



Intellectual[®]
Property
Owners
Association

2016 Standing IP Committee Leadership Meeting

JW Marriott Hotel
Washington, DC
March 16, 2016

Intellectual Property Owners Association

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AGENDA

IPO COMMITTEE LEADERSHIP MEETING

Wednesday, March 16, 2016

9:00 a.m. – 12:00 p.m.

JW MARRIOTT HOTEL – Salon II
WASHINGTON, DC
(CONTINENTAL BREAKFAST AVAILABLE AT 8:00 A.M.)

- 9:00 a.m. Welcome Remarks by Kevin Rhodes, IPO President
- 9:05 a.m. Remarks by Mark Lauroesch, IPO Executive Director
- 9:10 a.m. Presentations from the Standing IP Committees (2 mins. each)

I. Antitrust and Competition Law Division

- a. Antitrust and Competition Law
- b. Standards Setting

II. Business Issues Division

- a. Corporate IP Management
- b. IP Licensing
- c. Trade Secrets

III. Copyright Law Division

- a. Copyright Law and Anti-Piracy
- b. Open Source

IV. International IP Law and Practice Division

- a. Asian Practice
- b. Canadian Practice
- c. Emerging Technologies and Trade
- d. European Practice
- e. Genetic Resources and Traditional Knowledge
- f. International Patent Law and Practice
- g. International Trademark Law and Practice
- h. Latin American Practice

V. Litigation and Dispute Resolution Division

- a. Damages and Injunctions
- b. International Trade Commission
- c. Litigation

VI. Patent Division

- a. Industrial Designs
- b. Patent Search
- c. Pharmaceutical and Biotechnology Issues
- d. Software Related Inventions
- e. U.S. Patent Law
- f. U.S. Patent Office Practice
- g. U.S. Post-Grant Patent Office Practice

VII. Professional Division

- a. Women in IP Law

VIII. Trademark Division

- a. Anti-Counterfeiting
- b. Domain Names and Social Media
- c. U.S. Trademark Law
- d. U.S. Trademark Office Practice

- 10:30 a.m. Coffee Break
- 10:45 a.m. IPO's Amicus Brief Committee Report
- 11:00 a.m. Networking/Collaboration Discussion with Committees of Your Choice
- 12:00 p.m. Adjournment

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2016 IPO STANDING IP COMMITTEE LEADERSHIP MEETING
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ANTITRUST AND COMPETITION LAW

Chair: Greg Sivinski, Microsoft Corporation

Vice Chair: Monte Cooper, Orrick, Harrington & Sutcliff

Secretary: Jordan Sigale, Dunlap Codding, P.C.

Board Liaison: Daniel Enebo, Cargill Incorporated

Committee Charter

This committee will study and report on issues relating to U.S. and foreign antitrust and competition laws impacting intellectual property owners. The committee will seek to educate IPO members on issues at the intersection of antitrust and intellectual property law. The committee also will: a) track and report on proposed legislation, litigation, administrative actions, and other activity, in significant markets throughout the world, b) focus particularly on intellectual property licensing, including standard essential patent (“FRAND”) licensing, refusals to license and compulsory licensing, tying of intellectual property, and collective licensing through patent pools, c) address the acquisition of patents under key merger review schemes, d) assess and report on the expected FTC study of PAEs due in March 2016, and e) consider antitrust challenges to efforts to enforce intellectual property and settlement of patent litigation, including antitrust challenges to enforcement of “reverse settlements” of ANDA patent litigation (so-called “pay-for-delay” schemes). The committee also will coordinate with other committees within the IPO’s Antitrust and Competition Law Division, to complement the activities of the other committees.

Committee Agenda for 2016

The committee plans to (i) review and confirm the focus areas below, (ii) encourage greater member participation and hold monthly conference calls to track and discuss significant developments in the focus areas, (iii) coordinate with other committees to complement related activities, such as invited guest speakers, roundtable discussions, joint papers, or joint conference calls for certain related issues, and (iv) create a year-end report that can help IPO members understand key issues underlying the intersection of intellectual property and antitrust/competition law in these focus areas.

Focus Areas for 2016:

1. ***Proper Valuation of Patents under HSR*** is a perennial question, and more recently it has been used to challenge assertions of acquired portfolios at values that exceed HSR thresholds, but for which no HSR filing was made. Meanwhile, the PNO does not have a preferred method of valuation, and it does not give advice on what method is appropriate. Instead, parties must assess “the fair market value” of U.S. patents “in good faith” and “using a method that is consistent with the method used for determining the value of the overall patent portfolio.” If a valuation is conducted for the purpose of avoiding HSR compliance, that valuation may be disregarded by the antitrust agencies. The Committee will consider whether this “hot topic” in IP and antitrust law warrants a Panel discussion at the IPO Annual Meeting.
2. ***Reverse Settlements*** between competitors and potential competitors (the evolving law of “pay for delay” following *Actavis*), and “Product Hopping”.
3. ***Webinar***. The Committee would like to conduct a webinar sometime in the next quarter on reverse payment settlements—what have we learned since *Actavis*.
4. ***Agency Enforcement***. New or amended national competition agency IP guidelines are on the rise, e.g., Canada, China, Japan, and Korea. Meanwhile the EC has signaled stepped-up enforcement to clarify possible anti-competitive conduct after the ECJ decision in *Huawei*. What’s at stake for IP holders as agencies loosen traditional standards for essential facilities to reach “important” technologies, and seek to define and challenge anticompetitive licensing practices for both SEPs and

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non-SEPs? The Committee will consider whether this “hot topic” in IP and antitrust law warrants a Panel discussion at the IPO Annual Meeting.

