

“IP Question of the Day”

Question: To what extent is the refiling of trademarks allowed?



In conversation with... Marek Łazewski

Marek Łazewski has been the Secretary General of AIPPI since 2019. His term of office ends at this Congress. Marek is a patent attorney, his practice focuses particularly on complex patent and trade mark litigation. He is the managing partner of LDS Łazewski Depo & Partners – an IP boutique in Poland.

How have the Congress preparations been?

Hectic like always! History has accelerated under COVID. However this year we had the benefit of the lessons learned in the crazy year of 2020. We had a much longer lead-in, we started planning and preparing early on and had a clear decision-making schedule starting as early as January 2021. So much more of a controlled situation than last year.

What is the Secretary General Team's (SGT) role in relation to the Congress?

I want to focus on the “team” aspect in your question. Today in these extraordinary circumstances we are truly reaping the benefits of the reforms implemented in the 2010's in the structure of the AIPPI Bureau. The SGT team is large enough and yet compact. We have a development track, starting from Assistant Secretary General, so that the depth of involvement and challenges escalate slowly. We can align positions, assign tasks and divide the work. The efficiency of the SGT's teamwork impressed me, and I am similarly impressed by all we have achieved.

Annie Tsoi was the SGT member doing the heavy lifting on the Congress and her work was superb. She is also the driving force behind the Young Members Forum at the Congress. I was mostly involved in the strategic decision-making process, including as a member of the online Congress Task Force (a body combining Bureau and General Secretariat staff members). I also focused my efforts on pursuing test runs for various management topics. This is part of Pillar 2 of the AIPPI strategic plan – broadening the range of conversation.

Nazli Korkut focused on developing various membership metrics and data mining with the Membership Committee. She is also the SGT liaison to the Communication Committee and Independent Members to bring the perspective of the association into their works and ongoing projects. The SGT also managed to hold three separate calls with our national groups' leadership in September to receive the insights and expectations from our members in view of the upcoming Congress. Isabelle Chabot pursued the in-house and Women in AIPPI parts of the programme. There were further assignments among us on various topics. A team can do so much. It has been a treat to be a part of this particular team.

What are you most looking forward to at the Congress?

I am really excited about the opportunities for spontaneous interactions that have been created. This is much more challenging online, but they do happen! Last year there were spontaneous interactions on Zoom and other platforms. The concept of AIPPI Cafés, which started last year, has now been further developed and we will be able to offer this opportunity to a much broader audience.

Similarly, I am keen to see how the [new networking tool, Wonder](#), will be used by the delegates and attendees! It's an interesting way to bridge the gap virtually. We need to try all kinds of ways to make connections happen. Attendees expect an opportunity to replicate the type of in-person Congress interactions they usually experience.

So although challenging, it's also driving the association forward?

Yes. By pushing ourselves and getting out of our comfort zone, we can achieve even more than we thought possible.

Like?

For example, we have seen how the RGT deals with the Study Questions virtually. The online experience we've had during the pandemic will be very useful in improving AIPPI operations during Congresses in the future – whatever they will look like!

Has the online success surprised you?

In a way. I would not have believed two years ago how much you can do online. The whole thing still does not seem like the real thing, but it works in ways I never thought possible. What's more, online is more inclusive because it broadens the population of delegates and equalizes the playing field between introverts and extroverts. It improves the quality of debate when you have more voices in the room. It is the same with our Young Members. They have led the way with online interactions and maybe they are more adaptive to this kind of operation.

The Young Members have really come to the fore lately, haven't they?

Indeed. Some substantive work suggestions are coming out of the relatively new Young AIPPI Committee (YAC). And these suggestions have been taken on board by the Bureau in many cases.

How has it been to be the AIPPI Secretary General in a pandemic?

It's been a rollercoaster ride. A lot of what I have been groomed for over the years could not take place, but there have been other elements that no previous Secretary General has ever been exposed to. The whole change of bringing AIPPI into the virtual world has broadened my mind tremendously.

