

## “IP Question of the Day”

**Question: How have courts in Europe, the US and elsewhere addressed the complex issue of prior art infringement?**



**In conversation with...**

### **Peter Pawloy, AIPPI Treasurer**

Peter Pawloy has been AIPPI Treasurer since 2019. He is an Austrian Patent Attorney and an authorised representative before the EPO and the European Union Intellectual Property Office.

#### **How has COVID-19 affected AIPPI?**

Thankfully we have been spared the worst. Many things we do as an association are, or can be, done electronically. For example, our regular AIPPI Bureau meetings take place online.

There was probably more of an impact on the General Secretariat in Switzerland where the premises had to be closed for a certain period. However, the work could be continued remotely via Zoom etc.

#### **And what was the impact financially?**

My predecessors and I set aside a certain amount in the past to cover the risk of a Congress being cancelled. This prudence helped us with contingency planning once the virus hit. Nonetheless, we had to draft an emergency budget in April 2020 once it became clear that the Congress was in jeopardy.

The impact of all this forced us to delay the Congress in Hangzhou. It also meant we had to organize an online congress in 2020 – something that was a new undertaking for all of us and it didn't turn out to be as easy as one might think. For example, we had to find and evaluate alternatives for virtual meetings, guess the number of participants for an online event etc.

After careful consideration of all the costs involved, we decided to offer the 2020 Congress for free to our members. This was to help keep up the spirits and to let members meet and greet one another – as well as getting the substantive work done. It was a pity not to meet colleagues in person but overall, the online Congress was a very positive experience.

We learned a lot last year and can use our experience for this year's event.

#### **What exactly will you be doing at the 2021 AIPPI World Congress Online?**

It will be much the same as in person. There are scheduled National and Regional Group meetings I will attend. In particular, I will be active at the Treasurer and Secretary meetings on October 21. Of course, as a Bureau representative there are also several sessions I will attend in this capacity.

#### **What does the Finance Committee do?**

As it says in the Statutes, [the Finance Committee](#) exercises the functions of internal controller. The committee conducts internal auditing, gives advice to the Treasurer and reviews the budget and financial performance of AIPPI. We will report together to the Executive Committee on October 15 at ExCo I.

#### **What can people expect to hear at this meeting?**

The reporting of financial year 2020, in particular how we dealt with the Covid pandemic. There will also be the budget outlook for next year, including the Congress in San Francisco. Of course, the impact of Covid will have to be factored in – we don't even know for sure if we can travel next year!

#### **Any final remarks?**

I would like to express my thanks to the General Secretariat for their support, especially Susanne Kieliba, the Office and Financial Manager there.

To our members, I would like to reassure them that the financial position of AIPPI is sound. Our money is in Swiss banks so it should be safe there (*He grins*).

*Interview conducted by Diarmuid De Faoite, AIPPI Communications Manager.*

**Answer: Find out today at Panel Session 12: Doctrine of equivalents: can the prior art infringe?**



## In conversation with... Eryck Castillo

Eryck Castillo is the Chair of the AIPPI Study Question, Registrability of trade marks against public order or morality. He is the former President of the Mexican Group of AIPPI, and works as a trade mark attorney in Mexico.

### Can you briefly explain why this Study Question is of interest to the IP community?

As you know, all Study Questions are answered by the AIPPI National and Regional Groups. It is interesting to see the point of view of different groups. There is always a variety of opinions, even though the countries are signatories to various agreements like the Paris Convention.

The difference of opinions we encountered around this particular Study Question are interesting. Take a special jurisdiction like the EU where the provisions governing its community trade mark are compulsory for all member countries, but morality issues differ on country-by-country basis. It is this kind of topic that makes consensus slightly more difficult to achieve. We received and studied several replies to the Study Question from different countries and there are still some minor points to be harmonized. These will be discussed at the plenary session on Thursday, October 21.

### How was the teamwork?

We have a very good leadership group for this Study Question with Elena Miller from Bulgaria, Tommy Chen from Australia, and Jonathan Mesiano-Crookston from Canada. We interacted well because we were all committed to work on this topic and create a good draft.

Fortunately, we were also supported by Lena Shen from the Reporter General Team. She was really helpful in guiding us through the necessary AIPPI work processes, meeting deadlines, drafting and so on.