5. ***IP Chat Channel.*** Partner with Standards Committee in the next quarter to hold a joint roundtable on the IP Chat Channel covering related topic in item 4 above: “Extending Competition Law to Impose Compulsory IP Licensing Outside Scope of Standard-Setting Organizations”.
6. ***Patent Assertion Entities.*** The FTC’s market study of patent assertion entities is expected in early 2016. We will assess how it addresses key topics, including demand letters, deceptive practices, and proposed legislation. We will also address use of competition law by PAEs to attack collective action by licensees, e.g., *Cascades v. RPX Corp*; *MPHJ Tech Investments v. FTC*, and competition law to challenges to PAE activity.
7. ***United States Domestic and FTC Efforts to Legislate and/or Investigate Patent Demand Letter Activities.*** The Committee in 2015 regularly reviewed efforts by state judicial, legislative and and regulatory bodies, as well as the FTC, to investigate and, in some instances, to take legal action against various law firms and Patent Assertion Entities (“PAEs”) that sent demand letters to small businesses suggesting the business take licenses to patents assigned to or owned by the PAEs. The Committee anticipates continuing to monitor such developments and, where necessary, to report on these activities to the wider IPO membership.

STANDARDS SETTING

Chair: Amy Marasco, Microsoft

Vice Chair: Minda R. Schechter, Novak Druce Connolly Bove + Quigg

Secretary: Jonathan Retsky, Winston & Strawn

Board Liaison: Timothy Loomis, Qualcomm

Committee Charter

The Committee will monitor and analyze significant developments in legislation, case law and policies affecting intellectual property rights in relation to industry standard setting. The Committee will serve as a forum for education and the expression of opinions and recommendations concerning such legislation, case law and policies, as well as the role of intellectual property rights in the standards setting process. The Committee will work closely with the IPO Board to identify and make recommendations on those matters of particular concern to intellectual property owners. In addition, the Committee will seek to define the principles for achieving the optimum balance between the rights of intellectual property owners and other industry standard stakeholders.

Committee Agenda for 2016

The Committee plans to continue to track and discuss ongoing developments on a global basis regarding standard-essential patents (SEPs) and other standards-related IPR issues. This includes:

1. the effect of a FRAND licensing commitment,
2. proposals to increase transparency and disclosure of SEPs-related information at standard-setting organizations (SSOs),
3. the application of patent, contract and competition law to SEPs-related conduct,
4. related litigation outcomes, and
5. the increasing interaction between standards and open source software (OSS).

Some specific areas of focus include:

1. The increasing interest by some foreign governmental authorities in “de facto standards” and whether patents reading on technologies that are not standardized at a SSO but that are “popular” in the marketplace should be treated the same as SEPs that are subject to a FRAND commitment. The Standards Setting Committee is coordinating with the Antitrust & Competition Law Committee on this topic, including the organization of an IP Chat Channel webinar.
2. A number of governments have undertaken to prepare or revise Guidelines applying their competition law to intellectual property rights. This includes government authorities in South Korea, China, Japan and Canada. The Committee has been following these developments closely, especially as they relate to standards-setting and “de facto” standards.
3. Caselaw developments relating to SEPs. This includes recent decisions by the Courts of Appeals for the Federal Circuit and the 9th Circuit, as well as recent decisions in Europe following the *Huawei v. ZTE* decision by the European Court of Justice last summer.

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4. Increasing interaction of standards and OSS. This raises a number of related issues: How is code be used in connection with standards? Who is developing the code and under what licensing arrangements? What happens if OSS is contributed to the standards development process at an SSO in terms of related IPR policies and licenses?

In addition, the Committee intends to (a) encourage greater participation in regular conference call meetings, (b) prepare position papers where there is a consensus-based set of views and (c) schedule joint conference calls/events and liaise with other IPO Committees (such as the Antitrust & Competition Law Committee and the Open Source Committee).

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CORPORATE IP MANAGEMENT

Chair: KaRan Reed, BP America Inc.

Vice Chair: Neil Kardos, Harrity & Harrity, LLP

Secretary: Shawn Foster, Exxon Mobil Corp.

Board Liaison: Joe Kirincich, Avaya Inc.

Committee Charter

The committee will review new tools, techniques, and approaches for the management of corporate IP portfolios, including the strategic creation of new IP assets, the extraction of value from the existing IP portfolio, and the benchmarking and the cost-effective operation of the corporate IP function.

Committee Agenda for 2016

1. Complete Corporate IP Management Best Practices project
 - a. Completed interviews of approximately 20 Senior IP Counsel regarding best practices in eight key areas of corporate IP management
 - b. Presented initial results at 2015 IPO Annual Meeting
 - c. In 2016, will prepare final report detailing all results
2. Finalize deliverable(s) based on IP Metrics project
 - a. Progress committee project regarding using metrics to convey IP strategy to business partners and client groups
 - b. Pending approval by Annual Meeting Program Committee, will develop a presentation for the 2016 Annual Meeting detailing results and recommendations
3. Begin groundwork for next iteration of IPO Benchmarking Survey
 - a. Last IPO Benchmarking Survey completed in 2013, including a presentation at the 2013 annual meeting
 - b. In 2016, update survey questions based on responses to last iteration for launch in 1Q17 to members
 - c. Pending approval by Annual Meeting Program Committee, will develop a presentation for the 2017 Annual Meeting detailing results and findings/key insights
4. Identify and offer educational programs at monthly committee meetings
 - a. IP Valuation
 - b. Claim Scope and Damages
 - c. IP Metrics and Software Tools
 - d. Portfolio Analysis
 - e. Competitive Intelligence

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IP LICENSING

Chair: Andrew Wojnicki, IBM Corporation

Vice Chair: Erin Ator Thomson, Vinson & Elkins LLP

Secretary: Christopher C. Smith, Brooks Kushman P.C.

