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EU’ copyright reform passes first stage

The EU’s plans to reform copyright rules have been approved with a 14 to nine majority victory.

Axel Voss, German MEP and rapporteur, suggested that the result will “help the creative ones in the EU to strengthen their position. This vote marks the first step of the parliamentary procedure to adopt copyright laws fit to meet the challenges of the internet”. The proposed directive claims to “ensure that artists, news publishers and authors benefit from the online world and the internet in the 21st century”.

The current copyright rules date back to 2001, and current copyright exceptions in EU are optional and do not apply across borders.

Under the new rules, internet platforms will bear responsibility for the copyright infringement of their users and a new ‘link-tax’ will be implemented for news websites.

However, earlier this month the Electronic Frontier Foundation (EFF) said that EU copyright reform creates “problems so big” that they could “wreck the internet itself”.

EFF special advisor Cory Doctorow said that, while the directive fixes some long-standing problems with EU rules, it creates “much larger ones”.

The Greens-European Free Alliance suggested that the proposals for article 11 and 13 by Oettinger and Voss would “restrict how internet users can participate online—by sharing links and uploading their own works—to benefit the special interests of large media companies”.

On “the internet after Voss”, users will run into errors when attempting to express themselves on the web as they do every day today.

Now that the reform has passed the committee stage, a vote will be requested at the next Strasbourg session, where the plenary will decide whether to take on the debate and open the text up to amendments, or to proceed straight to trilogue negotiations with the European Council.

This vote is likely to take place on 4 July.
Countefeit Seizure
Police in Birmingham have confiscated £30,000 worth of counterfeit goods from an address in Witton

GDPR Clarification
A German court has chosen not to clarify how GDPR relates to WHOIS services in a case between the ICANN and EPAG

IP Careers
ChiPs has launched the Rachel Krevans Scholarship for female law students interested in a career in IP

UDRP Decisions
The North Face, Virgin Mobile, Honda, and Ann Summers have all been involved in UDRP disputes in recent weeks

Conference Report
ECTA’s 37th Annual Conference in Athens saw debates, speeches and discussions as a new IP landscape emerges

Industry Events
Pick up your copy of IPPro The Internet at the latest industry events
EUIPO launches new IP training programme

The European Union Intellectual Property Office (EUIPO) has launched a new training programme specifically designed for IP practitioners.

The practical course will focus on interactions between the EUIPO and IP practitioners in trademark and design registration and prosecution.

It will be delivered by EUIPO staff, leading IP professionals and academics.

The course will be delivered in English and will run from September 2018 to June 2019. It will consist of e-learning, face-to-face sessions and webinars.

The course will conclude with an exam, whereupon successful candidates will be awarded an EUIPO certificate.

Whirlpool has sued Pricebreak over refrigerator filter infringement

Whirlpool has sued Pricebreak for selling counterfeit water filters for refrigerators.

In its complaint, filed at the US District Court for the Eastern District of Texas, Whirlpool accused Pricebreak of being “engaged in the trade-off of and usurp for itself the value of the trademarks and the goodwill long associated with them, in order to sell counterfeit filters to unsuspecting consumers”.

Whirlpool said that Pricebreak’s infringing filters are not only “inferior in quality,” but could cause harm to consumers through “refrigerator breakdowns, water leakage in homes, and property damage”.

These products are supposedly sold online and according to Whirlpool, “targeted towards a substantial segment of the public that has long been familiar with Whirlpool’s appliances and accessories”.

Whirlpool noted in its complaint that its fluidic cartridges patent had been infringed and that Pricebreak was using its trademarks without permission.

Birmingham police seize £30,000 in counterfeits

Police in Birmingham have confiscated £30,000 worth of counterfeit goods from an address in Witton.

Almost 1,800 items were recovered, including football shirts, fake brand-name handbags and clothing apparel.

A 45-year-old man was arrested on suspicion of fraud and has been released under investigation.

