

Emily C. & John E. Hansen Intellectual Property Institute

**31st Annual Intellectual Property Law & Policy
Conference**

www.fordhamipinstitute.com

Fordham Law School, New York, NY

Thursday and Friday, April 4 – April 5, 2024

**Hugh C. Hansen
Director**

Learn Debate Have Fun

CONFERENCE PROGRAM

Wednesday, April 3

Reception & Dinner for Faculty and Sponsors

Reception: Bateman Room, Fordham Law School

6:15 PM to 7:30 PM

Dinner: Costantino Room, Fordham Law School

7:30 PM to 9:30 PM

Sponsored by:

Allen & Overy LLP

Thursday, April 4

Continental Breakfast

Fordham Law School, Bateman Room/Soden Lounge

7:00 AM – 9:00 AM

Registration

Fordham Law School, Soden Lounge

7:00 AM – 8:00 AM

SESSION 1: PATENT LAW

Concurrent Session

Thursday, 8:00 AM – 11:55 AM

Costantino A/B

1A. Patents & AI

Thursday 8:00 AM – 9:10 AM (70 minutes)

Costantino A/B

Moderator

Christopher Stothers

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.)

Speakers

Heinz Goddar

Boehmert & Boehmert, Munich

Trusted depository for data (as well as trade secreted-protected know-how) – a Meaningful Instrument for Training AI Systems to Become “Generative” for New Purposes

Generative AI systems become more and more a “tool-of-choice” for assisting inventors to create inventions, particularly for new fields of use. To make, particularly training data, but also other secret know-how necessary/advisable to use AI systems specifically for finding new ways of application, it is important to secure data/trade secrets in such a manner that they become “tradeable”, i.e. can be communicated and even separately “marketed” to/for third parties and “mankind”, resp. A trusted depository, e.g. blockchain-secured, is proposed to be created for that purpose.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Roya Ghafele

OxFirst Ltd, Oxford

Patent Valuation in the AI Space

The proper management of patent portfolios for litigation, licensing and business management purposes can be the difference between business success and failure; those working in the patent space should be cognisant of the approaches to patent valuation and the strategic value of adopting an economic perspective to patent strategy. IP valuation effectively identifies value, including new sources of value, quantifies that value and communicates it to key stakeholders. In this talk I offer a discussion of the utility and approaches to patent valuation.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Richard Meade

UK High Court, Chancery Division, London

Current Status of Patentability of AI Inventions in the UK

The discussion will include the impact of the decision of the UK Supreme Court in the *Thaler/DABUS case* on the patentability of inventions made by AI. The talk will identify what the decision covers, and what is left for future cases to address.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Laura Sheridan

Google, New York

Supporting AI Innovation Through the Patent System

AI innovation is flourishing around the world, along with AI patenting. How is the patent system, including the patentability standards, supporting AI innovation, and are adjustments needed?

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelists

Nahoko Ono

Lerner David, Cranford, New Jersey

Ari Laakkonen

Powell Gilbert LLP, London

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

General discussion: 20 minutes (speaker, panelists and members of the audience)

1B. Doctrine of Equivalents

Thursday 9:15 AM – 10:25 AM (70 minutes)

Costantino A/B

Moderator

George Badenoch

Hunton Andrews Kurth 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

Ken Adamo

Law Office of KRAdamo, Chicago

Doctrine of Equivalents Facing Tighter Defenses: Prosecution History Estoppel, Vitiating and Federal Circuit VLSI Cabining-In

In *VLSI Technology LLC v. Intel Corp., Appeal 2022-1906*, slip op. (Fed. Cir. Dec. 4, 2023), the Federal Circuit found that the DOE evidence presented there was “legally insufficient.” Stating that liability under the DOE is ‘exceptional,’” Judges Taranto, Dyk, and Lourie, as Professor Crouch termed it, “continue [] its efforts to tightly cabin-in the doctrine.” Dennis Crouch’s Patently-O Daily Review: VLSI’s \$2.2b Infringement Verdict Rejected by Federal Circuit” (Dec. 5 2023). Exactly what that panel did, and how a patent owner must carefully set its proofs to present a best-case work-around of their “cabining-in,” especially in front of a U.S. jury (the DOE being a question of fact), is a new challenge of great importance that demands immediate attention in U.S. district courts, the USITC, and the courts of several countries who have or are in the process of adopting a DOE.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Annsley Merelle Ward

Wilmer Cutler Pickering Hale and Dorr LLP, London

Overdone or Underbaked - Why the Doctrine of Equivalence has been a Victim of Too Many Cooks in the Kitchen and What to do About it. (Part A)

Since 2017 when the UK Supreme Court enshrined the doctrine of equivalence in the law, much ink has been spilled in Court submissions and academic literature on the existential question of “what does it all mean?”. It’s now time to take a look at the facts of what the last seven years have shown us in the UK, the rest of Europe and the US. Does the doctrine work, is it needed or is it just an inconsistently applied and unharmonized artifact of too many cooks – or judges and lawyers – in the proverbial patent kitchen? This talk will answer these questions by examining what has happened in practice in the cases.
(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Koen Bijvank

Brinkhof, Amsterdam

Overdone or Underbaked - Why the Doctrine of Equivalence has been a Victim of Too Many Cooks in the Kitchen and What to do About it. (Part B)

Extrapolating from the evidence provided in Annsley's talk, Koen will explore the boundaries of the utility and applicability of the doctrine of equivalence, and will argue that the evidence supports a refresh. Given the doctrine has not been applied uniformly across jurisdictions, now is the time to consider a new recipe. The Unified Patent Court is yet to consider a substantive doctrine of equivalents analysis and it should be cautious not to follow the scattered approach so far applied by other courts. Koen will attempt to make a prediction of what a UPC doctrine of equivalence might (or should) look like.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Aloys Hüttermann

Michalski, Hüttermann & Partner, Düsseldorf

Equivalence at the UPC

Will Equivalence play a role at the UPC? What are the legal foundations and are there already some indications about the line the UPC could follow?

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelists

Simon Holzer

Meyerlustenberger Lachenal AG, Zürich

Marleen van den Horst

La Gro Geelkerken Advocaten, Hague

Miquel Montaña,
Clifford Chance LLP, Barcelona

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

General discussion: 20 minutes (speaker, panelists and members of the audience)

Break

10:25 AM – 10:30 AM

1C. U.S. Patent Developments

Thursday 10:30 AM – 11:55 AM (85 minutes)

Costantino A/B

Moderator:

Martin J. Adelman

George Washington University Law School, 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:

Patricia Martone

NYU Law Engelberg Center on Innovation Law & Policy, New York

The Sudden Push to Weaken Design Patents

For many years design patents were rarely asserted in major patent litigation. But in recent years, design patents have been the basis of large damages awards in district courts as well as ITC Exclusion orders. The number of design patent applications keeps increasing. That may change as we await the Federal Circuit's en banc reconsideration of its decision in *LKQ Corp v. GM Global Technology*.

