IPI Academy

MANAGEMENT forum



Presented by
Management Forum

Annual Update for Senior Trade Mark & Design Administrators: EUIPO, International Filings and Global Practice Updates

29-30 September 27

Stay current with the latest EUIPO, USPTO, Madrid and Hague System developments in this essential two-day training course for senior trade mark and design administrators

Format:
Classroom

CPD:
12 hours for your records

Certificate of completion

Course overview

This advanced training course is specifically designed for senior trade mark and design administrators, formalities managers, IP paralegals and legal assistants who need to stay fully up to date with the latest developments in EUIPO practice, international trade mark and design filings, and global portfolio administration.

The training provides a comprehensive update on recent EUIPO legal reforms, practice changes, and key case law developments affecting trade mark and design administration. Delegates will gain a practical insight into the latest decisions from the CJEU, General Court, and Boards of Appeal, and understand how these developments impact day-to-day filing and portfolio management.

It also explores the differences between EU, US, UK and foreign trade mark and design filing practices, including common pitfalls, procedural challenges and jurisdiction-specific issues. It also highlights the pitfalls to be aware of in relation to trade marks in the US, covers best practice for managing international portfolios, working with local counsel, and avoiding costly filing errors across multiple territories.

In addition, the programme includes practical guidance on the Madrid System and Hague System, recent legal developments, international filing strategy, and the use of WIPO's latest online tools and e-services.

This highly practical course will ensure you remain current with the latest legal and procedural changes while giving you the opportunity to discuss challenges with the expert faculty and network with peers in similar senior IP administration roles.

This is a must-attend training course for all senior trade mark and design administrators to bring you right up to date with the latest changes and their implications for you and your role. It also provides the opportunity to discuss your challenges and to ask your questions of the expert faculty.

Key topics covered include:

- EUIPO updates and practice changes: including legal reforms, filing trends, office tools, and post-Brexit developments
- EU, UK, US and international design filing practice: comparing filing systems, portfolio management approaches, and Hague vs national filings
- Trade mark practice updates at the USPTO: including filing bases, office actions, TTAB procedure, maintenance requirements and key US case law
- Foreign filing pitfalls and portfolio management: managing local counsel, translations, classification, notarisation, and country-specific issues
- Madrid System and Hague System updates: practical filing considerations, legal developments, and WIPO e-services
- Latest EU trade mark and design case law: Key decisions and practical implications for administrators and portfolio managers

Benefits of attending

By attending this training course you will:

- **Learn** about the latest EUIPO updates – including latest case law and practice changes
- **Get to grips** with EU, US and UK foreign designs – differences and pitfalls
- **Expand** your knowledge of the latest good practice for design filings
- **Examine** the latest updates on USPTO practice – trade marks
- **Clarify** foreign filing pitfalls and learn how to avoid them
- **Master** jurisdiction-specific issues and reduce filing risk
- **Understand** international registration of trade marks and designs
- **Get up to date** with the Madrid and Hague Systems – recent developments and trends

Who should attend?

This training course has been specifically designed for:

- Senior trade mark administrators
- Senior design administrators
- Formalities managers
- IP paralegals
- IPR and legal assistants
- Trade mark portfolio managers
- Trade mark portfolio administrators

Programme

Day 1

Chair's introduction

- Welcome and introduction to the course

EUIPO

- EUIPO updates and practice changes
- Case law points resulting in practice changes
- Cases from CJEU, General Court, Boards of Appeal
- Trends in EU filings
- Office tools and projects
- Brexit - the years after

EU, US, UK and foreign designs – the differences and pitfalls

- Outline of US, EU and UK design filings and their differences
- How to run a good docket for a US to EU portfolio
- Filing applications elsewhere
- Choosing between Hague and national applications

General good practice for design filings - focus on UK and EU

- Selection of representations
- Issues with photo filings
- Grace periods
- Priority issues
- Reliance on unregistered rights

Update on USPTO practice – trade marks

- Filing bases, including foreign use/registration - State Register, Federal Register A vs B
- Differences in classification and goods/services descriptions
- Responding to office actions – descriptions of device marks, disclaimers, likelihood of confusion, descriptiveness
- Evidence of acquired secondary meaning, including surveys (practical examples)
- TTAB procedure and practice
- Declarations of Use and Incontestability at registration and maintenance stages
- Interesting US cases