### Have you previously been involved in any other Study Questions?

Last year, I was the Vice Chair of a Study Question. In previous years, I have participated in other Study Questions and enjoyed attending the plenary sessions, even if I was not the Mexican delegate. I normally go to AIPPI Congresses. It is a great opportunity to learn and to meet people. One of the things I love about AIPPI is that it has a focus on learning and not only the social and networking affairs you encounter at other associations.

### Did COVID make the process more difficult?

Yes, but more last year than this year, because 2020 was the first time we experienced an online drafting of the Resolution and an online Congress to approve it. It was a different way of doing things, but it was also very interesting and successful. This year the RGT had the benefit of the experience from 2020, as did many participants of the Study Group. I should say that the RGT has done a great job in making the process much easier for all of us.

### Any final thoughts

Now that we are almost done in the process to approve the Study Question, I can make a final observation that I consider this online process to be a really good exercise. I hope that AIPPI can also use a hybrid model in the future in-person Congresses. Doing online meetings to discuss the drafting of Study Questions presents a chance to listen to people from countries who cannot travel – this would be a good opportunity for them to still present their position virtually. It can get more people involved and Zoom meetings are part of daily life these days!

*Interview conducted by Diarmuid De Faoite, AIPPI Communications Manager.*



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## Report on the AIPPI Café hosted by the Young AIPPI Members Committee: “Young Members and the future of AIPPI”



The [Young AIPPI Members Advisory Committee](#) (“YAC”) hosted an interactive AIPPI Café session on Tuesday, 19 October. Over 20 young delegates were welcomed into the discussion, many of whom were first timers to the AIPPI World Congress. The group, guided by hosts Samantha Yung, Nevin Koshy and Kevin Feng of the YAC, shared about their challenges in the workplace, explored how AIPPI can support and help young members grow, and how they can contribute to the future of AIPPI.

Many great ideas flowed from the discussion, including the Young Members desire to continue their participation in AIPPI through virtual seminars and conferences, contribute to newsletter updates on IP issues and actively take part in Study Questions and Standing Committees.

The YAC, which was established as a Bureau Advisory Committee in January this year, consists of eight founding members. Their role is to engage Young Members and enhance interaction between the Young Member community and other AIPPI members and groups.

If you are a Young Member (defined as aged 36 or under) or if you are interested in helping as a volunteer, we welcome you to connect with the YAC at [yac@aippi.org](mailto:yac@aippi.org).



## Are you part of the 2021 AIPPI Challenge?

Get involved by completing as many challenges as you can. The top three competitors will win a prize! Have fun, make connections, get valuable resources, and score points while you're at it!



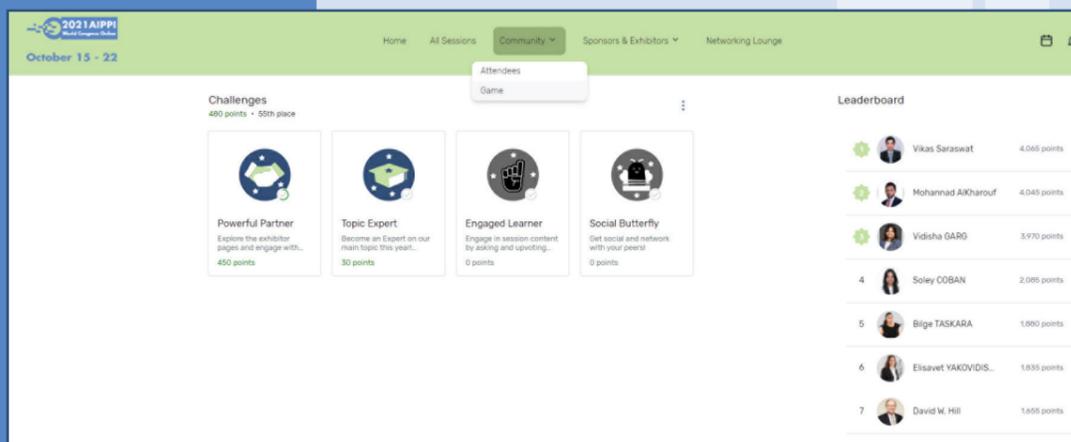
### How does it work?

Go to the Community tab on the Congress platform and select the dropdown menu *Game*.

For each action you complete, you will be automatically awarded points.

Different actions will help you gain special challenges throughout the event.

Climb your way to the top of the leader board as you post photos, engage with exhibitors, attend sessions, and gather stickers.