Commenting on the seizure, PC Matt Attwell, from the West Midlands police force CID, said: “This was a huge haul of counterfeit goods which could easily have been mistaken as genuine.”

“We regularly work with partners to suffocate and tackle the market for fake goods. Counterfeit goods not only dupe buyers but can have a huge impact on legitimate traders and brands.”
Whirlpool sued Pricebreak in 2016 for infringing the same patent mentioned in this lawsuit.

The parties had entered into valid written settlement agreement and Pricebreak agreed to no longer manufacture or sell infringing products. Whirlpool has accused Pricebreak of breaking this agreement.

Whirlpool is seeking a preliminary and permanent injunction against the sale of the trademark-infringing goods, a permanent injunction for patent infringement and enhanced damages.

Indian Minister of Commerce and Industry launches mascot for IP

The Minister of Commerce and Industry Shri Suresh Prabhu has launched the intellectual property mascot, IP Nani, at the conference on National Intellectual Property Rights Policy in New Delhi. IP Nani is a tech-savvy grandmother who helps the government and enforcement agencies in combating IP crimes with the help of her grandson, “Chhotu” aka Aditya.

Shri Suresh Prabhu said the IP mascot will spread awareness about the importance of intellectual property rights among people, especially children, in an interesting manner. This character is in line with the World Intellectual Property Organization’s campaign for World IP Day in 2018, which highlights how a strong IP system can support innovative and creative women and everyone in their quest to bring their ideas to the market.

IP rights are increasingly becoming crucial drivers of social and economic growth by encouraging creativity and innovation, said Shri Suresh Prabhu.

The National IP Rights Policy was approved by the Union Cabinet on 12 May 2016.

The first and foremost objective of the policy is “IP Rights Awareness: Outreach and Promotion”.

Under this objective, one of the key focus areas is awareness on IP rights for school children.

In this context, the cell for IP Rights Promotion and Management, a professional body under the Department of Industrial Policy and Promotion collaborated with the EU IP Office to produce a series of animated videos on IP rights for children with IP Nani as their central character.

All these videos are available on the Cell for IP Rights Promotion and Management official YouTube channel and Twitter handle.

Counterfeits confiscate €60 billion each year, says EUIPO

Over €60 billion is lost each year due to counterfeits, according to research from the
German court won’t clarify GDPR and WHOIS

The German Regional Court of Bonn has chosen not to clarify how the EU's General Data Protection Regulation (GDPR) relates to WHOIS services in a case between the Internet Corporation for Assigned Names and Numbers (ICANN) and German domain register, EPAG.

ICANN filed injunction proceedings against EPAG in an attempt to get clarity in interpreting the GDPR.

EPAG, which is part of the Tucows Group, had informed ICANN that when it sells new domain name registrations it would no longer collect administrative and technical contact information, as it believes the collection of the data would violate the new privacy regulation. But ICANN requires this information to be collected and recently adopted a temporary specification on how WHOIS data should be collected and which parts should be published.

ICANN said that if EPAG’s actions stand, those trying to access full WHOIS records for legitimate purposes, including security, law enforcement, and intellectual property rights holders, may no longer be able to.

But the court determined that it would not issue an injunction against EPAG, meaning that EPAG will not be required to collect the administrative and technical data for new registrations.

The court did not indicate in its ruling that collecting such data would be a violation of the GDPR, but instead said that the collection of the domain name registrant data should be sufficient in safeguarding against misuse.

The court argued that as it is possible for a registrant to provide the same data elements for the registrant as for the administrative and technical contacts, ICANN had not demonstrated that it was necessary to collect the additional data elements for those contacts. The court noted that the registrant can provide this information at its discretion.

John Jeffrey, ICANN’s general counsel and secretary, said that while ICANN appreciated the promptness with which this matter was dealt with, the court’s ruling “did not provide the clarity that ICANN was seeking when it initiated the injunction proceedings”.

