

Delos counsel talks  
trade secrets

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## Sheldon Klein: 'It's been a great privilege'

After a year of serving as AIPLA President, Sheldon Klein will pass the torch to Barbara Fiacco, a Partner at Foley Hoag. The transition comes after a year of hard work for Klein, who has balanced serving as a Principal at Gray Plant Mooty with his duties as president.

"An AIPLA President is definitely not a figurehead," Klein remarks. "A president is highly involved in the inner and outer workings of the Association."

The duties of the President include helping to develop the Association's agenda, presiding over meetings, leading delegations abroad, representing the Association at meetings with sister organizations and being involved in advocacy work.

**A wave of advocacy**

There has been ample opportunity for advocacy this year, and AIPLA has been involved both at a Congressional and a judicial level.

For example, in *Iancu v. Brunetti*, AIPLA argued that the Lanham Act's prohibition on the registration of immoral or scandalous marks violated the free speech clause of the first amendment. The Supreme Court agreed with AIPLA and others who had made a similar argument, and struck down the prohibition.

One of the key legislative issues the association has been involved in is Section 101 reform. Klein adds that Fiacco testified before Congress and presented AIPLA's views on this issue.



"We've been working very, very hard. We have participated in roundtables and have collaborated with other associations to try to encourage a legislative solution to this very, very knotty problem that is seriously impacting patents in the United States. This is probably the most important and impactful issue that we've been working on this year and will continue to work on."

Another issue that AIPLA is addressing concerns trademark fees. The USPTO has re-

cently proposed raising fees, and AIPLA has submitted written and oral testimony expressing concerns about some of the fee increases.

Klein believes that AIPLA has succeeded in having an important voice.

"We strive to be influential, especially in this country, but also in others. Associations, governments and patent and trademark offices seek us out. They want to know what we have to say. Courts cite amicus briefs we file. We're very active," he says.

**A talented group**

When reflecting on his most impactful experiences as President, Klein recalls two that stand out.

"[The first has been] leading, working and learning from what I consider one of the most talented group of individuals I've encountered in my entire career," he says. "I can't think of any other place that I could have grown my knowledge of IP law and my leadership skills as much as I have during my past year as President of AIPLA."

Klein also says that representing AIPLA and speaking to officials, judges and practitioners across the world has been particularly impactful. As President, Klein has traveled to Brazil, Italy, Japan, Scotland and England and has attended numerous meetings in the US.

"Those trips, meetings and presentations have had a great impact on me and it's been a great privilege to be able to do it."

**Cultivating diversity**

While Klein and his successor are private practice lawyers, other members of the AIPLA Board come from in-house positions, and Klein says this mix is deliberate. He adds that the membership also includes a mix of lawyers from large and small firms and companies.

AIPLA also seeks diversity when it comes to gender, race and sexual orientation, according to Klein.

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## Today's sessions at a glance

Patent prosecution will take center stage this morning during Concurrent Track 1, where one of the speakers is Kirk Damman, a Member at Lewis Rice. He will be speaking about where patent filings can go wrong and focus on why the Application Data Sheet (ADS) "is both your friend and your worst enemy."

"The ADS has come into increased importance at the Patent Office," he explains. "With this has come some mechanical issues in their use of it which attorneys need to address to make sure that the document helps them and doesn't create unnecessary problems."

He hopes that attorneys obtain an increased understanding of what the ADS is being used for and how important it is at the USPTO. "I think many of them don't interface with this

document directly – and they need to."

Rakhi Nikhanj, Attorney at Mueting Raasch & Gebhardt, will also be presenting – on the topic of "So Mistakes Were Made, Now What Do We Do?" She says the session will look at fixing problems with patent application filings, particularly petitions filed with the USPTO.

"These issues are important for IP practitioners because we are all human. Even if we happen to be superhuman in our own practices, our clients and support staff are not, and so mistakes can pop up anywhere," she says.

Nikhanj says she hopes to reach a broad audience of new and experienced practitioners that share these common issues and provide them with useful tips that they can implement in practice.

Track 1 will also hear from Melissa Pytel, Of Counsel at Medler Ferro Woodhouse & Mills, who says she will be discussing the need to take a strategic approach to restriction practice. Topics will include how the manner in which an application and claims are drafted can influence whether or not a restriction requirement is issued.