Foreign filing pitfalls and how to avoid them

- Managing local Counsel
- Notarisation and legalisation
- Translations and local language requirements
- Practicalities (time zones, National holidays etc)
- Country-specific issues
- Classification

Summary of the day and questions

Day 2

Overview of the Madrid System and Recent Legal Developments

- How the Madrid System works, main features
- Geographical coverage and possible expansion
- Recent legal developments

Practical considerations when filing an international application

- The role of the Office of origin and of WIPO
- Irregularities in international applications
- How to lower the risk of incurring in irregularities

Madrid eServices

- Madrid online services demo (eMadrid)
- WIPO Account and email address
- The future of eMadrid

Overview of the Hague System and recent developments

- Overview, statistics, latest accessions
- Recent legal developments
- Useful online tools

EU case law update and practical implications – trade marks and designs

- Learn about the latest case law and how it affects you and your role

Presenters

Juan Rodriguez

Juan Rodriguez is a Senior Legal Officer for the Legal Division of the Madrid Registry at the World Intellectual Property Office (WIPO) in Geneva. He is an attorney with a law degree from the Universidad de Lima (Peru) and a master's degree in business administration (MBA) from the University of Notre Dame (USA). Before joining WIPO he worked as the Head of Promotion at the Intellectual Property Office of Peru.



Xiaodan Dai

Ms. DAI joined Madrid Operations Division of WIPO in 2018. In her role as an examiner, she has focused on the examination of international applications, renewals, modifications, corrections, and other related tasks. Additionally, she is dedicated to delivering exceptional customer services to Madrid clients, offering precise and prompt responses tailored to their specific inquiries with her comprehensive knowledge of the Madrid system. Furthermore, she actively contributes as a member of an internal board, collaborating to establish consistent resolutions on examination practice issues.

Prior to joining WIPO, Ms. DAI served as a senior trademark examiner at China National Intellectual Property Administration (CNIPA), specializing in Madrid System. Throughout her tenure, she acquired extensive experience and expertise in conducting trademark examinations under Madrid System. She spearheaded the successful development of the Madrid e-Filing service of CNIPA and facilitated Madrid e-Communication between CNIPA and WIPO, along with the development of an internal examination system tailored for Madrid filings.

She has been invited as speaker to several webinars conducted in both English and Chinese languages, where she shares her expertise and insights on topics related to international applications under Madrid system.



Catherine Dupenloup

Catherine Dupenloup joined WIPO in 1996 and presently works as a Senior Applications Support Assistant in the Madrid Information and Promotion Division, Madrid Registry, Brands and Designs Sector. Since 2012, she has been the focal point for user Support in relation with Madrid System Online Services. Before 2012, she worked at the WIPO IT helpdesk as a user support for IT matters.



Silke Weiss

Silke Weiss is a fully qualified lawyer with a Master's degree in Intellectual Property from Victoria University in Wellington, New Zealand. She has worked at WIPO since 2008, initially in WIPO's PCT

Legal Division before moving to the Hague System Legal Division. Prior to that, she worked in a law firm in Germany and at the University of Economics in Vienna, Austria.



JoAnna Emery

JoAnna Emery, CLAS, F.Inst.Pa, is Project Manager, Intellectual Property at atai Life Sciences. Previously, JoAnna was Senior Intellectual Property Paralegal for Cambridge Mechatronics Limited where she was responsible for aiding in the management and growth of the patent portfolio. Prior to that she was the Head of and Director for Pure Ideas Limited where she managed the strategy, P&L, KPIs and intellectual property operations of the firm.

JoAnna has over 27 years experience in intellectual property in both the US and England. She holds an Associate and Bachelor's degree in Paralegal Studies from Rivier College.

Presenters



Rowena Tolley, a trade mark partner with Kilburn & Strode. She has almost 20 years of experience helping businesses protect and build value in their brands. She specialises in helping UK-based businesses in their international growth, as well as US and EU multinationals for whom the UK market is key. There are very few countries where Rowena hasn't filed trade marks, making her an expert in the local nuances of international brand protection. Her work includes everything from multi-jurisdictional clearance work, prosecution, oppositions and cancellations, through to portfolio reviews and management, infringement, dispute resolution and due diligence. Rowena works with clients of all sizes and across a wide range of sectors, including in particular food & drink, pharma, fintech, sports and music.

