

“IP Question of the Day”

Question: What factors need to be considered in the creation and management of global patent portfolios?



In conversation with... **Gauthier Obrecht**

Gauthier Obrecht has been the Chair of the [AIPPI In-house Committee](#) since 2021 and an AIPPI member for almost 20 years. He was also involved in the Convenor Group, the forerunner of the In-house Committee. Previously in private practice, he is based in Germany where he works for Boehringer Ingelheim.

The [In-house Committee](#) is a little different to other AIPPI Committees – can you tell us a little bit about it and why this is?

Yes, we are a so-called Bureau Advisory Committee. We report directly to the Bureau and make recommendations on how to make AIPPI more attractive and relevant to in-house members.

Do the Committee members have a special profile?

We are all in-house counsels, everyone works in the industry as a patent / trade mark / copyright practitioner or as an in-house lawyer. Currently, in-house counsels make up less than 10% of the AIPPI membership. In fact, we are the customers of the other AIPPI members!

We are closer to the end users of the IP system than private practitioners. As industry employees, our employers use IP as part of their business. They are the Applicants, Assignees and Owners of IP rights or they navigate the IP system to manufacture and sell non-infringing products and services.

Can you explain why in-house events (like the AIPPI Café 14 on Tuesday, October 19) are for in-house delegates only?

It's probably the best way that we can freely share ideas with our peers. It is one of the few chances we have to all get together. COVID has of course changed the way we communicate. In-person, it was very important that we could make the most of the opportunity. We can exchange on best practices, on the strategies we use in our companies, and on issues related to mandating private practitioners to work on our behalf without worrying about providers using these insights into our day-to-day life to try to sell us their services or to report to our competitors.

What kind of topics did the committee work on in the past year?

What we try to bring to the table is the in-house perspective, particularly what is currently of importance for the industry. We are more interested in the practical use of IP than more academic questions.

We want to know how a decision or harmonization can affect our daily work. The in-house counsels expect that AIPPI can add something of value on this issue.

Of course, we have prepared for the panel sessions such as *Panel Session 7: Managing global patent portfolios* on October 19. Another topic that we are close to is Trade Secrets. We have members who are also members of the [AIPPI Trade Secrets Committee](#). Trade Secrets quite obviously is a topic of great importance to the industry.

I personally am also on the [AIPPI Membership Committee](#). There I can give insights from industry and let AIPPI know how the association can be attractive to in-house counsels. This involvement in other committees is a good thing that all sides can benefit from I believe.

Where can someone go to find out more information about the In-house Committee?

The committee members are listed on [the AIPPI website](#). If someone wants to contact us, we would be happy to answer their question.

Interview conducted by Diarmuid De Faoite, AIPPI Communications Manager.

Answer: Find out today at Panel Session 7: Managing global patent portfolios.



In conversation with... Brian W Gray

Brian W Gray is the Chair of the AIPPI Study Question Q278. He is the owner of his firm Brian Gray Law in Toronto, Canada. He is a barrister, solicitor and registered patent and trademark agent in Canada. Details about Brian can be found at www.briangraylaw.com.

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

This study question is about the *Use of Prior Art in Assessing Industrial Designs*. Industrial Designs have become increasingly important as an economic driver for many commercial products. Good industrial designs sell products as witnessed by the success of Swedish, Italian, French designers to name only a few and not to mention Apple's success with the design of its products.

Notwithstanding the economic importance of designs, this form of intellectual property remains one of the least harmonized of all types of intellectual property. Is the criteria to get a design, novelty or originality or both? Is individual character or non-obviousness necessary and what does that mean? Should designs and any prior art be judged by the world at large or a select group of knowledgeable designers in a particular sector? Can prior art designs be combined when evaluating new designs for non-obviousness or individual character?

How was the teamwork?

I have been the chairman of a number of AIPPI questions over the years. I am always amazed at the dedication and interest that the questions create. This question is no different. Many of the national groups are engaged and participate to create a lively debate.

Have you previously been involved in any study questions?

Yes. Most recently I was the Chair of the Linking and Framing Question in Milan, but I have been involved in one or more Study Questions as the Study Question representative for Canada or as a member of a Canadian Study Question committee off and on for over 40 years.

What kind of unexpected discoveries did you make over the year working on this?

Well, I already knew that there was a lot of variation in the law of Industrial Designs all over the world. However, so far, I think we have had more agreement than I expected, but we have not had the final vote yet! So, stay tuned.

What can people expect at your Study Question's plenary session on Tuesday, October 19?

We have formed a preliminary consensus on a number of the questions I referred to previously, but there are still many voices to be heard which might prevent a consensus. We can expect a continued lively debate.

Is there any one person or group you would like to acknowledge for their support?

In any Study Question, there is always one person who has the burden of keeping track of the amendments and that is the Secretary. He or she has the hard job, not the chairman. For this question that person is Klaudia Błach-Morysińska from Poland. She has to keep track of all amendments and proposals, and it is not even her native language. Also, of course, the Assistant Reporter Generals, Guillaume Henry and Linda Lecomte have been very supportive as has the rest of the team, Margaret Polson and Maria Romoleroux.

