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Being kind key to client relationships

Current and former corporate attorneys revealed how private practice lawyers can better cater their services to in-house counsel and potential clients, in the “Know Thy Client: Practical Tips for Strengthening the Outside/Inside Counsel Relationship” session yesterday.

Top tips included avoiding the ‘bait-and-switch’ approach during pitches, ensuring that the team presented is diverse, and being honest when it comes to matters of cost. But perhaps the most important pointer was for external counsel to show empathy and be kind to clients.

“For me, having a person who cares about me and my business is extremely important,” said Robert DeBerardine, Chief IP Counsel at Johnson & Johnson. “It is about finding someone who is willing to do the hard work and is the kind of person who works well with others, and is not as concerned with themselves as making their clients successful.”

He added that private practice counsel should take the time to find out more about their clients and work around them. If they have budgetary constraints, for example, lawyers should work to accommodate those into their strategies and not draw matters out because they are expected to bill a certain number of hours.

Panel moderator Jessica Ergmann, IP Director at Arctic Fox, agreed that empathy is an important factor when it comes to



choosing to hire and keep external counsel, and added that likeability goes hand in hand with that attribute. She noted that it was important for her that she could “sit at the bar and have chit chat” with any lawyer she worked with.

Marc Adler, Of Counsel at Buchanan Ingersoll & Rooney and former Chief IP Counsel at chemicals company Rohm and Haas, said building personal relationships is important to in-house counsel.

“The people I picked were those I liked and had a good rapport with,” he said. “I could get an answer to a question quickly and

without worrying about being on the clock. They were the people who would give me information that I had not even asked for, and people I liked personally.”

Another important piece of advice panelists gave to the audience was to never go into a pitch with a team that ultimately would not be working on any cases for the businesses they were pitching to. DeBerardine said using that bait-and-switch approach might be the worst thing that a law firm could do.

“The team that will be working on your matters is one of the most important things to you as an in-house lawyer,” he said. “You

should bring a talented team to the pitch, but it should be the team that will be working on the new client’s cases.”

Making sure teams are diverse was another important point for panelists. Ergmann shared an anecdote of a time when a law firm brought eight white men to a pitch. When these lawyers were quizzed on their attitude to diversity and inclusion, their response was underwhelming.

Responding to a question from the audience, Ergmann noted that she understood that it can be difficult to find female talent in the field of IP, but added that she would rather hear an acknowledgment of that difficulty from potential external partners.

“I once had a firm pitch that similarly did not have any women in the team but who admitted that they found it hard to find female talent, and that was a very good response.”

The panelists also said that in-house want external counsel to prove their worth by doing a great job on their first project. Adler said it was a shame that some law firms got over the various likeability and diversity hurdles only to stumble at the point of drafting a good patent application.

“The first project is critical because if you start on the wrong footing, it may be your last. I don’t want to see a patent that looks like it was written by five different people and stitched together.”

USPTO Attorneys advise on TM use best practices

Imagine that you run a coffee business. You have a trademark that you use seasonally – for your ‘Pump Up the Spice’ pumpkin latte. You get a reminder from your attorney to file a declaration of use for said latte. But it’s December 15. The fall season is now over and you won’t use the mark again until September next year. Is it permissible to file a declaration of use at this time?

This was the question that Gabrielle Roth, Washington, DC-based Partner at Sughrue Mion, posed to a panel of USPTO Attorneys during the “USPTO Trademark Tips and Best Practices” session. The panelists were Nicholas Coleman and Robert Lavache, with Roth moderating.

According to Lavache, the answer to the question is yes. “What you’re attesting to is that the mark was used within the one-year period before the end of the six-year or 10-year period. You can claim use because you just used it in October. You’re not claiming you used it every day. It should be fine.”

The panel noted that the Office has seen an increase in false specimens, or specimens that are not actually used in goods and services. The panelists ran through several “tip-offs for refusal,” or characteristics of specimens that could raise flags for the examiner and make it more likely that a mark would be refused.

The panelists said that a photograph with a white background could cause issues.



Roth asked the panel why a white background would raise a red flag. “I have clients who tell me that oftentimes they

have professional photos of a product. The photographer often likes to have it on a white background. When I get these images, I always make sure I ask, ‘Is this an actual photograph or a digital rendering?’. But is that likely to be questioned?”

Coleman said that many stock photos exist on white backgrounds, so a white background could lead the examining attorney to question if an applicant had merely taken a photo from the Internet and changed it online.

