliance on the use of standardised forms to prepare routine submissions to Patent Offices around the world. In the United States (as in many countries), although the use of particular forms is not mandated, in order to ensure that submissions comply with the various patent regulations most firms rely on template forms either created in-house or obtained externally. The problem with using in-house forms is that changes to patent regulations or government fees may not always be captured. To avoid this difficulty many firms outsource the forms they use.

The United States Patent & Trademark Office (USPTO) does make available a set of forms as a guide for applicants. Historically, however, the forms offered have been applicable to a limited set of circumstances and, importantly for the user, needed to be printed and then typed rather than existing in a "fillable" format. One such programme that attempts to counter these limitations is IP LegalForm® Pro.

The IP LegalForm® Pro is a computer database of forms suitable for use with the USPTO that can be acquired through an annual license. The advantage of this programme is that it contains a wide variety of forms for use in many circumstances that may be encountered by the applicant. It contains forms for patent, trademark, PCT, service mark and copyright prosecution. The forms can be accessed by the user, information entered and then saved for future editing as needed. Regular updates to the programme are available as part of the license so that the forms always reflect the current fee schedule and any applicable patent rule changes.

The programme can be used with relative ease after an initial introduction, but it does not have an intuitively designed interface for the user. The file format for saving documents is not compatible with many large document management systems which may necessitate continued use or the introduction of a parallel filing system. Additionally, although a user manual is available, the installation of the programme and implementation of updates favours those firms that have an IT department, or at least a member of staff able to co-ordinate the programme.

IP LegalForm® Pro has been and continues to be a valuable tool for those firms with a significant U.S. practice, particularly those firms that do not have the resources to constantly monitor changes in U.S. patent rules and/or official fees. Going forward, however, use of the internet threatens to diminish the usefulness of such programmes. Increasingly, the USPTO is making most forms available electronically in "fillable" format. In order, however, to achieve the functionality of a programme like IP LegalForm® Pro (i.e. the ability to save and retrieve completed forms) a second programme such as Adobe® Acrobat® is required which leads to the question of comparative licensing fees. For those firms where access to a diversity of forms takes primacy investing in IP LegalForm® Pro will make sense. Others will be content to use the USPTO provided forms and, if needed, license a pdf reader/writer programme to obtain the additional functionality.

More information on IP LegalForm® Pro and related products may be found at <http://www.legalstar.com/index.asp>.

LOCAL ACTIVITIES

ARGENTINA

Meetings have been conducted with government officials and legislators to pursue the draft bill on Revalidation Patents protection. The head of the Committee on General Legislation of the Argentine Senate is on the verge of giving the bill formal legislative treatment.

Also, meetings with Custom authorities to discuss the implementation of border measures, particularly a draft Presidential Decree for the creation of a Voluntary Registry of Trademarks with Customs.

Patentees are being selected for two test cases, one to attempt revalidation of an Argentine patent in Uruguay and the other a Uruguayan patent in Argentina, under the provisions of the 1889 Treaty of Montevideo on Patents.

Miguel B. O'Farrell

ITALY

On December 3, 2004 a General Assembly of the Collegio took place.

The event has been considered remarkable because:

- a) it is the conclusion of the centennial celebration after the FICPI meeting in Venice;
- b) during the assembly an officer of the Italian Patent Office spoke about:
 - 1) imminent introduction of the electronic filing at the Italian Patent Office,
 - 2) direct effect of the new I.P. law on the profession (the ratification has been postponed to the beginning of 2005,

3) the protection of the IP under the Penal Code.

All the topics will have some impact on the daily activity and on the relationships with the foreign colleagues,

Meanwhile, Collegio also drafted and distributed to the Judges of the IP Specialized Courts recently established in Italy, a list of members of Collegio having experience of litigations and that will be able to act as Technical Expert of the Judge for patent related cases. It could be advisable that the foreign clients are aware of the fact in order to induce their lawyer to push for having one of such expert appointed if necessary.

Paolo Stucovitz

UNITED KINGDOM

The UK section has had a dinner meeting at which the subject of patent litigator right was addressed, a Christmas dinner at the Dorchester, a seminar on 17th February on business management issues; a dinner meeting on 17th March with AGM on HQS Wellington. There will also be a dinner meeting on the 12th of May.

FICPI ABC MEETING

A meeting organised by the American, British and Canadian groups of FICPI will be held in Quebec City June 15 to June 19, 2005. The meeting is open to all. Details are available at www.ficpi.ca.