How do you think you will feel when you step back after so many years in the AIPPI Bureau?

There is success ahead of us. I will be cheering on from the sidelines and will try to be involved to the greatest extent possible. It will be a bittersweet moment when the time arrives to leave but I am also feeling quite inspired. I can use what I have learned from this experience in my professional and private life. The SGT role is very strongly about interactions with people – other Bureau members, the General Secretariat, AIPPI National & Regional Groups – and this has been very enriching.

Any regrets?

Yes. I regret not picking up some more airmiles during my term as Secretary General! (*Laughs*).

Thank you for the interview, Marek, and especially for all your hard work over the past few years!

Interview conducted by Diarmuid De Faoite, AIPPI Communications Manager.

**Opening Ceremony**

**Watch the Red Carpet Prelude
video [here!](#)**



In conversation with... MaryAnne Armstrong

MaryAnne Armstrong is the Chair of the 2021 AIPPI Study Question, *Inventiveness and sufficiency of disclosure in AI inventions*. She is also the AIPPI-US Secretary. She is a partner at BSKB, LLP in Washington DC.

Can you briefly explain why this Study Question is of great interest to the IP community?

This Patent Study Question addresses a super hot topic. Artificial Intelligence (AI) is growing, evolving and creating a lot of IP-related questions. Does the availability of AI raise the standard of inventive step, eventually making it impossible for “human inventors” to meet this requirement? Given the nature of AI, do we need to adjust the requirements of the disclosure of an invention in a patent application, i.e. do we need to require the applicant to tell the world how the AI operates?

All of these are critical open questions which need to be answered by patent offices and courts in the very near future. AIPPI is taking the lead in this discussion as a global thought leader proposing the best possible approach, based on very thorough scientific research.

Was there a big divergence in opinion on these issues?

While there was a consensus that we do not make a fundamental change of the traditional rules on inventive step and sufficiency of disclosure, the quite tricky question is how to apply these rules to AI inventions. We have seen a very creative and constructive discussion process in the work of the Study Committee, and we hope that we will have a very meaningful Resolution by the end of this process, giving the much-demanded guidance to the patent offices and courts worldwide on these critical issues.

So the international teamwork worked well?

It was great. It surprised me to see how some country positions shifted on certain points the deeper we got into the topic and how consensus was reached on most points. You also realize how documents can be interpreted differently by different people. The need to have clear, unambiguous and consistent language was illustrated quite well.

Can you quickly explain the Study Question process?

Sure. We have a small team of people on the Study Committee leadership. Seong Tahk Ahn and Peter Finnie are the Vice Chairs. Nina Fitzgerald is secretary and Ralph Nack serves as the responsible reporter.

All of the countries within AIPPI submit reports on the Study Question. The AIPPI Bureau creates a summary report out of these. From all this work, the Study Committee Leadership comes up with a first draft of the Resolution. This first draft is circulated to the country delegates.

We then had a virtual first meeting in August with all of the country delegates for a couple of hours. We collected a lot of opinions from this first meeting, but there was no voting. The Study Committee took into account all of the comments made from the various country delegates and made revisions to the text, in an attempt to reflect the majority position.

In September, there was a second virtual meeting with voting on the draft Resolution by country delegates only. This was analogous to the Study Committee session at an in-person Congress.

At the Congress plenary session on Monday, October 18, there will be another vote weighted by the AIPPI National or Regional Group size. Finally, on Friday, October 22, the Executive Committee should pass the new Resolution.

Have you previously been involved in any AIPPI Study Questions?

I have been involved in the Patent Study Questions for the past 6 or more years. Working on the Study Questions is fun and coincides with my interests. It's a little like a Model United Nations for IP professionals! It is fascinating and interesting to hear what other countries think and then to work together on something that goes to IP offices around the world – it has a very concrete effect! I have found that the people who work on the Study Questions are very into it and we tend to be “legal/policy geeks”.