“It’s not so much the white background, but when you put it on a white background and take away all of the context, it makes it more difficult to determine if it’s an actual

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General Mills patent agent on the 'oldest art on the planet'

“Food is probably the oldest art on the planet; we’ve been making and eating food since we’ve existed as a species. There is a lot of art out there on food and one of the challenges for us is dealing with prior art rejections,” says Rachel Kahler, patent agent at food company General Mills in Minneapolis.

She adds that some patent examiners lack understanding of what commercial food production entails.

“I see a lot of art that probably isn’t relevant to commercial food production. So there’s a process of educating the examiners on what the prior art is really relevant to and differentiating what we do as a large food company versus what happens in kitchens and on blogs, and also on a very basic level on what ingredients are and what they do.”

Prior art considerations came up in *Hel-sinn v Teva*, a Supreme Court decision in January 2019, which ruled that confidential sales of inventions that are not yet patented can qualify as prior art.

Kahler says her company often provides sale samples to potential customers, such as grocery stores, and discusses the concepts for new products with these customers.

“We have to be mindful of what constitutes a sale,” she says. “Has the product been devel-



oped sufficiently so that we can and should file a patent application, and are these discussions offers for sale?”

A career with perks

Prior art and other patent matters present their challenges, but Kahler says she’s in a good position to address them.

“Being in-house definitely has its perks,” Kahler says.

Kahler worked at law firms before joining General Mills. While she’s enjoyed both, she says she’s come to appreciate her in-house career.

“A huge benefit of being in-house is having direct access to your inventors. You can call them up or email them; you have the same employer, so you don’t need permission. It frees you to be able to get the information you need at a lot of different levels.”

She adds that it’s helpful to have access to inventors, not only at the patent prosecution stage but earlier when they are doing research, so she can help train them on patent issues and influence how they do research to support patent prosecution.

“[Being in-house requires understanding] the potential risk of disclosure before drafting. Our innovators, just like a lot of innovators at other companies, want to publish their work in some way. They also like to go to industry conferences to present their work, and they want to work with partner companies to further develop their work.”

Kahler says that part of finding a balance between allowing inventors to disclose their work and protecting the company’s IP is “knowing what to let go.”

“Not every innovation is necessarily going to provide value as a patented innovation,” she explains.

She adds that building relationships with inventors and others at her company has helped maximize her ability to protect its IP.

How to hire

While forming relationships with inventors is key to protecting IP, relationships with outside counsel are also important for General Mills.

Kahler says that General Mills uses outside counsel for issues that are specialist and high impact and for those that are relatively less complex and have a more moderate impact on the company.

“For more specialist counsel we are looking for absolute expertise on the technology,” Kahler says.

Private practice lawyers who advise General Mills on moderate-impact issues often do a lot of drafting and prosecution and should become well-versed in the technologies that General Mills uses regularly, according to Kahler.

“Cost is part of the issue, but more important is that they have a relationship with us, they are willing to pick up the phone, they’re reliable, they will ask business questions and, because we use them a lot, these business questions are insightful,” Kahler says.

Kahler adds that General Mills likes to hire local counsel, since this allows the lawyers to meet inventors face-to-face without arranging travel.

“We want them to connect to our inventors as much as possible,” she concludes.

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USPTO ATTORNEYS

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photograph of an actual product or if it’s been digitally created to add marks,” said Coleman. He said that while a white background would not necessarily mean that a mark would be automatically refused, it did make it more likely that the examining attorney would have to look further into whether it was legitimate.

Lavache emphasized the importance of attorneys doing their due diligence.

“The key to it is to make sure what you’re signing, what you’re submitting, what you’re claiming is actually true. You need to make sure that for everything you’re claiming, the mark has been used and is in use in commerce. Check your list of your goods and services. Have a conversation with the owner and educate them about what use in commerce means and actually look at the records. It can’t be just, ‘Are you using it?’ ‘Yep.’ ‘Okay that’s good enough for me.’”



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How to protect and enforce trade secrets

Drafting enforceable employee agreements, maintaining cybersecurity processes and keeping juries interested during court cases are important components of a comprehensive trade secrets strategy, according to in-house and private practice attorneys.

Panelists at yesterday's "Winning Strategies and Practical Tips for Trade Secrets Litigation and Agreements" pointed out that protecting and enforcing confidential information is becoming more important in an increasingly tech and data-driven world.