Would you recommend getting involved so deeply in a Study Question?

Yes, of course. The Study Questions are the heart and soul of AIPPI and are what make this association different from all the other IP organizations. It is a great way to discuss policy and see the issues in other countries.

Interview conducted by Diarmuid De Faoite, AIPPI Communications Manager.



Voices from the Congress

Lena Shen attended Panel Session 2: Trademark Evergreening-Limitations in Refiling

"These are frequently asked questions, i.e., how to maintain a trademark registration if I do not use it (yet) and whether it is allowed to re-file the trademark application once and once again in order to avoid being cancelled for non-use. You may find answers in this session. Trademark Attorneys from UK, US and Korea introduced the relevant practice and provisions in their jurisdictions respectively, which will give you useful and practical guidance when making strategies for re-filing a trademark in these jurisdictions."



Panel Session 5

Multi-jurisdictional inventorship

Tuesday, October 19, 12:00 PM-1:00 PM (CEST)

This Panel Session will address the subject of inventorship of inventions where the inventors are the subject of different jurisdictions. Inventors of an invention may reside in different countries, have different citizenship, or have employment contracts under different national laws. Today, this is a common occurrence, already because many companies have geographically distributed research groups and engage in cross-border research projects (e.g. with other companies or universities).

Multi-jurisdictional inventorship represents a range of fundamental issues such as inventorship determination, ownership of the invention, filing requirements and remuneration of inventors.

Due to a lack of harmonization, various jurisdictions may have different or even conflicting laws thereon. AIPPI has previously studied aspects of the subject matter of this panel session, resulting in the 2015 Resolution on “Inventorship of multinational inventions”.

This panel session will focus on strategies for handling diverging national requirements and will explore different management approaches for tackling issues that may come up in this respect, e.g. regarding filing, ownership and remuneration.

Panel Session 6

Guilty or not guilty: platform liability & safe harbours

Tuesday, October 19, 12:00 PM-1:00 PM (CEST)

In many parts of the world, the liability of online service providers for their users’ conduct and content is determined by rules created around the turn of the century, when the internet was just starting to reach mainstream adoption. Safe harbours for access, caching and hosting providers have enabled the modern internet, but they also have their downsides. In recent years, there have been increasing demands for these rules to be updated.

New EU rules create a copyright carve-out from the safe harbour, making “online content-sharing service providers” liable for their users’ infringing uploads unless they can demonstrate “best efforts” to obtain authorization and “prevent availability” of works for which right holders have provided sufficient information. Separately, the US Copyright Office has published a study illustrating the perceived shortcomings of the current copyright safe harbour.

In the EU, US and beyond, copyright-specific projects are being overshadowed by broader and more fundamental proposals to update the liabilities and responsibilities of online platforms. 2021 sees heated debate in the EU on a proposed “Digital Services Act”, and in the US on changes to “Section 230”. Other jurisdictions are also enacting or debating significant updates. It remains to be seen what clarity these can bring to heated issues such as liability, notice and action, filtering and blocking obligations, user rights, and international jurisdiction with respect to cross-border infringers and the platforms they use.

This panel will bring some much-needed structure, facts and rational consideration to the debate.



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Panel Session 7

Managing global patent portfolios

Tuesday, October 19, 5:30 PM-6:30 PM (CEST)

This panel session will address creation and management of global patent portfolios for start-ups to big companies from an in-house perspective.

Creation and management of robust global patent portfolios is challenging for all companies. Many factors need to be considered, including: importance of a country for the company's business due to investors, competitors, manufacturing and distribution; company marketing; hidden risks such as undue exposure; patent vs trade secret protections; useful claiming; return on investment; enforcement interests; increasing fees, and so much more!

Managing global patent portfolios requires an understanding of one's business, legal issues, and industry trends.

This panel session will discuss current issues, including: how would the patent portfolios support an innovation strategy/sales strategy/M&A strategy/litigation/licensing approach? What factors should be considered when managing a global patent portfolio in view of business needs? How to balance the management of patent portfolios and trade secrets, in view of IP risk management? What are the differences in managing global patent portfolios for start-ups and big companies? How to develop IP management standards to drive improvement in IP protections without breaking the bank?

Panel Session 8

Turning local into international: protection of GIs

Tuesday, October 19, 5:30 PM-6:30 PM (CEST)

This Panel Session will have a twofold mandate. First, in many jurisdictions the common understanding of geographical indications (GIs) or appellations of origin (AOs) is often limited and serves to undermine the benefits and advantages that GIs can provide. This Panel Session will review means of protection available in different jurisdictions and how GIs and AOs are used and promoted in such jurisdictions, and what improvements may be considered.

Second, the panel will look at a number of specific topics that arise with GIs that will be of interest to practitioners in all jurisdictions, including for example:

- how should the term “essentially attributable” in Article 22 of TRIPS be understood in establishing whether a given quality, reputation or other characteristic of the product supports a GI designation?
- what are the limits on activities that can be performed on GI products outside their territory of origin (e.g. further packaging or treatment) and yet permit the manufacturer or seller to maintain the use of the GI designation?
- if a GI product is used as an ingredient, can the GI designation be used on the label or in marketing the final product, and if so under what conditions?