LETTER FROM THE PRESIDENT CONTINUED

Everybody knows that highly restrictive regulations in liberal professions could eventually have a negative impact on growth and might not serve the interest of the users.

Nevertheless restrictive professional rules can also be fully justified in order to serve the clients interests.

So as to maintain the quality of our services, FICPI has considered, for example, too a resolution a long time ago in favour of an officially recognized list of qualified practitioners in the IP field associated with a protected title, the adoption of a code of ethic conduct, and the obligation to enter into an insurance covering the professional liability.

It has always been a clear position of our Federation, that pure ethical rules on the one hand, as well as qualification and competence requirements on the other hand, are determinant to maintain high quality standards in our profession for the benefit of our clients.

We tried to generalise these guaranties in as many countries as possible for the ultimate benefit of the users.

Now, Article 16 of the Draft Regulation introduced the so called "Country of Origin Principle" (COP) which has to be combined with the principle of mutual recognition.

According to this first principle, Member State shall ensure

that service providers are only subject to the national provisions of their Member State of origin. Even the European Parliament expresses serious doubts and is worried about COP, if it is not to be presented with some

kind of limitations, such as a limited implementation in special fields where a minimum of harmonization has already been reached, or such as differed implementation until said harmonization has become reality. As far as our profession is concerned, fundamental questions linked with privileged professional immunity and prohibition of inter-professional cooperation, must be harmonized first, in order to avoid any discriminatory treatment inside our international profession.

Since this matter seems very important for our profession as a whole, I would like to stimulate your personal contribution to the work of our EUCOF & TASC Commissions by providing them with your own comments about this matter. This is not only a simple European question considering for example that Europe and Japan are seriously exploring the possibility of establishing a framework leading to the negotiation of central recognition of professional qualifications in areas of common interest! No doubt these questions will be discussed during our next ExCo in Seoul in May.

VENICE EXCO MEETING AND 8TH OPEN FORUM

BY BILL STONEHOUSE

Nearly 170 members, accompanying persons, guests and observers from 34 countries attended the EXCO Meeting held 3-6 October, 2004, in the autumnal sunshine and mists of Venice Lido. The numbers swelled to well over 500 for the Open Forum, 6-9 October, with attendees from a further 19 countries. There was no doubt that Venice was a very popular venue and the whole week was a great success.

31 of the 32 Associations and Sections were present at the EXCO Meeting, the 32nd, Peru being represented by proxy. We were pleased also to have observers and distinguished guests representing UNION, AIPLA, ASIPI and APAA, as well as the

establishment of a development agenda for WIPO. CET President David Bannerman outlined the extensive work being undertaken by the nine CET Groups which had presented between them a total of 37 papers on a range of topics for the EXCO Meeting. A synopsis of these papers may be found in the accompanying "ExCo News" and copies of the above are available on the FICPI website www.ficpi.org.

In the course of the Meeting Workshops were held on three topics considered by CET Groups entitled:

- 1) Prior Art Effect on Earlier Applications;
- 2) Whose genes are they anyway;
- 3) Trade-mark Issues in the Enlarged EU.

A resolution on the subject of Workshop (1) was not achieved because of differing US and European approaches and other problems relating to novelty, the concept of enlarged novelty and inventive step. However, resolutions did come out of Workshops (2) and (3)

The resolution from Workshop (2) entitled "Proposal on Disclosure Requirements Relating to Genetic



President of Collegio Italiano dei Consulenti in Proprieta Industriale, who are celebrating their centenary this year.

Before commencing the business of the meeting newly elected Delegates and Sub-Delegates for Canada, Denmark, Ireland and Italy were introduced, and a minute's silence was observed in memory of deceased members.

As usual there was a full workload for the attendees. FICPI President Francis Ahner reported on the activity of the Bureau since the Singapore EXCO in February 2004. The General Treasurer Francois Heritier advised that, despite a slight deficit in the financial year 2004, resulting from a loss from the Berlin World Congress, the present financial situation was good. His proposed budget for 2005 and 5% increase in Group and Individual Members' fees were adopted. Council activities were reported by Malcolm Royal, the Convener of Council. These included: consideration of the possibility of permanent Secretariat to assist with the work of the Secretary General and General Treasurer; the work of the Admission Commission; membership; review of European Qualifying Examinations and the proposal of Argentina and Brazil for the



Material Resources" concerned declaration requirements in a patent application of the source of genetic material on which an invention is based and sharing benefit accruing from the invention. The second resolution, from Workshop (3) entitled "Opposition Proceedings in the European Union" encouraged

high quality and timely processing of trade-mark applications and oppositions by Trade Mark Offices to give added value to registrations. Both resolutions can be seen on the FICPI website www.ficpi.org.