How did you come to be the Chair?

I started working with the US Group on Patent Study Questions a number of years ago, and then the US Group asked me to be the country delegate for a Patent Study Question. I was then the Secretary at the London meeting. The US group put my name forward again for the 2021 virtual meeting for the patent question and the Bureau asked me to serve as Chair. It's a typical story of deeper involvement as you get to know the people and processes.

What kind of unexpected discoveries did you make over the year?

It has been nice to see growing numbers of women being involved, especially younger professionals.

Did COVID make the process more difficult?

It has made it more difficult in some ways but easier in some other ways. In-person it is easier to communicate among your own country delegates to be aligned. You can also have informal chats

and so on with other delegates in between sessions and thereby better understand their positions.

The special COVID protocols for pre-meeting discussions, the August and September meetings I mentioned, are helping to streamline the plenary sessions. We should look at the possible learnings from this special pandemic situation for future in-person Congresses.

Would you recommend getting involved so deeply in a Study Question?

Yes. It is great way to get to know people – not only from your own country but from all around the world. You build relationships, both personal and professional. It leads to a much richer Congress experience.

Interview conducted by Diarmuid De Faoite, AIPPI Communications Manager.

Plenary Session 1:

Q276 - Inventiveness and sufficiency of disclosure in AI inventions

Join the session on Monday, October 18, 2:00 PM-4:00 PM (CEST)

Artificial Intelligence ("AI") is a rapidly evolving technology that finds new applications on virtually a daily basis. It has profoundly changed how problems are approached and solved in a wide variety of fields. With AI gaining an increasingly important position within the inventive process it is of extraordinary relevance to scrutinize the current statutes and case law and develop ways to handle its growing importance in the future.

This Study Question examines the issues of inventiveness and sufficiency of disclosure of inventions involving AI. As of today, AI and its capability to learn from various inputs potentially outputs technical solutions which would be considered as providing an inventive step if made by a human being. In this respect, the question is whether or not the increasing use of AI in the inventive process has an impact on the current standards used during the examination of the inventive step and, if so, how such standards would be affected by the presence of AI in the inventive process. In particular, the capabilities of an "objective" human being (typically referred to as a person skilled in the art) are used as the reference point for assessing inventive step. Today, an AI is potentially capable of considering the total range of prior art and information.

Against this background, the question is whether, and if so how, the definition of the person skilled in the art needs to be amended, potentially resulting in the effect of raising the bar for inventive step. Further, standards of sufficiency of disclosure are set to ensure that the person skilled in the art is enabled to carry out the claimed invention based on the disclosure of the patent specification. Since the inner workings of an AI are often undisclosed or at least very difficult to comprehend, such enablement might be hampered in case of AI Inventions. Thus, the question is whether it is necessary to adjust the current law regarding the sufficiency of disclosure requirement and if so, how.

This Study Question focuses on

- (1) possible particularities when assessing inventive step of AI Inventions, in particular
- (2) the definition of the person skilled in the art with regard to the increasing use of AI in the invention process and
- (3) the examination of the current standards of sufficiency of disclosure concerning AI Inventions.

We are bringing new sessions to the 2021 AIPPI World Congress - AIPPI Cafés!



In these 45 minute-long interactive sessions, participants can exchange views on the defined topic. After a brief introduction by the moderator, anyone can contribute to the conversation. No advance registration is required, participants can “walk-in” and join the conversation.

With 36 different topics there’s bound to be something that takes your interest! Check out the [online programme](#) for further details.