## Report on Panel Session 5: Multi-jurisdictional inventorship

By Laurence Loumes, PhD, Plasseraud IP

### Background

Multi-jurisdictional inventorship happens when inventors named in an application are citizens and/or residents of different countries. This may commonly happen when companies have R&D groups in different countries or during cross border research projects. The situation is happening all the more frequently now that work is becoming globalized. As a result, technical and legal difficulties arise for the applicant.

The fundamental issues are: determining the correct inventorship and ownership, completing the filing requirements, complying with all relevant national laws across multiple jurisdictions (First to file? Foreign license? Filing first in the inventor(s) own country?), and the remuneration of the inventors.

The multijurisdictional ownership question has been studied in the past (see [AIPPI Resolution on Q244](#)) and was particularly discussed at the Congress held in Rio de Janeiro on October 14, 2015. The Resolution aimed to harmonize the question over the various jurisdictions.

### Panel Session

This panel session at the 2021 AIPPI World Congress focused on filing strategies when national requirements diverged, taking the examples of China and the US.

The discussion was moderated by Duran Corretjer, Spanish and European patent attorney at Durán-Corretjer, SLP, included discussions with Mengmeng Yu, Patent Attorney at AFD for the Chinese side, and Dan Altman, Partner at Knobbe Martens, for the US side.

### The Chinese Experience

Regarding China, Ms. Yu explained that multijurisdictional inventorship counts for 5% to 8% of the patent applications filed in China every year, and that inventorship is based on the location of the conception of the invention, not on citizenship or residency. Unlike in other jurisdictions, no evidence or signature is required to prove inventorship. Inventors mentioned in the filing request are considered to be the actual inventors.

Improper naming does not threaten the validity of the patent. Wrong inventorship can be corrected via a request. In the case of a deletion of a co-inventor, declarations by all co-inventors before and after the removal of the co-inventor are required, as well as the signature of the patent owner. In the case of an addition of a co-inventor, evidence of the creative contribution to a substantive feature of the invention before the filing date of the application is required.

Ownership of an invention being made as part of the duties of an employee belongs to the employer, and that applies even one year after departure. It is therefore recommended for the employer to monitor patent filings by former employees even after their departure and conduct due diligence on new hires. These provisions apply to inventions made in China, whether the patent filing is national or foreign.

Interestingly, assigning a patent or patent application from a Chinese entity to a foreign entity has to go through a technology approval procedure, which may last from two to eight weeks. The technology approval procedure does not apply to a foreign entity assigning to a Chinese entity.

Under Article A19 of the Chinese Patent Law, where an invention (i.e., the substantive content thereof) is made on Chinese territory, it shall be submitted to secrecy review. Applicants have to be careful since omission of the secrecy review process poses a direct harm to the patent validity. A request for secrecy review is required for first filings in China or abroad. However, a PCT application filed with the Chinese patent office would not need to file such a request. Article A15 of the Chinese Patent Law provides that a reward (lump sum) and a remuneration (stock, options, dividends) based on the commercial success of the product should be awarded to the inventor. The reward and remuneration can be fixed by an agreement between the employer and the employee.

### The American Experience

Regarding the US, Mr. Altman explained that inventorship is determined by case law. Citizenship or residency is not considered for determining inventorship, rather it is the conception (and not the reduction to practice) that is key. Joint inventors must have collaborated in the conception of the claimed invention in order for them to be named as inventors in the same patent application. Post-filing and post-issuance correction of inventorship is fairly simple and can be done by a corrected ADS in the case of a patent application, or a certificate of correction in the case of a patent. Ownership is determined based on where the invention was made (meaning which US state). In general, inventors own the invention unless they have signed a contract requiring assignment. The inventions of an employee hired to invent automatically go to the employer.

Unlike in some jurisdictions, being named as an applicant does not confer an ownership right to the patent application. An executed assignment from each inventor is required to confirm ownership. Recordation of the assignment at the USPTO is not required but highly recommended to avoid ownership conflicts.

The relevant statute, 35 USC 184, provides restrictions on foreign filings. An invention made in the US needs to obtain a foreign filing license either through a first filing in the US or through a request for foreign filing, before filing abroad. Not complying with this requirement could have dramatic consequences: the patent could be declared invalid, and fines and imprisonment are possible punishments in case of willful violation. In the US, there is a possibility of excuse through a retroactive foreign license, if the first filing abroad without permission was made by mistake and the invention was not of a type subjected to secrecy review.