The original panel rejected the argument that long-standing precedent for design patent invalidity (the Rosen and Durling tests) was implicitly overruled by the Supreme Court decision in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), which established the current test for obviousness of utility patents. Utility and design patents have long been subject to different tests, even after KSR was decided in 2007. Using the KSR test would result in an unjustified increase in the invalidation of design patents. No rationale has been offered for this sudden sea change in settled law, which will further undermine the patent system.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Paul Michel

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

Time to Rebalance and Reshape the U.S. Patent System to Better Serve Innovation, Inventors and Investors and Advance Technology.

Recent years have witnessed growing and destructive imbalances: between courts and Congress, the Federal Circuit and the Supreme Court, the legal standards and actual practice at the USPTO, and funding technology v. entertainment. Necessary private sector incentives historically provided by robust patents are shrinking, threatening emergence of new products and cures, and even national security as China surges ahead in advanced technologies. As in 1952, it is time for a basic reset.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

John Richards

Ladas & Parry LLP, New York

The Prevail Act: Impending Changes to the U.S. Patent Litigation Landscape

In 2013, in response to complaints that there were “too many bad patents”, the America Invents Act (AIA) introduced a new type of procedure to American patent practice by allowing contested proceedings before a newly-created Patent Trial and Appeal Board (PTAB) within the Patent Office. The objective was to allow third parties to challenge the validity of granted patents in speedy and relatively inexpensive proceedings (similar to opposition proceedings in other countries) as an alternative to litigation in the federal courts. The result has not been quite what most had hoped. Some of the more contentious practices resulting from introduction of the new procedures, have been ameliorated by rule changes, but others persist and some can only be changed by amending the statute. Bills have been introduced into both Houses of Congress to try to correct (or some would say over-correct) this situation. Both bills go by the acronym “PREVAIL” (Promoting and Respecting Economically Vital American Innovation Leadership).

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Nick Groombridge

Groombridge, Wu, Baughman & Stone LLP, New York

The Recent Developments with the PTAB and the Director Review Process

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelists:

James Bollinger

McCarter & English LLP, Stamford

Justin Watts

Wilmer Cutler Pickering Hale and Dorr LLP, London

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

General discussion: 30 minutes (speaker, panelists and members of the audience)

SESSION 2: COPYRIGHT LAW

Concurrent Session

Thursday, 8:00 AM – 11:55 AM

MCR 1-01

2A. E.U. Copyright Developments

Thursday 8:00 AM - 9:10 AM (70 minutes)

MCR 1-01

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 online.)

Speaker:

Trevor Cook

Bird & Bird LLP, London

Interplay of Subject-Matter Specific and General Legislation on Copyright Protection in the European Union

In contrast to most other areas of IP, copyright harmonization in the EU has been piecemeal and fragmentary. In consequence, it has left lacunae and inconsistencies. Moreover, each new measure has had an increasingly difficult passage leading to legislation of fuliginous obscurity which invites references to the CJEU. The CJEU has been able in some cases, such as originality, to fill lacunae although the scope for doing so is limited. The Commission has recently adopted a new, but even more piecemeal approach to revising the copyright acquis, namely including copyright provisions in legislation in other fields - such

as that relating to data, and that relating to AI. None of this contributes to a coherent and accessible acquis, but the idea of a single copyright code as urged by some presents its own problems.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Eleonora Rosati

Stockholm University, Stockholm

The EU Press Publishers' Right: (Too) Much Ado About Nothing?

During the process leading up to the adoption of the DSM Directive, the press publishers' right in Article 15 was one of the most heatedly debated provisions. But has the provision "lived up" to the fears and criticisms that have accompanied it? And isn't the issue today much broader than what the provision targets, that is online uses of press content and news aggregation services?

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Thomas Koch

German Federal Supreme Court (Bundesgerichtshof), Karlsruhe

Under What Conditions can Works of Applied Art be Protected by Copyright Under E.U. Law?

According to the case-law of the Court of Justice of the European Union (CJEU) concurrent protection of the same subject matter as a design and under copyright can, under EU law, be granted only in certain situations. What follows from this? Is there a rule-exception relationship between design protection and copyright protection in the case of works of applied art, such that, when assessing the originality of those works for copyright purposes, higher requirements are to be imposed than for other types of work? And how must originality for copyright purposes be assessed? Is the creator's subjective view of the creation process relevant? Can circumstances occurring after the date of creation, such as the presentation of the subject matter in art exhibitions or museums, be taken into account? The talk will deal with these questions which have recently been referred to the CJEU for a preliminary ruling.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Panelists:

Jerker Rydén

National Library of Sweden, Stockholm

Paul Maier

Former Director of the European Observatory on Infringement of IPRs, Valencia

Jan Bernd Nordemann

Nordemann, Berlin

Terrence Hart

Association of American Publishers, Washington D.C.

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

General discussion: 30 minutes (speaker, panelists and members of the audience)

2B. A Global Perspective on Copyright Protection of 3D Designs

Thursday 9:15 AM - 10:25 AM (70 minutes)

MCR 1-01

Moderator:

Stan McCoy

Motion Picture Association EMEA, Brussels

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

Speakers:

David Stone

Allen & Overy LLP, London

UK Law on Protection of 3D Designs in Light of the WaterRower Case

The UK's Intellectual Property Enterprise Court has acknowledged, in a preliminary ruling, that there is an apparent inconsistency between the EU test for a copyright work and the UK's "artistic" requirement for works of artistic craftsmanship. The court in the *WaterRower v Liking* case will need to grapple with this issue and the UK's closed categories of copyright works as well as the problems associated with the UK case law on works of artistic craftsmanship and the relevance of the author's intention to create something artistic.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Laura Fresco

HOYNG ROKH MONEGIER, Amsterdam

E.U. Perspective on Protection 3D Designs

Those looking for protection of 3D designs in the EU are seemingly spoilt for choice: the same design can for instance be covered by copyrights, (un)registered design rights, trademarks and enjoy protection against unfair competition. Harmonization of laws is increasing, and so are cross-border injunctions. Yet diverging interpretations of EU national courts create uncertainty and drive forum shopping. This presentation will address the common grounds and challenges ahead.”

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Joel Schmidt

Cowan Liebowitz & Latman, PC, New York

Copyright Protection for 3D Designs in the U.S.