He said: “ICANN is continuing to pursue the ongoing discussions with the European Commission, and Article 29 Data Protection Working Party, to gain further clarification of the GDPR as it relates to the integrity of WHOIS services.”

EU Intellectual Property Office (EUIPO). The figures, released on World Anti-Counterfeiting Day, show that the accumulated losses from counterfeiting are equivalent to €116 per EU citizen per year.

Alongside this, 434,000 jobs are directly lost across 13 economic sectors.

Of these sectors, the UK sees 8.1 percent of counterfeit sales annually, which in turn is worth €141 or £103 per UK inhabitant, or €9.2 billion (£6.7 billion) overall.

The 13 sectors covered in the report range from cosmetics and personal care; clothing and smartphones, amongst others.

The EUIPO suggests that because of the high value associated with IP rights, infringement of those rights is a lucrative criminal activity, which generates significant costs to the rights owners and to the economy in general.

Commenting on the findings, António Campinos, executive director of the EUIPO, said: “Over the past five years, our reporting and research has given, for the first time, a comprehensive picture of the economic impact of counterfeiting and piracy on the EU economy and job creation, as well as intelligence on how IP rights are infringed.”

“Through our research, we have also shown the positive contribution that intellectual property has on employment and growth.”

“Our work has been carried out so that policymakers and citizens can be in no doubt of the value of intellectual property and the damage that arises from its infringement.”

Global counterfeits to reach almost $3 trillion in value, says INTA

The global value of counterfeit and pirated goods could reach $2.8 trillion by 2022, according to the International Trademark Association (INTA). This figure will show a vast increase from the $1.13 trillion value in 2013. Key factors leading to this increase are online sales of counterfeit goods and digital piracy.
INTA stressed that all consumers need to learn more about consumer rights and make smarter purchasing decisions. The organisation urged consumers to go straight to the source by shopping directly at authorised retail distributors both online and in stores. Consumers should look for verifiable contact details for retailers, such as a mailing address and telephone number, and the availability of real-time customer service.

Tish Berard, INTA president, said: “Counterfeiters are becoming so adept at producing and selling counterfeit goods that it is frequently difficult for shoppers to distinguish real versus fake. Consumers need to know that if the price of the item they are considering buying seems too good to be true, it probably is.”

INTA is also encouraging trademark owners and internet-related companies worldwide to review the association’s voluntary best practices on how to address the proliferation of online sales of counterfeit products.

INTA CEO, Etienne Sanz de Acedo, added: “On World Anti-Counterfeiting Day and year round, it is important for consumers to recognise the value of purchasing real goods as an essential way to protect public safety.”

“From cosmetics to car parts to vitamins, almost every product you can think of can be counterfeited, creating large-scale implications for society at large.”

Law school encourages women to pursue IP

ChIPs, an American non-profit organisation, has launched the Rachel Krevans Scholarship for female law students interested in a career in intellectual property. ChIPs established the scholarship in 2018 to honour the memory of Rachel Krevans, an IP litigator at Morrison & Foerster, and to promote diversity in IP. Krevans’s career spanned nearly three decades of trials and high-profile patent disputes. She was repeatedly recognised as a top IP litigator and a leader in technology law.

Krevans served on the ChIPs law firm advisory board and was inducted into the ChIPs Hall of Fame in 2014. She died in 2017 at age 60 after a battle with cancer.

Applications for the scholarship are now open. An award of $5,000 will be given annually to one student entering her third or subsequent year of law school to be used toward tuition.

Co-founder and board chair, Noreen Krall, Apple’s vice president and chief litigation counsel, who worked closely with Krevans, said: “Rachel Krevans was a brilliant litigator and a champion of women. We hope future generations of women will be inspired by her legacy as they embark upon their careers.”
Larren Nashelsky, Morrison & Foerster’s chair, commented: “Krevans was an inspiration to us all. She was a wonderful colleague, a world-class litigator, and a pioneer in the legal industry.”