Pytel says that it is always important to consider the goals of the client when preparing and prosecuting patent applications. "This remains true when it comes to restriction practice," she says. "I hope I am able to provide useful tips and guidelines for how to draft and prosecute a patent application with an eye towards US restriction practice."

In the afternoon sessions, Concurrent Track 2 will focus on topics relating to

driverless cars. One of the speakers, Anne Layne-Farrar, Vice President at Charles River Associates, says that the panel as a whole will be addressing the many IP challenges that autonomous cars, and the Internet of Things (IoT) more generally, pose.

"These issues are important because the IoT represents the aggregation of a number of industries that until now haven't had to interact that much," says Layne-Farrar. "Automotive, other manufacturing, and ICT have different industry norms and cultures, which are already clashing as IoT is implemented."

She says the panel hopes to provide a clearer understanding of what the IoT really is, what technologies are included, what the primary IP challenges are and will be, and how stakeholders can think about navigating those challenges.

# Delos IP counsel on trade secrets loss: 'It only takes one'

**S**cott Allison will cover the topic of "You Want to Do What with My Laptop?" during tomorrow morning's Trade Secret concurrent track. Allison is Chief IP Counsel at Delos, which strives to create indoor spaces that contribute to health and well-being.

Allison says the discussion will focus on how to protect trade secrets when going through customs and crossing borders, and issues that arise when cell phones, laptops and other electronics are being searched. He says he'll primarily focus on the US during the talk.

"I think it's important to put this into context of general, day-to-day IP protection issues when you're traveling," he says. "There's always a lot of increased risk of potential loss of IP with traveling."

## Trade secret strategy

Since the passage of the Defend Trade Secrets Act in 2016, trade secret litigation has increased in the US.

Allison says that the best way to avoid such litigation is to be proactive and take precautions so you avoid losing a trade secret in the first place. He emphasizes the importance of educating colleagues and others on best practices.

"It only takes one. One loss of your laptop, one hack of your cell phone, one misplaced document, one unwatched laptop, for



a valuable trade secret to get lost.

"It never ends and unfortunately the ability of people out there and organizations to hack, to fish, to steal, to install malware or other kinds of virus software on your devices is only continuing to grow and that's not going to change in the foreseeable future."

## Finding a balance

Allison says that one of the key challenges he faces is finding a balance between protecting his company's IP and allowing the company to share what it needs to.

"As an intellectual property lawyer who's paid to be paranoid about protecting intel-

lectual property, we could put everything in a steel drum, seal it up, bury it 10 feet under the ground and have watchdogs all around it so no one could ever get it," he says.

"But that's not practical. You have to have a balance between using trade secrets and protecting trade secrets. As a business, we still need to be productive and generate income, and I think it's the willingness to get into those discussions which makes a huge difference here."

He again emphasizes the importance of educating colleagues about IP issues and says that a legal department needs to be willing to find a middle ground. As an example, he says that a company might have a 40-page agreement but only need to share two pages.

"What needs to be shared, and why?" Allison asks. "And can we only share that?"

## In-house expertise

Allison has worked across several industries. Before coming to Delos, he was at General Electric, and before that he was in the food and beverage industry at Kraft Foods and Cadbury.

Reflecting on his career, Allison recalls different challenges at different companies, though he says his experience within each sector might not be universally true for that sector.

When he worked at GE, he says the company was involved in a lot of sophisticated technology, like jet engines, train engines, and wind and other power sources. Because the technology was sophisticated, he says that people were more in tune to its importance and the need for trade secrets.

Allison says that when he worked in the food and beverage sector, "there was less of an understanding that these were potentially valuable trade secrets."

"It was a bit more of a challenge conveying this message of 'we still need to investigate, there's still a lot of intellectual property here, there are still a lot of precautions we need to take.'"

## First lawyer to work with

At Delos, Allison says he has tried to increase awareness of IP issues.

"We have a lot of researchers here who are brilliant PhDs in a lot of different technology areas, but for a lot of them, I'm the first lawyer they've ever worked with."

Allison strives to build relationships and works to ensure his non-legal colleagues feel comfortable approaching him about IP issues.

"I don't often sit with the rest of the legal department. I sit where the scientists, the technologists and the researchers are because that generates a lot more of that kind of conversation than if I'm separated and sitting with the rest of the legal department somewhere else."