In an era shaped by technological advancements, artificial intelligence, and 3D printing, the need for copyright protection for 3D designs is increasingly important. This presentation will delve into the legal nuances surrounding copyright protection for three-dimensional designs in the U.S.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Douglas S. Berman

Kilpatrick Townsend & Stockton LLP, New York

Chinese Perspective on Copyright Protection of 3D Designs

Obtaining copyright protection in China is typically less onerous than obtaining a trademark registration and can help plug gaps in trademark rights. However, what are the benefits of having a copyright for a non-conventional work, such as three-dimensional logo design? This talk will discuss the copyright system in China in the context of 3D designs from a practical and enforcement perspective and make some predictions on future growth.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Panelists:

Brian W. Gray

Brian Gray Law, Toronto

Mary Kate Brennan

Dentons, New York

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

General discussion: 20 minutes (speaker, panelists and members of the audience)

Break

10:25 AM – 10:45 AM

2C. Copyright Potpourri

Thursday 10:45 AM - 11:55 AM (70 minutes)

MCR 1-01

Moderator:

Tobias Timmann

Freshfields Bruckhaus Deringer LLP, Düsseldorf

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

Speakers:

Nicholas Bartelt

U.S. Copyright Office, Washington D.C.

The Right to Repair: Section 1201 Exemptions & Legislation

Beginning in 2015, in three successive rulemakings, the U.S. Copyright Office has recommended exemptions from Section 1201 of title 17's general prohibition against circumventing digital locks to allow users to access software necessary to repair a variety of devices—from vehicles to consumer electronics to medical equipment. This talk will address the “right to repair” in the context of the section 1201 rulemaking, now in its ninth triennial cycle, and various legislative efforts.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Justin Hughes

Loyola Law School, Los Angeles

Shifting or Thickening Copyright Protection for Musical Works

In recent decades, copyright protection of musical compositions has undergone a process of “thickening” -- more elements of a composition are protected, the protection has arguably become more granular, and the boundary between composition and performance has moved toward a grey zone frontera. Classical thinking about property would say that's not good -- and common sense customs may be our best hope to prevent suboptimal outcomes.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Marie Sellier

Vivendi, Paris

European Media Freedom Act, Digital Services Act : What is the New E.U. Framework in Combating the Spread of Deepfakes?

The European Media Freedom Act (EMFA) recently introduced a new regulatory framework for media material on Very Large Online Platforms (VLOPs). This provision enables media service providers to receive special treatment by VLOPs, including prior warning of content removal and an amicable dispute resolution process. VLOPs must set up procedures that allow organizations to declare themselves as independent media. At the same time, VLOPs are required by the Digital Services Act (DSA) to handle systemic issues that can result in misinformation or unlawful content dissemination. How do these provisions interact and design a new approach in fighting the spread of deepfakes.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Sarah Matz

Adelman Matz P.C., New York

Server Test – Should it Survive

A discussion regarding recent developments with respect to the ‘server test’, as well as its pros and cons and issues with consistency in application.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Panelists:

Regan Smith

News/Media Alliance, Washington, D.C.

Menachem Kaplan

Freshfields Bruckhaus Deringer LLP, New York

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

General discussion: 20 minutes (speaker, panelists and members of the audience)

SESSION 3: TRADEMARK LAW

Concurrent Session

Thursday, 8:00 AM - 11:55 AM

Costantino C

3A. EU Trademark Law Update

Thursday, 8:00 AM – 9:00 AM (60 minutes)

Costantino C

Moderator:

Peter Ruess

ARNOLD RUESS, Düsseldorf

(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:

Richard Arnold

UK Court of Appeal, London

UK Departs from CJEU Case Law for the First Time

The UK ceased to be a member of the EU on 31 January 2020, and EU law ceased to apply in the UK with effect from 31 December 2020. Nevertheless, UK trade mark law continues to be based on the EU Trade Mark Directive and UK jurisprudence is based on the case law of the CJEU prior to 31 December 2020.

The European Union (Withdrawal) Act 2018 gave the Supreme Court and Court of Appeal power to depart from such CJEU decisions. The Court of Appeal exercised this power for the first time in *Industrial Cleaning Equipment v Intelligent Cleaning Equipment*, when it departed from *Budejovický Budvar v.*

Anheuser-Busch on the date when time starts to run for limitation by acquiescence. In doing so, however, the Court of Appeal followed a divergent line of cases in the EUIPO Boards of Appeal and General Court. In that sense, it continued to apply EU trade mark law. Looking forwards, the Retained EU Law (Revocation and Reform) Act 2023 is designed to reduce the influence of EU law on UK law, and in particular to make it easier for UK courts to diverge from CJEU decisions, but it remains to be seen what impact this will have in the context of trade marks.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Gordon Humphreys

European Intellectual Property Office, Alicante

Recognizing Artisans: First Thoughts on Europe's Latest Addition to the Geographical Indication (GI) Family

Although protection of the quality, reputation, or other characteristics linked to the geographical origin of wines, spirits, and agricultural products has existed at EU level for many years, craft and industrial products such as Limoges porcelain or Murano glass have had to rely on national GI protection in a handful of countries.

With the adoption of Regulation (EU) 2023/2411 on 27 October 2023, a new EU intellectual property right has been added to the panoply of rights that the EUIPO will handle. This presentation will give a birds eye view of what this ground-breaking Regulation contains, what its impact may be expected to be, and the relevant timelines.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

James Nurton

IP Writer/Editor, London

How Green is Your Trademark?

"Green" trademark applications are increasingly popular. This presentation will examine the latest data on green trademarks in Europe, the latest regulations on "greenwashing", and some recent judgments concerning green terms, and will ask: is the trademark system helping or hindering the sustainability cause?

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelists:

Irene Calboli

Texas A&M University School of Law, Fort Worth

Tobias Timmann

Freshfields Bruckhaus Deringer LLP, Düsseldorf

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

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

3B. Trademark Law Around the Globe

Thursday 9:05 AM – 10:25 (80 minutes)

Costantino C

Moderator:

Anderson Duff

Hogan Duff, 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:

Marshall Leaffer

Maurer School of Law, University of Indiana, Bloomington

Abitron Case and the Extraterritorial Application of the Lanham Act

In *Abitron Austria GmbH v. Hetronic International, Inc.*, 143 S. Ct. 2522 (2023), the Court, for the first time in seventy years, has decided a case involving the application of the Lanham Act. In so doing, it has resolved a circuit split on the applicability of the Lanham Act actions involving foreign conduct. In *Abitron*, the Court concluded that the Lanham Act applies only to domestic conduct and does not apply extraterritorially to purely foreign sales that never reached the United States. To many, Judge Alito's highly formalist opinion in *Arbitron* is ill-conceived because it ignores the realities that a trademark owner faces in today's world where infringing conduct abroad can have a substantial effect on U.S. commerce. The talk will review the real-world ramifications of the decision.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Jenny Simmons

