

Program Updated on April 3, 2013 (Subject to Change)

**Fordham Intellectual Property Law Institute
&
Emily C. & John E. Hansen Intellectual Property
Institute**

**21st Annual Intellectual Property Law & Policy
Conference**

www.fordhamipconference.com

**Fordham University School of Law
Thursday and Friday, April 4-5, 2013**

**Hugh C. Hansen
Director**

Learn Debate Have Fun

CONFERENCE PROGRAM

Subject to Change

Wednesday, April 3

Reception & Dinner for Faculty and Sponsors

Reception: 12th Floor, Lowenstein

6:15 PM to 7:30 PM

Dinner: 12th Floor, Lowenstein

7:30 PM to 9:00 PM

Thursday Morning, April 4

Breakfast

Platt Atrium
7:00 AM – 9:00 AM

Sponsored by:

Crowell & Moring LLP

Registration

Platt Atrium
7:00 AM – 8:00 AM

Please note: Doors to the McNally Amphitheater will close at 8:00 AM. People arriving after 8:00 AM should go to Room 311. Registrants not yet seated will be escorted to Room 311.

Welcoming Remarks:

Thursday 8:00 AM – 8:05 AM
McNally Amphitheater

Prof. Hugh C. Hansen

Fordham University School of Law, New York

SESSION 1: Plenary Session

Thursday 8:10 AM – 1:00 PM
McNally Amphitheater

1A. Governmental Leaders in IP: Can Individuals Make a Difference?

Thursday 8:10 AM – 9:10 AM (60 minutes)
McNally Amphitheater

Moderator:

Prof. Hugh C. Hansen

Fordham University School of Law, New York

Program Updated on April 3, 2013

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

David J. Kappos

Cravath, Swaine & Moore LLP, New York
(up to 15 minutes)

Antonio Campinos

President of OHIM, Alicante
(up to 15 minutes)

Panelists:

Maria Martin-Prat

Head of Unit – Copyright, DG Internal Market & Services, European Commission,
Brussels

Prof. Ralph Oman

The George Washington University Law School, Washington D.C.

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

1B. Views from the Judiciary

Thursday 9:15 AM – 10:15 AM (60 minutes)

McNally Amphitheater

Moderator:

Prof. Hugh C. Hansen

Fordham University School of Law, New York
(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Panelists:

Hon. Annabelle Bennett

Federal Court of Australia, Sydney

Hon. Mr. Justice Peter Charleton

High Court of Ireland, Dublin

Hon. Denny Chin

Program Updated on April 3, 2013

U.S. Court of Appeals for the Second Circuit, New York

Dr. Klaus Grabinski

Federal Supreme Court, Karlsruhe

Lord Hoffmann

Honorary Professor of Intellectual Property, Queen Mary, University of London

Hon. Roger T. Hughes

Federal Court of Canada, Ottawa

Hon. Rian Kalden

Vice President, District Court of The Hague, The Hague

Hon. Pauline Newman

U.S. Court of Appeals for the Federal Circuit, Washington D.C.

Hon. Shinji Oda

Intellectual Property High Court, Tokyo

Hon. Robert Van Peurse

Court of Appeal The Hague, The Hague

(Panelists have no individual time allocated; they take part in the general discussion.)

Break

10:15 AM – 10:40 AM

1C. Multilateral / FTA Issues & Policy

Thursday 10:40 AM – 11:40 AM (60 minutes)

McNally Amphitheater

Moderator:

Prof. Hugh C. Hansen

Fordham University School of Law, New York

(up to 5 minutes to introduce the subject matter; intro of speakers –

just name and affiliation, please see bios in print materials and online.)

Speakers:

Michele Woods

Director, Copyright Law Division, World Intellectual Property Organization, Geneva

Multilateral Progress At WIPO In The Copyright Area

After a twelve-year gap in diplomatic conferences, the Standing Committee on Copyright and Related Rights (SCCR) adopted the text of a treaty to protect audiovisual performers in June 2012 and is preparing for another diplomatic conference to conclude a treaty on exceptions and limitations for the visually impaired and print disabled in June 2013. The SCCR also has an ambitious agenda and workplan on topics including protection for broadcasting organizations, exceptions and limitations for libraries and archives, and exceptions and limitations for research and educational institutions and other persons with disabilities.

(up to 10 minutes)

Pedro Velasco Martins

Deputy Head of Unit, Intellectual Property and Public Procurement, DG Trade, European Commission, Brussels

(up to 10 minutes)

Stanford McCoy

Assistant U.S. Trade Representative for Intellectual Property and Innovation, Office of the U.S. Trade Representative, Washington D.C.

Intellectual Property and Innovation in the 2013 U.S. Trade Policy Agenda

The U.S. Administration has laid out an ambitious trade Policy Agenda for 2013, including major trade negotiations with countries in the Pacific Rim, and planned negotiations with the EU. This presentation will discuss how the Administration sees intellectual property issues playing a role in these and other trade policy initiatives in the year ahead.

(up to 10 minutes)

Panelists:

Prof. Justin Hughes

Senior Advisor to the Undersecretary of Commerce for Intellectual Property;
Professor of Law, Cardozo Law School, New York

Shira Perlmutter

Chief Policy Officer and Director for International Affairs, United States Patent and Trademark Office, Alexandria

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

1D. General Counsel Roundtable: The View from the Top

Program Updated on April 3, 2013

Thursday 11:45 AM – 1:00 PM (75 minutes)
McNally Amphitheater

Moderator:

Prof. Hugh C. Hansen

Fordham University School of Law, New York
(up to 5 minutes to introduce the subject matter; intro of speakers –
just name and affiliation, please see bios in print materials and online.)

Panelists:

Paul T. Cappuccio

Executive Vice President and General Counsel, Time Warner, Inc., New York

Rick Cotton

Executive Vice President and General Counsel, NBC Universal Media LLC, New York

Louise Pentland

Executive Vice President, Chief Legal Officer, Nokia, Dallas

Brad Smith

General Counsel and Executive Vice President, Legal and Corporate Affairs,
Microsoft Corporation, Redmond

Kent Walker

Senior Vice President & General Counsel, Google Inc., Palo Alto

(Panelists have no individual time allocated; they take part in the general discussion.)

Lunch

Platt Atrium & 12th Floor Lounge, Lowenstein Building
1:00 PM – 2:20 PM

Sponsored by:

Fulbrook Capital Management, LLC

Speaker

Hon. Jed S. Rakoff

U.S. District Court, Southern District of New York, New York

IP and IP Litigation: A Judge's Perspective
(up to 15 minutes)

Thursday Afternoon, April 4

THREE CONCURRENT SESSIONS:
Patents, Copyright, Trademarks & Multilateral

SESSION 2: PATENT LAW

Concurrent Session

Thursday 2:30 PM – 6:30 PM

10 on the Park*

**10 on the Park requires that our attendees complete a bag screening. Please plan to arrive a few minutes in advance of the session start time.*

2A. Global Patent Developments

Thursday 2:30 PM – 3:30 PM (60 minutes)

10 on the Park*

**10 on the Park requires that our attendees complete a bag screening. Please plan to arrive a few minutes in advance of the session start time.*

Moderator:

Prof. John R. Thomas

Georgetown University Law Center, Washington D.C.

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Hon. Roger T. Hughes

Federal Court of Canada, Ottawa

Canada's Promise of Patent Doctrine

Canada's highest Court has confirmed in two recent decisions that a Patent is based on a bargain between the inventors and the state. The inventor gets a limited term monopoly in the claimed invention in return for disclosure of the invention. However,

the invention must live up to the promise made in the disclosure as to what the invention will accomplish. Failure to do so means that the invention lacks the promised utility and is invalid.

(up to 8 minutes)

Prof. Dr. Heinz Goddar

Boehmert & Boehmert, Munich

Occlusion Device” in German Federal Court of Justice – A Change of Tide for Doctrine of Equivalents and File Wrapper Applicability in Germany?

Since the decision "Occlusion Device" of the German Federal Court of Justice (May 2011), the applicability of Doctrine of Equivalents in Germany has changed.

Whatever is only in the specification, but not in the claims, cannot be covered by DOE. Furthermore, a file wrapper consideration in case of differences between a published version of application and its specification is becoming easier.

(up to 8 minutes)

Dr. Jürgen Dressel

Head Patents, Litigations ex US, Novartis Pharma AG, Basel

Development of established drugs for new indications – compensation by IP-exclusivity fit for purpose?

The value of new medical indications has been recognized by patent systems in most of the developed countries. However enforcement has been critically undermined in most of those countries by a complex mixture of issues including carve-out of patented uses by Generics, mandatory or incentivized substitution as well as prescription and reimbursement mechanisms. This presentation will highlight the issues across jurisdictions and propose possible solutions which provide certainty and fairness to all stake-holders.

(up to 8 minutes)

Panelists:

Hon. Annabelle Bennett

Federal Court of Australia, Sydney

Brian P. Murphy

Edwards Wildman Palmer LLP, New York

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 20 minutes (speakers, panelists and members of the audience)

2B. The European Unitary Patent and the Unified Patent Court

Thursday 3:35 PM – 4:50 PM (75 minutes)

10 on the Park*

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Moderator:

James Nurton

Managing Intellectual Property, London

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Hon. Robert Van Peursem

Court of Appeal The Hague, Netherlands

This discussion will provide a helicopter view on the European Unitary Patent and the Unified Patent Court. It will include a delineation of the set-up and tasks of the Preparatory Committee of the Unified Patent Court and an inquiry into its future, especially regarding when and how it will proceed, if it ever does.