Board Liaison: Bill Krovatin, Merck

Committee Charter

The IP Licensing Committee focuses on (including discussion, review and analysis of) intellectual property licensing and related matters and issues. This can include topics or issues associated with patent, technology/trade secret, software/copyright and trademark licensing; cross and joint licensing; licensing for income or other business value; industry and market trends; best practices; agreements and agreement provisions; impact or relevance of bankruptcy, anti-trust, standards, compulsory licensing, etc. on licensing; and associated legal and business aspects and issues. Prior topics addressed have included: Developing a Reasonable and Non-Discriminatory (RAND) Patent License; Maximizing The Value Of Technology & IPR Through Licensing; and Post-Expiration Royalty Considerations. The Committee interfaces, when applicable, with other committees on issues pertaining to standards, anti-trust, and other areas of mutual interest.

Committee Agenda for 2016

1. **Key Accomplishments:** The Committee provided feedback and suggestions to the Asian Practice Committee on their draft China Licensing survey. At the 2015 IPO Annual Meeting, the Committee presented a breakout CLE session in conjunction with the Software & Related Inventions and Copyright Law & Anti-Piracy Committees, and hosted a social event for Committee members. The Committee continued to provide topical presentations at many of its monthly meetings, from guest speakers as well as Committee members.
2. **Recommendations for Committee Activities in 2016:** The Committee plans to continue monthly training sessions, taking a two track approach: 1) one introductory and one advanced session each covering (a) patent, (b) copyright, and (c) trademark licensing, and 2) specific topics of interest (e.g. government licensees, allocating IP rights in collaborative agreements, lessons learned in litigation, etc.). The Committee will remain prepared to respond to inquiries from the IPO Board, and will actively seek opportunities to collaborate with other Committees, including proposing one or more breakout sessions for the 2016 Annual Meeting. The Committee will continue to encourage: 1) tracking of case law developments affecting licensing practitioners, and 2) formation of one or more subcommittees to focus on specific topics.

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TRADE SECRETS

Chair: Kenneth Corsello, IBM Corporation

Vice Chair: Kurt G. Calia, Covington & Burling LLP

Secretary: Kurt Goudy, IBM Corporation

Board Liaison: Karen Cochran, DuPont

Committee Charter

The Committee will focus on providing practical education to IPO membership and the public on the topic of trade secrets. Such education may include presentations at IPO meetings, white papers, form documents for posting to www.ipo.org, etc.

Committee Agenda for 2016

Key Accomplishments

1. Continued to monitor federal legislation (Defend Trade Secrets Act) that would establish a federal cause of action for trade secrets misappropriation, and to educate the IPO membership about the legislation both in terms of substance and process.
2. Actively promoted education of the Committee members by inviting Committee members and guest presenters to lead monthly discussions concerning issues related to trade secret misappropriation and protection. Presentations in 2016: (1) Jan. - Samantha Aguayo and Jim Pooley on the December Senate Judiciary Committee's hearing on the Defend Trade Secrets Act; (2) Feb. - guest speaker Nick Akerman of Dorsey & Whitney on the Computer Fraud and Abuse Act; (3) Mar. - Paul Keller of Norton Rose Fulbright on getting U.S. trade secret evidence into Chinese courts; and (4) Apr. - Pamela Passman of The Center for Responsible Enterprise And Trade (CREATE).
3. Sent survey to the Committee members and received feedback on topics of interest, and used the feedback to plan Committee activities for 2016.
4. Provided speaker for IP Chat Channel session to be held March 9th on First Response to Trade Secret Theft: Best Practices for Answering an Alarm.

Recommendations for Committee Activities in 2016

1. Continue to monitor domestic and foreign legislative trade secret developments.
2. Propose presentation for IPO Annual Meeting on the combined topic of the Defend Trade Secrets Act / renewing your client's focus on their trade secret protection program, including cybersecurity, in the current IP environment.
3. Work with IPO International Committee and other Committees to further develop and engage in ideas and strategies for increasing focus on international issues.
4. Complete Stage 1 of white paper survey (to Committee members) to identify important trade secret issues; use results to formulate Stage 2, to be proposed for circulation to IPO membership; and use those results to prepare white paper on emerging challenges relating to trade secrets protection.

COPYRIGHT LAW AND ANTI-PIRACY

Chair: Eric Massant, RELX Group

Vice Chair: Katherine Spelman, Lane Powell

Secretary: Jenevieve Maerker, Foley Hoag LLP

Board Liaison: Dana Rao, Adobe Systems, Inc.

Committee Charter

The charter of the Copyright Law and Practice Committee was expanded by the Board in 2015 to include anti-piracy. The Anti-Counterfeiting and Anti-Piracy Committee was folded into the renamed Copyright Law and Anti-Piracy Committee. This Committee focuses on determining what issues and topics regarding copyright law and practice are of greatest concern to the IPO membership and establishing positions on those issues and topics that would most benefit IPO members, including anti-piracy. The Committee will be following significant bills in Congress on copyright law and procedure, and taking positions where appropriate and consistent with the interests of IPO members. The Committee will also follow Copyright Office, US Patent and Trademark Office and any other relevant rule-making efforts of interest to copyright owners, and consider recommendations for involvement in the rule-making process where appropriate. The Committee will also follow initiatives in international groups such as WIPO and important cases relating to copyright as they occur. The Committee will attempt to consider the interests of both content owners and content users among the IPO community to develop balanced positions. The Committee will also work toward developing practice-oriented tools relating to copyright issues.