Seyfarth Shaw Partner Dan Hart said that the first step businesses should take to protect their secrets is to set out what employees can and cannot do with regards to confidential information and setting up competing ventures after leaving the business.

He added that attorneys should be wary, however, to take account of federal and state laws that might restrict the kinds of provisions that can go into an employee agreement. "You want to draft an agreement in such a way that it adequately protects your information without unintentionally violating laws," he said.

For example, laws have been introduced in some states since the #MeToo movement to ensure that staff cannot be restricted from reporting matters of discrimination or sexual harassment. Shaw pointed out that even seemingly basic provisions surrounding re-



strictions on divulging information might be seen to violate these rules.

He added that it can also be tricky to navigate state law when it comes to non-compete provisions. In Idaho, for example, non-compete covenants can only apply to key employees or independent contractors, and employees in Illinois must make more than \$13 per hour for such provisions to apply to them.

Scott Allison, Chief IP Counsel at Delos, went on to advise attendees to be careful when crossing US borders while carrying sensitive and confidential information on laptops, smartphones or other devices. Border Patrol, he explained, can conduct warrantless searches without reasonable

grounds of suspicion and can confiscate belongings. They are also allowed to take data from those belongings, which they can share with other government agencies.

He advised audience members to take heed of this risk and prepare for travel over US land or sea borders by removing sensitive and confidential information from devices.

"You can claim journalistic or attorney client privilege, and that will raise a red flag that the patrol will hopefully respond to by consulting senior officials. But the result of that may be that your device is detained, and it could be kept for a number of months.

"The best thing to do then is simply delete all that data. That is a pain because we all want to be productive when we travel and

we want to access that information remotely. But doing that will ultimately help you."

He added that some precautions he takes as a corporate attorney are to turn off access to the internet on all his devices. Border Patrol are not allowed to connect one's devices to external devices or sources of information, he explained.

Another tip he gave was to constantly delete emails and other such sources of information in a way that they are no longer retrievable from devices.

Allison noted that attorneys should not argue with Border Patrol if they are approached, and should be careful not to say anything that might be interpreted as consent to search. "Be very clear with them," he said. "Do not say harsh things, but do take those precautions. And remember, if you do not mention that you are bound by client attorney privilege, that provision does not apply automatically and it cannot be applied retroactively."

Lynn Pinker Cox & Hurst Partner Trey Cox revealed some tips for how to keep a jury engaged with arguments during a trade secrets case. If attorneys want to use PowerPoint slides, he said, they should limit themselves to six words per slide and use large and captivating images.

By doing that, attorneys can ensure that jurors process information on slides quickly and are better able to concentrate on the points that litigators are making.



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Canada, China, Clarice, and more

In the last five years and in particular in the last year, Canada has reformed virtually all of its IP legislation,” said Brian Daley, a Partner at Norton Rose Fulbright Canada.

He was speaking on the topic of “Oh, Canada!!! Getting Out in Front of Canada’s Soon-To-Be-Implemented Patent, Trademark, and Design Law Changes” at yesterday’s panel “Managing Your Global IP Portfolio.”

Daley explained that the changes have affected patents, trademarks and design rights. In the trademark arena, he said that Canada has implemented the Madrid Protocol.

Daley added that a declaration of use no longer needs to be stated when registering for trademark protection.

“This allowed a number of trademark trolls to file applications which may impede the rights of certain trademark owners in Canada. We’re trying to see how that’s going to play out.”

Alison Frey, a Texas-based Partner at Dickinson Wright, spoke on “Winning Strategies for Clearing Global Trademarks – Assessing and Protecting Your Mark in Markets Around the World.”

She said that US lawyers and those looking to register their goods and services abroad should make use of local counsel.

“For the preliminary search phase, it’s fine to click on boxes for the countries that you want to search and run that through the search engine, but if you’re doing full search, there’s no substitute for using local counsel given their knowledge of local practice and local laws,” Frey said. “It can



be really difficult for a US practitioner to substitute their own judgement for that local counsel.”

As an example, she mentioned that China’s use of sub-classes could be hard for a US attorney to navigate.

“Local counsel may see a path forward that we wouldn’t, just because of their more

“For each and every jurisdiction that the applicant potentially cares about, you need to know what they offer and what their limitations are.”

intimate knowledge of cultural considerations and local practice and information which they may have available to them that we don’t,” Frey said.