(up to 10 minutes)

Dr. Myles Jelf

Bristows, London

Unified Patent Court Agreement and Draft Rules: Strategic Observations

The possibility of the new courts' embracement of bifurcation will be explored, including an inquiry into how much of an effect it may have. The strategic options which the new framework appears to provide to patents through licensee litigation will also be discussed along with how the absence of any power to amend a partially valid patent may affect litigation before the new courts.

(up to 6 minutes)

David Laliberté

Director, Intellectual Property Policy, Intellectual Property Group, Legal and Corporate Affairs, Microsoft Corporation, Redmond

A discussion on the unitary patent and unified patent court's impact on industry, including areas of concern relating to bifurcation, injunctions and fees.

(up to 6 minutes)

Pierre Véron

Véron & Associés, Paris

Unified Patent Court: a single court for patent disputes in Europe?

Some weeks ago, a majority of Member States of the European Union decided to create a European Patent with Unitary Effect and a Unified Patent Court. Will this be

the beginning of a new era for patent litigation in Europe? Will the new system be adopted enthusiastically by the users? Or will they “opt-out” as is possible? Will the new rules about jurisdiction allow less or more forum shopping? Will the cards be reshuffled between the capitals of patent litigation in Europe?

(up to 6 minutes)

Gabriel Cuonzo

Trevisan & Cuonzo, Milan

(up to 6 minutes)

Christoph de Coster

Taylor Wessing, Munich

Unitary Patent and the Unified Patent Court: Strategic Considerations for the Patentee

This discussion will include the following issues: choice of patent between the unitary patent, European patent, national patents, and divisionals; stay-in or opt-out options for European patent owners during the transitional period of the Unified Patent Court; and forum shopping and multiple actions against the same product under the Unified Patent Court.

(up to 6 minutes)

Panelist:

Dr. Klaus Grabinski

Federal Supreme Court, Karlsruhe

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

Break

4:50 PM – 5:15 PM

2C. U.S. Patent Law: Recent Developments

Thursday 5:15 PM – 6:45 PM (90 minutes)

10 on the Park*

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Moderator:

Prof. Martin J. Adelman

The George Washington University Law School, Washington D.C.

Program Updated on April 3, 2013

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Dimitrios T. Drivas

White & Case LLP, New York

Current Developments in US Patent Law

An overview of Supreme Court and significant Federal Circuit opinions and cases on Appeal. The following cases will be discussed: Gunn v. Minton, Kappos v. Hyatt, Bowman v. Monsanto, FTC v. Actavis, AMP v. Myriad, Akamai v. Limelight, Ninestar v. ITC in view of Kirtsaeng v. John Wiley, CLS Bank v. Alice Corp., Bard v. WL Gore, Lightning Ballast v. Phillips Electronics, Apple v. Motorola Mobility
(up to 25 minutes)

Alexander Macgillivray

General Counsel, Twitter, Inc., San Francisco

The Twitter “Innovator’s Patent Agreement”

Twitter’s Innovator’s Patent Agreement will be described, including why it was Adopted and what it signifies regarding other similar initiatives about software patents
(up to 7 minutes)

Bruce M. Wexler

Paul Hastings, New York

Formulation patents typically raise significant issues in pharmaceutical patent litigation. With respect to questions of infringement, unlike the situation of active ingredient patents, generic drug companies often have some room to attempt to design-around and the FDA has authority for leeway in formulation differences. In these situations, innovators must at times rely on the doctrine of equivalents, a controversial doctrine under U.S. patent law. There have been some interesting recent developments in this doctrine and a surprising trend, which shows that the doctrine is very much alive in US patent law. Examples of significant recent decisions illustrating this trend are: Pozen Inc. v. Par Pharm., Inc., 696 F.3d 1151 (Fed. Cir. 2012); Adams Respiratory Therapeutics, Inc. v. Perrigo Co., 616 F.3d 1283 (Fed. Cir. 2010).

(up to 7 minutes)

Panelists:

Noah M. Leibowitz

Simpson Thacher & Bartlett LLP, New York

John Pegram

Fish & Richardson P.C., New York

Program Updated on April 3, 2013

Prof. John R. Thomas

Georgetown University Law Center, Washington D.C.

Harold C. Wegner

Foley & Lardner LLP, Washington D.C.

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 40 minutes (speakers, panelists and members of the audience)

Reception

10 on the Park

Time Warner Center

North Tower, 10th Floor

60 Columbus Circle (entrance on 60th St btw Broadway & Columbus)

6:30 PM – 8:30 PM

Sponsored by:

Freshfields Bruckhaus Deringer LLP

SESSION 3: COPYRIGHT LAW

Concurrent Session

Thursday 2:30 PM – 6:45 PM

McNally Amphitheater

3A. EU Copyright: Recent Developments

Thursday 2:30 PM – 3:40 PM (70 minutes)

McNally Amphitheater

Moderator:

Prof. Jane Ginsburg

Columbia Law School, New York

(up to 5 minutes to introduce the subject matter; intro of speakers –

just name and affiliation, please see bios in print materials and online.)

Speakers:

Julie Samnadda

Member, Legal Service, European Commission, Brussels

(up to 15 minutes)

Hon. Mr. Justice Peter Charleton

High Court of Ireland, Dublin

The Oracle Speaks

Once again a surprise from Europe's highest court; a licence agreement for computer software is turned into a sale. The decision is based on economic reasoning: what is not copyright, such as a broadcast of a football match, can be interpreted to attract protection because of the expense involved and what is copyright can lose protection because there has been sufficient economic return through first sale? Where is Europe on all of this and would not a fair use defence be better than a clash of rights jurisprudence that is unpredictable?

(up to 8 minutes)

Dr. Mihály Ficsor

President, Hungarian Copyright Council; International Legal Consultant, Budapest

The Inundation of the CJEU by Copyright Referrals and the Dangers of 'Creeping Harmonization'

This talk intends to deal with three structural and "constitutional" problems: (i) the referral system results in too early and unnecessary jumping to the highest EU judicial level which may be an obstacle to healthy case-law development; (ii) it is a collateral effect of not allowing the clarification of certain legal issues at lower judicial levels - even if with some possible transitional contradictions - that sometimes the CJEU itself adopts conflicting decisions; and (iii) time and again the CJEU enters the field of law-making which is not its task, and it may also go so far as to de facto amend certain existing provisions of directives. My intention is to state these problems in a short cover paper (corresponding also to the contents of my ppt.) to which I would attach three annexes consisting in short studies to illustrate these problems on the basis of concrete cases; namely (i) the Oreal/eBay - Scarlet - Netlog chain of decisions on intermediary liability to illustrate emerging contradictions in the CJEU decisions; (ii) the referral of the Tribunal of Milan to the CJEU in the Nintendo ("modchip") case as an example of unnecessary burdening the CJEU; (iii) the UsedSoft decision where, in my opinion, the CJEU has adopted a decision which is in conflict with a clear (and duly justified) provision of the Information Society (Copyright) Directive.

(up to 8 minutes)

Panelists:

Trevor Cook

Bird & Bird, London

Dr. Silke von Lewinski

Max Planck Institute for Intellectual Property and Competition Law, Munich

Christopher Stothers

Arnold & Porter LLP, London

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 30 minutes (speakers, panelists and members of the audience)

3B. Copyright Developments in Canada

Thursday 3:45 PM – 4:55 PM (70 minutes)

McNally Amphitheater

Moderator:

Hon. Roger T. Hughes

Federal Court of Canada, Ottawa

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Gilles Daigle

General Counsel and Head of Legal Services, Society of Composers, Authors and Music Publishers of Canada, Ottawa

Recent Canadian Supreme Court Copyright Decisions

This talk will provide a brief description of six copyright cases rendered by the Supreme Court of Canada in 2012, including the Court's interpretation of the communication right and the fair dealing exemption. This talk will also discuss ongoing litigation resulting from one of the cases in relation to ringtones.

(up to 10 minutes)

Howard Knopf

Macera & Jarzyna LLP, Ottawa

Canada's 2012 Copyright Modernization Act: Impact in Canada and Abroad

The new Canadian copyright legislation that has been in gestation for 15 years is now in force. On the one hand, it includes tough anti-circumvention provisions dealing with technical protection measures as well as strong anti-enabler provisions aimed at certain types of websites. On the other hand, it includes a broad new fair dealing exception for "education" and limits the availability of statutory minimum damages to a maximum of \$5,000 for all non-commercial infringing activity by any person or entity prior to commencement of any proceedings. Is this legislation balanced? Is it sustainable? What effect will it have elsewhere?

(up to 10 minutes)

Panelists:

Steven J. Metalitz

Mitchell Silberberg & Knupp, LLP, Washington D.C.