Full list of AIPPI Cafés

- | | |
|--|---|
| 1: IP and COVID-19: compulsory licensing, TRIPS waivers and more | 20: Working requirement in patent law: a global perspective |
| 2: Latest trends in ADR & IP | 21: Forensics in biotech litigation |
| 3: Trade marks: use requirements and refiling strategy | 22: Hit ‘pause’, then pivot: non-use and TM protection in a pandemic |
| 4: FTA agreements – hot IP topics | 23: Damages for trade secret misappropriation |
| 5: Patenting banking: fintech, blockchain & IP | 24: Exchange of local brand stories and interesting brand protection strategies |
| 6: Designs into the future | 25: Pharma & border enforcement |
| 7: WIPO Sequence Listing Standard ST. 26: what you need to know | 26: Bad faith & trade marks |
| 8: Copyright & photography | 27: IP for currency: Non-fungible Tokens |
| 9: Best practices for preserving trade secrets | 28: ADR in FRAND disputes |
| 10: Current practice in trade mark oppositions in the EU | 29: Accelerated digitalization of services in IP practices (pre and post COVID) |
| 11: PCT Challenges | 30: FRAND & Anti (anti++) suit injunctions |
| 12: IP valuation & IP value– from IP rights to IP assets | 31: Genetic resources, traditional knowledge and more |
| 13: Global impact free trade agreements on IP | 32: A Colourful Discussion on Patents |
| 14: In-house (for In-house only) | 33: The use of AI by IP offices |
| 15: Reaping the fruits of wise prosecution when litigating BioPharma patents | 34: Parody, satire & pastiche |
| 16: Patents & AI – past, present and future | 35: Open justice and trade secrets |
| 17: Changes in IP office practice during the pandemic | 36: Undiscussed aspects in TRIPs under COVID-19 situation |
| 18: Spurring Innovation in Green Technologies | |
| 19: Young Members and the future of AIPPI | |

Panel Session 1

Pharma: Compulsory licences and TRIPs waivers for COVID?

Monday, October 18, 12:00 PM-1:00 PM (CEST)

The possibility of compulsory licenses has been ever-present in the biopharmaceutical industry, even in normal times, so it may be no surprise that the topic has again erupted in the wake of the development of new, highly successful vaccines against the COVID-19 global pandemic.

Article 31 of TRIPs permits, in certain circumstances, the government-authorized use of a patented invention without the authorisation of the right-holder. However, this provision also includes several limitations and conditions; the rationale is that if governmental use of a patented invention is critical, e.g. for security or health reasons, and the invention is not being made available then governments can insist on a compulsory licence.

TRIPs was amended in 2017 to waive certain requirements of Article 31 for countries with insufficient manufacturing capabilities. Furthermore, a waiver has been agreed to allow Least Developed Countries to forgo implementation of TRIPs requirements related to pharmaceuticals until 2033. In October 2020, the governments of India and South Africa submitted a proposal to the WTO TRIPs Council, seeking a complete waiver of not only patent rights, but also copyrights, industrial designs, and trade secrets (undisclosed information), where those rights are related to the “prevention, containment, or treatment of COVID-19.” AIPPI’s TRIPs and Pharma Committees issued a position paper which includes (amongst other observations) the view that there is no evidence of IP blocking the availability of COVID-19 vaccines.

This panel session will discuss the current state of the India/South Africa proposal, the ramifications of a waiver that extends to trade secret protection and considers issues relevant to assessing reasonable compensation for life-saving vaccines that would not exist were it not for the innovation that created them.