Robert Katz, a Washington, DC-based Attorney at Banner & Witcoff, spoke on “Strengthening Your International Design Application – Drafting Your Design Patent Application to Ensure You Cover as Many Jurisdictions as Possible.”

Katz said that he has coined names for two tests that he applies to design rights: the MAD test and the WWID test.

The MAD test deals with whether someone would be “commercially mad” or would seek legal action against a company that infringed a particular portion of their design.

The WWID test, or ‘What Would Infringer Do,’ focuses on thinking like infringers. To illustrate his point, Katz pulled an example from *The Silence of the Lambs*.

“There’s this discussion between Hannibal Lecter and Clarice, who’s the FBI detective, and they’re trying to catch a serial killer. They’re not doing judicial detective techniques; they’re trying to think like a serial killer. And that analysis is the [WWID test].”

He explained that many infringers will not copy a design exactly but will copy most of it, and that applying the test can allow a lawyer to consider how a design could be infringed before it happens.

Katz noted that while design protection seems inexpensive compared to having utility patents, the costs can add up. He said this was especially true for independent investors and smaller companies, but that larger companies also have budgets.

Katz said because of the cost of protection, it’s often not possible for a company to seek protection in every country they want protection in or for every aspect of a design that they want to protect, so they have to consider which aspects and countries are most important.

“You really need to know, [for] every jurisdiction that you care about, what the laws are, different intangibles about enforcement, the market, the costs, and what statutory subject matter is permitted,” he said.

“For each and every jurisdiction that the applicant potentially cares about, you need to know what they offer and what their limitations are. Hopefully you know about all those aspects in your home country, but the fact is you need to know about all those aspects in each country that is being considered because, without that, you really can’t get that bang for the buck.”

Ethics and self-employment take center stage

Iwould strongly urge no one ever to do both. If you have an enemy from law school, urge them to do both,” said David McGowan, Professor of Competition and Innovation Law at the University of San Diego School of Law, during a panel yesterday. The panel was called “Lawyers Behaving Badly: Avoiding Messy Transitions and Complying with Your Ethical Obligations.”

He was speaking on a hypothetical scenario posed by Georgann Grunebach, of The Law Offices of Georgann S. Grunebach, where a patent attorney was offered equity in an inventor’s “newly formed company” in exchange for doing patent prosecution work for him.

McGowan said that while one can take equity in a patent, a lawyer in this scenario would need to decide if they were representing the company, the inventor, or both. Representing both, according to McGowan, is a bad idea.

Grunebach focused her own presentation, called “So, You Want to Start Your Own Firm,” on some of the issues and ethical dilemmas that come up when starting a practice.

“I tell my family, ‘when you see me talking to myself, I’m actually having a staff meeting,’” she joked.

She noted that self-assessment was key when starting one’s own firm. She said it is important to know your skill level, both at law and at non-legal administrative tasks like IT and accounting.

“I worked in-house for 35 years and all I did was practice in-house, which gave me a very protected approach to my practice. If I had an issue with my computer I called IT. If I had an issue with expenses, I had someone who could answer that question for me. When you’re a business owner you don’t have that fallback.”

Grunebach referenced advice that a friend gave her which was: “Don’t do it unless you’ve got your first year’s income already in the bank.”

As she explained: “You don’t want the pressure of figuring out where the next dollar’s coming from which may cause you to make choices that are shortsighted.”

She also noted that lawyers need to consider how their workspace is set up. Many solo practitioners are tempted to work from



home, but offices need to be set up in a way that supports confidentiality.

Grunebach said that since she’s admitted to practice in both California and Pennsylvania, she reached out to ethics counsel at both Bars when forming her firm to get advice on situations she was entering into.

Panelists also discussed how regulations can vary from state to state, and that it was important to be aware of the obligations and limitations that come with practicing in each state.

Grunebach said that when she relocated from California to Nevada, she reached

out to the Nevada Bar Association to see if there would be an issue with her representing California-based clients on California matters exclusively and not representing anyone in Nevada or practicing in Nevada courts.

“The response was very interesting. The Nevada ethics counselor said, ‘We have two main incomes that allow us to have a state that has no state income tax. It’s called entertainment and conventions. It would be very difficult for us to tell attorneys they can no longer answer questions from their clients

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Top tips for business best practice in IP

One of the last sessions on Friday focused on how businesses can navigate the IP landscape, particularly when it comes to matters such as employment agreements, branding and incentivizing staff to get on board with the company's patent strategy.