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He adds that while he strives to educate his colleagues about IP issues, they teach him a lot too.

"This is a two-way education. I'm teaching them about trade secrets and what might be patentable, but I'm also here to learn from them. I need to better understand what they're working on to do my job."

While Allison has worked in private practice and enjoyed it, he thrives in an in-house environment.

"I love being an in-house lawyer because the involvement that I have with the projects and the teams is ongoing. I'm not charging them by the hour, so there's no hesitancy to bring me in."

He adds that the IP aspects of commercial strategy are a relevant issue and he enjoys being part of strategic discussions that aren't just IP-focussed.

"One thing I tell new attorneys when they're starting out is that there's a big difference between being an attorney and being a counselor, and I try to take the counselor approach so that people will come talk to me about just about everything. I do not mean to disparage attorneys at all, but [you're not] necessarily going to be asked as often – just because you're a smart person – for your opinion. That's part of the fun I find being in-house."

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**IP** Prosecution  
Infringement  
Litigation



# Andrei Iancu: ‘We must drive real change’

“I applaud members of Congress, particularly Senators Tillis and Coons, for taking on this issue,” says Andrei Iancu, referring to the work on possible legislation to amend Section 101 of the US Patent Act.

Elements of the proposed bill say that “provisions of Section 101 shall be construed in favor of eligibility” and that exceptions to subject matter eligibility (both judicial and implicit) will not be used to determine patent eligibility under Section 101.

“I believe that any solution should be narrowly tailored to address the problem at hand, without raising new issues that could add new burdens to, and inject even further uncertainty into, the system,” Iancu adds.

Reflecting on the US Supreme Court’s decision in *Alice v CLS Bank* (2014), Iancu says the case has presented challenges for the USPTO. “In the four years after *Alice* was decided, Office Actions containing a 101 rejection increased on average by 5%, with increases in the artificial intelligence (AI) areas [by] 22%.”

In January 2019, the USPTO released guidelines on subject matter eligibility. Iancu says that in the six months after the release of the guidelines, Office Actions containing a 101 rejection decreased on average by 6%, with decreases in AI areas by about 21%.

## USPTO and AI

According to Iancu, AI will bring benefits to

the USPTO. He expects AI to reduce administrative costs and highlights the technology’s ability to search for prior art, explaining that the volume of potential prior art is expanding “exponentially.”

The USPTO has also seen AI elements included in patent applications. “We have even seen applications for inventions allegedly conceived entirely by an AI machine,” Iancu says.

As AI and other disruptive technologies continue to make waves, the USPTO strives to engage the IP community on relevant issues. For example, the USPTO recently issued a request for comments to its stakeholders, seeking feedback on a series of questions related to AI. The USPTO also operates the Patent Examiner Technical Training Program, where technology experts, including scientists and engineers, volunteer to provide technical training and expertise to patent examiners.

## Marijuana: patents v trademarks

While inventors continue to provide new technological resources such as AI, legislatures are contemplating our rights to access existing resources, most notably marijuana.

As more states continue to legalize medical and recreational marijuana in the US, questions have arisen about the role of patents and trademarks in the industry. Iancu cites a 20 to 40% year-on-year filing growth of cannabis-related patents since 2015.



“There are no special statutory requirements or restrictions applied to patents directed to marijuana. Additionally, there are no exceptions for medical use of marijuana,” Iancu says.

Although marijuana patents are treated the same as other applications, trademarks are different; because marijuana is illegal federally, federal applications for marijuana-related trademarks are currently ineligible, Iancu explains.

Still, recent legislation could be relevant for some cannabis-related products.

Iancu highlights the 2018 Farm Bill, which said that “hemp” (defined as cannabis containing less than 0.3% THC) was no longer subject to regulation under the Controlled Substances Act. Because of this, certain products directed to “hemp” could be eligible for federal trademark protection, though this is not guaranteed.

“We still have to look at whether the application raises legality issues under the Food, Drug and Cosmetic Act for cannabis goods that are foods and beverages, and also at the 2018 Farm Bill for certain cannabis-related services,” Iancu says.

In May 2019, the USPTO issued guidance called “Examination of Marks for Cannabis and Cannabis-Related Goods and Services after Enactment of the 2018 Farm Bill.”