Panel Session 2

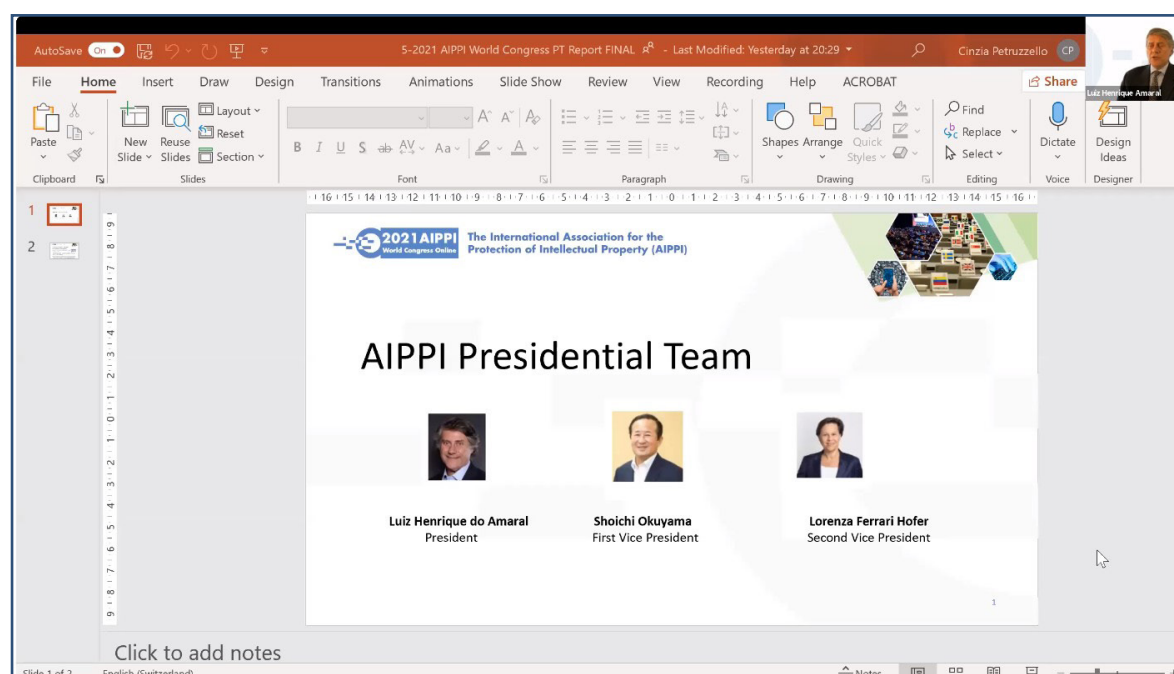
Trademark evergreening – limitations to refiling

Monday, October 18, 12:00 PM-1:00 PM (CEST)

To what extent is the refiling of trademarks allowed? This Panel Session will address the limitations and will explore what options remain.

Trademark owners generally have a 5-year grace period to start using their trademark, after which non-use can result in a loss of rights. While this may seem long, there can be many reasons why trademark owners do run into problems towards the end of this term. The trademark may for example have been filed for many different goods/services, the use may have been limited in terms of geographic spread, the use may have differed a little from the actual registration, etc. Repetitive filing thus not only concerns so-called “defensive trademarks”, but also trademarks affected by e.g. an evolution in the products and services offered, or by a change in corporate identity. To circumvent losing their trademark, owners may try to register the same trademark again, or a trademark very similar thereto.

The panelists will discuss recent developments in the area, such as the EU MONOPOLY decision. They will also more generally discuss in what circumstances a repeat filing is problematic and what strategy trademark owners can adopt to continue to protect their trademark.



Executive Committee Meeting I

Watch the video [here!](#)

Panel Session 3

Pharma: Alternative medicine? Data protection rules for pharmaceutical compounds

Monday, October 18, 5:30 PM-6:30 PM (CEST)

This Panel Session will address data protection rules for pharmaceutical compounds in different jurisdictions and their interplay with trade secrets and patent rights.

With regard to data protection rules for pharmaceutical compounds, the core issue is whether there is a data exclusivity claim in addition to the already existing patent and trade secret protection for pharmaceutical preparations. This also raises the question whether data exclusivity is something that can be granted in an approval procedure or whether it is much more of an intellectual property right. It is even possible that both could be the case.

The discussion of this topic is of great relevance since the legal situation regarding data exclusivity laws in the pharmaceutical sector is not fully clear. However, such clarity is necessary to ensure effective protection for prior applicants of pharmaceutical compounds.