Christian LaForgia, Attorney at Banner & Witcoff and former IP Counsel at Wickr, kicked off the talk by explaining the importance of getting buy-in for an IP strategy from the company's C-suite executives, including the chief financial officer (CFO) and the chief technology officer (CTO).

He pointed out that while obtaining patents for lucrative inventions is vital, those rights do not generate an immediate return on investment, and the CFO should be made aware of that fact. Similarly, the CTO oversees product development and should be brought on board.

LaForgia went on to explain that it is also crucial to get buy-in from engineers and developers, and how that can sometimes prove to be difficult.

"I've encountered developers who feel strongly about patents one way or another," he said. "You get some developers who just don't want to patent anything and think that code should be put onto the open source space."

LaForgia added that it is important to explain to them why that situation does not always work. "We wouldn't ask you to write code for free for us, we explain, so why should we give away our code for free?"

LaForgia also noted that companies should have some sort of incentive scheme to get employees on board with the IP program. Inventors at Wickr, he said, responded well to being given plaques in recognition of their hard work, as well as financial incentives.

The business also made a point of celebrating each patent it filed, he said, by using a company chat app to make corporate announcements on matters of prosecution.

"One time, we had four or five patents issued in one go, and to get everyone up to speed with that good news, we made an announcement on the group chat. It engaged a lot of people and the inventors got the recognition they deserved."

"And ultimately, it lifted the mood of the company and served to keep inventors engaged with the patenting process."

A final point he made was that open source licensing was also a big concern for his business. There are many licenses in the open source space and attorneys must make sure, if their business or client is contributing to a project, that their IP is not lost in the process.

Lesley Grossberg, Counsel at Baker-Hostetler, went on to talk about the dos and don'ts of brand management, and how to avoid and survive a trademark disaster.

"There are good financial reasons to avoid such a disaster," she said. "A rebranding can cost 10% to 20% of the business's annual marketing budget. Furthermore, trade-



mark infringement litigation costs between \$250,000 and \$750,000."

She advised members of the audience to always conduct a trademark search to determine the availability of a proposed mark, and find out if it is identical or similar to another mark already in use and would thus pose an infringement risk.

Searching can also help determine registrability based on criteria such as whether the mark is strong or weak compared to other marks registered by the USPTO.

She noted that it is not enough for businesses to simply conduct a Google search for trademark use. "Not all trademark use happens on the Internet," she said. "We would like to think it does, but that is simply not

true. So it is a good idea to outsource a full search from a specialist vendor who can take federal and state registrations into account."

These searches can aid attorneys when it comes to policing marks as well and make sure that no new marks that might cause confusion are being registered. "Just because your trademark is cleared after one search, doesn't mean you should stop searching," said Grossberg.

While there is no legal requirement to conduct these searches, she said, doing them may help the business fend off a bad faith assertion. A finding of good faith against an accusation that the business intended to capitalize on the goodwill of another company's mark may be supported by evidence of requests for trademark searches.

Grossberg pointed out that there are also risks when it comes to foreign registrations that counsel should be aware of. A delay in filing could frustrate the business's ability to enter foreign markets quickly, may lead to an injunction on sales, and ultimately to the seizure of exports and interference with production.

"It is so important to get protection in the places where you manufacture and where you intend to manufacture," she said.

Grossberg ended her talk by advising delegates to go beyond the standard search report by considering unfavorable meanings of a mark, looking at generational differences in commercial impression, and conducting a social media search.

How general counsel can work best with IP attorneys

Cybersecurity is becoming a more important part of business life.

Employees today must regularly dodge a tirade of phishing emails, malware links and phony phone calls. On top of that, companies must make sure their data is locked down and managed well so that they are not slapped with a large data-breach fine.

Cybersecurity companies are there to help businesses navigate this tumultuous landscape. But like any good firm, they want to find innovative ways to assist customers in a more efficient and cost-effective way. That innovation often generates IP, which also needs to be protected in the right way.

Jennifer DeTrani, General Counsel at Nisos, says her firm has built a lot of IP around solutions that help drive down the time it takes for it to engage with clients.

"We use tools that we develop internally to get engagements down from 60 to 20 hours so our clients are using us efficiently and we are using technology efficiently. We have a large R&D department that works on these tools."