International Trademark Association, Alexandria

Quebec's Bill 96 Impact on Trademark Law Protection in Canada

In 2022, the provincial legislature in Quebec, Canada, adopted Bill 96 to amend the Charter of the French Language, which regulates the use of French in commerce, business, education, and various public services in the province. Surprisingly for brand owners and IP experts alike, the legislation includes a number of significant restrictions and some outright bans on the use of non-French trademarks in product packaging, labeling, signage, and commercial advertising.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Thies Bösling

boesling IP, Hamburg

"NHRNTLY DSTNCTV? The Case for or Against Disemvoweled Trademarks

The trend towards vowel-reduced or "disemvoweled" trademarks raises the issue of whether such marks are inherently distinctive, descriptive or generic. The USPTO, EUIPO and the German Federal Patent Court come to opposite conclusions on the protectability of marks such as SNKRS for footwear.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Michael Maier

Nordemann, Berlin

Navigating Trademark Challenges in the Metaverse

An exploration of trademark challenges in the metaverse - where virtual environments blur the lines between real and digital. Brands face complex issues as they navigate trademark infringement, and protection in this evolving landscape.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelist:

Matthew Asbell

Lippes Mathias, New York

Julia Peng (Invited)

Heping Law Office, Shanghai

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

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

Break

10:25 AM – 10:45 AM

3C. U.S. Trademark Law Update

Thursday 10:45 AM – 11:50 AM (65 minutes)

Costantino C

Moderator:

Kate Patton

Frankfurt Kurnit Klein & Selz PC, 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:

Sari Mazzurco

SMU Dedman School of Law, Texas

Trademark Law and Cultural Practice

This talk will examine recent and ongoing court cases involving new or unsettled applications of trademark law. These include the Second Circuit and Ninth

Circuit's recent applications of *Jack Daniel's Properties v. VIP Products*, union trademark litigation, and disputes over the use of personal names. These cases navigate the margins of trademark law's traditional focus on consumer confusion. They also raise questions about whether trademark law can or should serve other, non-consumer-centered values.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Joshua Simmons

Kirkland & Ellis LLP, New York

Getting Out of the Art Business: First Andy Warhol Foundation v. Goldsmith, Now Vans v. MSCHF?

Like the Supreme Court in *Jack Daniel's v. VIP Products* last term, the Second Circuit in *Vans, Inc. v. MSCHF Product Studio, Inc.* declined to apply the *Rogers v. Grimaldi* test to an allegedly parodic product. Yet, whereas *Jack Daniel's* involves a dog toy, *Vans* involves an art collective's sneaker. As a result, although MSCHF imitated the trade dress and trademarks of Vans' iconic Old Skool shoe, it asserts protection under allegedly core First Amendment principles, relying on a similar pro-artist theme as a Petitioner from another Supreme Court case from last term: *Andy Warhol Foundation v. Goldsmith*. But, like the Supreme Court, the Second Circuit declined to focus on whether MSCHF's product was art, instead considering whether the allegedly parodic elements were used as source identifiers in a manner that was likely to cause consumer confusion. Are courts getting out of the business of considering the expressive nature of works of art, or was this the *Rogers* inquiry the whole time?

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Daan Erikson

Husch Blackwell LLP, Boston

Selected Food & Bev TTAB Cases 2023-2024

Advising clients on food, beverage, and restaurant trademarks is trickier than it has ever been given the USPTO's recent trend towards finding everything related even though nothing is per se related. This talk examines a few recent cases involving food, beverages, and restaurants to see what practical lessons may be gleaned and how the law may continue to develop in this area.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelists:

Jeff Handelman

Crowell & Moring LLP, Chicago

Eric Prager

Venable LLP, New York

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

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

Lunch

12:00 PM – 1:30 PM

Rosa Mexicano

61 Columbus Ave New York, NY 10023

Sponsored by:

WILMER CUTLER PICKERING HALE AND DORR LLP

Welcoming Remarks:

Thursday 1:45 PM – 2:00 PM

Costantino A/B/C

Hugh C. Hansen

Fordham University School of Law, New York

Matthew Diller

Fordham University School of Law, New York

SESSION 4: PLENARY SESSIONS

Thursday 2:00 PM – 6:20 PM

Costantino A/B/C

4A. Government Leader's Perspective on IP

Thursday, 2:00 PM – 3:15 PM (75 minutes)

Costantino A/B/C

Moderator

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

World Intellectual Property Organization (WIPO), Geneva

WIPO Report from Geneva

Update on developments at the multilateral level including two diplomatic conferences in 2024, intense WIPO Conversations on generative AI, extensive work on SDGs including for World IP Day 2024, new initiatives on IP & Sports, and much more.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Sharon Israel

U.S. Patent and Trademark Office (USPTO), Alexandria

The Importance of Engagement

Stakeholder engagement is an important part of the process for the formulation of policy recommendations and proposals. In addition, engagement and outreach is an important service of the USPTO in its work to help improve IP systems internationally. This talk will briefly cover stakeholder engagement from the outside and the inside, and talk about the engagement and services provided by the USPTO's IP attaches.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Morgan McPherson (Invited)

Customs and Border Protection, Washington D.C.

The Evolving Face of IP Infringement

From our vantage point we are seeing a renaissance in how intellectual property (IP) infringement is viewed by our own government, foreign governments, as well as the public. Both the COVID-19 pandemic and the National Emergency declared by the Biden Administration “to deal with the unusual and extraordinary threat to the national security, foreign policy, and economy of the United States constituted

by global illicit drug trafficking,” have transformed the way Americans think about IP infringement. Internationally, nations across the globe are accepting that the government has a compelling interest in preventing trade in counterfeit goods and that it is not merely a private right of action and are taking steps to amend their laws and regulations accordingly. These are all positive developments for U.S. Customs and Border Protection (CBP) and benefit society at large. This session will discuss the evolution in how CBP approaches IP infringement both operationally and in their overall trade enforcement strategy.
(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelists

Giuseppe Mazziotti

Católica Global School of Law, Universidade Católica Portuguesa, Lisbon

Denny Chin

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

Gordon Humphreys (Invited)

European Intellectual Property Office, Alicante

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

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

Break

3:15 PM – 3:40 PM

4B. Key Current IP Issues: Reflections & Analysis

Thursday, 3:40 PM – 5:00 PM (80 minutes)

Costantino A/B/C

Moderator

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

Maria Martin-Prat

European Commission, Directorate General for Trade, Brussels

Main Developments and Some Reflections on the TRIPS Agreement

The latest discussions related to the TRIPS Agreement and the role of IP more generally in the WTO context. Reflecting on some new challenges to the protection/enforcement of rights under the Agreement.
(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

F. Scott Kieff

Kieff Strategies LLC, Washington, D.C.