When an invention is made in two countries through inventor collaboration, for example both in China and the US, one may need to obtain a foreign filing license from both countries. This creates a conflicting situation as a first-filed application cannot be filed in two countries at once. In this special case, the PCT route through China may be advantageous. One first obtains a foreign filing license in the US within one day through an expedited proceeding using a draft of the application, then files in English a PCT application with the Chinese Patent Office as the receiving office once the foreign filing license is granted by the USPTO.

The US is somewhat of an outlier regarding the reward and remuneration question. Under US law, everything that benefits the employee has to be in the employment contract, including a remuneration clause. There is no separate requirement to remunerate inventors. Depending on the state, inventions made in the course of the employment may or may not be automatically assignable to the employer.

### Summary

As a conclusion, in multi-jurisdictional cases, it is important to complete the secrecy requirements for each of the countries involved and to have employment agreements addressing the compensation and assignment of the invention in each jurisdiction.

## Plenary Session 2: Q278 - Industrial Designs and the Role of Prior Art

By Sarah Matheson (Chair of the session) and Andrew Massie

The Plenary Session was held on Tuesday and was attended by over 320 participants. A great many written proposals were received in advance of the session which ensured vigorous debate over 4 hours, which saw many of the suggestions received in advance, and those proposed during the session, adopted.

A basic distinction was made between a design that is the subject of a registered or unregistered right and the design right itself, while much discussion took place around the “Criteria of prior art” section of the Resolution. Of significance was the deletion of the European style requirement that a prior art disclosure be one that “could reasonably have become known in the normal course of business to the circles specialized in the sector concerned in the respective jurisdiction”. The other area of major discussion related to the use of prior art when assessing the requirements for protection of a design, in particular when a combination of prior art references can be used. The final draft Resolution only allows the combination of prior art references when the combination is suggested in the prior art, and the design is assessed as a whole.

2021 AIPPI World Congress Online The International Association for the Protection of Intellectual Property (AIPPI)

### INDUSTIRAL DESIGNS AND THE ROLE OF PRIOR ART

- 19 October 2021
- Plenary chair: Sarah MATHESON
- Study committee: Brian GRAY, Margaret POLSON, Maria Cecilia ROMOLEROUX, Klaudia BLACH-MORYSINSKA
- Responsible reporters: Linda LECOMTE & Guillaume HENRY

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## Panel Session 11

### A year in an hour – EU & US case law

**Thursday, October 21, 12:00 PM-1:00 PM (CEST)**

This Panel Session will provide a fast-paced update on recent, must-know decisions from the United States and the EU across the IP spectrum. It will provide a one-stop opportunity for practitioners from around the world to quickly get up to speed on the most pertinent IP decisions that have arisen over the last year and any related changes in the law or practice. The session will be presented by leading IP practitioners from the United States and the EU and will provide valuable insights into the practical implications and takeaways from these matters and will also touch upon upcoming decisions to watch out for. Decisions reviewed may include, amongst others:

- US decision in *Google v. Oracle* (copyright protection and software interfaces)
- EU decision in *Monopoly* (bad faith & refiling)
- EU decision in *VG Bild-Kunst v SPK* (is framing communication to the public?)

It is expected that some of the decisions discussed and the resulting changes in law or practice may provide the basis for future AIPPI Study Questions.

## Panel Session 12

### Doctrine of equivalents: can the prior art infringe?

**Thursday, October 21, 5:30 PM-6:30 PM (CEST)**

The doctrine of equivalents is a rule that is applied to determine the scope of protection of a patent. It is not a rule of claim construction as such: the premise is that when an allegedly infringing product falls outside the scope of the claim as normally construed, that product may nonetheless infringe if it is considered to be an equivalent of the invention. This was the position reached in the U.K. Supreme Court decision in *Actavis UK v. Eli Lilly*, and reflected in the U.S. CAFC decision in *Eli Lilly v. Hospira*.

However, once there is a divergence between the scope of protection and the scope of the claim as normally construed, it becomes possible, at least in theory, for the prior art to infringe if the prior art falls outside the scope of the claim as normally construed but nonetheless falls within the scope of protection of the patent as an equivalent. This would be the case at least on a strict novelty analysis, and the validity of the patent then could turn on whether the invention would have been obvious in light of the prior art. This highlights an uneasy parallel between the tests for obviousness/inventive step and equivalents.