But she adds that while it is important to develop as much innovation as possible, it is also important for start-ups such as Nisos to walk

a line between everything the business could possibly want to protect and what it is fiscally responsible to patent or keep as a trade secret.

To walk said line, DeTrani wants to keep as many options open to the company as possible. That task requires that a strong team of generalist and specialist counsel work together on matters such as preventing employees from publicly disclosing inventions and working out what should be patented based on the needs and budget of the business.

"There are those people who live and breathe IP who understand issues in a much deeper way than generalists. At a high level, generalists should be able to speak the same language as specialists who are so in the weeds of what is going on at the USPTO."

She says it can be easy for a business to build up its portfolio without ever standing back and asking why it has that portfolio in the first place. It is the specialists' job to determine whether something can or should be patented and the generalists' job to ensure that the patent-building aligns with the business's long-term goals.

More language lessons

DeTrani says she and her colleagues have been undertaking a concerted effort to get

everyone else in the business to speak the same language when it comes to IP, including sales people and engineers.

"It's about creating a culture of innovation. We are looking to make sure we garner ideas from employees and having a quid pro quo system and mindset.

Someone might have a great idea, but if they don't think there will be any interest or reward for it – or it falls outside the scope of what the company does – we haven't necessarily succeeded in getting employees to share their innovations."

She adds that employees need to know that they should disclose innovations to someone they trust in the legal department and, if the company decides to progress the inventions, there is a financial reward for that. The business now has that system in place and is working to get buy-in from all the relevant stakeholders.

DeTrani says it is also vital for general counsel to line up the right external counsel to help drive the right IP strategy within the business.

"When, as a general counsel, you come to a company, said firm may have engaged with an outside private practice firm to do everything – and those firms often give a



one-size-fits-all service.

"So it becomes a matter of assessing a better fit and finding specialists that are more adept at doing things for a company throughout its lifecycle.

"That fiscal determination of whether something is worth it can shift with the cost associated with a patent, which differs depending on whether you're giving the job to a large law firm or a more niche firm that might be cheaper, but actually do a better job for a particular type of filing."

Q&A with Matthew Bryan, WIPO

The Director of the PCT Legal Division and User Relations Division at WIPO talks about trends, challenges, questions, and more.

What have been the biggest PCT-related developments in the past 12 months? And what are the biggest ones on the horizon?

For the first time in the history of the PCT, over 50% of PCT applications were filed in Asian countries, predominantly China, Japan, and the Republic of Korea. A look at the 2018 statistics for filings in China shows that China's application rate was up over 9% from 2017, and it is worth noting that prior to 2018, China's year-on-year growth rate was in double digits for many years.

I expect this trend to continue as other Asian countries are also showing an upward incline in the number of applications filed. India's PCT filing rate is starting to increase. In just one year (between 2017 and 2018), the country showed a PCT filing growth rate of 27.2%. The rate of growth seen in the statistics for China also indicates that it will soon become the origin of the largest number of PCT applications.

"The trend in Asia indicates that for countries in this region of the world, IP continues to be increasingly important."

What do these trends reveal about the state of IP?

The trend in Asia indicates that for countries in this region of the world, IP continues to be increasingly important. The PCT is one indicator of this. WIPO has just issued another report, World Intellectual Property Indicators 2019, which contains not only PCT statistics but also those on national applications around the world. It notes that there has been a significant increase in demand for IP rights in China, with China's national office receiving

the highest number of total patent applications last year. This, coupled with the PCT statistics, shows that countries in Asia continue to make use of IP systems, reflecting a stance which is serious about protecting innovation and inventions in a global marketplace. Asia has effectively become the hub of global patent filings.

What challenges do you face in your role?

We do not believe that much more development is essential in relation to the PCT legal framework. The system runs smoothly and is generally appreciated. One (non-legal) area in which we see room for continued development is the work our partner national and regional offices undertake in their important role in the PCT process, performing international searches and international preliminary examination on PCT applications. As we continue to discuss with all 23 national/regional offices which serve as International Searching and International Preliminary Examining Authorities, the timeliness of their work and the quality of the reports they produce needs to continue to improve.