## Diversity and patents

As changes in legislation and technology raise questions about how lawyers practice IP law, growing social awareness sparks questions about who is practicing IP law.

Encouraging more diversity in inventorship and the IP profession itself is a priority for the USPTO, according to Iancu. “There is untapped potential in the community, and the USPTO wants to do everything possible to encourage diversity in innovation, create equal opportunities for every inventor, and ensure that all voices are heard,” Iancu says. “We must advance the national dialogue around this issue and drive real change.”



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# Things to do in Washington, DC



## CULTURAL ACTIVITIES

**The National Mall** is arguably one of the most recognized public spaces in the world. Martin Luther King Jr. issued his famous “I Have a Dream” speech from the steps of the Lincoln Memorial, and the Mall is an assembly point of public protest dating back to the Vietnam War. The east end of the Mall is surrounded by the National Smithsonian museums, each one celebrating a different aspect of American science and history.

**The National Air and Space Museum** has a temporary exhibit running until the end of the year featuring items from the Apollo 11 moon landing. The space ice cream from the gift shop makes an excellent souvenir that fits neatly into a suitcase.

**The Newseum** can be found along Pennsylvania Avenue – also home to the White House. Exhibits include *Seriously Funny*, which focuses on the lasting impact that *The Daily*

*Show with Jon Stewart* had on politics and campaigning. There is also a special show room of each Pulitzer Prize winning photo dating back to 1940.

**The International Spy Museum** is great for every fan of James Bond and John le Carré. Permanent exhibits include Tools of the Trade where visitors can learn how spies have used gadgets and disguises to deceive their adversaries. The museum also boasts the ice pick used to kill Leon Trotsky in 1940 in Mexico.

**The Kennedy Center for the Performing Arts** is situated on the banks of the Potomac River and is the best place in the city to catch an opera, ballet or symphony. The Millennium Stage has free concerts every evening at 6:00 pm. For the best terrace view of the city, check out the Roof Terrace Restaurant.



## PLACES TO EAT

**Busboys and Poets** is a restaurant and bookstore chain named for poet laureate Langston Hughes, who worked as a busboy at the Wardman Park Hotel in the 1920s. The restaurant first opened on 14th Street and was a meeting point for social activists. Now with seven locations across the city, the restaurant/bookstore makes for a great social gathering point for those interested in reading good poetry while eating good food.

**Kramerbooks and Afterwards** is Dupont Circle’s most famous bookstore and café. Celebrities and politicians are known to frequent the café’s terrace during evening hours, and there is a space upstairs for live concerts on weekends. The bookstore/café is recognizable enough that if you are caught reading with one of the store’s famous bookmarks you are likely to get favorable sideways glances from fellow travellers on public transportation around the world. The apple crumb pie is the best thing on their dessert menu.

**Zenebech** was voted the best Ethiopian restaurant in DC by the *Washington Post Magazine*. Diners eat with their hands by scooping up portions of vegetables and meat dishes using injera, an Ethiopian flatbread. The vegetarian platter is more than enough for two.

**La Chaumiere** in Georgetown is the perfect candle-lit restaurant for marriage proposals (or even deal-making with shady foreign agents!). The tables are crammed tightly against one another, requiring the French waiters to perform acrobatic feats between the chairs to get the dishes safely from kitchen to table. The cassoulet is so good that diners can imagine a French grandmother spent a whole week making it.

**Hawk N’ Dove** behind the Capitol Building is a great place to spot Senators and staffers at happy hour. Named after the two opposing sides of the Vietnam War, the bar is a welcome spot for political debate for those who find themselves anywhere on the political spectrum.



## SHELDON KLEIN

*Continued from pg1*

“We’ve done a pretty good job in our leadership; we always need to do better in our membership,” Klein reflects.

He adds that AIPLA is one of the founders of the American Intellectual Property Law Education Foundation, which provides scholarships to students from minority backgrounds to go to law school.

“The profession has to do more, but that is a real [goal] for us to promote diversity and to have all types of diversity on our Board,” he says.

### A smooth transition

Klein says he has been working closely with Fiacco to ensure a smooth transition between their presidencies. He says that since the presidential terms are only one year, it’s important to have continuity.

“We all have our own priorities, but we have to be on the same page in terms of where we think the organization should go. Otherwise it’s just going to zig and zag.”