Amongst other matters was a report from Francois Curchod (Switzerland), who had arrived directly from the WIPO General Assembly in Geneva. He reported that there had been general agreement on: revision of the TM Law Treaty – there will be two more meeting of the Standing Committee before a Diplomatic Conference scheduled March 13-31, 2006; electronic exchange of priority documents and certification, and entry into force on April 1, 2005 of the PCT Amended Regulation. The proposed 12% increase of PCT fees is to be considered further because of disagreement between developing and industrial countries. WIPO is to respond

NGO's representing (a) users and (b) public interest, is to be studied in special committee. On SPLT the US and Japanese proposal to reduce issues on prior art has been opposed by developing countries.

Finally, on FICPI Admissions, an applicant in Kenya was accepted which now brings the number of countries represented by FICPI to 81.

All the hard work of the EXCO was well rewarded by a Gala Dinner at the beautiful 15th century Pisani Moretta Palace fronting on the Grand Canal.

The Forum, following the EXCO Meeting, followed its usual format of three parallel streams covering Patents, Trade Marks and General Issues. The topics included in each of the streams were chosen to be current, practical and relevant to day-to-day practice. They were well presented and gave rise to lively and interesting questions and discussions in the sessions. The Hon. Judge Michael Fysh was amongst the presenters. Copies of each paper is available from the FICPI website.

For the final reception of the Forum the participants were privileged to be taken to the imposing courtyard of the Doge's Palace adjacent to St. Mark's Square. For some of us, at least, a perfect evening was finished off by sitting in the Square, in the open air, drinking a nightcap (or two) and listening to the soothing music of a small orchestra at one of the cities.



positively in readiness for an Intergovernmental Committee meeting in May 2005 to consider a revised version of the draft on genetic resources. The FICPI resolution from

Workshop [2] is to be submitted to WIPO for consideration before their proposals are tabled. The Argentina/Brazil proposal for a development agenda for WIPO, which provides two categories of



Report of FICPI Visit to Japan and China

20 – 31 October 2004

At the end of October 2004 a FICPI delegation visited Japan and China to visit the Japanese section of FICPI and to strengthen the Federation's ties with its sister organisations, JPAA, APAA and ACPAA, and with the Japanese Patent Office (JPO) and the State Intellectual Property Office of China (SIPO). The visit was timed to coincide with the 50th Council Meeting of the APAA which was held from 24th to 27th October 2004 in Fukuoka, Japan.

A FICPI delegation, including the President and Vice President met with representatives of the Japanese Patent Office on 21 October 2004. The FICPI delegation initially had a short meeting with the JPO Director General, Mr. Ogawa and Deputy Director General, Mr. Ono, for a short meeting.

Mr. Ogawa reported that the Japanese government had adopted a strategy for the promotion of intellectual property rights throughout the country. He thought that the influence of the offices of the Trilateral Cooperation (EPO, USPTO and JPO) would continue to grow, he also noted that developments in the IP system must be user-oriented and for the benefit of users. In that context, he particularly recognised the value of a dialogue with FICPI as an international user organisation.

The President expressed thanks on behalf of the Federation for being given an opportunity to discuss matters of mutual interest with representatives of the JPO. He reported that FICPI held regular meetings with the EPO, USPTO, WIPO and the European Commission and hoped to increase the regularity of meetings with the JPO.

Mr. Ono reported on development of a network (AIPN) for the exchange of patent information with the other offices of the Trilateral Cooperation. Eventually, the network may be available to the public and could alleviate some of the burden on applicants to provide information to the USPTO.

The FICPI delegation then spent well over two hours with a large group of officials from the JPO, headed by Mr. Yonetsu, Director of International Affairs at the JPO.

FICPI reported to the JPO officials on developments in Europe, including the problems currently facing the proposed

Community Patent Regulation and the issues involved in a case currently before the Enlarged Board of Appeal at the EPO concerning the patentability of diagnostic methods.