Barry B. Sookman

McCarthy Tétrault, Toronto

Program Updated on April 3, 2013

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 35 minutes (speakers, panelists and members of the audience)

Break

4:55 PM – 5:20 PM

3C. View from the Copyright Office & U.S. Recent Developments including Kirtsaeng

Thursday 5:20 PM – 6:45 PM (85 minutes)

McNally Amphitheater

Moderator:

Michael Shapiro

Senior Counsel for Copyright, Office of Policy and External Affairs, United States Patent and Trademark Office, Alexandria

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Maria Pallante

Register of Copyrights, U.S. Copyright Office, Washington D.C.

The View from the U.S. Copyright Office

This talk will address the general state of affairs within the United States regarding copyright revision discussions, including the divergent views of stakeholders, key policy studies of the Copyright Office, statutory and regulatory challenges, the role of Congress in weighing the public interest and the role of the Copyright Office itself.

(up to 15 minutes)

Panel discussion: up to 15 minutes (speakers, panelists and members of the audience)

Thomas Kjellberg

Cowan Liebowitz & Latman, New York

Recent Developments in U.S. Copyright Case Law including Kirtsaeng v. John Wiley & Sons

(up to 20 minutes)

Panel discussion including wrap up: 30 minutes (speakers, panelists and members of the audience)

Program Updated on April 3, 2013

Panelists:

Tod Cohen

Vice President and Deputy General Counsel, eBay Inc., San Jose

Prof. Hugh C. Hansen

Fordham University School of Law, New York

Howard Knopf

Macera & Jarzyna LLP, Ottawa

Prof. Tyler Ochoa

Santa Clara University School of Law, Santa Clara

Tom Rubin

Chief Intellectual Property Strategy Counsel, Microsoft, Seattle

(Panelists have no individual time allocated; they take part in the general discussion.)

Reception

10 on the Park

Time Warner Center

North Tower, 10th Floor

60 Columbus Circle (entrance on 60th St btw Broadway & Columbus)

6:30 PM – 8:30 PM

Sponsored by:

Freshfields Bruckhaus Deringer LLP

SESSION 4: TRADEMARK LAW AND MULTILATERAL

Concurrent Session

Thursday 2:30 PM – 6:30 PM

Room 311

4A. The new gTLDs

Thursday 2:30 PM – 3:35 PM (65 minutes)

Room TBA

Moderator:

Martin Schwimmer

Leason Ellis LLP, White Plains; Publisher, The Trademark Blog

Program Updated on April 3, 2013

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Prof. Mary W. S. Wong

University of New Hampshire, Concord

Trademark Protections In An Expanded Internet Domain Name System

In 2008 the Board of Directors for the Internet Corporation for Assigned Names & Numbers (ICANN), the international body responsible for managing the Internet domain name system (DNS), approved an unprecedented, massive expansion of the DNS. With the cooperation of many trademark and brand owners, several rights protection policies were developed prior to the launch of the program in January 2012 in order to provide anticipated protection to trademarks and brands at both the top level (the right of the dot) and the second level (the left of the dot). New issues have since emerged that may necessitate a change to some of these policies as well as new protections. What are the shortcomings of the current policies? What needs to be changed to ensure adequate protection for trademarks and brands while safeguarding consumer rights and interests? Is there a risk that ICANN policies will replace traditional judicial and legislative solutions for trademark protections?

(up to 15 minutes)

Panelists:

Dickerson M. Downing

Crowell & Moring LLP, New York

Steven J. Metalitz

Mitchell Silberberg & Knupp LLP, Washington D.C.

David Weslow

Wiley Rein LLP, Washington D.C.

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 40 minutes (speakers, panelists and members of the audience)

Break

3:35 PM – 4:00 PM

4B. Multilateral Developments

Thursday 4:00 PM – 5:15 PM (75 minutes)

Room 311

Moderator:

Michael Schlesinger

Program Updated on April 3, 2013

Mitchell, Silberberg & Knupp, New York
(up to 5 minutes to introduce the subject matter; intro of speakers –
just name and affiliation, please see bios in print materials and online.)

Speakers:

Prof. Justin Hughes

Senior Advisor to the Undersecretary of Commerce for Intellectual Property;
Professor of Law, Cardozo Law School, New York
(up to 8 minutes)

James Love

Director, Knowledge Ecology International, Washington D.C.
The global regulation of exceptions to rights reflects both expressions of national interests and values, and industry lobbying efforts, with the later often taking center stage in the United States and the European Union. Why is the value of expanding robust exceptions weakly appreciated by negotiators from countries that use and benefit from exceptions the most?
(up to 8 minutes)

Panel discussion: 20 minutes (speakers, panelists and members of the audience)

Hon. Weerawit Weeraworawit

Deputy Secretary General, National Human Rights Commission, Thailand
The Role of Developing Nations in Multilateral Negotiations
The TRIPS Agreement is a result of hard-fought multilateral negotiations and the spirit of gives and takes. Unfortunately, the basis principles and objectives of this Agreement have been much overlooked by developed nations in their bilateral and multilateral negotiations with developing countries on IPRs. It is desirable for developing countries to not only reinvigorate but also realize such balanced principles and objectives in the multilateral negotiations.
(up to 8 minutes)

Panel discussion: 15 minutes (speakers, panelists and members of the audience)

Panelists:

Dr. Mihály Ficsor

President, Hungarian Copyright Council; International Legal Consultant, Budapest

Stanford McCoy

Assistant U.S. Trade Representative for Intellectual Property and Innovation, Office of the U.S. Trade Representative, Washington D.C.

Pedro Velasco Martins

Deputy Head of Unit for Intellectual Property and Public Procurement, DG Trade, European Commission, Brussels

Program Updated on April 3, 2013

Michele Woods

Director, Copyright Law Division, World Intellectual Property Organization, Geneva

(Panelists have no individual time allocated; they take part in the general discussion.)

4C. Trade Secrets: National & International Developments

Thursday 5:20 PM – 6:45 PM (85 minutes)

Room 311

Moderator:

Daan G. Erikson

Senior Research & Conference Fellow, Fordham IP Institute, New York
(up to 5 minutes to introduce the subject matter; intro of speakers –
just name and affiliation, please see bios in print materials and online.)

Speakers:

Stanford McCoy

Assistant U.S. Trade Representative for Intellectual Property and Innovation, Office
of the U.S. Trade Representative, Washington D.C.

***The Administration's strategy on mitigating theft of trade secrets, with a particular
focus on trade policy elements***

(up to 8 minutes)

Matt Rainey

Director of the Innovation Division, World Intellectual Property Organization,
Geneva

(up to 8 minutes)

Richard Rainey

Executive Counsel for IP Litigation, General Electric Corp., Fairfield

***Trade Secrets: Rapidly Growing in Importance as a Tool to Protect Innovation and
Economies***

*In today's global information and innovation age, the ability to protect know how and
other knowledge is vitally important. It is also vitally important to protect the engines
of economic growth from third-party threats. Rapid global reform of trade secret
laws, which are key on both fronts, must be our collective focus.*

(up to 8 minutes)

Paul B. Keller

Allen & Overy, New York

***Tinker Emailer Downloader Spy: A Snapshot of Misappropriation of Trade Secrets
Law in the US***

Program Updated on April 3, 2013

Today, trade secrets can represent the most valuable assets in a company's IP portfolio. However, they commonly are under-protected and can be taken with relative ease using today's standard technology. This talk will briefly describe the value of trade secrets, how they are created and protected, and what can be done if they are taken.

(up to 8 minutes)

Rutger M. Kleemans

Freshfields Bruckhaus Deringer LLP, Amsterdam

Discussion of international trade secret issues such as the knowledge requirement in TRIPs, the Ajinomoto/GBT case in the Dutch Supreme Court, and protecting confidential information while proving breach of confidentiality

(up to 8 minutes)

Panelist:

Shira Perlmutter

Chief Policy Officer and Director for International Affairs, United States Patent and Trademark Office, Alexandria

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 35 minutes (speakers, panelists and members of the audience)

Reception

10 on the Park

Time Warner Center

North Tower, 10th Floor

60 Columbus Circle (entrance on 60th St btw Broadway & Columbus)

6:30 PM – 8:30 PM

Sponsored by:

Freshfields Bruckhaus Deringer LLP

Friday Morning, April 5

Breakfast

Platt Atrium
7:00 AM – 9:00 AM

Sponsored by:

Paul Hastings

Sunrise Seminars

Sunrise Seminar I: Valuing and Extracting Value from Patents: A Brave New World

Friday 7:30 AM – 9:10 AM (100 minutes)
Room 312

Moderator:

Michael Lubitz

CEO and Chairman, Global Technology Transfer Group, Inc. (GTT Group),
Portland, Oregon
(up to 5 minutes to introduce the subject matter; intro of speakers –
just name and affiliation, please see bios in print materials and online.)