Klein says that the length of the presidential term is sometimes a surprise to presidents of other associations who serve two or three years. Still, he adds that given the number of responsibilities that the President has, and the fact that the President still works at his or her full time job, the one-year term makes sense.

“Most of us are not able to devote this type of intensity for more than one year and still expect our law firms to take us back.”

### A more modern space

Klein says that the Gaylord National Resort & Convention Center is an optimal location for the Annual Meeting.

“We’re really excited about our new space; it’s more modern and user-friendly. It’s going to make for a much more pleasant meeting. I’m hoping [people] will be excited about being there and about hopefully coming back the year after.”

Klein says that the space this year better allows attendees and exhibitors to interact with one another.

“In our former space we had the exhibitors downstairs where the registration desks were, which forced people to go where there weren’t any sessions going on. This year the exhibits are all going to be up on the floors where the meetings are.”

He adds that AIPLA has built in breaks between each session that are at least 15 minutes and included half hour breaks throughout the day to enhance networking opportunities.

“In the past we have been tightly scheduled and at this meeting our hope is to be a little bit more relaxed and allow people to have the time to connect with each other.”

This morning, Klein will be conducting a “fireside chat” with USPTO Director Andrei Iancu which he is especially excited for. Additionally, he looks forward to seeing familiar faces.

“The highlight is always spending time with my friends and colleagues from all over the world.”

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# Navigating the Russian patent enforcement landscape

**Sergey Vasiliev** of **Goroditsky & Partners** analyzes the various aspects of patent disputes, including evidence collection, preliminary injunctions and the doctrine of equivalents.

**E**nforcement of IP rights in foreign jurisdictions is often a challenge. Different legal systems provide different legal tools and remedies. The goal of this article is to shed some practical light on patent enforcement and litigation practices in Russia.

To deliver the subject in a comfortable and reader-friendly manner, we have considered the enforcement proceedings from the very beginning and then studied the main stages through which patent disputes normally pass.

## Collecting evidence

The concept of pre-trial discovery (US style) or initial disclosure (UK style) is not available in Russia. The burden of proof lies solely with the claimant. Therefore the main task of the claimant is to collect and produce the evidence otherwise the case could be dismissed due to lack of admissible, true and sufficient evidence.

There is only one exception which becomes available once the case reaches court. The litigant may ask the court to force the other party to submit certain evidence. Prior to filing this motion, the litigant should make all possible effort to access the evidence himself. It is, however, at the court's discretion to decide whether to satisfy such a motion.

There are a few standard ways to collect evidence of infringement. They are test purchase, detective investigation, and notarization.

Test purchase is a very common practice. Normally, it is a solid piece of evidence, such as an infringing product and a number of supporting documents (sales agreement, invoice, specification, manual, etc.).

A professional investigator can be used when the defendant's activity is hidden. His report is another good piece of evidence.

Notarial services are very helpful to certify evidence of the infringement, which could be removed or modified by the adversary to impede enforcement. For example, the infringer may remove the relevant data from the website. Notarization of the screenshots, as well as other evidence, may significantly support the claim.

## Pre-trial notices

Cease and desist letters are part of an enforcement strategy. In this case, the patentee voluntarily sends a warning letter to the opposing party.

The other reason to commence an action with a C&D letter is the legal requirement. Prior to launching a court action, the claimant should approach the adversary with a pre-trial notice if he intends to bring a claim for damages. If, however, damages are not part of the claim, the claimant does not have to send the pretrial notice before commencing a court action.

## Submissions

The submissions to the court must clearly show who, how, where and for how long the

patent rights have been violated. All the details of the possible infringement must be supported with proper documents (sales contracts, invoices, customs declarations, detective reports, etc.), otherwise the claim will be considered as merely an allegation on the part of the claimant. The submissions shall show the court what the defendant is doing (manufacturing, importing, storing, distributing) and whether the possibly infringing product or method contains all the features of the independent claim of the invention. In order to support findings on use of the invention, the patent expert report should be submitted along with other pieces of evidence.

Documents, audiovisual files, photos, specimens, parties' explanations, witness testimonies, notary protocols and expert opinions may be presented to support the claims. Evidence obtained during administrative or criminal proceedings, if relevant, can also be disclosed.