The JPO asked for feedback from users on the usefulness of its new IPDL system by which machine-translated English language versions of all Japanese applications are made



available online at the same time as publication of the original Japanese applications. The President noted that the EPO Administrative Council was proposing to allocate a budget of €1,000,000 for providing machine-translated versions of European patent applications.

The JPO officials were interested in FICPI's views on the proposed grace period. Mr. Bannerman explained why a 12-month grace period was preferable to a six month one, particularly having regard to the strict requirements of the EPO for the substantiation of priority rights.

The JPO generously gave up a significant amount of time to give the FICPI delegation a detailed presentation on a number of

topics, including recent tactics adopted by the JPO in collaboration with other offices to enable the mutual exploitation of search results. Speaking for the JPO, Mr. Okada said that the JPO had recognized that better results were achieved where search results from more than one office were available, and the JPO wished to share the results

of its searches with other offices through the AIPN system. So far, the patent offices of Korea, China, the U.K., Germany and Australia had all indicated that they intended to use AIPN.

Mr. Tamura presented a summary of the new Japanese law on employee inventions.

JAPAN PATENT ATTORNEYS ASSOCIATION (JPAA)

After the meeting with the JPO, the FICPI delegation was entertained at lunch by the Japan Patent Attorneys Association (JPAA). After lunch, the representatives of FICPI and JPAA exchanged views on a range of topics of mutual interest. The JPAA delegation was headed by the President of JPAA, Mr. Kinoshita.

The JPAA delegation was interested in FICPI's recent resolution, taken at the EXCO meeting in Venice, on the subject of the declaration requirements for genetic resources in patent applications. Mr. Bannerman gave a detailed

presentation on the various recitals and clauses included in the resolution. Mr. Fujimura,

Commissioner of the JPAA's International Activities Center, agreed that it was a good idea to deal with the genetic resources separately from traditional knowledge.

Mr. Matsuoka, a member of the International Activity Center of JPAA, expressed JPAA's concern at the recent

proposals for an agreement between the EU and Japan on the mutual recognition of professional qualifications. Negotiations before the WTO had proven difficult, and so it seemed the initiative had shifted to bi-lateral agreements. The position of JPAA was that there needed to be substantive harmonisation of patent laws before mutual recognition could be achieved, but with reference to existing provisions for the registration of foreign lawyers in Japan, JPAA was concerned that foreign patent attorneys would soon be able to become registered in Japan and handle all IP matters except domestic Japanese applications.

In reply, the President said that he would ask the EUCOF and TASC committees of FICPI to begin work on this topic immediately.

Mr. Fujimura expressed concern on behalf of JPAA at the cost to Japanese applicants of complying with information disclosure statement requirements in the U.S. Mr. Crump reported that FICPI had passed a resolution on this subject at



its Executive Committee meeting in 2002 in Prague. Mr. Huntington thought that the real problem lay not with the USPTO, but with the US courts.

JAPAN INSTITUTE OF INVENTION AND INNOVATION (JIII) / ASIA-PACIFIC INDUSTRIAL PROPERTY CENTER (APIC)

FICPI met with members of the Japan Institute of Invention and Innovation (JIII) (www.jiii.or.jp/english/e.htm). This was the first time that FICPI had met with the JIII, and the FICPI delegation was warmly received by Mr. Tsuji, Director General, Mr. Niwa, Director, and a number of their colleagues.

JIII is one hundred years old and now had the objective of promoting inventiveness throughout Japan. JIII worked towards its objectives of encouraging innovation and disseminating knowledge of IP systems by organising local exhibitions for inventors, invention clubs for children and the international exchange and promotion of young people's

creativity.

The President thanked Mr. Tsuji for his presentation and, referring to recent attacks on the IP system from various quarters, was pleased to note the JIII's defence and promotion of the IP system.

The JIII was interested in FICPI's Venice resolution on the declaration requirements for genetic resources in patent applications, and Mr. Bannerman gave an

explanation of that resolution.

The Asia-Pacific Industrial Property Centre (APIC), which is a division of the JIII, was founded in 1996 with the aim of developing human resources in intellectual property in developing countries. Each year APIC ran a training course for Asian countries on the enforcement of IPRs. The course was attended by some twenty people from eight or so different countries.

The President reported on FICPI's training activities, particularly the South East Asian Drafting course. The Vice President felt that FICPI and APIC shared a similar goal of achieving a distributed IP system, particularly with respect to IP attorneys, to promote respect for the IP system generally.