Speaker:

David Anderson

Vice President, Corporate Development, RPX, San Francisco
*Role of non-practicing entities in patent monetization, transaction costs in the patent
“market” including costs of litigation, role of defensive aggregators, trends in the
patent market and patent monetization.*
(up to 7 minutes)

Peter Holden

Senior Vice President, Corporate Development and Investments, IPValue,
Bridgewater, New Jersey
*Investment Banking, private equity, hedge fund type investing in and financing of
transactions in patent rights (including brief history, and projection for future)*
(up to 7 minutes)

Panel discussion: 12 minutes (speakers, panelists and members of the audience)

Daniel Ilan

Cleary Gottlieb Steen & Hamilton LLP, New York

Patent monetization and bankruptcy - Nortel, Kodak and the next case:

Recent high-profile bankruptcy filings by global technology companies, such as Nortel and Kodak, were followed by the offering for sale of all or a significant portion of their patent portfolios. The risks, challenges and potential opportunities associated with purchasing patents out of bankruptcy will be discussed.

(up to 7 minutes)

Jose Esteves

Skadden, Arps, Slate, Meagher & Flom LLP, New York

IP monetization techniques: trends and challenges

(up to 7 minutes)

Panel discussion: 12 minutes (speakers, panelists and members of the audience)

Owen Byrd

Director of Sales & Marketing, Lex Machina, Palo Alto

Valuing patent rights and chances of success in litigating and enforcing the rights (including brief history, and projection for future)

(up to 7 minutes)

Selvyn Seidel

Chairman and CEO, Fulbrook Capital Management, New York

Third Party Financing has a pivotal role to play in evaluating IP claims, and extracting value from those claims. A qualified Third Party Funder can assist in valuing the claim, both outside of and within litigations, and enhancing that value. It can also match capital and skill with worthy claims to support prosecuting those claims. Beyond this, it can assist in or be a principal in, trading the claims -- whether that entails evaluating the claims, buying the claims, and/or selling, pledging, advising on, acting as an intermediary, or otherwise dealing in the claims (comparable to dealing with other assets in other asset categories, although commercial claims are a new asset class that is in its early days).

(up to 7 minutes)

Panel discussion including wrap up: 22 minutes (speakers, panelists and members of the audience)

Sunrise Seminar II: Digitization and Aggregation: Fair Use or Foul?

Friday 7:30 AM – 8:25 AM (55 minutes)

McNally Amphitheater

Program Updated on April 3, 2013

Moderator:

Nick Bartelt

Fordham Intellectual Property Institute, New York
(up to 5 minutes to introduce the subject matter; intro of speakers –
just name and affiliation, please see bios in print materials and online.)

Speaker:

Christian Liedtke

Independent IP Consultant, Newport Beach
A Modern Fairy Tale: Fair Use and News Aggregators
This talk will analyze the compensation entitlement of publishers for use of their original content by news aggregators such as Google News and Meltwater in the light of empiric evidence, presently pending court proceedings in the US and UK and solutions found elsewhere around the world.
(up to 10 minutes)

Prof. Ralph Oman

The George Washington University Law School, Washington D.C.
Georgia State and HathiTrust: Trend or Diversion?
(up to 8 minutes)

Panelists:

Dr. Roya Ghafele

Director, Oxfirst Ltd.; Fellow, Said Business School, University of Oxford, Oxford

Howard Knopf

Macera & Jarzyna, LLP, Ottawa

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 20 minutes (speakers, panelists and members of the audience)

Sunrise Seminar III: IP: Should Trademark, Copyright and Patent Protection Overlap?

Friday 7:30 AM – 8:40 AM (70 minutes)

Room 311

Moderator:

Prof. Marshall Leaffer

Maurer School of Law, Indiana University, Bloomington

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speaker:

Prof. Justin Hughes

Senior Advisor to the Undersecretary of Commerce for Intellectual Property;
Professor of Law, Cardozo Law School, New York

Copyright, Trademark, and the Ninth Circuit's Flirtations With 'Aesthetic Functionality

Patents, copyrights OR trademarks – that's easy. Patents, copyrights, AND trademarks – that's more difficult. Vexing issues often arise when a party claims that the same thing or same interest is protected by more than one form of intellectual property.

(up to 8 minutes)

Jeff Handelman

Brinks, Hofer, Gilson & Lione, Chicago

Combining Different Branches of IP Protection without Jeopardizing Your Case

A business can strengthen its legal position by asserting trademark, copyright and design patent protection in the same subject matter. All of these IP rights are harmonious and serve to complement each other. When it comes to adding utility patents into the mix, however, there are important pitfalls to be avoided.

(up to 6 minutes)

Ken Germain

Wood Herron & Evans LLP, Cincinnati

Climbing Onto Multiple Branches of IP Protection (for Product Design Trade Dress) Will Leave You Hanging--Without Constitutional Support!

Traditional doctrine--approved by the CCPA/Federal Circuit and many other courts--allows for multiple protections (specifically, trademark/trade dress, copyright, and design patent) for "nonfunctional" product designs. (These same courts clearly recognize that "functional" designs are protectable only via trade secrets or utility patents.) But virtually no courts have considered whether there might be an implicit constitutional prohibition of allowing more than one type of protection, either concurrently or consecutively. This presentation shows that multiple protections are, indeed, unconstitutional.

(up to 6 minutes)

Giovanni Casucci

Bardehle Pagenberg, Milan

Product design and trade dress: strategic issues within Design, 3D Trademarks and Copyrights

A product's appearance is one of the most relevant marketing tools to attract prospective

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consumers. This presentation will address the available IP doctrines that can protect the exclusive use of a trade dress and product design.
(up to 6 minutes)

Martin Schwimmer

Leason Ellis LLP, White Plains; Publisher, The Trademark Blog

The Law of Shapes To Come: The Protection of Shapes.

This presentation will address how 3D Printing has the potential to do for 3D objects what the photocopier did to books, the VCR did to movies, and the MP3 did to music – namely create great possibilities for creativity, but also possibilities for infringement.

(up to 6 minutes)

Panelist:

Elizabeth Weiswasser

Weil, Gotshal & Manges LLP, New York

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

THREE CONCURRENT SESSIONS:

Patents, Competition, Trademarks, Trade & Enforcement

SESSION 5: PATENT LAW

Concurrent Session

Friday 9:15 AM – 1:10 PM

Room 312

5A. Supplementary Protection Certificates

Friday 9:15 AM – 10:15 AM (60 minutes)

Room 312

Moderator:

Brian Cordery

Bristows, London

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speaker:

Hon. Rian Kalden

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Vice President, District Court of The Hague, The Hague

The Aftermath of Medeva

The Medeva and further rulings of the Court of Justice of the European Union on the “protected by a basic patent in force” requirement of article 3(a) of SPC Regulation 469/2009. Further uncertainties and how do national patent offices and courts deal with it?

(up to 10 minutes)

Brian Cordery

Bristows, London

Other Settled and Outstanding Issues

A discussion on the prospect of Second Medical Use Supplementary Protection Certificates, squatting, and other issues such as the recent issue on adjuvants referred by Arnold J.

(up to 8 minutes)

Panelists:

Laëtitia Bénard

Allen & Overy LLP, Paris

Christine Kanz

Reimann Osterrieth Köhler Haft, Düsseldorf

Shimako Kato

Abe, Ikubo & Katayama, Tokyo

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

Break

10:15 AM – 10:40 AM

5B. Administrative & Substantive Patent Office

Harmonization

Friday 10:40 AM – 11:55 AM (75 minutes)

Room 312

Moderator:

Gonzalo Ulloa

Gómez-Acebo & Pombo Abogados, Madrid

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Yuichiro Nakaya

Deputy Director, International Affairs Division, Japan Patent Office, Tokyo

JPO's efforts in Patent Harmonization

International discussions on patent harmonization have been revitalized by enactment of the AIA and IP offices in the world including the JPO are now engaging such international discussions. In such discussions, Grace Period is one of major topics. Japan revised its Patent Act to enlarge a scope of grace period and started the new grace period system since April 2012. The JPO gathered some statistical data regarding implementation of the new system.

(up to 8 minutes)

Shoichi Okuyama

Okuyama & Sasajima, Tokyo

JPO has decided to revive the post-grant opposition system once again after it was abandoned in 2003. This talk would outline facts that occurred after 2003 and led to the revival, and point out differences among the proposed Japanese system, the AIA post grant proceedings and EPO oppositions.

(up to 8 minutes)

Shira Perlmutter

Chief Policy Officer and Director for International Affairs, United States Patent and Trademark Office, Alexandria

(up to 8 minutes)

Matt Rainey

Director of the Innovation Division, World Intellectual Property Organization, Geneva

(up to 8 minutes)

Jeremy Phillips

IPKat, London

Patent quality: do we really want it?

The words “patent quality” have become a significant slogan in the current debate as to how to reform the patent system. Curiously, while the cause of “patent quality” has been taken up by so many people, it has no agreed meaning and may mean quite different things to patent examiners, judges, businesses, competition regulators and investors. This presentation will review the issues and pose questions that require further analysis.

(up to 8 minutes)

Panelists:

John Pegram

Fish & Richardson P.C., New York

Harold C. Wegner

Foley & Lardner LLP, Washington D.C.

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 30 minutes (speakers, panelists and members of the audience)

5C. Secondary and Collective Liability in Patents

Friday 12:00 PM – 1:00 PM (60 minutes)

Room 312

Moderator:

Dr. Myles Jelf

Bristows, London

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Wendy Miller

Cooper & Dunham LLP, New York

This talk will begin with a brief, definitional discussion of direct infringement, joint and divided infringement, and indirect infringement by inducement in the context of the patent statute. It then will review the recent Federal Circuit holding that indirect infringement by inducement may be based on underlying acts of direct infringement that are performed by multiple actors, as set forth in the Federal Circuit's en banc decision in the companion cases of Akamai Technologies, Inc. v. Limelight Networks, Inc. and McKesson Technologies, Inc. v. Epic Systems Corp.