The purpose of this panel session is to explore these tensions, and examine how courts in Europe, the US and elsewhere have addressed this complex issue. There has been an increase in the number of cases in which infringement by equivalents is alleged (e.g. *Icescape Ltd v Ice-World International BV & Others* [2018] EWCA Civ 2219) and clearly a resolution to these issues will need to be found.

## Panel Session 13

### Update on UPC

**Thursday, October 21, 5:30 PM-6:30 PM (CEST)**

Following the rejection of constitutional complaints in Germany in relation to the Unified Patent Court (UPC), and the subsequent ratification of the UPC Agreement by Germany in August 2021, all eyes are on the UPC. The question of how and when the UPC may provide a new patent litigation system in Europe is closer to being resolved. In this session, the Chair of AIPPI's Standing Committee on the UPC will discuss next steps and directions forward with Alexander Ramsay, Chair of the UPC Preparatory Committee.

## Thursday, October 21, 2021

<b>10:30 AM - 11:30 AM</b>	<b>Replay Recorded PS 10: Many A's and no end in sight: anti-suit &amp; anti-anti-suit injunctions</b> Panellists: Peter Damerell, Zhichao (Kevin) Duan, Clemens-August Heusch Sponsored by Beijing Gaowo Law Firm
	
<b>12:00 PM - 1:00 PM</b>	<b>Panel Session 11: A year in an hour – EU &amp; US case law</b> Panellists: Vanessa Bailey, Jan Bernd Nordemann
<b>12:00 PM - 1:00 PM</b>	<b>Secretaries / Treasurers Meeting 1</b> By invitation only
<b>1:00 PM - 1:45 PM</b>	<b>AIPPI Café 30: FRAND &amp; Anti (anti++) suit injunctions</b> Panellists: Ken Adamo, Peter Damerell, Gustavo De Freitas Morais, Christof Augenstein, Stefanie Bergia, Hemant Singh, Johann Pitz, Carlos Pérez de la Sierra
<b>1:00 PM - 1:45 PM</b>	<b>AIPPI Café 31: Genetic resources, traditional knowledge and more</b> Panellists: Karen Abraham, Takeshi Komatani, Ana Claudia Mamede, Martin Michaus, Audrey Williams
<b>1:00 PM - 1:45 PM</b>	<b>AIPPI Café 32: A Colourful Discussion on Patents</b> Panellists: Charles Boulakia, Israel Jimenez, Leonor Magalhães Galvão
<b>1:00 PM - 2:00 PM</b>	<b>Independent Members Meeting 1</b> By invitation only
<b>2:00 PM - 4:00 PM</b>	<b>Plenary Session 4: Q277 - Registrability of trade marks against public order or morality</b>
<b>4:30 PM - 5:15 PM</b>	<b>AIPPI Café 33: The use of AI by IP offices</b> Panellists: Ricardo Abrantes, Santosh Chari, Xiaoling Duan, Vidisha Garg, Thomas Marlow, Karri Leskinen
<b>4:30 PM - 5:15 PM</b>	<b>AIPPI Café 34: Parody, satire &amp; pastiche</b> Panellists: Stefan Naumann, Dale Nelson, Sanna Wolk, Kevin Tottis, Brian Gray
<b>4:30 PM - 5:15 PM</b>	<b>AIPPI Café 35: Open justice and trade secrets</b> Panellists: Sophie Lens, Anshul Saurastri, Marina Cunningham, Vilhelm Schröder, Hans Eriksson
<b>4:30 PM - 5:15 PM</b>	<b>AIPPI Café 36: Undiscussed aspects in TRIPs under COVID-19 situation</b> Panellists: Victor Garrido, Ivan Hjertman, Behrang Kianzad, Takeshi Komatani, Menda Manoj
<b>4:30 PM - 5:30 PM</b>	<b>Secretaries / Treasurers Meeting 2</b> By invitation only
<b>5:30 PM - 6:30 PM</b>	<b>Panel Session 12: Doctrine of equivalents: can the prior art infringe?</b> Panellists: Sabine Agé, Trevor Cook, Michael Schneider, Agata Gabriela Sobol
<b>5:30 PM - 6:30 PM</b>	<b>Panel Session 13: Update on UPC</b> Panellists: Christof Augenstein, Alexander Ramsay
<b>7:00 PM - 8:00 PM</b>	<b>Replay Recorded Panel Session 11: A year in an hour – EU &amp; US case law</b> Speakers: Panellists: Vanessa Bailey, Jan Bernd Nordemann

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Edited by Christian Czychowski & Jan Bernd Nordemann

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