She added: “We are proud that Krevans made her home at Morrison & Foerster, and we are delighted to partner with ChIPs to continue her legacy of passionate client service and the advancement of women in IP.”

ESF takes aim at counterfeit electricals on e-commerce sites

Amazon, eBay, and Fruugo are being misused by counterfeit sellers, exposing consumers to substandard and suspected recalled electrical goods, according to an investigation by Electrical Safety First (ESF).

ESF discovered that 1 in 3 UK residents has mistakenly purchased a counterfeit electrical item online. That is the equivalent of 18 million people. The investigation found that consumers were being duped into buying what they thought was genuine, only to discover a counterfeit once delivered.

Counterfeit electricals pose a potential risk of electric shock or fire. According to the report, the items with the biggest cause for concern are tumble dryers, Kodi set-top boxes, and hair straighteners.

The charity highlights a number of goods advertised on such sites matched items listed on its product recall list.

ESF suggested that these e-commerce sites must work harder to protect consumers from counterfeit goods. One in seven research participants had suffered damage or loss as a result of a counterfeit item from an online purchase.

This is not the first time ESF has raised concerns about the issue of counterfeit goods sold online. In December 2017, the charity published a report revealing that the majority of counterfeit Apple chargers sold online have the potential to deliver lethal electric shock and/or cause a fire. Of the 50 tested chargers purchased in the UK, 98 percent failed one or more safety tests. Commenting on the report, Phil Buckle, CEO of ESF said: “We are appalled to discover how easy it is to buy dangerous electrical goods online. Our investigation uncovered appliances that were visibly substandard, counterfeit or even subject to a recall, with model numbers matching items on our product recall list.”

He added: “Latest figures show card spending on the internet totals £154 billion per year, so it’s unsurprising that one in three of us have mistakenly bought a counterfeit online.”

‘It’s evident that e-commerce websites must work to improve the way in which they regulate third-party sellers to protect consumers from the risks posed by dangerous fake goods.”

ESF created its own seller profile ‘Dangerous Electrical’, which was successfully verified after using a fake name, passport number and date of birth to create the profile. It did this to expose the flaws of registration for such sites.

The ESF also found that millennials are most likely to fall victim to counterfeit scams on such sites, with half of 25 to 34-year-olds having purchased fake or substandard electrical goods.

In contrast, less than 10 percent of people aged over 55 have received a counterfeit item after shopping on e-commerce websites.

The quality of each logo and product was allegedly substandard.

FIFA was notified by customs officials, who confirmed that the seized items were not licensed.

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Whose Domain Name Is It Anyway?

The North Face, Virgin Mobile, Honda, and Ann Summers have all been involved in UDRP disputes at the World Intellectual Property Organisation Arbitration and Mediation Centre.

Virgin has recovered a domain in a UDRP dispute at the World Intellectual Property Organization (WIPO) Arbitration and Mediation Centre.

Virgin alleged that virginmobilelimited.com infringed its trademarks for Virgin and Virgin Media.

Sole panellist Leon Trakman agreed that the domain was confusingly similar to Virgin’s trademarks.

Trakman also found that the ‘limited’ aspect of the domain meant “a common term signifying the legal formation of a company” and was too generic when it comes to distinguishing the domain name.

He said that the original registrant of the domain, who used an anonymity service to hide their identity, was “most likely engaging in the sale of smartphones [and] would have been aware of Virgin’s pre-existing smartphone business”.

Trakman ordered that the disputed domain be transferred to Virgin.

Virgin has been the target of numerous UDRP disputes recently.

Honda won a UDRP dispute at the WIPO Arbitration and Mediation Centre.

The multinational car manufacturer claimed that hondaaircraft.com is confusingly similar to Honda’s trademarks for Honda Jet. Honda has been manufacturing luxury aircraft since 2003.

The original registrant of the domain, Hulmiho Ukolen, had responded to cease and desist letters by demanding $1250, despite Honda earlier offering out-of-pocket expenses of $500 to settle the case.