(up to 10 minutes)

Trevor Cook

Bird & Bird, London

Tailoring the contributory infringement regime for patents in Europe to different technologies

The doctrine of contributory infringement of patents in Europe is on its face broad in that it does not even require that there be a primary infringer. Its features have been explored in a number of recent cases in the English, German and Dutch courts, which have in general given expansive interpretations of its scope. One emerging issue is

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that its practical breadth as established in the context of mechanical engineering and medical devices risks undermining the scope for generic pharmaceutical manufacturers to make effective use of the provisions in medicines regulatory legislation allowing for "skinny labels" which omit patented indications from the marketing authorisation in order to avoid infringement of medical use patents.

(up to 10 minutes)

Panelist:

James Bollinger

Troutman Sanders LLP, New York

Edmund J. Haughey

Fitzpatrick, Cella, Harper & Scinto, Washington D.C.

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

Lunch

Platt Atrium & 12th Floor Lounge, Lowenstein Building

1:10 PM – 2:20 PM

Speaker

Teresa Stanek Rea

Acting Under Secretary of Commerce for Intellectual Property and Acting Director
of the United States Patent and Trademark Office, Alexandria

(up to 15 minutes)

SESSION 6: COMPETITION LAW

Concurrent Session

Friday 8:30 AM – 1:10 PM

McNally Amphitheater

6A. Competition Overview and Recent Developments

Friday 8:30 AM – 9:30 AM (60 minutes)

McNally Amphitheater

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Moderator:

Prof. Hugh C. Hansen

Fordham University School of Law, New York

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speaker:

Prof. Eleanor Fox

New York University School of Law, New York

The IP/Competition Wars – Why is there a tug of war when we all share the same goal – an inventive, competitive economy?

These remarks will present an overview of the big battlefields and identify the factors that may cause the weary soldiers to pledge allegiance to one flag or the other – more competition, or more IP protection. Pay for delay, standard essential patents, and refusals to deal will all be fodder. Examples will be taken from the US, the EU, and developing countries.

(up to 20 minutes)

Monika Tomczak-Górlikowska

Miller Canfield P.L.C., Gdynia, Poland

EU Competition Recent Developments

The last year or so has presented a number of competition themes and topics. Some of these developments include an abundance of Article 102 cases (abuse of dominant position), the Technology Transfer Block Exemption Regulation (TTBER), the rise of commitments and settlements in EU competition policy, and issues related to effective judicial review.

(up to 8 minutes)

Panelists:

Prof. Randal C. Picker

University of Chicago School of Law, Chicago

Carey Ramos

Quinn Emmanuel Urquhart & Sullivan LLP, New York

Gerald Sobel (invited)

Kaye Scholer LLP, New York

Joseph F. Wayland

Simpson Thacher & Bartlett, New York

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 27 minutes (speakers, panelists and members of the audience)

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Break

9:30 AM – 9:55 AM

6B. Pharma & Competition

Friday 9:55 AM – 10:55 AM (60 minutes)

McNally Amphitheater

Moderator:

Prof. Daryl Lim

The John Marshall Law School, Chicago

(up to 4 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Dr. Steven J. Lee

Kenyon & Kenyon LLP, New York

Reverse payments in the US, including the Watson case

(up to 10 minutes)

Christine L. White

Senior Staff Attorney, Northeast Regional Office, Federal Trade Commission, New York

FTC v. Actavis: The Antitrust Analysis of Reverse Payment Settlement Agreements

(up to 8 minutes)

Romano Subiotto

Cleary Gottlieb Steen & Hamilton LLP, Brussels

Reverse payments in the EU, including the Lundbeck case

The EU Commission's current review of reverse payment patent settlement agreements in the pharmaceutical sector creates many issues to discuss, playing into the worldwide discussion of pharmaceuticals and competition.

(up to 8 minutes)

Panelists:

Prof. Kent Bernard

Adjunct Professor, Fordham University School of Law, New York

Prof. Michael Carrier

Rutgers School of Law, Camden

Nicola Dagg

Allen & Overy LLP, London

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 30 minutes (speakers, panelists and members of the audience)

6C. Smartphones: FRAND, Injunctions and Other Issues

Friday 11:00 AM – 1:10 PM (130 minutes)

McNally Amphitheater

Moderator:

Justin Watts

Freshfields Bruckhaus Deringer LLP, London

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

A. FORDHAM WIPO REPORT ON SMARTPHONES

Speaker:

Prof. Joel Reidenberg

Fordham University School of Law, New York

The impact of the acquisition and use of patents in the Smartphone Industry

This presentation will discuss conclusions from this paper prepared for the WIPO.

The paper was an empirical study of patents in the smartphone industry including data from patent records, litigation records, industry market share reports, corporate public records and a survey concerning the acquisition and use of patents in the smartphone industry. The study sought to make an assessment of the openness of the smartphone market and the impact that the ownership and enforcement of large patent portfolios has on the market.

(up to 10 minutes)

B. DEVELOPING CASE LAW ON INJUNCTIVE RELIEF, ANTI-SUIT INJUNCTIONS AND COURT DETERMINATIONS OF FRAND ROYALTIES

Speakers:

Hon. Shinji Oda

Intellectual Property High Court, Tokyo

Recent Japanese Cases Concerning FRAND

Recently Tokyo District Court decided that a patent owner who submitted FRAND declaration is not allowed to collect monetary damages from an infringer who proposed detailed license terms, unless the owner faithfully paid effort to enter into a license. This presentation explains the Japanese case law on FRAND and discusses the implications thereof.

(up to 8 minutes)

Heinz Polsterer

Senior Vice President, Deutsche Telekom, Austria

Injunctions, NPEs, and Downstream Commerce: What Should be the Availability of Injunctive Relief?

In contrast to patent assertions by manufacturers, patent assertions by non-practising entities in some jurisdictions sometimes target downstream commerce in goods said to infringe. Is the availability of injunctive relief appropriate in relation to downstream commerce, especially where a commitment to license the patents in suit has been given and it is open to the manufacturer to either remove the accused functionality or acquire a licence, and thus no further infringing downstream dealing will necessarily take place?

(up to 6 minutes)

Kenneth R. Adamo

Kirkland & Ellis LLP, Chicago

FRAND Issues: What is the Court's Appropriate Role?

The last 12 months have seen an increased use of the U.S. courts in relation to FRAND issues. There are now debates on the availability of anti-suit injunctions, and determinations underway in which the Courts themselves set the FRAND terms and conditions that should apply as between parties who have indicated that they are willing to enter into a licence. Is a single-Court resolution of FRAND issues the future for telecoms battles?

(up to 6 minutes)

Joseph F. Wayland

Simpson Thacher & Bartlett, New York

A Perspective from the Department of Justice, Antitrust Division

The Antitrust Division has expressed views on several points related to smartphones. The government, across several agencies, is increasingly concerned that the use of injunctions can cause significant competitive harm through the extraction of excessive royalties, unfair licensing terms, and the exclusion of directly competing products. The government will focus increasingly on the SSOs as a vehicle to restrain perceived anticompetitive practices. Also, the government has developed theories of harm and seeks factual data and analysis to test theories.

(up to 6 minutes)

Panelists:

David L. Cohen

Special Counsel, Vringo, New York

Carey Ramos

Quinn Emmanuel Urquhart & Sullivan LLP, New York

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Luis Jorge Romero

Director General, ETSI, Sophia Antipolis, France

Richard Vary

Head of Litigation, Nokia, Guildford

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

Moderator:

Ari Laakkonen

Powell Gilbert LLP, London

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

C. DEVELOPING CASE LAW ON PRINCIPLES FOR THE DETERMINATION OF FRAND ROYALTIES

Speakers:

Dr. Tobias Hahn

Reimann Osterrieth Köhler Haft, Düsseldorf

Principles for the evaluation of FRAND terms and conditions set forth in German decisions

Has the Orange Book decision of the Supreme Court led to an impasse? What methods have the German courts used in recent cases to determine whether there has been an anti-competitive refusal to license?

(up to 6 minutes)

T. Andrew Culbert

Associate General Counsel, United States Litigation, Microsoft Corporation, Redmond

A Framework for the Judicial Resolution of FRAND Disputes

Mr. Culbert will discuss the establishment of a framework for the judicial resolution of FRAND disputes. His presentation will discuss the creation of a mechanism for establishing reasonable royalties for FRAND-committed patents, as well as the meaning of the patentee's obligation to license on non-discriminatory terms.

(up to 6 minutes)

Warren S. Heit

White & Case LLP, Silicon Valley

Determination of a FRAND royalty in the context of an unwilling licensee

Mr. Heit will discuss the balance between the right of SEP holders to recoup their R&D investment and fair value for their patents and the right of implementers to obtain reasonable rates for use of a SEP. His presentation will discuss the “Georgia-Pacific” hypothetical negotiation as well as how “hold-up” and “royalty stacking” factor into this determination.