All pieces of evidence shall have equal power and priority and be uniformly considered and weighed up by the court. However, the expert report is commonly treated as a key piece of evidence to decide on use of the patent.

## "Patent infringement disputes are commenced and heard by courts, while patent invalidity actions are brought in front of the RUPTO."

### Who can sue?

Normally patent owners act as plaintiffs in patent infringement cases. If the asserted patent is co-owned, each patent owner may individually take action to enforce patent rights. Exclusive licensees shall have the same remedies as the patent holder if their rights are affected. Non-exclusive licensees and distributors do not have the right to sue, but they can participate in patent infringement cases as third parties.

### Preliminary injunctions

Usually the courts are reluctant to grant preliminary injunctions (PI) in patent disputes. The reason is that patent disputes concern technical questions and thus the court cannot easily weigh up the potential use of the invention in the disputed product, contrary to trademark or copyright related disputes where similarity can be seen and assessed by the judge from the perspective of ordinary consumers at the very beginning of the dispute.

A motion for PI is considered by the court without hearing the parties and therefore it is crucial to submit a clear-cut and

well-grounded motion supported by *prima facie* evidence.

### Structure of the court proceedings

**Preliminary hearings** – Within the framework of preliminary hearings, the court resolves a number of procedural issues, such as the necessity to appoint an expert, evidence collection, engagement of third parties, checking the legal status of the parties, etc.

**Hearings on the merits** – After the preliminary hearings are completed, the court moves to hearings on the merits. The defendant is obliged to provide the statement of defence in advance, otherwise, implications related to abuse of rights are possible. Litigants are welcome to file additional motions and pleadings.

Independent court expertise is normally one of the key stages of the litigation. Once the patent expert is assigned by the court, the case is postponed for a few months. The consideration shall be resumed as soon as the expert's report is prepared and submitted to the court files. The court examines the expert report and the evidence submitted by the parties and moves to oral pleading where the parties present their legal position. During the pleading, evidence examination may be resumed. Upon completion of evidence examination and oral pleadings, the court issues a judgment.

Normally the patent infringement case is heard by the commercial courts of first instance. Further, the judgement can be contested in the courts of appeals. The IP Court supervises the inferior courts and considers patent disputes at the level of cassation. At the same time, the IP Court may be a court of first instance for disputes related to acquisition, cancellation and invalidation of patent rights, including challenging of decisions of the RUPTO in cases heard at the Chamber of Patent Disputes (e.g. the decisions of RUPTO on invalidity actions).

### Bifurcation

The Russian patent litigation system is bifurcated, meaning that patent infringement disputes are commenced and heard by courts, while patent invalidity actions are brought in front of the RUPTO.

A patent infringement matter may remain on hold pending the outcome of a patent invalidity matter. If the motion for suspension of court proceedings is not satisfied by the court, and the patent infringement matter is resolved, it may be re-considered following the result of the patent invalidity matter in the future.

### Litigation and patent invalidation

Invalidation of the patent-in-suit is a ground for termination of the court proceedings. If, however, the patent is invalidated in part, the situation could be different. Now it is more common for the courts to continue litigation based on the



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Sergey is a senior lawyer working in the Moscow office of the law firm Goroditsky & Partners.

Sergey litigates IP rights and fights unlawful/unauthorized use of IP as well as illegal content on the Internet. He handles matters connected to unfair competition and false advertising, parallel imports and grey market goods, counterfeits and piracy. He represents the interests of clients in court and before law enforcement agencies on various infringement issues. Sergey participates in extra-judicial as well as judicial dispute resolution actions, civil procedures, administrative and criminal proceedings.

Sergey deals with various types of IP, including copyright and related rights, software and databases, patents and designs, trademarks, brands and domain names. He also deals with know-how and confidential information, as well as privacy and data protection.

Sergey provides legal support to clients in connection with different transactions related to disposal and conveyance of IP/IT assets. He is regularly in charge of developing, reviewing, negotiating and perfecting (registering) licensing agreements, franchising contracts, security interests and other arrangements. Sergey is also involved in heavyweight M&A, joint venture and investment projects, IP legal due diligence and IP transfer processes.

Sergey delivers speeches at seminars and conferences. He is the author of a number of articles and works published by leading Russian and international publishing houses. He is a member of the Licensing Executives Society International (LESI).

newly issued patent although, as it is a procedural question, the judge should decide whether to continue or terminate the proceedings.