This panel session aims to provide a global overview of how data protection with regard to pharmaceutical compounds is handled by individual national regimes. Furthermore, possible consequences of granting additional protection in the form of a data exclusivity claim will be discussed.

Panel Session 4

Video gaming: copyright & design issues

Monday, October 18, 5:30 PM-6:30 PM (CEST)

Video games, including online video games via the internet, have been developed to include not only static/series of graphical views but also game player images. E-sports has witnessed an explosion with more than 450 million estimated viewers and revenues exceeding US\$ 1 billion. As E-sports and live video game broadcasting has become mainstream, several key IP issues have arisen.

Issues such as publishing, design rights, online streaming rights, end user license agreements, performance rights, publicity rights, and advertising and merchandising have become hotly contested. We have seen issues of exclusive authors' rights and publicity rights to names, images, and other identifying personal information of the life, activities and personalities of certain public persons, be adjudicated. Specifically, tattoos and image rights of persons have drawn questions of what is fair use, copyright and/or design ownership in body art and personality rights in video game content.

This panel session will discuss high profile case law and unharmonized law for this rapidly growing industry sector with international context.

The Academy of European Law (ERA) is offering AIPPI members a 25% discount on two courses!



AIPPI members are welcome to use a discount code exclusively created for AIPPI members. In order to claim the 25% discount please select the price for discount voucher holders and enter **2021IPLawERA**. **This code can be combined with the Early Bird discount but no other discounts.**

Intellectual Property and Artificial Intelligence

Online, 27 October 2021 – 29 October 2021

- Trade mark strategies for AI technologies
- The use of AI in intellectual property registers
- Emerging legal issues on patent and copyright law
- IP rights enforcement and artificial intelligence
- Impact on intellectual property law of the European Strategy for Data

Full course programme available on the [ERA website](#)

Annual Conference on European Copyright Law 2021

Trier/Online, 18 November 2021 – 19 November 2021

- Recent CJEU rulings on copyright
- Access to documents and copyright
- Relationship and tension between copyright and trade mark
- Fundamental rights, copyright and online platforms
- Impact of the Digital Services Act on copyright
- Update on the activities of the European Commission and the Member States on copyright
- Future of EU copyright law

Full course programme available on the [ERA website](#)

Monday, October 18, 2021

12:00 PM - 1:00 PM

**Panel Session 1: Pharma: Compulsory licences and TRIPs waivers for COVID?**

Panellists: Tahir Amin, Gustavo De Freitas Morais, Komal Kalha, Catherine Mateu

Sponsored by CCPIT Patent and Trademark Law Office

12:00 PM - 1:00 PM

Panel Session 2: Trademark evergreening – limitations to refiling

Panellists: Sung Pil Hwang, Jonathan Moss, Maria Scungio

1:00 PM - 1:45 PM

AIPPI Café 1: IP and COVID-19: compulsory licensing, TRIPS waivers and more

Panellists: Eran Bareket, Eyal Bressler, Victor Garrido, Sharon A. Israel, Shukadev Khurajam, Anita Nador, Reinhard Oertli, John Todaro

1:00 PM - 1:45 PM

AIPPI Café 2: Latest trends in ADR & IP

Panellists: Rafael Atab, Steven Bauer, Richard Price, Rindforth Pette, Jonathan Mesiano-Crookston, Cheryl Agris

1:00 PM - 1:45 PM

AIPPI Café 3: Trade marks: use requirements and refiling strategy

Panellists: Jorge Llevat, Mark Metzeling

1:00 PM - 1:45 PM

AIPPI Café 4: FTA agreements – hot IP topics

Panellists: Roberto Carapeto, Ed Clarke, James Tumbridge

2:00 PM - 4:00 PM

Plenary Session 1: Q276 - Inventiveness and sufficiency of disclosure in AI inventions