ASIAN PATENT ATTORNEYS ASSOCIATION (APAA)

After the meetings in Tokyo, the members of the FICPI delegation moved on to Fukuoka on Japan's southern island of Kyushu to attend the 50th Council Meeting of the Asian

Report of FICPI Visit to Japan and China CONTINUED

Patent Attorneys Association (APAA) from 24-27 October 2004. There were no formal meetings arranged during this time, but the FICPI team held numerous discussions with representatives of other sister organisations and advocated FICPI's positions and views on a range of topics.

ALL CHINA PATENT AGENTS ASSOCIATION (ACPAA)

After Japan, the FICPI delegation moved on to China where it met with representatives of the All-China Patent Agents Association (ACPAA) on 29 October 2004.

Mr. Gao Lulin, President of the ACPAA, welcomed the FICPI delegation to the ACPAA's new offices at Yuetan Nanjie in the Xicheng district of Beijing.

Brief introductions were followed by a semi-formal presentation from each side as to the activities and immediate future plans of the respective organisations. Speaking for ACPAA, Mr. Yuan De, Secretary General, reported that on the structure of ACPAA and its role in issuing practice certificates to all patent agents and patent attorneys throughout the whole of China. ACPAA also organised training for patent attorneys and was responsible for maintaining professional standards.

Mr. Gao noted the increase in Chinese filings from 4,000 in 1987 to about 50,000 in 2003. However, about 85% were filed by non-Chinese applicants.

Mr. Ahner invited ACPAA to send observers to the ExCo in Seoul.

In addition, Mr. Ahner expressed the desire for FICPI and ACPAA to cooperate on education and training and proposed that the two organisations should organise a joint seminar in China to promote IP awareness.

Mr. Griffiths led a discussion on increased membership from China and Mr. Gao advised that the ACPAA would certainly encourage its members to take part in activities in FICPI.

STATE INTELLECTUAL PROPERTY OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA (SIPO)

After lunch with the ACPAA, the FICPI delegates were escorted by Mr. Yuan De, Secretary General of the ACPAA, to a meeting with the SIPO. SIPO was represented by Mr. Tian Lipu, Deputy Commissioner, and Mr. Jhang Haiyang, Chief of the Asian Pacific Division of SIPO's International Corporation Department.

The FICPI representatives were welcomed warmly to SIPO by Mr. Tian, who noted that the meeting marked a first chapter in the cooperation between SIPO and FICPI.

Mr. Tian reported that SIPO had been founded in 1980, but the IP system in China was younger than that. The 20th

anniversary of the Chinese patent law would occur in 2005. Nevertheless, in 2003, SIPO had received some 450,000 trademark applications and more than 300,000 patent applications, of which more than 50% were filed by non-Chinese applicants. In terms of number of applications filed, China now ranked first for trade marks, utility models and designs and fourth or fifth for patents. The first Chinese patent application had been filed on 1 April 1985.

SIPO was now an International Search and Examining Authority under the PCT and would accept applications in Chinese or English.

Mr. Tian noted the SIPO, in its role of PCT authority and English was now the working language for search and examination in SIPO.

SIPO had already begun work on the automatic translation of patent applications from English to Chinese to be followed by translations from Chinese to English.

In response to a question from Mr. Hérítier, Mr. Tian reported that a recent change in Chinese customs law now provided greater protection for IP holders

against the importation or exportation of infringing products; in practice the export of infringing products presented the greater problem.

Mr. Bannerman led a discussion on traditional knowledge and genetic resources and the interface with the Patent System.

Mr. Tian noted that China had rich genetic resources, traditional knowledge and folklore and attached great importance to the protection of this knowledge. China favoured an international system for such protection and felt that the present system was insufficient.

Mr. Jhang looked forward to further contact with FICPI and encouraged cooperation between FICPI and the ACPAA
Julian Crump, Reporter General of the CET

This is an abridged copy of the report which will be made available on the FICPI website.



LONG ATTACHMENT FILE NAMES

If the filename of an e-mail attachment exceeds 128 characters, many email systems will not process the message and will discard it without generating an error message or creating a log entry indicating it was received and discarded. This problem is exacerbated when a document retrieval system is used that appends a document number to the file name.