Because of the subject matter overlap between this Committee and several other committees, when selecting topics, we consult and coordinate with the leadership of our sister committees. We also address such issues as the IPO Board of Directors asks this Committee to consider.

Committee Agenda for 2016

1. Continue to monitor and provide input on potential legislation and regulatory proceedings regarding copyright issues, including but not limited to orphan works, small claims, exemptions to the prohibition against circumvention of technological measures protecting copyrighted works, Copyright Office Modernization, statutory damages, first sale in embedded software, DMCA notice and takedown safe harbor, and other potential copyright legislation or regulations, and advise the IPO Board regarding positions on any such proposed legislation or regulations.
2. Plan and propose session topics on copyright law for 2016 IPO Annual Meeting.
3. Continue to monitor relevant copyright cases, legislation, U.S. Copyright Office policies, and activities of the US Executive Branch and international copyright organizations for possible IPO action.
4. Advise the IPO Amicus Committee and IPO Board on potential amicus positions.

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OPEN SOURCE

Chair: Joseph D'Angelo, EMC Corporation

Vice Chair: Philmore H. Colburn, II, Cantor Colburn, LLP

Secretary: Hanna Kim, Microsoft Corporation

Board Liaison: Anthony DiBartolomeo, SAP SE

Committee Charter

The Committee studies and, when appropriate, reports on issues relating to open source licensing, open source governance, and open source litigation. Development and distribution of software and other technologies under open source (sometimes called "free") licenses has become a multibillion dollar industry. There are a wide variety of open source licenses available (many, but not all, of which can be found at the Open Source Initiative's website: www.opensource.org), ranging from "academic" or "permissive" licenses like the Berkeley Systems Distribution (BSD) license to "copyleft" licenses like the GNU General Public Licenses (GPL). All of these licenses raise legal, business, and policy issues and have different requirements with respect to copyright, patent and other intellectual property to which the licensor gives fairly unrestricted rights. Some of the ramifications of these various licenses are yet to be fully interpreted by courts or administrative bodies, and as a result there are a variety of opinions on how these licenses would ultimately be enforced. Open source licenses raise many as-yet-unresolved issues involving IP ownership, licensing, control, integration, business model, divestiture and merger/acquisition, among others. The committee's primary purposes will be to monitor, discuss, and possibly participate (under Board direction) in legal developments associated with open source licensing, to participate (under Board direction) in formulating any agreed-upon IPO policies relating to open source licensing, to inform the IPO Board and membership of current issues and practices relevant to open source licensing, and to take positions consistent with the needs and desires of the IPO Board and members on open source licensing in appropriate fora.

Committee agenda for 2016

For 2016 we are considering addressing the following topics at our committee meetings:

- Continue to meet and discuss issues relating to open source licenses
- Work on drafting a paper about creating an open source project
- Present at an IP Chat Channel webinar
- Explore issues regarding FCC non-modification regulations and OSS compliance
- Explore Copyright Office's ruling on modification of car software and Open Source
- Present at the Annual Meeting regarding Open Source Issues

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ASIAN PRACTICE

Chair: Lawrence T. Welch, Eli Lilly

Vice Chairs: Robert Siminski, Harness Dickey; Jimmy Cheng, Qualcomm Inc.; Michael D'Aurelio, Thomas, Horstemeyer; Steven Bauer, Medtronic

Secretaries: Michelle Shen, Medtronic, Inc.; Brad Chin, Bracewell & Giuliani LLP

Board Liaison: Edward Blocker, Koninklijke Philips Electronics N.V

Committee Charter

To identify, monitor, study and recommend IPO positions regarding intellectual property acquisition, licensing and enforcement issues in Asia with initial emphasis on Japan, China, India, Korea and Taiwan. To also disseminate and exchange information and views among corporate members of IPO regarding intellectual property problems in Asia. Regular activities of the committee will include:

1. Organizing fact finding visits to Asia
2. Participate in seminars and conferences within the United States and Asia directed to Asian IPR
3. Develop white papers addressing acquisition, licensing and enforcement aspects of Asian IPR.
4. Make recommendations to the IPO Board on potential collaborations between IPO and Asian trade associations such as PPAC

Committee Agenda for 2016

- We are planning a return fact finding trip to China tentatively scheduled for the week of October 30-November 4, 2016.
- We will continue our monthly conference calls, with occasional guest speakers on Asian IP topics of interest.
- We have submitted comments on the Chinese patent laws and antimonopoly laws, and plan to submit comments on Indonesian and Indian patent provisions as well.
- We are beginning preparations on a possible two day CLE session on comparative Asian IP laws, including China, India, Japan, and Korea, for early 2017.

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CANADIAN PRACTICE

***Co-Chairs: Diane Yee, Johnson & Johnson and
Arvie Anderson, Eli Lilly and Company***

***Co-Vice Chairs: Santosh Chari, Blake, Cassels & Graydon LLP and
Andrew Sojonky, Borden Ladner Gervais LLP***

Board Liaison: Brian Suffredini, United Technologies Corp.