Rowena is well-known and respected in the industry, having sat on various intellectual property committees including FICPI, TIPLO and INTA. She has been ranked by MIP as one of their "Top 250 Women in IP" and by World Trademark Review as a "Gold Individual" in their WTR1000.



Nora Fowler, trade mark attorney and counsel with Kilburn & Strode, has over a decade of experience in advising clients and assisting them with the protection of their trade marks and designs. Nora has a particular focus on contentious matters and dispute resolution, as well as helping clients manage their worldwide trade mark and design portfolios. Throughout her career Nora has assisted clients with complex strategic international trade mark and design filing projects, working with clients from a broad range of sectors including the travel, sports, automotive, fashion, food and beverage, and beauty industries. She advises in relation to matters at the IPO, IPEC and EU General Court. She regularly represents clients at hearings before the UKIPO including in trade mark opposition and cancellation matters and trade mark and design registrability/absolute grounds hearings. Nora has an international background; she has worked in the UK and Germany and often assists clients in multijurisdictional matters and projects.

Course date

29-30 September 27	**Classroom** Venue TBC *Course code 17367*	GBP **1,399** ~~1,599~~ EUR **1,959** ~~2,239~~ USD **2,247** ~~2,559~~ **Until 04 Aug**

How to book

Online:
ipi.academy/2214

Alternatively contact us to book, or if you have any queries:

Email:
info@ipiacademy.com

Phone:
+44 (0)20 7749 4749

Discounts

- Booking more than one delegate on any one date qualifies for a **30% discount** on the second and subsequent places.
- Most events qualify for an **early booking discount** prior to 6 weeks before the course date. Be sure to check on our website, where the latest discounts will be shown.

Further information

Fee
The fee includes all meals and refreshments for the duration of the course (for venue-based courses) and a complete set of course materials (provided electronically). If you have any particular requirements, please advise customer services when booking.

Please note
IPI Academy (and our training partners) reserve the right to change the content and timing of the programme, the speakers, the date and venue due to reasons beyond their control. In the unlikely event that the course is cancelled, we will refund the registration fee and disclaim any further liability.

Terms and conditions
The rest of the our terms, the event cancellation policy and the terms and conditions are on our website, please visit ipi.academy/content/terms-and-conditions

Reviews

★★★★★

I hoped to learn more on designs and to get an update on the latest case law and this was definitely accomplished. I also appreciated the demo of the latest TM & design search tools and the interaction between all speakers and how they shared their knowledge with us in discussions.

Annelies Dobbelaere
IP Paralegal
Mithra Pharmaceuticals
Nov 7 2019

★★★★★

I really think that the course fulfilled my expectations. As a small group, we all had a chance to chip in with comments and it really felt nice that there was the time for that.

Christine Bruhn Sander
Trademark Paralegal
Chr. Hansen A/S
Nov 7 2019

★★★★☆

I felt it was a serious and interesting course that covered important topics which we as administrators need to follow. It's hard to cover everything in a two-day course but I felt inspired to keep myself more updated regarding case law and also to use the international filing systems even more. I liked that we got a chance to hear more about WIPO from a person who works there, and got the opportunity to ask him our questions.

Helen Magnusson
Paralegal
Essity Hygiene & Health AB
Nov 7 2019

★★★★☆

Splendid!

Claudia Görgey
IP Paralegal, Senior Specialist
MorphoSys AG
Nov 7 2019

Run this programme in-house for your whole team

Coming to IPI Academy for your in-house training provides an all-inclusive service which gives you access to a wide variety of content, learning platforms and delivery mechanisms as well as your own personal training adviser who will work with you from the initial enquiry through to feedback and follow-up after the programme.

With over 600 trainers, all practitioners and experts across a huge range of fields, we can provide the training you need, where you need it, when you need it, and at a price which suits your budget. Our approach to tailored learning and development consists of designing and delivering the appropriate solution for each client.

For your FREE consultation and to find out more about how we can work with you to solve your training needs, please contact our training advisers:



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IPI Academy

IPI Academy is a training initiative of Falconbury and Management Forum; leading providers of industry training for over 30 years, based in the UK.

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