PRIVILEGE REVISITED KNORR-BREMSE V. DANA

After a near twenty year hiatus, the exclusion from disclosure traditionally enjoyed under US law for attorney-client communications has been restored to patent law actions by the *en banc* Federal Circuit opinion in *Knorr-Bremse v. Dana*, 383 F.3d 1337 (Fed. Cir. 2004). Since 1986, the court in a patent infringement action has been permitted to infer, from the failure of an accused infringer to produce an exculpatory opinion of counsel, that the infringer either did not obtain an opinion of counsel or obtained an unfavorable opinion of counsel. *Kloster Speedsteel v. Crucible*, 793 F.2d 1565, 1580 (Fed. Cir. 1986).

Imposition of this so-called 'adverse inference' effectively destroyed attorney client privilege in patent litigation, because *Underwater Devices v. Morrison-Knudsen*, 717 F.2d 1380, 1389-90 (Fed. Cir. 1983) had previously imposed upon accused infringers "an affirmative duty to exercise due care to determine whether or not [they] are infringing". Disclosure of an exculpatory opinion of counsel became entrenched in the case law as the only effective way for an infringer to demonstrate that they had met their affirmative duty in order to defend against a finding of 'willful' infringement and the possible award of multiple damages and attorney fees.

Judge Newman wrote the nearly unanimous opinion for the Court, which expressly overruled precedent authorizing the adverse inference. The Court's opinion notes that "implementation of this precedent has resulted in inappropriate burdens on the attorney-client relationship." *Knorr-Bremse*, 383 F.3d at 1343. The adverse inference may no longer be drawn either against infringers who obtain an opinion but refuse to disclose it to the patent owner (codefendant Haldex) *Id.* at 1344, or against infringers who do not obtain an opinion of counsel (codefendant Dana) *Id.* at 1345. "We conclude that a special rule affecting attorney-client relationships in patent cases is not warranted." *Id.* And so, after nearly twenty years, attorney-client communications may once again be excluded from disclosure to the same extent in a patent case as in any other litigation in the United States.

The patent bar, US trial courts, and litigants alike have long bemoaned the difficulties imposed by the adverse inference rule. The necessity of accused infringers to produce an attorney opinion led to a cottage industry writing prepared-for-the-court exculpatory opinions. Accused infringers who sought out the advice of their chosen attorney for the purpose of actually relying upon that advice often found the necessity to disclose the advice in subsequent litigation required selection of different trial counsel. Once the opinion was disclosed, satellite discovery and litigation concerning the scope of the waiver, for example should it extend to related domestic and international patent applications and to related international litigation, consumed valuable resources of both courts and litigants.

The Court in *Knorr-Bremse* also ruled that defendants who mount a "substantial defense" can not thereby defeat liability for willful infringement. *Id.* at 1347. Having determined that a substantial defense is not sufficient, the Court left unresolved just how an accused infringer can demonstrate that it has met its affirmative duty of due care without disclosing an exculpatory opinion?

Judge Dyk, concurring with the majority opinion in discarding the adverse inference, dissented from the majority on precisely this issue. In Judge Dyk's view, the Court should have gone further and eliminated the affirmative duty of due care as well as the adverse inference. Judge Dyk believes that recent Supreme Court cases limiting the imposition of punitive damages to situations where the conduct is reprehensible are inconsistent with the affirmative duty of due care requirement in patent cases. *Id.* at 1348. "[A] potential infringer's mere failure to engage in due care is not itself reprehensible conduct". *Id.* at 1349.

Wesley Whitmyer (The author is a member of FICPI and counsel for one of the co-defendants in this case. FICPI joined an amicus brief in support of the retention of privilege.)

PATENT DRAFTING COURSES

FICPI continues to run its patent drafting courses in Asia and in Europe. The course structure provides two weeks of workshops and lectures separated by a distance learning segment.

The next FICPI SEAD Course will be held in Singapore. The first segment is between **4th April** and **8th April** and the second segment between **3rd October** and **7th October 2005**.

The 1st part of the FICPI EuroSead Course will be held at Lincoln College, Oxford, England between **11th April** and **15th April** with the second week from **26th to 30th September 2005**.

Both of these courses are intensive hands on courses intended for new entrance to the profession to teach patent drafting skills. There is limited enrolment so early application is required.

Full details and application forms are on the FICPI website www.ficpi.org.