(up to 6 minutes)

Noreen Krall

Chief Litigation Counsel, Apple, Cupertino

A reasoned and formulaic approach to calculating RAND/FRAND royalties

There are two prongs of the discussion around SEP abuse, injunctions and rates. Much of the focus has been on the injunction prong, with significant developments in the US, Europe and Asia over the last 12 -15 months. This presentation will focus on FRAND royalties, and in particular, describe a predictable formula that could be used by the parties and courts to determine a RAND/FRAND royalty using an appropriate rate and common base.

(up to 6 minutes)

Panelists:

Sarah Guichard

Vice President and Associate General Counsel, BlackBerry, Waterloo, Ontario, Canada

Alex Sinclair

Chief Technology Officer, GSMA, Cambridge, United Kingdom

Olivier Thirard

Deputy Legal Director, Intellectual Property, Orange, Paris

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

Lunch

Platt Atrium & 12th Floor Lounge, Lowenstein Building

1:10 PM – 2:20 PM

Speaker

Teresa Stanek Rea

Acting Under Secretary of Commerce for Intellectual Property and Acting Director
of the United States Patent and Trademark Office, Alexandria

(up to 15 minutes)

SESSION 7: TRADEMARK LAW

Concurrent Session

Friday 8:45 AM – 1:10 PM

Room 311

7A. EU and U.S. Design Law Including a Discussion of Apple v. Samsung

Friday 8:45 AM – 9:45 AM (60 minutes)

Room 311

Moderator:

Prof. Jeremy Sheff

St. John's University School of Law, New York

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Gordon Humphreys

Member of the Boards of Appeal, OHIM, Alicante

Selected topics of current EU design law: Gnomes, radiators and technical function

This presentation looks briefly at the two cases that have come before the EU Courts in Luxembourg in the last 12 months before going on to discuss issues that have arisen at the level of OHIM Boards of Appeal in cases involving technical function and the quest for harmonization.

(up to 10 minutes)

Alain Strowel

Covington & Burling LLP, Brussels

Design law as a weapon in the smartphone wars on the EU battleground

The European decisions relying on design protection will be briefly reviewed, with a focus on the infringement test. Does the case law adequately balance the need to protect product shapes and the need for a vibrant competition on the smartphone market? The presentation will also show how design is more and more used to protect graphic user interfaces. GUIs might well be at the centre of the next smartphone battles.

(up to 8 minutes)

John Richards

Ladas & Parry LLP, New York

Design Patents

The smart phone wars have revived interest in an often-neglected form of IP protection: the design patent. Long thought of as providing very narrow protection, recent case law has shown that by use of the right drawings and title, effective protection of significant breadth may be obtained. As with all broad patent claims, however, this expands the relevant prior art base from which the design patent may be attacked.

(up to 10 minutes)

Panelists:

Dr. Myles Jelf

Bristows, London

Prof. Dr. Annette Kur

Max Planck Institute for Intellectual Property and Competition Law, Munich

Jeremy Phillips

IPKat, London

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

Break

9:45 AM – 10:10 AM

7B. Video Games: IP Issues and Strategies

Friday 10:10 AM – 11:30 AM (80 minutes)

Room 311

Moderator:

Anderson J. Duff

Wolf, Greenfield & Sacks, P.C., Boston

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Prof. Greg Lastowka

Rutgers School of Law, Camden

The scope of copyright in digital games is a controversial subject. Game developers alternately lament and celebrate the common practice of “cloning” online games: making a new online game, often with original artwork and software code, that is clearly based on a prior online game, yet that avoids clearly infringing the original game's copyright. Supporters of cloning practices argue that it promotes price

competition and improves consumer access to new forms of creativity in the marketplace. Critics argue that it allows opportunistic game companies to free-ride on the investments of true innovators. Another controversial question in the game industry is the legality of certain forms of “user-generated content,” such as modding, machinima, and fan works. Fans of online games often make modifications (“mods”) of game software or use online games as platforms for video production (called “machinima”). While these practices may technically fall afoul of copyright law, game owners will often encourage these activities, which can also be viewed as voluntary labor that sustains public interest in the game.

(up to 8 minutes)

Christian Genetski

Senior Vice President and General Counsel, Entertainment Software Association, Washington D.C.

(up to 8 minutes)

Christopher G. Reid

Law Offices of Christopher G. Reid, New York

Right of Publicity

(up to 8 minutes)

Dr. Mihály Ficsor

President, Hungarian Copyright Council; International Legal Consultant, Budapest
Technological Measures to Protect Video Games and Illegal “Mod Chips” to Circumvent them, In Light of the CJEU

Two aspects of technological measures (“TPM”) provision of the World Copyright Treaty relevant in the illegal “mod chips”. The EU Information Society on TPM covers “access controls” and the principle of no direct link with infringements. In Nintendo CO., Ltd and Others v. Pc Box Srl and 9Net Srl, Case C-355/12, the Tribunal of Milan focused on fixed game console, specifically Nintendo Wii, and TPM.

(up to 8 minutes)

Jonathan Colombo

Bereskin & Parr LLP, Ontario

Dealing with Game Developers to Secure IP: A Canadian Perspective

There is a need to identify the IP rights being assigned/licensed with precision in video games. There are also recent and significant Canadian copyright laws that affect game development/exploitation. There are also business challenges and opportunities in Canada regarding IP rights and video games.

(up to 8 minutes)

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Panelists:

Prof. Ron Lazebnik

Fordham University School of Law, New York

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

7C. The EU Observatory on Infringements of IP Rights Including a Discussion of Piracy

Friday 11:35 AM – 1:10 PM (95 minutes)

Room 311

Moderator:

Paul Maier

Director, The European Observatory on Infringement of Intellectual Property Rights,
Alicante

(up to 5 minutes to introduce the subject matter; intro of speakers –
just name and affiliation, please see bios in print materials and online.)

Speakers:

Paul Maier

Director, The European Observatory on Infringement of Intellectual Property Rights,
Alicante

The EU Observatory: A First Response to the Challenges of IP?

The EU Observatory has four major fields of intervention. It's first task is to provide solid and reliable economic data on the importance of IP for the EU economy.

Secondly it must study the perception of IP by European consumers and then propose a new narrative on IP and awareness campaigns. The third area is to help in the enforcement of IP rights through specific projects destined to support EU enforcement authorities (customs, police, judges,...). Last but not least, it must provide training to enforcement authorities and national IP offices through the OHIM Academy.

(up to 12 minutes)

Karen Thorland

Senior Vice President, Global Content Protection Counsel, Motion Picture
Association of America, Inc., Sherman Oaks

Piracy 2.0

This talk will explore how the piracy landscape has evolved from peer-to-peer (P2P) websites based on the simple concept of individuals sharing what they have on their

computers with others (Piracy 1.0) to a sophisticated, profit-driven and global endeavor that has brought us millionaires like Kim Dotcom. While P2P continues to account for a significant portion of internet traffic and remains a substantial threat to content owners, the new model relies on a symbiotic relationship between link aggregators (linking sites) and their sources for content (largely cyberlockers). The talk will explore how P2P works, how linking sites and cyberlockers operate, why linking sites appeal to consumers, the key players, how the money is made, and the legal challenges presented by Piracy 2.0.

(up to 10 minutes)

Joris van Manen

Hoyng Monegier LLP, Amsterdam

Action against on-line intermediaries in Europe: The Pirate Bay, Kino.to and AltusHost cases.

Two recent EU directives have opened new possibilities for action against “intermediaries who’s services are used by third parties to infringe”. As legal action against the source of the on-line IP infringement often is not available, these new possibilities have cause ground breaking case law in Europe. The EUCJ will render a landmark decision on website blocking by the end of this year. One of the lawyers central in this EU litigation will give you the latest.

(up to 8 minutes)

Panel discussion: 20 minutes (speakers, panelists and members of the audience)

Marcus von Welser

Vossius & Partner, Munich

The EU-Council’s Proposal for a Customs Enforcement Regulation

In January 2013, the EU-Council proposed a new Customs Enforcement Regulation. The presentation gives an overview about the main changes with a focus on factory overruns, i.e. goods produced by the manufacturer in excess of the quantities agreed to by the right holder. The presentation summarizes the current practice and contrasts these with the proposed changes.

(up to 8 minutes)

Panel discussion: 10 minutes (speakers, panelists and members of the audience)

Panelists:

Leanne O’Donnell

Senior Lawyer, Melbourne

Bret Parker

Vice President and Associate General Counsel, Elizabeth Arden, New York

Michael Schlesinger

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Mitchell Silberberg & Knupp LLP, Washington D.C.

(Panelists have no individual time allocated; they take part in the general discussion.)

Lunch

Platt Atrium & 12th Floor Lounge, Lowenstein Building

1:10 PM – 2:20 PM

Speaker

Teresa Stanek Rea

Acting Under Secretary of Commerce for Intellectual Property and Acting Director
of the United States Patent and Trademark Office, Alexandria

(up to 15 minutes)

Friday Afternoon, April 5

Three Concurrent Sessions:

Patents, Copyright & Trademarks

SESSION 8: PATENT LAW

Concurrent Session

Friday 2:30 PM – 6:30 PM

McNally Amphitheater

8A. Remedies: Including the Current State of Injunctions

Friday 2:30 PM – 4:10 PM (100 minutes)

McNally Amphitheater

Moderator:

Robert J. Goldman

Ropes and Gray LLP, East Palo Alto

(up to 5 minutes to introduce the subject matter; intro of speakers –
just name and affiliation, please see bios in print materials and online.)