Politics vs Law: Patent System Signals

Exploring common themes that have emerged across cultures and geographies since antiquity as new technologies have disrupted systems of human institutions, laws, rules, norms, and their enforcement characteristics. Topic highlights several tell-tale signals transmitted by particular locutions for doctrinal tests within the patent system and shows how well they match when that aspect of the system is operating more in line with the Rule of Law Virtues and when it is operating more in line with politics.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

David Kappos

Cravath, Swaine & Moore LLP, New York

The U.S. IP System is Under Siege

COVID vaccine IP waivers, COVID therapeutic and diagnostic waivers, a shotgun marriage for the USPTO and FDA, accusations of “evergreening” and “patent thickets” in the biopharma area, SEP rate-setting by EUIPO, constricted subject matter eligibility, the Bayh-Dole Act turned into a price regulation regime. What message is to be taken from the extreme anti-IP atmosphere in the US? Can we stop the craziness before it is too late?

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Peter Charleton

The Supreme Court, Dublin

European Union Data-sealing: Nullifying Proof in Civil and Criminal Litigation

This presentation will be based in part on a recent article: European Union data-sealing: nullifying proof in civil and criminal litigation by Peter Charleton & Victoria O’Connor. It will focus on how data protection increasingly dominates litigation in the EU. Decisions of the CJEU puts the ability to use general data on

internet sites or in civil and criminal litigants in doubt, except where terrorism in some form is present. Therefore, the question is how broadly this will impact all litigation, including some in the United States.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelists

Rachel Mumby

Bristows LLP, London

Pauline Newman

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

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

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

4C. Unified Patent Court

Thursday 5:10 PM – 6:20 PM (70 minutes)

Costantino A/B/C

Moderator:

John Pegram

Fish & Richardson P.C., 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

Klaus Grabinski

Unified Patent Court, Court of Appeal, Luxembourg

The UPC – 10 Months after Being Up and Running

The Agreement on a Unified Patent Court entered into force on 1 June 2023. Since then, more than 200 actions have been filed and the Court has issued a number of decisions and orders. The talk will provide a brief overview on key developments at the Court

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Maximilian Haedicke

Albert-Ludwigs-Universität Freiburg, Freiburg; Unified Patent Court, Central Division, Paris

Forum Shopping at the UPC?

The talk addresses different approaches taken by different divisions of the UPC and how a coherent case law is being developed.

(up to 6 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Myles Jelf

Bristows LLP, London

UPC: Preliminary Injunctions, Transparency, and Protective Letters

The advent of the UPC has been awaited with bated breath by the global patent community, and now 9 months after it's launch, we are starting to get some feel for the kind of decisions its taking and the way it is approaching them. The talk will touch on how the new court has approached the ever fascinating topic of preliminary injunctions, as well as noting a practice point concerning protective letters and then discussing the issue of transparency and access to Court documents which could be crucial in understanding how the Court has come to its conclusions

(up to 6 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Toby Sears

CMS United Kingdom, London

What is the Relevance of the UK Patent Court System Post the Opening of the UPC?

Why the UK is still a highly relevant jurisdiction that remains a vital piece of international patent litigation strategy and must be considered as part of any global/UPC approach. This includes the UKs leading SEP/FRAND decision making capabilities, the importance/weight of the decisions arising from the UK court, in particular due to our highly skilled and respected judiciary, and what the UK legal profession are doing to ensure they can operate in the UPC system.

Carl Josefsson

Boards of Appeal of the European Patent Office (EPO), Haar

EPO Boards of Appeal and Unified Patent Court: two courts, One Shared Responsibility. Parallel Revocation Jurisdiction in Europe.

Although independent from each other as judicial bodies, the EPO Boards of Appeal and the Unified Patent Court both share the commitment to the rule of law and the principle of harmonization enshrined in the European Patent Convention, paving the way for legal certainty in the European patent system.

(up to 6 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelists

Edgar Brinkman

Unified Patent Court, Local Division, The Hague; Court of The Hague, The Hague

Wolrad Prinz zu Waldeck und Pyrmont

Freshfields Bruckhaus Deringer LLP, Düsseldorf

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

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

Thursday Reception

Empire Rooftop

44 West 63rd Street, New York, NY 10023

6:30 PM – 9:30 PM

Sponsored by:

Freshfields Bruckhaus Deringer LLP

Friday, April 5 **Continental Breakfast**

Fordham Law School, Bateman Room/Soden Lounge
8:00 AM – 10:00 AM

SESSION 5: PATENT LAW

Concurrent Session

Friday, 8:30 AM - 12:25 PM

Costantino A/B

5A. Pharma Update

Thursday 8:30 AM - 9:40 AM (70 minutes)

Costantino A/B

Moderator:

Jay Thomas

Georgetown University, 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.)

Speaker:

John Todaro

Merck & Co., Inc., New York

Compulsory Licensing and March-in Rights.

Since the COVID 19 pandemic there have been increasing calls around the world for the compulsory licensing of intellectual property rights covering medicines.

Most significantly, the WTO authorized the waiver of IP rights covering vaccines, in June 2022. In the U.S., there are calls for the compulsory licensing of government funded inventions under the “march-in rights” provisions of the statutory Bayh Dole scheme. Despite these calls, broader compulsory licensing will not provide benefits to today’s patients, and will harm the innovation environment that is crucial to developing innovations for tomorrow’s patients.

(up to 6 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Penny Gilbert

Powell Gilbert LLP, London

Plausibility – a Plague on Pharma Patents?

Although not a specific requirement under the European Patent Convention, lack of plausibility has become a regular ground for challenging the validity of pharma patents. In G2/21 the Enlarged Board of Appeal of the EPO looked at plausibility, but has anything changed? Certainly not in the UK. Data remains important to support the alleged utility of a claimed invention - but why, where and when? Is the concept of plausibility an extra hurdle for pharma patentees or a valuable tool to prevent overly broad claiming?

(up to 6 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Charles Eloshway

U.S. Patent and Trademark Office (USPTO), Washington D.C.

USPTO Update on International Pharma-Related IP Developments

The presentation will canvass recent developments at the intersection of pharmaceuticals and IP, with a focus on multilateral discussions.

(up to 6 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Kevin McGough

BioNTech US Inc., Cambridge

Escaping an Innovator's Dilemma

Inexorable competitive and political pressure will leave biopharmaceutical firms with no choice but to innovate and collaborate at an accelerating rate. Fascinating AI applications and a torrid search for assets such as obesity-related product candidates are just two of the many recent examples where IP will continue to play a key supporting role. Key developments and likely future approaches will be discussed.

(up to 6 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Jeremy Saks

Fish & Richardson P.C., New York

Avoiding Consequences for Noncompliance with New PTO Rules Requiring Coordination of Submissions to Government Agencies

Recent guidance from the USPTO emphasizes how the duties of candor and reasonable inquiry include the disclosure of potentially inconsistent statements

patentees made to government agencies, such as FDA, which may be material to patentability. This talk will discuss the recent guidance, its practical effect on practitioners in the pharma space, and best practices for avoiding pitfalls.

