

Tuesday 6  
October



- 11:30 - 13:00** Panel Session: Judging The Similarity of Two Marks Sharing a Non-Distinctive Part
- 11:30 - 13:00** Panel Session: AI Inventive Step & Sufficiency
- 13:00 - 14:00** Virtual Roundtable: Regional Development and IP in Asia  
Hosted by: Shoichi Okuyama, Okuyama & Sasajima
- 13:00 - 14:00** Virtual Roundtable: Should a Letter of Consent be Accepted to Overcome a Conflicting TM Refusal?  
Hosted by: Lena Shen, Beijing Sanyou Intellectual Property Agency Ltd
- 13:00 - 14:00** Virtual Roundtable: Action Learning for Managing IP Teams in a VUCA World I  
Hosted by: Nazli Korkut, Korkut
- 14:00 - 16:00** Online Plenary Session for Proposed Resolution (2) Standing to Litigate and Effect on Remedies
- 16:00 - 17:00** Virtual Roundtable: Should Patent Examination be Tougher, so That The Granted Patent Resists Post-Granted Invalidation More Reliably?  
Hosted by: Matthew Zischka, Smarter & Bigger / Fetherstonhaugh
- 16:00 - 17:00** Virtual Roundtable: Action Learning for Managing IP Teams in a VUCA World II  
Hosted by: Nazli Korkut, Korkut
- 16:00 - 17:00** Virtual Roundtable: Inhouse Counsel Perspective: Collaborating and Maintaining Productivity During a Global Pandemic **In-House Attendees Only**  
Hosted by: Isabelle Chabot, EXFO
- 17:00 - 18:30** Panel Session: Designs for Medical Devices and Supplies – From Procurement to Enforcement
- 17:00 - 18:30** Panel Session: Patentability of Diagnostic Inventions

# Panel Sessions

## **Panel Session: Judging the Similarity of Two Marks Sharing a Non-Distinctive Part**

**Tuesday 6 October - 11:30-13:00**

Moderator: Qiang Ma, Jun he Law Firm (CN)

Speakers:

- Michelle Mancino Marsh, Arent Fox LLP (US)
- Felipe Claro, Claro y Cia. (CL)
- Ewelina Karolina Sliwinska, European Union Intellectual Property Office (EUIPO) (EU)

### **Session description**

How does one judge the similarity of two marks sharing a non-distinctive part? What is the significance of this issue? As trademark lawyers we often receive refusals from the Trademark Offices against clients' trademark applications. For many citation refusals, the refusal grounds are not persuasive because the non-distinctive parts shared in the two marks are compared while the distinctive parts of the marks are neglected. As known to all, a trademark can contain a descriptive word, e.g. "KIA MOTORS" (Class 12), "BMW LIFESTYLE" (Class 25). If a later mark contains such generic or descriptive words as "motors" and "lifestyle", they shall be considered as the non-distinctive parts and accordingly disregarded when making the similarity finding. This issue will also emerge in trademark opposition and invalidation cases, because in theory a non-distinctive part in a trademark may acquire distinctiveness based on actual use. The issue will therefore include the possibility of acquired distinctiveness which needs support from sufficient actual use proof.

The panel will discuss the issue from a global perspective, explore the practices of different jurisdictions based on specific cases, and propose some factors for consideration in judging the similarity of two marks sharing a non-distinctive part.

# Panel Sessions

## **Panel Session: AI Inventive Step & Sufficiency**

**Tuesday 6 October - 11:30-13:00**

Moderator: Peter Finnie, Potter Clarkson LLP (UK)

Speakers:

- MaryAnne Armstrong, BSKP, LLP (US)
- Divyendu Verma, Krishna & Saurastri Associates LLP (IN)
- Bhupinder Randhawa, Bereskin & Parr LLP (CA)
- Katherine Rock, Pizzeys Patent and Trade Mark Attorneys (AU)
- Stefan Schohe, Boehmert & Boehmert (DE)

### **Session description**

This panel session addresses inventive step and obviousness issues of AI inventions around the world. AI capabilities rely primarily on software, processes and algorithms using machine learning or data. The session will also look into the requirements and challenges existing in the area of disclosure and sufficiency.

## **Panel Session: Designs for Medical Devices and Supplies – From Procurement to Enforcement**

**Tuesday 6 October 17:00-18:30**

Moderator: Christopher Carani, McAndrews, Held & Malloy Ltd (US)

Speakers:

- Crystal Chen, Tsai, Lee & Chen Patent Attorneys & Attorneys at Law (TW)
- Philippe Kutschke, Bardehle Pagenberg (DE)
- Sa'ar Alon, Reinhardt Cohen & Partners (IL)
- Alexis Simpson, Gilead (US)

### **Session description**

In the wake of the world-wide battle royale between consumer tech titans Apple and Samsung, design rights have continued to capture the attention of designers and companies around world. One area that has seen a particular uptick in attention to design rights is the field of medical devices and supplies. This panel discussion centers on the protection and enforcement of medical devices and supplies through the use of design rights. From the perspective of several jurisdictions around the world, attendees will learn about: (1) strategies for protecting designs for medical devices and supplies, which includes not only traditional industrial design, but also UX, graphic user interfaces and icons, and (2) outcomes of, and insights from, design right enforcement efforts for medical devices and supplies.

# Panel Sessions

## **Panel Session: Patentability of Diagnostic Inventions**

**Tuesday 6 October - 17:00-18:30**

Moderator: Charles Boulakia, Ridout & Maybee LLP (CA)

Speakers:

- Debora Plehn-Dujowich, Eckert Seamans Cherin & Mellott, LLC (US)
- Amy Feng, Wu, Feng & Zhang (CN)
- Cristina Biggi, Bugnion S.p.A (IT)
- Ana Claudia Mamede Carneiro, Dannemann, Siemsen, Bigler & Ipanema Moreira (BR)

### **Session description**

The patentability of Diagnostic Methods has come into attack over the last decade in certain jurisdictions. In the U.S., the patentability has been considered in several cases, including *Athena Diagnostics v. Mayo Collaborative Services*, *Mayo Collaborative Services v. Prometheus Laboratories*, and *Association for Molecular Pathology v. Myriad Genetics*. Other countries have followed suit to varying degrees, either based on the US jurisprudence or based on jurisprudence of their own, for example, G1/04 decision from the European Enlarged Board of Appeals. This has resulted in some divergence of how diagnostic method claims are treated in different jurisdictions, particularly, but not exclusively, due to their subject matter basis. Panelists from the US, Europe, China and Brazil consider how diagnostic methods are treated in their jurisdictions and elsewhere.