Committee Charter

The Canadian Practice Committee seeks to promote a reliable and effective Canadian intellectual property regime through advocacy and education. The Committee identifies, monitors and studies Canadian IP issues, including legislation, judicial decisions, and Canadian Intellectual Property Office (CIPO) activities and recommends an IPO position. The Committee envisions a membership including those located in Canada as well as those whose organizations seek or are interested in IP protection in Canada. This year's emphasis will be to increase membership from industry representatives.

Committee Agenda for 2016

Key Initiatives

IPO Advocacy Opportunities via Comments to CIPO

- Comments on Amendments to the Rules
 - Patent (Upon pre-publication anticipated in late 2016)
 - TM (Upon pre-publication anticipated in late 2016)
 - Industrial Design (Upon pre-publication anticipated in late 2016)
 - Amendments are anticipated to include a review of the Government fees.

- MOPOP (Manual of Patent Office Practice) Amendments
 - Recently Updated Chapters (although there is no consultation period, CIPO provides an opportunity to ask questions about the revisions)
 - Chapter 15: Anticipation, obviousness and double-patenting (updated January 2016)
 - Chapter 19: Amendments to Patent Applications
 - Upcoming Chapter Reviews (no timelines set):
 - Chapter 11: Claims
 - Chapter 12: Subject matter and utility
 - Chapter 16: Computer implemented inventions
 - Chapter 17: Biotechnology

- Recent Important PAT Practice Notices:
 - Examination Practice Respecting Medical Diagnostic Methods (PN2015-02). There was no consultation and IPO could consider making a submission.
 - Revised Examination Practice Respecting Medical Uses (PN2015-01)
 - Practice Guidance Following the Amazon FCA Decision (PN2013-02 and PN2013-03)

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- TM:
 - CIPO has not updated their TM Examination Manual in years and the Practice Notices are issued without consultation. IPO could consider making a submission but at this time we are not aware of a real demand for this. A submission on the proposed Rules in 2016 may be more relevant.

Pharmaceutical Patent Issues

- Advocacy on utility law jurisprudence
- Attention on obviousness standard
- Attention on section 8 and other damages litigation
- CETA implementation
 - Right of Appeal for brands
 - Patent Term Restoration
- Dual litigation
- Monitoring competition issues relating to pharm patents

Copyright/Trademark Issues

- New border enforcement provisions (addressing counterfeiting goods)

Trade/International IP

- Comments on Canada's IP regime submitted for the IPO 2016 USTR Special 301 Report

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EMERGING TECHNOLOGIES & TRADE

Chair: Allison Mages, General Electric Company

Vice Chair: Bryan J. Vogel, Robins Kaplan LLP

Secretary: Jeff Gordon, Borden Ladner Gervais LLP

Board Liaison: Micky Minhas, Microsoft Corp.

Committee Charter

The Emerging Technologies and Trade Committee has been developed to explore intellectual property issues relating to emerging technologies in the global IP community. The Committee will monitor the changing landscape relevant to emerging technologies, particularly green technology and additive manufacturing / 3D printing, and any other emerging technologies that give rise to novel IP issues. The Committee will seek to positively influence global policy positions on behalf of the IPO relevant to this important area. The Committee will promote strong incentives for the discovery, development, use, and intellectual property protection of emerging technologies. The Committee will specifically monitor judicial, legislative, and regulatory activity in this area as well as other proposals and initiatives from various organizations and governments having the potential to impact emerging technologies, all on a global scale.

Committee Agenda for 2016

- Organize a series of discussions and guest speakers on emerging technologies, including additive manufacturing and clean/green technology.
- Provide submissions and testimony on trade related issues, as appropriate, leveraging existing efforts for Special 301. Specifically, consider providing submissions to annual exercises such as Special 301, China's Compliance with WTO Commitments, and the National Trade Estimate Report on Foreign Trade Barriers, in addition to providing input on ad hoc comment requests. Efforts will be done in conjunction with other IPO Committees with overlapping mandates concerning the comments requested.
- Monitor norm-setting activity at WIPO, as it relates to emerging technologies, including by leveraging IPO's accreditation. Provide expert insight including through speakers and submissions, and recommend interventions as aligned with IPO member goals. (Ex. Participation in WIPO's Expert Forum on International Technology Transfer). Prepare interventions for key WIPO meetings, including the Standing Committee on Patents (SCP) and the Committee on Development and IP (CDIP), in collaboration with out IPO Committees, as appropriate.
- Organize proposal(s) for break-out session(s) at IPO's Annual Meeting relating to emerging technologies.
- Monitor developments within UN negotiations that have the potential to affect the value of IPO members' assets, such as the UN Framework Convention on Climate Change and 2030 Agenda for Sustainable Development.
- Monitor developments within TTIP and other trade agreements that have the potential to affect the value of IPO members' assets.
- Develop outreach strategies to raise awareness and existing profile of international discussions that could affect the value of IP assets in emerging technologies, as appropriate.
- Develop case studies that illustrate how IP works in practice for use with policymakers.

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EUROPEAN PRACTICE

Chair: Robert B. Furr, Jr. INVISTA S. à r. l.

Vice Chairs: Aloys Hüttermann, Michalski · Hüttermann & Partner
James Signor, Leydig, Voit & Mayer Ltd.

Secretary: Matthew Georgiou, Carpmaels & Ransford LLP

Board Liaison: Dennis Skarvan, Caterpillar Inc.