FICPI IS PLEASED TO WELCOME THE FOLLOWING NEW MEMBERS:

Ms Ana Cristina MULLER (Brazil)

Mr Gang YU (China)

Ms Vali SAKELLARIDES (Greece)

Ms Jacqueline LIU (Hong Kong)

Mr Duk Yeul BAEK (S. Korea)

Mr Hong-Sik JEONG (S. Korea)

Ms Hulya CAYLI (Turkey)

Ms Cynthia A. Webb (Israel)

Mr Dave A. Wyatt (Malaysia)

Mr U Myint Lwin (Myanmar)

Mr William Maema (Kenya)

Ms Monica Wolf (Colombia)

Mr Ramzi Tarazi (Lebanon)

Ms Laura Alvarez-Lopez (Spain)

AIPLA PRESENTS PRESIDENTIAL MEDALLION TO FICPI



During the Executive Committee meeting in Venice, Mike Kirk, Executive Director of AIPLA presented a medallion to FICPI for use by its President. In making the presentation, Mike Kirk noted the long standing relationship between

AIPLA and FICPI and the co-operative efforts that the two organisations had made over the years in addressing issues of interest and concern to the Intellectual Property profession.

In receiving the medallion on behalf of FICPI, the President Francis Ahner thanked AIPLA for honouring FICPI with the medallion. He welcomed the co-operation between the AIPLA and FICPI and trusted that it would continue in the future. The medallion, which will be passed to successive FICPI Presidents, was worn with pride and style by the President through the balance of the meeting.

TRILATERAL USERS GROUP MEETING

Prior to the meeting of the Trilateral Offices (USPTO, EPO and JPO) met in Alexandria, Virginia a "Users Conference" was held at which FICPI was represented by the Vice President, Danny Huntington. The main topic of the meeting was movement toward harmonisation. In his representation, the Vice President noted that everyone agrees that the best approach would be to attempt to restart discussion of the Substantive Patent Law Treaty (SPLT) in WIPO with a reduced number of issues. However, FICPI recognizes that to do that it will be necessary to somehow address needs of developing and least developed countries, particularly with respect to the issue of disclosure of the origins of genetic resources and traditional knowledge.

Regardless of whether harmonization proceeds within the framework of trilateral discussions or WIPO, FICPI's view is that believes three issues should be treated first. These are adopting a first-to-file system, adopting a one-year grace period for the first-inventor-to-file, and adopting a consistent standard for prior art.

All of these will be needed to allow the Trilateral offices to readily use the search and examination of the other offices without having to reconsider in the context of its own laws. They

will also be valuable to reduce costs for applicants for the same reasons, as well as allowing a single application to be sufficient for examination in each of the offices.

FICPI emphasised its position that there should be a one-year grace period to ensure that publications by the inventors within the priority year are not prejudicial to the filing of an application at the end of the priority year, noting that for example, publications of corrected DNA sequences during the priority year have resulted in a loss of patent protection. Anything less than one year would not allow an inventor to avoid unpatentability by relying on its filing at the end of the convention year.

It was also emphasised that FICPI is very much in favor of harmonization but this must be contrasted with centralization. A way must be found to ensure that there are people in all countries who can give advice about intellectual property and explain the IP system. Otherwise, there will be a loss of respect for the IP system, and the "us" versus "them" problem between developed countries, and developing and least-developed countries, will only get worse.

Copies of FICPI resolutions and position papers on these issues, including the issue of disclosures concerning genetic resources, were made available to attendees.

IN PRAISE OF ARPAD BOGSCH

In Arpad Bogsch, who passed away on September 19, 2004, the world of intellectual property has lost the founding father of modern intellectual property, the man who was largely responsible for making an esoteric legal field, once reserved for specialists, into a recognized instrument at the service of economic development, the encouragement of innovation and creativity and the fight against counterfeiting and piracy.

Arpad Bogsch was born in Hungary in 1919 and became a citizen of the United States of America in 1959; he studied law, and was awarded two doctorates, one in Hungary and one in Paris, and a master's degree in the United States. After having practised at the bar in Hungary, he held the posts of legal officer at UNESCO in Paris and thereafter of legal counsellor at the US Copyright Office in Washington. In 1963 he arrived in Geneva, where he became Deputy Director of the United International Bureaux for the Protection of Intellectual Property (BIRPI), the predecessor of the World Intellectual Property Organization (WIPO), and then Deputy Director General of the latter Organization when it actually came into being in 1970. After that, for the 25 years from 1973 to 1997, he was Director General of WIPO and also Secretary General of the International Union for the Protection of New Varieties of Plants (UPOV), WIPO's sister organization.