Sole panellist Charles Gielen found that the disputed domain was “identical” to the Honda trademark and that adding the word ‘aircraft’ “does not alter the conclusion that the disputed domain name is confusingly similar to the trademark”.

Gielen concluded by ordering that the domain be transferred to Honda.

Lingerie retailer Ann Summers has reclaimed a domain in a UDRP dispute at the WIPO Arbitration and Mediation Centre.

Ann Summers alleged that annsummerss.info, which was originally registered by Mingchun Chen, is confusingly similar to its trademarked brand name.

Sole panellist Martin Schwimmer found that the disputed domain is confusingly similar and that the addition of an extra ‘s’ “does not change the appearance, pronunciation, nor connotation of the trademark”.

Schwimmer also found that the domain was being used to redirect users to the Ann Summers official website, which “reinforces the likelihood of confusion”.

He ordered the domain to be transferred to Ann Summers.

American outdoor clothing brand The North Face has recovered an infringing domain name in a UDRP dispute at the WIPO Arbitration and Mediation Centre.

The North Face alleged thenorthfaceindirim.biz caused confusion and infringed its trademark for The North Face.

Sole panellist Ian Lowe ruled that the domain name was confusingly similar as it “comprises the entirety of [The North Face’s] trademark”.

The second part of the domain, the Turkish word ‘indirim’ which translates into English as ‘discount’.

Lowe added that Max Neumann, the original registrant of the domain name, was offering counterfeit goods on the website.

The goods were offered at substantially discounted prices, compared to official North Face prices.

He concluded that disputed domain should be transferred to The North Face.
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In the light of the sun

ECTA’s 37th Annual Conference in Athens saw debates, speeches and discussions on issues ranging from Brexit, to the upcoming EU Trade Mark Directive, as a new intellectual property landscape emerges

The theme of this year’s conference was ‘Gods in Transit’, with Greek allegories, gods, and legends in focus. Many of the sessions followed this theme, with Carolin Kind, secretary general of ECTA, telling a humorous story about the Greek gods, trademark filing and the upcoming changes to the EU Trade Mark Directive.

The directive was an important talking point of the conference, with Andrea Marx, secretary of ECTA’s law committee, reassuring attendees that any changes will benefit practitioners.

She highlighted that increased cost-efficiency in the enforcement of rights is one of the main benefits to practitioners once the new directive has been implemented.

However, Marx noted that there are two key areas to address, the implementation of revocation and invalidity proceedings before the national trademark offices, and the extension of rights holders rights in custom-related situations.

Marx said that her home nation, Germany, had “limited revocation proceedings”. She added that the German trademark office “sees that people aren’t happy with the current state and want to make changes”.

However, one panellist believed that when it comes to the upcoming directive, some EU member states are “embarrassed adolescent kids with overly helpful parents”.

ECTA is lifting the standard and constantly improving

Max Oker-Blom
Adjunct professor
Hanken School of Economics
The panellist referred to the EU Intellectual Property Office and EU Commission as “a mum and dad who are doing everything for the EU and offering too much. They should just let us adolescent kids be”.

The panellist then said that, despite the recent influx of new types of trademarks, the directive should “overhaul the representation of trademark types and find new ways to represent old types of trademarks”.

He said there has to be “a very intensive communication campaign to get the message out there” in relation to the new directive. He pointed out that once one set of changes are brought forward, then “maybe other necessary changes can come into play”.

He highlighted that the specific areas where the transitional regime is really intriguing are goods and services, the renewal procedure, and the “new” and “disappearing grounds for refusal”.

The panellist concluded by admitting that he was “surprised that [the directive] has come at such a good time”.

Something that may not have come at a good time, is the prospect of a hard Brexit.

The UK voting to leave the EU was the other massively notable topic dominating the ECTA conference in Athens, with one specific aspect causing major concerns—Ireland.