Another challenge we face in the PCT system is connected to the growth of the overall system itself. It is essential that WIPO keeps up with the volume of applications coming in. The rise in Chinese applications, for example, means that WIPO must have staff who have the required linguistic capabilities in Chinese. There has also been a large increase in the number of member states over the past many years, with approximately 100 new Contracting States having joined the PCT over the last 25 years. A key challenge in that connection is making sure that the IP offices in these countries are integrated into the PCT system and receive training on the processing of PCT applications. It is also important that the user communities in these



"IP attorneys do frequently ask questions about the countries which are not yet members of the PCT system."

jurisdictions (companies, universities, research institutions and IP attorneys) understand how to make use of the PCT system.

Other parts of my role in the PCT are to oversee the training and teaching about the PCT system in its main user countries and ensure the resolution of any "problem cases" which arise. It is often a challenge to ensure that users of the PCT system stay up to date on its legal and practical developments. In addition, a significant proportion of the PCT member states are developing and least developed countries, and WIPO has the re-

sponsibility to provide assistance to those countries on how to derive benefit from their membership in the PCT, specifically how they can take advantage of the work already undertaken on PCT applications during the international phase when PCT applications enter the national phase in their countries.

What are the most common questions that IP attorneys ask about the PCT? What about misconceptions?

I don't think there are many true misconceptions about the PCT in the community of IP attorneys, at least among the countries which are the main sources of PCT applications today. They understand its basics and benefits. Perhaps they are sometimes not completely up to date on its most recent changes, but they generally show a good comprehension of the system.

IP attorneys do, however, frequently ask questions about the countries which are not yet members of the PCT system. There are currently 40 UN Member States which are not yet party to the PCT. Some of these are significant economies in which innovators may wish to seek patent protection and they clearly want to use a single procedure to seek that protection in all countries of interest. Filing individually (outside of the PCT system) is more onerous.

What does the PCT do best?

In my opinion, what the PCT does best is that it gives the inventor/innovator more time to make well-founded patenting decisions (18 months more than in the Paris Convention route), and valuable information about whether the invention is likely to be patentable before having to make the potentially cost-intensive decisions about where to ultimately seek patent protection.

ETHICS & SELF-EMPLOYMENT

Continued from pg 4

or help them in their home state. It would cut into our income, so consequently, so long as you're not representing anyone in Nevada, you're fine with us."

Keisha Hylton-Rodic, a Washington, DC-based Managing Principal at Hylton-Rodic Law, has also started her own firm.

She agreed that it was important to seek advice when unsure of an ethical situation.

"If you don't have a good feeling, the best thing to do, rather than flying by the seat of your pants, is to ask the Bar Association. Depending on the circumstances, go as far as actually getting an opinion from someone [who focuses on ethics all day.] They should be able to give proper guidance on what you should and should not do."

Saturday sessions at a glance

To round off this year's conference, attendees are invited to look back at the key IP developments from 2019. The three-hour session will pick apart the key cases, policy changes and developments in trademark, patent, copyright and trade secrets law.

Kicking things off at 9:00 am, Stephanie Bald, partner at Kelly IP in Washington, DC, will look at the current state of play from a trademark point of view. Her talk will include an update on new trademark precedent from the US Supreme Court, lower courts and the Trademark Trial and Appeal Board.

Dennis Crouch, Associate Professor of Law at the University of Missouri School of Law, will take on all things patent-related, while New York-based Kirkland & Ellis partner Dale Cendali will provide an overview of the major copyright developments. Former AIPLA President James Pooley, who owns his firm James Pooley, a Professional Law Corporation in Menlo Park, California, will look at trade secrets-related developments.

Also in the final session, Allison Martin Rhodes, partner at Holland & Knight in Portland, Oregon, will provide an overview



of managing potential conflicts in intake and joint engagements.

BREAKFAST

7:30 AM – 9:15 AM	WIPO Madrid Focus Group Breakfast Meeting (WIPO Focus Group Members Only)	Chesapeake C
7:30 AM – 8:30 AM	WIPO Advisory Working Group Breakfast Meeting (WIPO Advisory Group Members)	Chesapeake B

CLOSING PLENARY SESSION

9:00 AM – 12:00 PM	The Year In Review – Trademarks, Patents, Copyright, Trade Secrets, and Ethics: Managing Potential Conflicts	Maryland Ballroom AC, 1-3
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BOARD MEETING

12:00 PM – 4:00 PM	Board of Directors Meeting (Board Members Only)	Annapolis 1-3
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HIGHLIGHTS FROM THE MEETING



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 | LICENSING TECH TRANSFER
FRANCHISING | ADMINISTRATIVE LAW | REGULATORY LAW