(up to 6 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelist:

James Love

Knowledge Ecology International, Washington, D.C

Laura Whiting

Freshfields Bruckhaus Deringer LLP, London

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

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

5B. International Patent Law Update

Friday, 9:45 AM – 11:00 AM (75 Mins)

Costantino A/B

Moderator:

Carey Ramos

Quinn Emanuel Urquhart & Sullivan 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.)

Speaker:

Carlos Aboim

Licks Advogados, Rio de Janeiro

The Increasing Importance of Civil Law Countries in Global Patent Litigation.

The remedies against patent infringement in Brazil and the independence of the Brazilian courts in granting preliminary and permanent injunctions despite attempts to shut down disputes through ASIs.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Jiyoung Yi

IP High Court South Korea, Daejeon, South Korea

The IP High Court of Korea: Harnessing Technical Expertise in Intellectual Property Law

The Intellectual Property Court of Korea (The IPHC) is the first specialized IP Court in Asia, established in 1998. It holds exclusive jurisdiction over all patent, trademark, and design patent cases. The court features unique systems to assist judges in various technical fields, including the roles of a technical examiner, technical advisor, and expert witness. Additionally, this conference will introduce Korea's unique IP litigation jurisdiction and the international trial system.
(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Jill Ge

Allen & Overy LLP, Shanghai

Bifurcation, Backlog and the World's Busiest Patent Docket

China handles more patent cases than any other country in the world. The courts have creatively developed means to address a heavy docket and backlog within the constraints of a bifurcated system. These means include pre-docketing mediation and dismissal upon invalidation by the patent office. This demonstrates that the Chinese patent system is progressive and constantly evolving but it also poses practical challenges for patentees to enforce their patents. However, the Chinese courts are not necessarily biased against foreign parties but rather require a better understanding of and adaptation to their practice.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Shimako Kato

Abe, Ikubo & Katayama, Tokyo

Scope of Protection of Extended Patent right-A Hot Topic in a Limited Field in Japan

Article 68-2 of the Japanese Patent Law stipulates the scope of extended patent rights. Conventionally, the scope of extended patent rights, particularly with respect to pharmaceuticals, was broadly construed in accordance with the wording of the article. However, a subsequent Supreme Court decision which changed the requirements for patent right extension, Grand Panel decision of Oxaliplatin Case held the scope of the extended patent right in a limited manner based on the content of the disposition stipulated by the Cabinet Order. In this presentation, two recent cases concerning the validity of extended patent rights will be presented.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelist:

Sanjaya Mendis

McCarthy Tétrault LLP, Toronto
Ute Kilger
Boehmert & Boehmert, Berlin
Hans van Walderween
Court of The Hague, The Hague

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

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

Break

11:00 AM - 11:20 AM

5C. Patents and Trade Secrets

Friday, 11:20 AM – 12:25 PM (65 Mins)
Costantino A/B

Moderator

John Richards

Ladas & Parry 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

Melanie Müller

Boehmert & Boehmert, Munich
***Trade Secret Protection as Supplement to Patent Protection – do we need a
trusted Depository for Trade Secrets?***

The talk aims to explore the concept of a "Trusted Depository for Trade Secrets" as an innovative complement to traditional patent protection. This approach allows holders to confidentially safeguard sensitive information and data outside of public patent filings. By blending patents and protected trade secrets, this hybrid protection system facilitates new licensing opportunities and optimizes the management of confidential invention details in the digital age.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

David Por

Allen & Overy LLP, Paris
Are Remedies for Patent Infringement Economically Efficient?

In Europe, the default remedy for patent infringement tends to be an injunction; by contrast, in US patent litigation, injunctions are almost becoming a rarity, while damages can be massive. The talk will discuss whether either approach appropriately takes into account the issue of the overall economic efficiency of the patent system.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Dustin Guzior

Sullivan & Cromwell LLP, New York

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelists

John Lee

Gilbert + Tobin, Sydney

Greg Bombard

Greenberg Traurig, LLP, Boston

SESSION 6: COPYRIGHT LAW & COMPETITION LAW

Concurrent Session

Friday, 8:30 AM - 12:30 PM

MCR 1-01

6A. U.S. Copyright Developments

Friday 8:30 AM - 9:45 AM (75 Minutes)

MCR 1-01

Moderator:

Sandra Aistars

Antonin Scalia Law School, George Mason University, Arlington

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

Speakers:

Jane Ginsburg

Columbia Law School, New York

Transforming 'Transformative Use'?: The Future of Fair Use in Light of Andy Warhol Foundation v. Goldsmith (US 2023)

In *AWF v. Goldsmith*, the Supreme Court returned to its fair use analysis in *Campbell v Acuff-Rose*, which adopted the interpolation of "transformative use" into the first fair use factor, but whose limitations on "transformative use" many lower courts had subsequently overlooked. The Supreme Court clarified that merely adding "new meaning or message" to content copied from a prior work did not suffice to make a use "transformative." In shifting the focus from defendant's creation of a transformative work, to the similarity of defendant's use to plaintiff's actual or potential exploitation of its work, the Court acknowledged that a defendant's work might be fair use in some contexts, but not in others. This presentation will consider how that shift in focus may affect outcomes in future fair use cases.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Susan Scafidi

Fordham Law School, New York

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

David O. Carson

Copyright Claims Board, Washington D.C.

The Copyright Claims Board: A Progress Report

Almost two years ago, the Copyright Claims Board opened its virtual doors as a voluntary tribunal for the resolution of relatively low-value copyright disputes. A member of the Board will report on the Board's progress in carrying out its mission of providing an inexpensive, streamlined process for adjudicating claims for copyright infringement, declarations of noninfringement, and misrepresentations in DMCA takedown notices and counter notices to online service providers.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Barry Sookman

McCarthy Tétrault, Toronto

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Panelists:

Christopher Davis

Cravath, Swaine & Moore LLP, New York

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

General discussion: 20 minutes (speaker, panelists and members of the audience)

6B. FRAND

Friday 9:50 AM - 11:05 AM (75 Minutes)

MCR 1-01

Moderator:

Christine Yiu

Bird & Bird LLP, Shanghai

(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:

Myles Jelf

Bristows LLP, London

Adrian Howes

Nokia, London

James Mellor

UK High Court, Chancery Division, London

Thomas Pease

Greenberg Traurig, LLP, New York

Cordula Schumacher

ARNOLD RUESS, Düsseldorf

Yuan Hao

Senior Fellow, Berkeley Center for Law & Technology, Berkeley

Alex Calver

Wilmer Cutler Pickering Hale and Dorr LLP, London

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

General discussion: 70 minutes (speakers, panelists and members of the audience)

Break

11:05 AM - 11:20 AM

6C. Competition

Friday 11:20 AM - 12:30 PM (70 Minutes)

MCR 1-01

Moderator:

Daryl Lim

Penn State Dickinson Law, Carlisle

(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:

William Kovacic

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

Milan Kristof

Court of Justice of the European Union, Luxembourg

Priya Nair

ACT - The App Association, Washington D.C.