Tania Clark, recently appointed president of CITMA, went as far to say that “nothing will go forward until Ireland is resolved”.

Clark said that the UK government is “too busy dealing with Ireland” and that she doesn’t expect anything to be resolved soon.

Clark said that greater clarity is needed, “especially on fees and forms”, and suggested to that the audience might want to review what “clients are doing on behalf of the customs union”, before the transition period.

To try and bring some of this much required clarity, Clark explained that CITMA had written a letter to the UK IP Office in relation to pending EU Trade Mark applications, but nothing was returned. She went on to add that the association may send the same letter again, or instead, to the EU with “some amendments”.

Deborah Brincat, senior legal manager, global brand legal, at Procter and Gamble France (P&G), said that the initial reaction from companies to Brexit was that it was a catastrophe.

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“**This is my first time at the ECTA Annual Meeting. It’s small, but there are a lot more people I can talk to and the sessions are very informative. There are a wide range of topics that are discussed and they are discussed in a very deep manner**

Ewa Skrzydło-Tefelska
Partner
Sołtysiński Kaweck & Szeląg
Brincat herself admitted that she was worried about what Brexit could mean for her business. However, she highlighted that recent figures show some companies haven’t been affected as much, pointing out Shell and British Petroleum as stand out examples.

Brincat quoted David Haigh, CEO of Brand Finance, who said: “Brexit is proving to be an opportunity and stimulus for many British brands.”

She said to the audience that P&G will think carefully in regards to what trademarks to carry over to the UK post-Brexit, and of the importance to transition trademark rights for holders once the UK does leave Europe. Brincat also asked the audience to do a crossword puzzle, making it one of the more interactive sessions.

From withdrawal from Europe, to withdrawing unnecessary search tools, in another session Sara Amini, senior project officer from the World Intellectual Property Organization (WIPO) said that IP brands need to move away from making IT tools, just for the sake of having them.

Amini highlighted what WIPO has currently done to help make search tools more useful for the user, and that the main focus has to be “user-friendly for both novice and experienced users”.

Amini said that before making any registrations, users should check if any similar marks already exist and “always start with the WIPO global brand database”, which she noted has access to nearly 35 million records from 38 national and two international collections.

She added that it is “a good place to start to see whether the market is open for you”.

Amini also highlighted WIPO’s image similarity search tool, which searches based on the features of the image, like shape, colour and texture. She said that it “can be very effective on simple shapes, but can also be used for more dynamic shapes”.

She did, however, suggest that searching for certain images can miss key features.

An example Amini highlighted was the LG logo, which features a smile and letters inside the shape, which she said can end up being delivered as a “lot of noise about circles with lines in it” and can miss some of the key aspects.

WIPO has recently started using AI-based image similarity searches, which by definition is based on an automated classification of images.

Amini said that AI-based search tools “will create an image of what the lines mimic in the shape,” and pointed out to the audience that new adaptations to WIPO’s AI-based image search tool “should be released later this year”, IPPro
The world’s premier IP directory

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The German Association for the Protection of Intellectual Property (GRUR) cordially invites you to this year’s Annual Meeting entitled “Digital Future”, which will take place at Hotel InterContinental in Berlin from 26 to 29 September 2018.

Learn more about:

- Technical aspects, applications and perspectives of Machine Learning, Artificial Intelligence and Big Data
- Digital Mobility and the legal framework for autonomous cars
- Surreptitious advertising through Influencer Marketing
- Liability in the virtual world from the perspective of the German Federal Court of Justice
- The protection of competition in digital markets
- Patents on the Internet of Things
- Legal issues regarding 3D Printing
- Copyright and Artificial Intelligence

What better place for exploring the general topic of the GRUR conference than Berlin, the capital of the start-up scene in Germany, where new ideas and business models for the digital age are developed on a daily basis.

We trust that more than 700 experts in intellectual property, antitrust and data law from over 30 countries will join us for this year’s GRUR conference and look forward to welcoming you to Berlin!