#### Court expertise/expert report

Examination of the product-in-suit and the claim interpretation always concerns a number of technical questions, requiring special terms and sentences to be construed. Even if the judge is a person skilled in the art, he must decide from the perspective of the law and shall not take on responsibility for technical matters. Therefore, normally, the judge invites parties to suggest candidates to be appointed as an independent expert. Experts are proposed by litigants and chosen by judges. After the submission of an opinion, experts may be called to the court hearing and must answer questions from judges and litigants. If the expert opinion is insufficient or inconsistent, the court can appoint additional experts.

#### Doctrine of equivalents

The doctrine of equivalents is quite often applied in patent litigation. A feature will be considered equivalent if it gives the same result as the patented feature in the independent claim.

No doctrine of equivalents shall apply to the use of industrial designs and utility models.

#### File-wrapper estoppel

Russian regulations do not make any direct reference to the rule of estoppel, although abuse of rights is prohibited by federal law.

Case studies show that judges are quite familiar with and apply the rule of estoppel. In the context of patent litigation, the rule of estoppel is understood as meanings and limitations provided by the applicant with regard to a pending patent at the examination stage at the RUPTO. These should be taken into account by the courts and experts when construing the claims and applying the doctrine of equivalents.

#### Direct and contributory infringement

The law and practices recognize both direct infringement and preparatory activities that create a threat of infringement, although it is more common to prosecute standard (direct) cases of infringement.

#### Confidential information

Generally, court proceedings are open to the public in Russia. Once adopted the rulings of

the courts are published in a special electronic court database. Confidential court proceedings may be conducted when a dispute concerns state secrets or other confidential information.

#### Timing

In contrast to other jurisdictions, patent litigation is very quick in Russia. In practice, the court schedules preliminary hearings one or two months after filing a lawsuit. The hearing on merits will be scheduled one month right after the preliminary hearing, if there are no 'international notification' issues.

The judgment of the first instance court may be issued by the court within six to eight months, if the case develops smoothly and the case is not suspended due to a patent invalidity action. If the judgment is subsequently appealed, the duration of the patent infringement case may be up to 15-18 months in total.

#### Cost reimbursement

Attorney fees are recoverable within reasonable limits and at the discretion of judges. If the claim is granted in part, the defendant covers the claimant's costs proportionally. If

there is a settlement agreement, the parties may reach an agreement on the amount of costs to be recovered, or state that each party bears its own costs. Services of third party experts, specialists, witnesses and translators are also reimbursed.

#### Enforcement of decisions

Enforcement of court decisions for all types of claims (both monetary and non-monetary) can be enforced with a bailiff service. Alternatively, judgments relating to monetary claims can be enforced by the bank where the debtor has an account. If the claimant does not have any information on the accounts of the debtor, it can submit an inquiry to the Federal Tax Service, which can disclose this information after the debt is confirmed by the court.

Being a party to the most vital international IP treaties and conventions, Russia has adopted a set of IP principles and implemented institutions widely used in the global arena. Therefore IP holders and their attorneys can feel safe and well equipped with the efficient tools and remedies available to enforce IP rights.