It was under his influence that BIRPI, which was a legacy of the nineteenth century, mutated into WIPO, an organization for the second half of the twentieth, that WIPO joined the United Nations family in 1974, thereby taking on the universal dimension that it had previously lacked, and that it grew considerably thereafter.

Arpad Bogsch launched a multitude of ground-breaking initiatives, notably by advocating the conclusion and revision of numerous international treaties, by launching an ambitious program of assistance to developing countries, by modernizing the system for the international registration of marks, by creating the WIPO Arbitration and Mediation Center and by presiding over the baptism of ATRIP, a world association of intellectual property teachers and researchers. But above all he was the inventor of the Patent Cooperation Treaty or PCT, the remarkable success of which made WIPO into an international organization unique in the United Nations system in that it is, to a very predominant extent, financed today by the fees that the private sector pay for the use of the PCT.

In addition he contributed extensively to providing China with a modern intellectual property system and bringing that vast country into the international intellectual property community. Similarly, when the Soviet Union broke up, he actively assisted

the countries that emerged from it to create their own national systems and, as far as most of them are concerned, to build up a common patent regime through the Eurasian Patent Convention.

Arpad Bogsch was an exceptional leader, albeit a demanding one, indeed a very demanding one, but truly exceptional. The example that he set, impossible though it might have been to follow, was a formidable stimulus for us all. Not only was our top man able, through patient and often hard-hitting diplomacy, to persuade the delegates of Member States and organizations of the rightness of his proposals, but he was also awe-inspiring for his thorough knowledge of the subjects on which he led discussions.

Internally too, his profound knowledge of issues very often had the effect, as a former staff member recently reminded me, of his knowing more on the subject on which a colleague was making a proposal to him than the

colleague did himself. Indeed what he did was spot immediately, to our great discomfiture, the slightest defect in the dossiers that we submitted to him.

Arpad Bogsch's professional and human qualities earned him appreciation, admiration and respect throughout the world. Evidence of this is the score of decorations and over a dozen honorary doctorates awarded him in the course of his career, not to mention the honorary memberships bestowed on him not only by FICPI but also by the International Association for Intellectual Property (AIPPI) and by the International Literary and Artistic Association (ALAI). All those who have had the opportunity to come into contact with him have been left with the memory of an extraordinary personality.

The heartfelt sympathies of the entire international intellectual property community go to his widow Adèle, herself a former WIPO colleague, to his children Sylvia and Henry, to his grandchildren and to his whole family.

*François Curchod
former Deputy Director General of WIPO
translation by Patrick Andrews*



ADVANCE NOTICE

Masters Course in US Drafting Technique

There have been some recent and important changes in US drafting requirements. FICPI has decided to conduct a 2- day course to be held at Ettington Chase (near Stratford-upon-Avon) from Saturday, 15 October to Monday, 17 October 2005.

Admission to the course will be limited to attorneys/agents having at least one year post qualification experience in drafting. The course is open to attorneys/agents located anywhere in Europe. Workshops of eight persons will be led by an experienced US practitioner. Each workshop will report to a plenary session of 32 delegates. There will also be plenary sessions attended by all delegates.

There will be a cost for the course to cover the travel expenses of the tutors who are expected to be:

- His Honour Judge Paul Michel, Chief Judge of Court of Appeals of the Federal Circuit
- Dan Collopy, Fantasy Corporation
- Sharon Crane, Patent Attorney, Burns Doane Swecker & Mathis
- Danny Huntington, Patent Attorney, Burns Doane Swecker & Mathis
- Joe Kolasch, Patent Attorney, Birch Stewart Kolasch & Birch LLP
- Prof. Don Reynolds
- Willem G Schuurman, Patent Attorney, Vinson & Elkins LLP
- Ray Stewart, Patent Attorney, Birch Stewart Kolasch & Birch LLP

A similar course conducted in Australia was most successful and attracted 64 delegates meeting the above criteria. Some potential delegates could not be admitted due to limitations on the numbers. It is anticipated that similar conditions will apply to this course.

Expressions of interest are invited by e-mail to mroyal@ficpi.com. **Invitations will be dispatched on a first in first served basis and full details will then be sent.** Firms may book places, nominating the delegates later.

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