Speakers:

Dr. Klaus Grabinski

Federal Supreme Court, Karlsruhe

Nine years after Ebay – Should German courts have discretion when deciding on injunctions in patent infringement litigation?

In Ebay the US Supreme Court held that the decision to grant or deny an injunction is an act of equitable discretion by the court. The talk will deal with the question how injunctions are dealt with in German patent infringement litigation where the concept of equitable discretion is not known but where alternative approaches exist.

(up to 8 minutes)

Laëtitia Bénard

Allen & Overy LLP, Paris

Cross-border injunctions for registered IP rights in Europe: an overview of recent developments

Laëtitia Bénard will review the rules applicable to cross-border injunctions at the European level and outline the existing differences between trademarks, designs and patents. In particular, she will comment two recent CJEU judgments concerning Community trademarks (DHL/Chronopost) and European patents (Solvay/Honeywell). In the light of a few national precedents, she will then put forward some remaining obstacles to pan-European injunctions. Finally, she will present the relevant provisions of the Unified Patent Court Agreement and conclude on their potential impact on cross-border patent litigation in the upcoming years.

(up to 8 minutes)

Panel discussion: 12 minutes (speakers, panelists and members of the audience)

Patricia Martone

Morrison & Foerster LLP, New York

Differing Damages between Non-Practicing Entities and Practicing Entities

In the past three years, the Federal Circuit has issued a series of decisions on damages issues, particularly on the determination of a reasonable royalty. The goal of the decisions is obviously to make it difficult to sustain outsize jury awards obtained by patent trolls. However, these decisions have so weakened the damages law that companies suing competitors will find that their remedies have been seriously undermined. If injunctive relief is unavailable because damages are adequate, and the damages law has made it impossible to prove anything other than nominal damages, then the statutory framework for remedies for patent infringement has been eviscerated.

(up to 8 minutes)

Gerald J. Flattmann, Jr.

Paul Hastings LLP, New York

Generic Manufacturers May Be Subject To The Remedies of the ANDA Statute Even In The Absence Of A Paragraph IV Certification

This presentation will survey some of the surprising recent case law from the Federal Circuit and the District Courts that establish this proposition and the perhaps even more surprising proposition that even final approval of an ANDA prior to issuance of an Orange Book listed patent does not preclude application of the statutory remedy of withdrawal or stay of approval under the ANDA statute. This trend in the case law is likely to significantly impact the strategies of branded and generic drug manufacturers in patent litigation.

(up to 8 minutes)

Eiji Katayama

Abe, Ikubo & Katayama, Tokyo

New Judgment of Presumption Clause of Damages in Japan

Grand panel of IP High Court of Japan rendered a new judgment on presumption clause of damages. Under this interpretation, patentee, especially foreign patentee, may assert damages claim using presumption clause easier than before.

(up to 8 minutes)

Panel discussion: 12 minutes (speakers, panelists and members of the audience)

Prof. John M. Golden

The University of Texas School of Law, Austin

A Patent Small Claims Court for the U.S.?

In December 2012, the USPTO requested comments on “whether the United States should develop a small claims proceeding for patent enforcement.” 77 Fed. Reg. 74830. The USPTO has extended the deadline for filing comments to April 30, 2013. I will discuss both some reasons for considering the development of such a proceeding and potential ways in which it might be implemented.

(up to 8 minutes)

Panel discussion including wrap up: 10 minutes (speakers, panelists and members of the audience)

Break

4:10 PM – 4:35 PM

8B. Patentable Subject Matter: Are Software and Gene Patents still “Under the Sun”?

Program Updated on April 3, 2013

Friday 4:35 PM – 6:45 PM (130 minutes)
McNally Amphitheater

A. SOFTWARE PATENTS

Moderator:

John Richards

Ladas & Parry, New York

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Prof. John F. Duffy

University of Virginia School of Law, Virginia

(up to 7 minutes)

Laura Sheridan

Patent Counsel, Google Inc., New York

Sections 101 and 112: Important Tools for Improving Software Patent Quality

For too long, applicants have been granted software patents with claims amounting to no more than an abstract idea, and without ample support in the specification for the claimed functions. The proper application of sections 101 and 112 to software patents provides a substantive check, ensuring that only those claims having proper coverage and clear scope are issued or upheld.

(up to 7 minutes)

William Chandler

Member, Board of Appeal, European Patent Office, Munich

(up to 7 minutes)

Jay Zakaïb

Gowling Lafleur Henderson LLP, Ottawa

Canadian Perspective

(up to 7 minutes)

Panelists:

James Bollinger

Troutman Sanders, New York

(Panelists have no individual time allocated; they take part in the general discussion.)

Program Updated on April 3, 2013

Panel discussion: 10 minutes (speakers, panelists and members of the audience)

B. GENE PATENTS

Moderator:

John White

Cooper & Dunham LLP, New York

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Prof. John R. Thomas

Georgetown University Law Center, Washington D.C.

(up to 8 minutes)

Lord Hoffmann

Honorary Professor of Intellectual Property, Queen Mary, University of London

European Perspective

(up to 8 minutes)

Shimako Kato

Abe, Ikubo & Katayama, Tokyo

The Japanese View about Subject Matter Eligibility of Gene Patents - Should the bar be raised? -

According to the previous decisions and examination guidelines, the requirement of “usefulness” is important for gene patents to grant subject matter eligibility. Is there any further point to be considered with regards to the eligibility?

(up to 8 minutes)

Panelists:

Prof. Martin J. Adelman

The George Washington University Law School, Washington D.C.

Nicholas Groombridge

Paul, Weiss, Rifkind, Wharton, & Garrison, New York

Prof. Daryl Lim

The John Marshall Law School, Chicago

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 30 minutes (speakers, panelists and members of the audience)

CLOSING RECEPTION

Platt Atrium
6:30 PM – 8:30 PM

Sponsored by:
Bristows

SESSION 9: COPYRIGHT LAW

Concurrent Session

Friday 2:30 PM – 6:30 PM
Room 312

9A. Access to Information & the Public Domain

Friday 2:30 PM – 3:30 PM (60 minutes)
Room 312

Moderator:

Prof. Sonia Katyal

Fordham University School of Law, New York
(up to 5 minutes to introduce the subject matter; intro of speakers –
just name and affiliation, please see bios in print materials and online.)

Speakers:

Prof. Randal C. Picker

University of Chicago Law School, Chicago
With the emergence of major digital scanning projects for works in the public domain, we are at a point of possibly unparalleled practical access to the public domain. But there is an emerging shadow control regime for the public domain—a regime situated in contracts and terms of use, in the DMCA and in the Computer Fraud and Abuse Act—that will determine the scope of the actual access to the public domain that emerges and in the extent of competition on the provision and use of the public domain. This talk considers and assesses that regime.
(up to 15 minutes)

Panelists:

David Carson

Executive Vice President, Global Legal Policy, IFPI, London

James Love

Director, Knowledge Ecology International, Washington D.C.

Program Updated on April 3, 2013

Joris van Manen

Hoyng Monegier LLP, Amsterdam

Prof. Coenraad Visser

University of South Africa, Pretoria

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

Break

3:30 PM – 3:55 PM

9B. View from the European Commission; Copyright & Collective Licensing

Friday 3:55 PM – 5:25 PM (90 minutes)

Room 312

Moderator:

Ted Shapiro

Wiggin LLP, Brussels

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Maria Martin-Prat

Head of Unit – Copyright, DG Internal Market & Services, European Commission, Brussels

(up to 20 minutes)

Panel discussion: 10 minutes (speakers, panelists and members of the audience)

Jerker Ryden

Senior Legal Adviser, National Library of Sweden, Stockholm

Collective Rights Management and Extended Collective Licensing - a prerequisite for mass usage of Audiovisual Works?

New technology and business models enable mass usage of copyright protected works. The answer is collective rights management. But works by so called Outsiders (non members and Orphan Works) cannot be licensed the traditional way. You need a licensing solution which solves the problem with the Outsiders - Extended Collective Licensing.

Much of the discussions have focused on Books - the mass digitisation by Google is the primary reason. Audiovisual works though by tradition are much more complex and Outsiders are in abundance. A television broadcaster could have as many as 70,000 contracts a year. A national library could have tens of millions of hours of audiovisual works.

If the problem is the same should the remedy be the same?
(up to 10 minutes)

Karyn Temple Claggett

Associate Register of Copyrights and Director of Policy & International Affairs, United States Copyright Office, Washington D.C.

Orphan Works: A View from the U.S. Copyright Office

The presentation will include a brief overview of the difficulties caused by the problem of orphan works, previous proposals to address orphan works and the Copyright Office's current review of the issue. We will also briefly discuss recent international developments.