Committee Charter

The European Practice Committee has the objective to be the Voice of Europe within the global organization of IPO and a voice of IPO towards European institutions. The European Practice Committee envisions a balanced representation of committee members appointed by the IPO President from all industry sectors and other categories of IPO members, with a substantial number of committee members physically located in Europe. The Committee will identify, monitor, study and recommend an IPO position on European-wide Intellectual Property Rights issues. Furthermore the Committee has the objective to disseminate and exchange information and views within global IPO regarding intellectual property issues in Europe, and to make recommendations to the IPO Board of Directors on possible harmonization of patent, trademark and copyright laws among Europe, Asia, the United States, and other regions.

Committee Agenda for 2016

Meetings:

Monthly calls will be held on a regular basis.

We are planning to continue our annual May conference which is scheduled for 12 May 2016 at the Steigenberger Metropol in Frankfurt and will be hosted by Leydig, Voit & Mayer Ltd. The proposed theme is "Combined IP Strategies for Europe and the U.S." Pending IPO approval, it is proposed to provide a discount to members of the Vereinigung von Fachleuten des Gewerblichen Rechtsschutzes (VPP), as well as to IPO members, in order for VPP to advertise the conference to its large membership in Germany and Europe. Vice Chair James Signor (of the Leydig, Voit & Mayer firm) has the lead on organizing this conference.

The meeting in 2017 is planned to be held in Paris (intended co-hosts: Veron & Associates and Cabinet Plasseraud), once IPO approves, first organizational steps will be undertaken.

Advocacy Activities:

Currently in the process of preparing an amicus brief for the EPO Enlarged Board of Appeal Referral G1/15 on partial priority. A sub-committee headed by Matthew Georgiou has prepared a proposal which will be discussed with the IPO amicus committee before moving forward.

Currently in the process of preparing IPO comments and positions for January 14, 2016 symposium in The Hague on Article 84 EPC. A paper detailing possible positions was prepared by the Chair and Vice-Chairs and will be reviewed and revised in view of comments from the committee before being submitted to the Board of IPO for approval. James Signor and Aloys Hüttermann will be attending the symposium on behalf of IPO and Mr. Signor will present the views of IPO at the symposium.

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Continued Recruitment Activities:

We plan to seek new membership with European companies and European law firms and plan to appeal directly to IPO Board members to encourage corporate IP attorneys to participate in committee activities.

We will engage our members to actively collaborate with the International Practice Committee on articles for the newsletter and actively contribute news blurbs about Europe to the *IPO Daily News*, thus continuing to ensure interest amongst the US practitioners in the European IP scene.

GENETIC RESOURCES & TRADITIONAL KNOWLEDGE

Chair: Manisha A. Desai, Eli Lilly and Company

Vice Chair: William L. Warren, Sutherland Asbill & Brennan LLP

Secretary: Rebecca Lawrence, Redd Solicitors LLP

Board Liaison: D. Michael Young, Roche Diagnostics

Committee Charter

The IPO Genetic Resources & Traditional Knowledge (GR/TK) Committee will focus on developing IPO positions relating to the intersection of genetic resource and traditional knowledge issues and intellectual property law. The goal is to develop legal frameworks for access and benefit sharing that will lead to increased international conservation and to effective and equitable utilization of genetic resources and traditional knowledge.

The Committee will advise the Board of Directors of IPO and its membership about proposed legal frameworks for access and benefit sharing, including the use of form material transfer agreements and the impact of special patent disclosure requirements. The Committee will monitor and study proposals from and provide input to other organizations, including the CBD, WIPO, WTO, USPTO, EPO, JPO and Non-Governmental Organizations (NGOs).

Committee Agenda for 2016

1. Key Accomplishments in 2015

- a. The GR/TK Committee submitted a proposal and was selected to present a Breakout Session entitled "The Nagoya Protocol: Conserving Biodiversity or Withering the Fruits of Innovation?" at the IPO Annual Meeting on September 28 in Chicago. This session examined the Nagoya Protocol, the Regulations being adopted by EU Member States, and the impact on research and development activities extending well beyond the traditional life sciences, including research and licensing scenarios that could be significantly affected. We combined three IPO committees to address this multi-faceted topic. The breakout session was moderated by GR/TK Committee Vice Chair Bill Warren, and jointly presented by GR/TK Committee member Matthew Madsen, European Practice Committee member Andreas Hübel, and Pharma/Biotech Issues Committee member Donna Perdue.
- b. The Committee held conference calls during the year to share information concerning new developments – calls were held on February 23, April 8 and November 2. The Committee also arranged several calls with members of the European Practice Committee and Pharma/Biotech Issues Committee in preparation for the Annual meeting breakout session. The Committee held an in-person meeting during the IPO Annual Meeting in Chicago on September 27, which allowed several committee members to meet in person for the first time and also introduced non-members to the work of the Committee.
- c. Committee Chair, Manisha Desai, participated in a panel discussion during WIPO's "Seminar on Intellectual Property and Genetic Resources, Traditional Knowledge and Traditional Cultural Expressions: Regional, National and Local Experiences" from March 30 to April 1, at WIPO headquarters in Geneva, Switzerland. Information about the seminar was included in IPO Daily News on April 7.

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2. *Recommendations for Committee Activities in 2016*

- a. As the mandate for WIPO's Intergovernmental Committee on GR, TK, and TCEs (IGC) was renewed, the Committee will monitor the work of the IGC and seek to ensure discussions are fact-based and reflect the concerns of the innovator community.
- b. The Committee will continue to follow implementation of the Nagoya Protocol, particularly in Europe, as well as related legislation in Brazil and China. The GR/TK Committee will influence such implementation where possible, and will seek to do so in coordination with other IPO committees.
- c. The Committee will endeavor to conduct conference calls at least quarterly, as well as an in-person Committee meeting at the next IPO Annual Meeting.