Kristen O'Shaughnessy

White & Case LLP, New York

Peter Yu

Texas A&M University School of Law, Fort Worth

Claire Xie

NERA Economic Consulting, Washington D.C.

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

General discussion: 65 minutes (speakers, panelists and members of the audience)

SESSION 7: TRADEMARK LAW

Concurrent Sessions

Friday, 8:30 AM - 12:30 PM

Costantino C

7A. Enforcement

Friday 8:30 AM – 9:50 AM (80 minutes)

Costantino C

Moderator:

Maria Scungio

Cowan Liebowitz & Latman, PC, 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:

Michael Goodyear

New York University Law School, New York

Illegitimate E-Commerce Injunctions

In the last few years, rights owners have filed trademark (and to a lesser extent copyright and patent) infringement actions against dozens to hundreds of alleged e-commerce infringers in the same suit, skirting the rules of civil procedure by grouping defendants that are unrelated beyond their alleged offering for sale of products that infringe the same intellectual property and seeking ex parte injunctive relief. An unexamined aspect of this Schedule A litigation is that, to be effective, these injunctive orders require non-parties, especially e-commerce platforms, to act despite those courts' tenuous authority over them. Courts, knowingly or not, are ordering non-party e-commerce platforms to adopt one-strike termination rules, although a growing minority of district court judges are starting to resist this overreach in Schedule A litigation.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Peter Ruess

ARNOLD RUESS, Düsseldorf

Provider Liability after ECJ's Louboutin Decision – Will it Extend Beyond Trademark Law?

Amazon was held liable as an intermediary for trademark infringement in the *ECJ's Louboutin decision*. Since then, German decisions seem to suggest this also extends to design law. Amazon has appealed two preliminary injunctions handed down by the Duesseldorf District Court on that matter very recently. The impact of the Louboutin Decision is thus to be reviewed.

(up to 8 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

David Stone

Allen & Overy LLP, London

Intermediary liability in the UK and EU

Intermediary liability in the UK and EU has been directed for many years by The E-Commerce Directive (2000/31/EC), its regime of “notice and take-down” and its prohibition on a general obligation to monitor. More recently, there have been

indications that platforms may need to take more responsibility for IP infringements. Recent caselaw (e.g. *Montres Breguet v. Samsung* and *Louboutin v. Amazon*) and new legislation (e.g. the EU Digital Services Act) raise questions about the diligent operator and what it needs to do to escape liability for IP infringements.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelists:

Sarah Wright

CMS United Kingdom, London

Rachel Epstein

Quinn Emanuel Urquhart & Sullivan LLP, New York

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

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

7B. UDRP & Cybersquatting: Past, Present and Future

Friday 9:55 AM – 11:00 AM (65 minutes)

Costantino C

Moderator:

James Nurton

IP Writer/Editor, 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:

Gerald Levine

Levine Samuel LLP, New York

25th Anniversary of the UDRP - 1999-2024 - The Rise and Development of a Jurisprudence for the Suppression of Cybersquatting

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Gareth Dickson

Mishcon de Reya LLP, London

Remedies for Blockchain Trademark Infringements

Most trademark owners are familiar with UDRP, but so too are most cybersquatters and fraudsters, who have used the Policy's predictability and transparency as a blueprint for how to evade detection. One of the more recent methods is to abandon the "traditional" domain name system in favor of using anonymous and decentralized peer-to-peer networks (i.e. blockchains) to create infringing domain names for illicit purposes. These domain names are harder to regulate since they are ostensibly outside the purview of ICANN and the UDRP, but that may be changing with some significant registrar updates on trademark enforcement expected to be announced before the conference.

(up to 5 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Dean Marks

Emeritus Director and Legal Counsel, Coalition for Online Accountability, Los Angeles

Know Your Customer

Article 28 of the EU Directive on Cybersecurity (NIS-2) adopted at the end of 2022 imposes obligations on domain name service providers to collect, verify and give access data about their customers. The "know your customer" obligations of Article 28 contribute not only to cybersecurity, but to the protection of intellectual property online. Robust implementation of such obligations on domain name service providers and other internet infrastructure providers can provide a path forward to better protection of intellectual property online as well as an overall reduction in cybercrime.

(up to 5 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelist:

Georges Nahitchevansky

Kilpatrick Townsend, New York

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

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

Break

11:00 AM – 11:15 AM

7C. Can I Have My Cake And Eat It, Too? Trademark Law and Overlapping Rights

Friday 11:15 AM – 12:30 PM (75 minutes)

Costantino C

Moderator:

Sarah Wright

CMS United Kingdom, 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:

Maria Scungio

Cowan Liebowitz & Latman, PC, New York

Lookalikes: Secondary Meaning, Copyist Intent & Something Extra

This presentation will briefly examine recent trade dress infringement decisions, highlighting courts’ differing treatment of evidence of copying, in the context of secondary meaning. We will also consider select “lookalike” case outcomes for which overlapping design patent arguments were also available.

(up to 5 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Irene Calboli

Texas A&M University School of Law, Fort Worth

Resurrecting Design Protection with Trademarks? Why, How, and Why Not

This presentation addresses the overlap between design (intended as industrial design and design patents) and trademark protection and highlights how extending trademark protection to designs may result in breaching the societal bargain upon which design law is built. Areas in which the traditional contours of design and trademark law overlap, are the protection of shapes and other aesthetic works used in the course of trade. In particular, through the analysis of recent EU and US cases, this presentation argues that design and trademark law serve different purposes and protect different economic and social interests, and their overlap should be critically questioned and often forbidden based on these interests.

(up to 5 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Kai Schmidt-Hern

Lubberger Lehment, Berlin

Device Marks and Spare Parts – the AUDI Case Before the ECJ

European law aims to facilitate competition on the spare parts market by limiting design rights. What if a spare part resembles a registered device mark?

(up to 5 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Massimo Sterpi

Gianni & Origoni, Rome

Shades of Infringements - The Scope of Protection of Color Trademarks

Can a trademark owner register a certain shade of a color trademark for certain products based on secondary meaning, even though shades of this color are typically used in the trade for the similar products? And then, can the same trademark owner assume that the registration protects any shade of the same color?