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TODAY'S SCHEDULE

THURSDAY, OCTOBER 24, 2019

COMMITTEE MEETINGS	
7:00 AM – 8:45 AM	Corporate Practice Committee Breakfast (Corporate in-house counsel only) National Harbor 12-13
7:45 AM – 8:45 AM	Alternative Dispute Resolution Chesapeake D
7:45 AM – 8:45 AM	Global Sector IP Leadership Group (Committee Members Only) Chesapeake G
7:45 AM – 8:45 AM	Patentable Subject Matter Task Force (Committee Members Only) Chesapeake J
7:45 AM – 8:45 AM	Professional Programs Chesapeake A & B
OPENING PLENARY SESSION	
9:00 AM – 10:00 AM	Opening Plenary Session Maryland Ballroom AC, 1-3
CONCURRENT MORNING TRACKS	
10:15 AM - 12:00 PM	Track 1 - Patent Prosecution Maryland Ballroom BD, 4-6
10:15 AM - 12:00 PM	Track 2 - Patent Litigation Cherry Blossom Ballroom
10:15 AM - 12:00 PM	Track 3 - Trademark Trial and Appeal Board Live Hearing (TTAB) Woodrow Wilson BCD
SPOUSE/GUEST TOUR	
11:15 AM - 4:35 PM	Spouse/Guest Tour Meet at Maryland Bus Loop at 11:00 AM for an 11:15 AM departure
LUNCHTIME EVENTS	
12:00 PM – 12:30 PM	Lunch Reception Maryland Ballroom AC Lobby & 1-6 Foyer
12:30 PM – 2:00 PM	Luncheon - Why Uncomfortable Feels Good in the End: Stretching for Diversity Maryland Ballroom AC, 1-3
BOARD OF DIRECTORS MEETING	
2:15 PM – 3:45 PM	Board of Directors Meeting (Board Members Only) Potomac Ballroom C
CONCURRENT AFTERNOON TRACKS	
2:15 PM – 3:45 PM	The State of Design Rights – Fall 2019 Maryland Ballroom BD, 4-6
2:15 PM – 3:45 PM	Driving the Future of IP: How Driverless Vehicles Are Driving New Trends in IP Protection Cherry Blossom Ballroom
2:15 PM - 3:45 PM	Public Policy, Patent Law and the Changing Life Sciences Landscape Woodrow Wilson BCD

COMMITTEE EDUCATIONAL SESSIONS	
3:55 PM – 4:55 PM	ANTITRUST/IP IN CHINA/IP IN EUROPE (JOINT SESSION) Woodrow Wilson BCD
COMMITTEE MEETINGS	
3:55 PM - 4:55 PM	Biotechnology (Networking Event to Follow Meeting) Chesapeake C
3:55 PM - 4:55 PM	Committee on Legislation (Committee Members Only) Chesapeake G
3:55 PM - 4:55 PM	Online Programs National Harbor 12
3:55 PM - 4:55 PM	Patent Cooperation Treaty Issues Chesapeake B
3:55 PM – 4:55 PM	Patent Law Chesapeake E&F
3:55 PM – 4:55 PM	Special Committee on Education (Committee Members Only) Chesapeake A
3:55 PM – 4:55 PM	Special Committee Pro Bono Chesapeake J
3:55 PM - 5:30 PM	Mentoring (Speed Networking and Reception) Chesapeake D
3:55 PM - 6:00 PM	American Intellectual Property Law Education Foundation (Foundation Trustees Only) Azeala 1
3:55 PM - 6:00 PM	International and Foreign Law, IP Practice in China, IP Practice in Israel Chesapeake H&I
5:00 PM - 6:00 PM	Harmonization (Committee Members Only) National Harbor 12
5:00 PM - 6:00 PM	International Trade Commission Chesapeake A
5:00 PM – 6:00 PM	IP Practice in Latin America Chesapeake G
5:00 PM – 6:00 PM	Law Practice Management Chesapeake E&F
5:00 PM – 6:00 PM	Law Students Chesapeake J
5:00 PM – 6:00 PM	Special Committee on Privacy & Data Security Chesapeake B
EVENING EVENTS	
6:00 PM – 7:00 PM	New Member/First Time Attendee Reception Eastern Shore 1-3
6:30 PM – 7:30 PM	Diversity Reception National Harbor 2-3
7:30 PM – 9:00 PM	Opening Night Reception “Garden Party” Maryland Ballroom AC, 1-3

We don't just practice Mexican Law. We help shape it.

In an uncertain legal environment, we are one law firm that is not content simply to accept the status quo. We work constantly to influence the evolving body of Mexico’s intellectual property laws, with the goal of ultimately bringing them in line with international standards. While we continue to make great strides in this regard, clients from all over the world rely on us to prosecute, manage, and defend their IP portfolios under the laws that exist today. In other words, we work effectively within the system, even as we seek to change it.



PATENTS | TRADEMARKS | COPYRIGHTS | IP LITIGATION, CIVIL AND COMMERCIAL LITIGATION, ALTERNATIVE DISPUTE RESOLUTION | ANTI-PIRACY, ANTI-COUNTERFEITING & ENFORCEMENT | CORPORATE AND COMMERCIAL LAW | LICENCING TECH TRANSFER | FRANCHISING | ADMINISTRATIVE LAW | REGULATORY LAW