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INTERNATIONAL PATENT LAW & PRACTICE

Chair: John Treangen, The Dow Chemical Company

Vice Chairs: Mark Guetlich, Lakshmi Kumaran & Sridharan

Charles Knobloch, Arnold, Knobloch & Saunders, LLP

Holger Tostmann, Wallinger Ricker Schlotter & Tostmann

Secretary: Janet Cord, Ladas & Parry LLP

Board Liaison: Carl Horton, General Electric Company

Committee Charter

The IPO International Patent Law & Practice Committee will focus on developing IPO positions for the harmonization and simplification of the patent laws of the world regarding the acquisition and enforcement of patents. The ultimate goal is to obtain a system that provides uniform, objective, predictable, and cost effective acquisition and enforcement of patents globally.

The International Patent Law & Practice Committee will continue to study proposals from, and provide input to, USPTO, WIPO, EPO, JPO, and Non-Governmental Organizations (NGOs) to advance the harmonization of global patent laws. It will continue to attend and provide input to the WIPO Patent Cooperation Treaty (PCT) Reform discussions in Geneva, which continue to work on further enhancements to the PCT to afford a more robust, efficient and extensive platform from which a “world patent” might be filed and examined.

In order to achieve these goals, this committee will continue its support of efforts to negotiate a limited basket of harmonization provisions via the Substantive Patent Law Treaty (SPLT) and otherwise. It will also work toward the enactment of appropriate protocols for IP enforcement. In addition, the committee will work to educate judges and other professionals around the world.

The committee will continue to express IPO established views at these fora, and will recommend for adoption by the IPO Board as new proposals are presented.

Committee Agenda for 2016

1. **Committee Conference Calls:** We have monthly conference calls, both to plan our work, and to discuss items of interest. These meetings are also helpful towards our goal of educating membership on current international patent law issues and we will continue to have guest speakers from various organizations, including from WIPO, EPO, USPTO among others.
2. **Global Harmonization and Simplification of Patent Laws and Procedures:** This remains an overarching priority for our committee. Our committee will continue to monitor global and local efforts towards this priority, including attendance at relevant meetings as requested by IPO leadership.
3. **Industry IP5 and Industry Trilateral:** Related to the above priority of “global harmonization and simplification”, and as requested by IPO leadership, we will continue to represent the IPO at the Industry IP5, B+ SubGroup, and at the Industry Trilateral, including meetings with the IP5 heads of government. Among the key priorities for ongoing discussion and efforts at the IP5 is continued adoption and progress in roll-out of the Global Dossier. Larry Welch (Chair of the Asian Practice Committee), Mark Guetlich (committee Vice-Chair) and Sam Helfgott (committee member) have been particularly active on this matter and have also served as representatives of the IPO for both the Industry Trilateral and Industry IP5.

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4. **Subcommittees:** We have formed four subcommittees, each with its own chair. These subcommittees will have a particular focus on their specific areas, including identifying and monitoring legislation and legal issues in these areas. The subcommittees (and Chairs) are as follows:
 - a. Global Patent Harmonization (Mark Guetlich)
 - b. WIPO/PCT (Holger Tostmann)
 - c. International Filing Strategy and Cost Management (Roger Gobrogge);
 - d. Patent Enforceability Worldwide (Charles Knobloch)
5. **Coordination with other International Committees:** The IPO has various regional and internationally focused patent committees, including the Asian Practice Committee, the European Practice Committee, the Latin American Practice Committee, Emerging Technologies & Trade Committee, and the Canadian Practice Committee. We invite their leadership to join us on our conference calls and to jointly cooperate on topics of mutual interest. Potential topics of particular interest to our committee for cooperation include inventor remuneration and compulsory licensing.
6. **International Outreach:** Consistent with the IPO Board's desire for increased international strategic focus, our committee stands ready to assist with these activities, including through participation on the IPO's International Steering Committee.

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INTERNATIONAL TRADEMARK LAW AND PRACTICE

Chair: Matthew G. Owen, Caterpillar Inc.

Vice Chair: Elizabeth E. Houlihan, Houlihan² Patent & Trade Mark Attorneys

Secretary: Bradley J. Olson, Barnes & Thornburg LLP

Board Liaison: Thomas R. Kingsbury, Bridgestone Americas, Inc.

Committee Charter

The International Trademark Law and Practice Committee will evaluate the effects of newly implemented international treaties and national laws on international trademark prosecution and international trademark enforcement, including trade dress. The Committee will evaluate the need for legislative action to address such concerns. The Committee will also focus on developing policies and educating IPO members, the judiciary and other stakeholders regarding the value of trademark rights, the impact of relevant changes in the legal landscape of each of the various jurisdictions, and any new proactive measures owners and practitioners should take to maximize the potential benefits from international trademark rights.

Committee Agenda for 2016

Members of the newly demerged International Trademark Law and Practice Committee have already conducted two teleconferences in the first quarter of 2016 to develop a revised charter and goals for 2016 to reflect the new Committee objectives and constituency. The charter above and stated goals below have been revised to reflect these initial discussions.

Members of the Committee are identifying topics for a white paper similar in format and international scope to the paper on Shape Trade Marks published in 2015 and presented at the 2015 IPO Annual Meeting to wide positive feedback.