(up to 8 minutes)

Panel discussion: 10 minutes (speakers, panelists and members of the audience)

Dr. Roya Ghafele

Director, Oxfirst Ltd.; Fellow, Said Business School, University of Oxford, Oxford

Dinosaurs in the Digital Age? Counting the Costs of Collective Rights Management of Music Copyright in Europe

Money is being left on the table. According to our analysis the market for music licensing revenues is valued at over 2.6 billion Euro in France, Germany and the UK alone. This constitutes a potential royalty market of 212 million Euro. Yet, only 49 million Euro in royalty revenue from online sources was collected by SACEM, GEMA and PRS for Music. The disparity between potential and actual revenue for all of the European markets suggests there are problems with the current collective rights management system. This calls for action on behalf of policy makers.

(up to 8 minutes)

Panel discussion: 10 minutes (speakers, panelists and members of the audience)

Panelists:

David Carson

Executive Vice President, Global Legal Policy, IFPI, London

Carlo Scollo Lavizzari

Lenz & Caemmerer, Basel

Jukka Liedes

Program Updated on April 3, 2013

Director, Department for Cultural, Sport and Youth Policy, Division for Cultural Policy, Ministry of Education and Culture of Finland, Helsinki

(Panelists have no individual time allocated; they take part in the general discussion.)

9C. Performance Rights in Copyright: Public, Private or “Digital”?

Friday 5:30 PM – 6:45 PM (75 minutes)

Room 312

Moderator:

Britton Payne

Business Development and General Counsel, 30 Ninjas, New York
(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Prof. Tyler Ochoa

Santa Clara University School of Law, Santa Clara

Distinguishing Public Performances from Private Performances

Public performances, including retransmissions, are covered by copyright, but private performances are not. Recent court decisions concerning new online business models have tried to draw a line between the two, with inconsistent results. Prof. Ochoa will discuss these decisions and address how online business models should be evaluated by the courts.

(up to 10 minutes)

David Ellen

Executive Vice President and General Counsel, Cablevision, New York

(up to 10 minutes)

Barry Sookman

McCarthy Tétrault, Toronto

Cablevision: How It and Its Doctrines Have Fared Around the World

(up to 15 minutes)

Dr. Silke von Lewinski

Max Planck Institute for Intellectual Property and Competition Law, Munich

Communication to the public - does the European Court re-invent the wheel?

To date, the European Court has developed a set of criteria to determine the term "communication to the public" and it continues to revert to them. This contribution

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analyses and in part criticizes the Court's way of argumentation in the recent cases, in particular in SCF and TV Catch Up, including their references to earlier case law. It also reflects about the possible "escapes" from some of the criteria.
(up to 10 minutes)

Panelists:

Prof. Susan Crawford (invited)

Cardozo Law School, New York

Janet Cullum

Cooley LLP, New York

Prof. Jane Ginsburg

Columbia Law School, New York

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 30 minutes (speakers, panelists and members of the audience)

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Platt Atrium

6:30 PM – 8:30 PM

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SESSION 10: TRADEMARK LAW

Concurrent Session

Friday 2:30 PM – 6:30 PM

Room 311

10A. EU Trademark Law: Recent Developments Including Legislation and Genuine Use

Friday 2:30 PM – 4:00 PM (90 minutes)

Room 311

Moderator:

James Nurton

Managing Intellectual Property, London

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Paul Maier

Director, The European Observatory on Infringement of Intellectual Property Rights, Alicante

Selected judgments from Luxembourg in trade mark cases; including genuine use and class headings

A discussion of Case C-149/11 Leno Merken on genuine use in one Member State, Case C-553/11 B. Rintisch on genuine use of a trade mark in a slightly different version and Case C-307/10 IP Translator on class headings.

(up to 10 minutes)

Prof. Spyros Maniatis

Queen Mary, University of London, London

Broad specifications and use requirements: competition and bad faith considerations.

The breadth of trade mark specifications and the existence of a use requirement prior to registration are two fundamental differences between the US and EU trade mark regimes. The paper will consider recent European jurisprudence against a practical and comparative context and explore future developments in this area.

(up to 10 minutes)

John Olsen

Edwards Wildman Palmer UK LLP, London

The EU Commission's proposals for amendment of EU trademark law including the Max Planck study

(up to 10 minutes)

Panel discussion: 25 minutes (speakers, panelists and members of the audience)

Prof. Dr. Peter Ruess

International School of Management, Frankfurt; Arnold Reuss, Düsseldorf

Trademark Distinctiveness and Trademark Office Decisions: Is it time to look beyond borders?

With IP being very much an international subject, judges and legislators alike have been looking for guidance or inspiration in other jurisdictions. Trademark Offices seem not at all inclined to follow this route. OHIM or any other EU office may e.g. hold an English mark to be descriptive which was found perfectly admissible in the national office of the native-speaking country. APPLE has maintained its iPhone mark to be descriptive in Brazil but fiercely defends it elsewhere. Is all this something we just need to accept or do we consider improvements?

(up to 10 minutes)

Panelists:

Prof. Dr. Annette Kur

Max Planck Institute for Intellectual Property and Competition Law, Munich

Jeremy Phillips

IPKat, London

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 15 minutes (speakers, panelists and members of the audience)

Break

4:00 PM – 4:25 PM

10B. Color Marks: EU and U.S. Recent Developments

Friday 4:25 PM – 5:25 PM (60 minutes)

Room 311

Moderator:

Prof. Susan Scafidi

Fordham Law School

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Gordon Humphreys

Member of the Boards of Appeal, OHIM, Alicante

A Selective Review of Color Mark Issues and Case Law in the EU

Despite the CJEU's statement in Libertel (C-104/01) that colors "advertise and market goods, without any specific message" commercial operators continue to seek registration of colors as trademarks. This presentation looks at when it is appropriate for a color per se to be protected, difficulties of spacial delimitation or color combinations, problems of consumer perception and obstacles in showing acquired distinctiveness through use in the EU. Additional consideration will be given to some examples of inter partes conflicts involving color marks in the EU (OHIM, UK, Austria, Poland and Germany).

(up to 10 minutes)

Prof. Marshall Leaffer

Maurer School of Law, Indiana University, Bloomington

Color Mark Protection Era

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Qualitex Co. v. Jacobson Products Co. Inc., 514 U.S. 159 (1995) issued a new era of branding by color. *Christian Louboutin S.A. v. Yves Saint Laurent*, 696 F. 3d 206 (2d Cir. 2012), in which the court of Appeals held color marks, so long as the claimant can prove distinctiveness and non-functionality, are available in all endeavors industries—even fashion. *Limits on color mark protection under aesthetic functionality.*

(up to 10 minutes)

Panelists:

Lydia Temesgien Gobena

Fross Zelnick Lehrman & Zissu, P.C., New York

Matthias Koch

Freshfields Bruckhaus Deringer LLP, Cologne

Harley I. Lewin

McCarter & English, LLP, New York

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 15 minutes (speakers, panelists and members of the audience)

10C. U.S. Trademark Law: Recent Developments

Friday 5:30 PM – 6:45 PM (75 minutes)
Room 311

Moderator:

Christian Liedtke

Independent IP Consultant, Newport Beach

(up to 5 minutes to introduce the subject matter; intro of speakers – just name and affiliation, please see bios in print materials and online.)

Speakers:

Robert L. Raskopf

Quinn Emanuel Urquhart & Sullivan, LLP, New York

Refusing Registration/Cancellation of Marks For Disparaging Racial and Ethnic Groups

There are several recent cases in which registration has been refused ex parte, the newest of which involves the designation Anti-Islamisation; and there is the long running Redskins case making its way through the TTAB as we speak. These cases are at the center of law and politics and generate significant controversy.

(up to 8 minutes)

Prof. Marshall Leaffer

Maurer School of Law, Indiana University, Bloomington

Recent Appellate Court Decisions

In Miller’s Ale House, Inc. v. Boynton Carolina Ale House, LLC, 702 F.3d 1312 (11th Cir. 2012), the issue of genericness and whether a mark owner may argue that a mark has become rescued from genericness after the passage of time. Rearden LLC v. Rearden Commerce, Inc., 683 F.3d 1190 (9th Cir. 2012), which concerns the standard of “use in commerce” for the purposes of priority. In Swarovski Aktiengesellschaft v. Building No. 19, Inc., 704 F.3d 44 (1st Cir. 2013), the court looked at the issue of nominative fair use, specifically whether the court can consider the defense before determining likelihood of confusion.

(up to 8 minutes)

Jeremy Sheff

St. John’s University School of Law, New York

Already v. Nike and Trademark Enforcement Strategy

In Already v. Nike the Supreme Court explored how a covenant not to sue can affect the analysis of an alleged trademark infringer's standing to continue to assert a counterclaim of invalidity. The analysis of both the majority and concurring opinions offers both guidance and warnings to trademark owners, and suggests that some particularly aggressive enforcement strategies may need to be reconsidered if trademark owners want to avoid putting their own legal interests at risk.

(up to 8 minutes)

Eric A. Prager

K & L Gates LLP, New York

(up to 8 minutes)

Panelist:

Jeff Handelman

Brinks, Hofer, Gilson & Lione, Chicago

(Panelists have no individual time allocated; they take part in the general discussion.)

Panel discussion: 35 minutes (speakers, panelists and members of the audience)

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6:30 PM – 8:30 PM

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