(up to 5 minutes)

Discussion: 5 minutes (speakers, panelists and members of the audience)

Panelists:

Anderson Duff

Hogan Duff, New York

Daan Erikson

Husch Blackwell LLP, Boston

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

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

Lunch

12:30 PM – 2:00 PM

<p>Cafe Fiorello 1900 Broadway New York, NY 10023</p>	<p>&</p>	<p>Cafe Paradiso 144 W 65th Street New York, NY 10023</p>
---	--------------	---

Sponsored by:
Groombridge, Wu, Baughman & Stone LLP

SESSION 4: PLENARY SESSION

Friday 2:15 PM – 6:30 PM

Costantino A/B/C

4D. Artificial Intelligence Chapter 1 – Input

Friday, 2:15 PM – 3:25 PM (70 minutes)

Costantino A/B/C

Moderator:

Joshua Simmons

Kirkland & Ellis LLP, New York

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

Speakers:

Lauren Chamblee

Microsoft, Washington D.C.

Beyond the Buzz: What can GenAI Models Do & How?

While much of the IP discussion in the AI space is around training generative AI and the technology's ability to produce text, images, music and more, GenAI and large language models are poised to support and accelerate innovation. This presentation examines how these models work and what they can do when used in GenAI tools and applications.

(up to 10 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Michael Fricklas

Advance Publications, New York

Beyond the Boston Strangler: Towards a Sustainable Media Ecosystem in the Age of AI.

A discussion of issues affecting creators and media businesses arising from the advent of generative AI systems, and in particular, the assertions that providers of these systems do not require permission from, or owe compensation to, content owners, nor bear responsibility for output.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Shlomit Yanisky Ravid

ONO Academic Law School, Israel

Protection of AI-Generated Works: A Comparative Study

This talk will delve into how various jurisdictions address the rights surrounding AI-generated works, and explore questions such as: What do other jurisdictions say about AI-generated works? Can artworks be copyrightable, and why is this significant? Amid the current lack of protection for AI-generated works in the U.S., our discussion will address the legal frameworks in the UK, Ireland, and other jurisdictions, highlighting recent court decisions, including one from Beijing, that protect computer-generated works by focusing on ownership rights. The talk will also emphasize the importance of these protections for the U.S. creative industries, and how safeguarding AI-generated works can maintain the U.S.'s competitive edge, support individuals (e.g., with disabilities), and ultimately strengthen the U.S. economy.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Catherine Rowland

Copyright Clearance Center, Washington D.C.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Panelists:

Ole Jani

CMS Germany, Berlin

Ursula Feindor-Schmidt

Lausen Rechtsanwälte, Munich

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

General discussion: 17 minutes (speakers, panelists and members of the audience)

Break

3:25 PM- 3:35 PM

4D. Artificial Intelligence Chapter II - Output & Infringement

Friday, 3:35 PM – 4:50 PM (75 minutes)

Costantino A/B/C

Moderator:

Joshua Simmons

Kirkland & Ellis LLP, New York

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

Speakers:

Shira Perlmutter

U.S. Copyright Office, Washington D.C.

Examining Generative AI Outputs: Where the Copyright Office Draws the Line

Over the past two years, the U.S. Copyright Office has issued several decisions and provided registration guidance on the copyrightability of works that incorporate the output of generative AI. While the Office has refused registration for several works, it has registered more than 200 works where applicants properly disclaimed AI-generated elements. This talk describes the Copyright Office's ongoing AI initiative, with a focus on how to determine which generative AI outputs may be copyrightable and where to draw the line between human expression and AI-controlled choices.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Robert Arcamona

META, New York

AI and Content Protection

This discussion will focus on the use of AI systems to identify and report for removal infringements across digital platforms, and the challenges accompanying such systems. The discussion will further address existing copyright law in light of these considerations, and whether current law is still fit for purpose.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Sari Depreeuw

Crowell & Moring LLP, Brussels; UCLouvain Saint Louis Bruxelles, Brussels
Transparency obligations in the AI Act: is the EU-emperor wearing any clothes?

The recently voted AI Act imposes several transparency obligations with copyright relevance. The use of Gen AI to generate or manipulate content (text, visual or audiovisual) must be indicated (“deepfakes”), which has consequences for the protection of the output under copyright (no) and the related rights (maybe). The provider of general purpose AI models also has the obligation to disclose which training data have been used, which should allow the right holders to exercise their rights. But can the author enforce the transparency obligation? And how does it relate to other measures for preservation of evidence?

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Michael Goodyear

New York University School of Law, New York

Artificial Infringement

When an AI-generated output is infringing, who should be liable? In the past, courts refined direct copyright infringement standards in response to new technologies by using proximate causation. Applying this same framework in the AI context suggests that, in many cases, the most promising candidate for direct infringer is the AI system itself.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

P. McCoy Smith

Lex Pan Law, Portland

Generative Artificial Intelligence & Open Source/Open Access Models

Although much of the focus of the discussion, and litigation, over Generative AI has been on input in the form of images and text, there is a separate discussion, and litigation, about Generative AI systems that ingest software – most, if not all, of it licensed under an Open Source licensing model. This presentation will describe the unique issues that arise when a Generative AI system is trained on software, and how the open source software licensing model may, or may not, impose impediments on that training. Also discussed will be how some of the fundamental copyright law doctrines may be tested in the current litigation over

this training. Finally, a brief overview will be given of the current debate about how an “Open Source” AI system would look, and where that debate may diverge from how “Open Source” has traditionally been defined for software.

(up to 7 minutes)

Discussion: 5 minutes (speakers, panelists, and members of the audience)

Panelists:

Marcus von Welser

Vossius & Partner, Munich

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

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

Break

4:50 PM - 5:00 PM

4E. Views from Judicial Decision Makers

Friday 5:00 PM – 6:30 PM (90 minutes)

Costantino A/B/C

Moderator:

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:

Richard Arnold

UK Court of Appeal, London

Edger F. Brinkman

Unified Patent Court, Local Division, The Hague; Court of The Hague, The Hague

Peter Charleton

The Supreme Court, Dublin

Denny Chin

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

Klaus Grabinski

President, Unified Patent Court, Court of Appeal, Luxembourg

Maximilian Haedicke

Designated Judge, Unified Patent Court, Central Division, Paris

Carl Josefsson

President, Boards of Appeal of the European Patent Office (EPO), Haar

F. Scott Kieff

Kieff Strategies LLC, Washington, D.C

Thomas Koch

German Federal Supreme Court (Bundesgerichtshof), Karlsruhe

Richard D. Meade

UK High Court, Chancery Division, London

James Mellor

UK High Court, Chancery Division, London

Paul R. Michel

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

Pauline Newman

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

Hans van Walderveen

Court of The Hague, The Hague

Jiyoung Yi

IP High Court South Korea, Daejeon

Closing Reception

Bateman Room, Fordham Law School

6:30 PM – 8:30 PM

Sponsored by:

Bristows LLP