4:30 PM - 5:15 PM

AIPPI Café 5: Patenting banking: fintech, blockchain & IP

Panellists: Fred Barbieri, Kevin Shipley

4:30 PM - 5:15 PM

AIPPI Café 6: Designs into the future

Panellists: Dunstan Barnes, Santosh Chari, Nestor Corominas, Aurelia Marie, Peter Schramm

4:30 PM - 5:15 PM

AIPPI Café 7: WIPO Sequence Listing Standard ST. 26: what you need to know

Panellists: Emma Francis, Leonor Magalhães Galvão, Niklas Mattsson

4:30 PM - 5:15 PM

AIPPI Café 8: Copyright & photography

Panellists: Dale Nelson, Rainer Oesch, Kevin Tottis, Sanna Wolk

4:30 PM - 5:15 PM

AIPPI Café 9: Best practices for preserving trade secrets

Panellists: Hector Chagoya, Marina Cunningham, Maud Fragnière

5:30 PM - 6:30 PM

STOCK

Panel Session 3 - Pharma: Alternative medicine? Data protection rules for pharmaceutical compounds

Panellists: Brigitte Carion-Taravella, Masaru Nakajima, Michael Stern, John Todaro

Sponsored by Stock Intellectual Property

5:30 PM - 6:30 PM

DERIS^{TR}**Panel Session 4: Video gaming: copyright & design issues**

Panellists: Eugene Low, Stefan Naumann, Vilhelm Schröder, S. Gregory Boyd

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7:00 PM - 8:00 PM

**Replay Recorded Panel Session 1: Compulsory licences and TRIPs waivers for COVID?**

Speakers: Panellists: Tahir Amin, Gustavo De Freitas Morais, Komal Kalha, Catherine Mateu

Sponsored by CCPIT Patent and Trademark Law Office

7:00 PM - 8:00 PM

Replay Recorded Panel Session 2: Trademark evergreening – limitations to refiling

Panellists: Sung Pil Hwang, Jonathan Moss, Maria Scungio

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Law of Raw Data

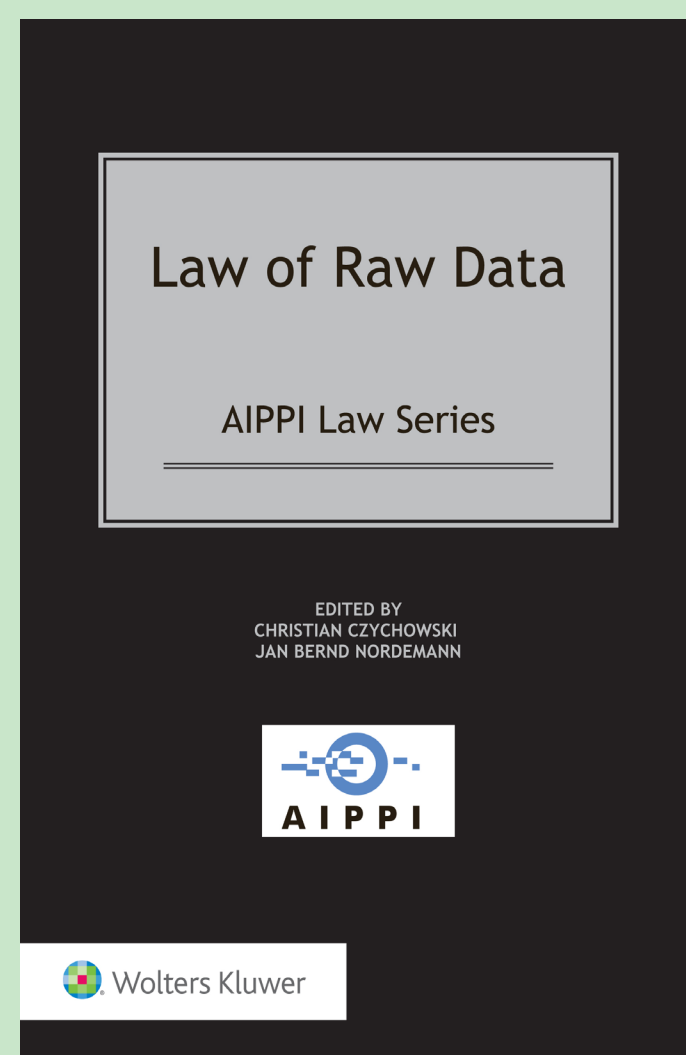
Edited by Christian Czychowski & Jan Bernd Nordemann