Voices from the Congress

Debbie David attended Panel Session 4: Video gaming: copyright & design issues

Video games and e-sports have fast become household names in the entertainment space. As these virtual worlds flourish, so too is there an explosion of IP and related considerations – from copyright, designs and trademarks, across to broadcasting and streaming rights, and interesting thoughts about what rights players might have with more creative freedom and customizations available within the game. The panelists delved into key issues across Asia, Europe and the USA, and provided great insight into current developments and issues as well as gazing into what the future of video games and e-sports might look like.



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Tuesday, October 19, 2021

10:30 AM - 11:30 STOCK	Replay of Recorded Panel Session 3: Alternative medicine? Data protection rules for pharmaceutical compounds Panellists: Brigitte Carion-Taravella, Masaru Nakajima, Michael Stern, John Todaro Sponsored by Stock Intellectual Property
10:30 AM - 11:30 AM DERIS [™]	Replay Recorded Panel Session 4: Video gaming: copyright & design issues Panellists: Eugene Low, Stefan Naumann, Vilhelm Schröder, S. Gregory Boyd Sponsored by Deris
12:00 PM - 1:00 PM 	Panel Session 5: Multi-jurisdictional inventorship Panellists: Dan Altman, Luis-Alfonso Durán, Mengmeng Yu Sponsored by PitchMark LLP
12:00 PM - 1:00 PM	Panel Session 6: Guilty or not guilty: platform liability & safe harbours Panellists: Trevor Albery, Alfred Macchione, Cédric Manara
1:00 PM - 1:45 PM	AIPPI Café 10: Current practice in trade mark oppositions in the EU Panellists: Christian Durán, Bartosz Krakowiak, Aurélia Marie, Gilles Rubens
1:00 PM - 1:45 PM	AIPPI Café 11: PCT Challenges Panellists: Rafael Beltran, Catherine Bonner, Noel Courage, Mary Drabnis, Elisabetta Papa, D. Calab Gabriel, Neeti Wilson, Richelet Gastón
1:00 PM - 1:45 PM	AIPPI Café 12: IP valuation & IP value– from IP rights to IP assets Panellists: Eyal Bressler, Reinhard Oertli
1:00 PM - 1:45 PM	AIPPI Café 13: Global impact free trade agreements on IP Panellists: Roberto Carapeto, Victor Garrido, Sharon A. Israel, Ed Clarke
1:00 PM - 1:45 PM	AIPPI Café 14: In-house (for In-house only) Panellists: Isabelle Chabot, André Clerix, Ayse Ildes Erdem, Emily O'Neill, Gauthier Obrecht
2:00 PM - 4:00 PM	Plenary Session 2: Q278 - Industrial Designs and the Role of Prior Art
4:30 PM - 5:15 PM	AIPPI Café 15: Reaping the fruits of wise prosecution when litigating BioPharma patents Panellists: Anna Bladh Redzic, Daniel Lim, Juergen Meier, Sanjeev Kumar Tiwari
4:30 PM - 5:15 PM	AIPPI Café 16: Patents & AI – past, present and future Panellists: Elif Kayral, Stefan Schohe, Stephan Freischem, Bhupinder Randhawa, Örjan Grundén, Mike Jennings, Bhupinder Randhawa, Thomas Kretschmer, Divyendu Verma, Kiyoshi Tsuru, Canan Öztürker, Sanjeev Kumar Tiwari
4:30 PM - 5:15 PM	AIPPI Café 17: Changes in IP office practice during the pandemic Panellists: Santosh Chari, Vidisha Garg, Karri Leskinen, Jose-Juan Mendez
4:30 PM - 5:15 PM	AIPPI Café 18: Spurring Innovation in Green Technologies Panellists: Leonor Magalhães Galvão, Peter Treloar
4:30 PM - 5:15 PM	AIPPI Café 19: Young Members and the future of AIPPI Panellists: Nevin Jacob Koshy, Samantha Yung, Kevin Feng
5:30 PM - 6:30 PM 	Panel Session 7: Managing global patent portfolios Panellists: Gauthier Obrecht, Loek Steffanie, Shohta Ueno, Naomi Voegtli Sponsored by Dannemann Siemsen
5:30 PM - 6:30 PM	Panel Session 8: Turning local into international: protection of GIs Panellists: Laura Collada, Marcus Höpperger, Miwako Takimura
7:00 PM - 8:00 PM 	Replay Recorded Panel Session 5: Multi-jurisdictional inventorship Panellists: Dan Altman, Luis-Alfonso Durán, Mengmeng Yu Sponsored by PitchMark LLP
7:00 PM - 8:00 PM	Replay Recorded Panel Session 6: Guilty or not guilty: platform liability & safe harbours Panellists: Trevor Albery, Alfred Macchione, Cédric Manara

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Edited by Christian Czychowski & Jan Bernd Nordemann

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