Law of Raw Data gives an overview of the legal situation across major countries and how such data is contractually handled in practice in the respective countries. In recent years, digital technologies have transformed business and society, impacting all sectors of the economy and a wide variety of areas of life. Digitization is leading to rapidly growing volumes of data with great economic potential. Data, in its raw or unstructured form, has become an important and valuable economic asset, and protection of raw data has become a crucial subject for the intellectual property community. As legislators struggle to develop a settled legal regime in this complex area, this invaluable handbook will offer a careful and dedicated analysis of the legal instruments and remedies, both existing and potential, that provide such protection across a wide variety of national legal systems.

Special Wolters Kluwer offer for delegates of the 2021 AIPPI World Congress Online

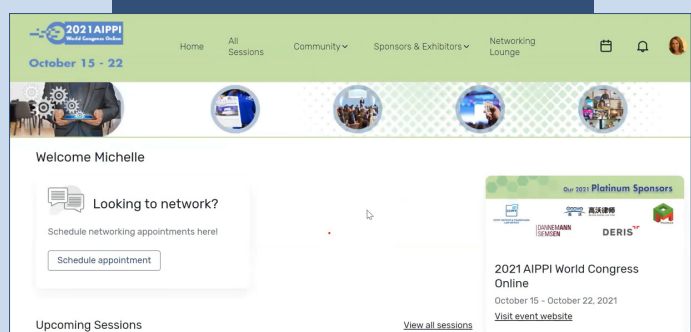
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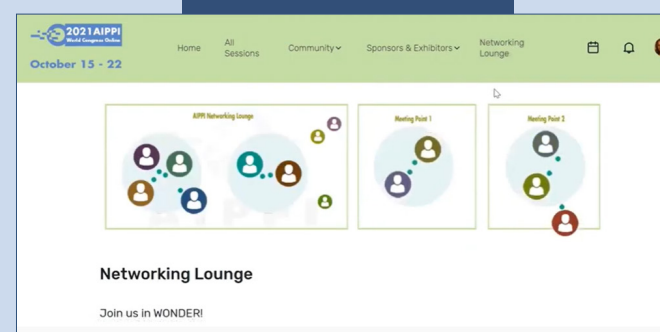
Getting used to the AIPPI World Congress platform:

Part 1



This year's virtual Congress is hosted on a new platform. Because new applications may be difficult for some people to navigate at first, we have prepared two videos to demonstrate to you how to get around and find everything you need. A couple of minutes invested here should lead to a richer Congress experience!

Part 2



Networking at the 2021 AIPPI World Congress Online Join us in WONDER!

Wonder is a virtual space where people can meet and talk. You will have to move around to meet people, you can move your avatar around with your mouse. You can see who is speaking to whom. To join a conversation, you have to move closer to a group or other people. To leave a group, you simply move away.

This short video shows you how you can use Wonder - the new online networking tool for AIPPI World Congress delegates:



The Networking Lounge for the 2021 AIPPI World Congress Online opens on Friday, October 15.

There are different meeting points within the platform, so you can suggest to others to meet you at a specific meeting point.

Note:

Wonder does NOT work on mobile devices. You will need to access the Networking Lounge from your computer

When you are done, make sure that you leave the room and close the browser completely, otherwise, you will stay connected

Wonder will not work if you have another video conferencing tool open, therefore please ensure you exit any other session prior to joining the Networking Lounge



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OCTOBER 15 - 22, 2021

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