The Committee anticipates presenting a resolution to the IPO Board of Directors in 2016 requesting the IPO Board to issue a letter to the State Department and the Office of Foreign Assets Control (OFAC) in response to their request for comment on the merit of issuing a General License for the protection of intellectual property rights (IPR) in North Korea. U.S. based trademark owners are currently precluded from perfecting, maintaining and enforcing any forms of their IPR in North Korea.

The Committee will continue to monitor the progress of regulations/bills/laws that address international trademark law and practice, provide comment, and reach out to other industry groups, as appropriate.

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LATIN AMERICAN PRACTICE

Chair: Roberto Ribeiro, Sanofi

Vice Chair: Ricardo Nunes, Licks Attorneys

Secretary: Federico Aulmann, Obligado & Cia.

Board Liaison: Thomas P. McBride, Monsanto Co.

Committee Charter

The Latin American Practice Committee has the objective of identifying, monitoring, studying and recommending IPO positions regarding intellectual property acquisition, licensing and enforcement issues in Latin America with initial emphasis on Mexico, Brazil, Colombia, and Argentina, as well as disseminating and exchanging information and views among corporate members of IPO regarding intellectual property problems in Latin America. Regular activities of the committee will include:

1. Organizing fact finding visits to Latin America;
2. Participating in seminars and conferences within the United States and Latin America directed to Latin American IPR;
3. Developing white papers addressing acquisition, licensing and enforcement aspects of Latin American IPR; and
4. Making recommendations to the IPO Board on potential collaborations between IPO and Latin American trade associations.

Committee Agenda for 2016

1. Key Accomplishments:

- a. Almost doubled our membership between 2014 and 2015 – from 15 to 26 members from seven different countries;
- b. Held conference calls with our members every month;
- c. Provided our members with updates on important developments in Latin America, monitoring important lawsuits and pending bills;
- d. Organized a breakout session about patent law in Latin America during the IPO annual meeting in Chicago, with focus on Brazil, Colombia and Mexico;
- e. Prepared and delivered a welcome letter from IPO to the new chair of the Brazilian PTO; and
- f. Collaborated with the group in charge of assisting IPO with the preparation of the comments to be submitted to the USTR for the 2016 “Special 301 Report”.

- 2. Recommendations for Committee Activities in 2016:** We plan to organize a fact finding trip to Latin America, and continue to collaborate with other committees, including the Task Force that helps IPO to increase its international strategic focus. We will continue to seek new membership and will keep our monitoring activities. We plan to start collaborating with *IPO Daily News* and to discuss the possibility of preparing educational material to assist small and medium enterprises.

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DAMAGES AND INJUNCTIONS

Chair: Tom Brown, EMC Corp.

Vice Chair: Scott Miller, Sheppard Mullin Richter & Hampton LLP

Secretary: Karen Vogel Weil, Knobbe Martens Olson & Bear, LLP

Board Liaison: Tina Chappell, Intel Corp.

Committee Charter

The Damages & Injunctions Committee intends to identify and discuss the various legal and economic theories of intellectual property damages currently accepted by the courts, including the elements necessary to prove damages under those theories. The Committee will strive to examine, compare and contrast the damages frameworks in various intellectual property fields. Damages theories discussed will include reasonable royalty, lost profits, price erosion, and any other theory of damages that may be allowed by the courts. We will also examine the developing law in the area of injunctive relief. Papers on these topics may be drafted, and a seminar held for final discussion and review.

In addition, the Committee will consider trends in intellectual property law, including ongoing and proposed changes to the law, and evaluate the effect or expected effect of those changes on damages theory. Where appropriate, recommendations will be made to the board to formally suggest modifications to existing laws.

Committee Agenda for 2016

The Committee plans to undertake the following activities in 2016:

- The Committee has received approval to host a one-day seminar in California on issues pertaining to patent damages. This seminar is a follow-on to a similar seminar hosted by the Committee on May 27, 2015 in Washington, D.C. The Committee will continue working with the IPO leadership and staff to finalize the exact topics. The Committee will then develop a list of speakers and the substantive materials for the conference.
- Continue monthly committee calls, which include discussion of developing law in the areas of damages and injunctive relief, as well as other relevant topics.
- Continue monitoring Federal Circuit decisions, decisions from the regional Circuits and district courts, as well as legislative developments that are likely to significantly impact intellectual property litigation.
- The Committee will continue to work with IPO leadership on appropriate resolutions regarding damages and injunctions. The Committee anticipates that the one day seminar on patent damages may highlight issues on which IPO could make recommendations.
- Identify best practices relating to attorneys fee requests under Section 285, particularly in light of the recent decisions in this area by the Supreme Court.

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- Continue to identify appropriate CLE opportunities for the Annual Meeting, the Committee and the broader IPO membership. Possible topics include:
 - a. The latest case law applying and interpreting the Federal Circuit decisions regarding damages;
 - b. Best practices for establishing a demand for the patented feature when determining an appropriate measure of damages;
 - c. Best practices for determining a royalty base for reasonable royalty damages;
 - d. Best practices for determining damages in SEP, FRAND and RAND litigation;
 - e. Best practices for addressing the causal nexus requirement in cases seeking injunctive relief for multi-featured products;
 - f. Remedies available in internet piracy matters where a service provider's customers infringe a content provider's intellectual property;
 - g. The pro and con view on early summary judgment proceedings to resolve disputes regarding the applicability of the EMVR, proffered comparable licenses, and settlement license admissibility;
 - h. Standards for establishing comparable licenses and use of settlement agreements; and
 - i. Comparative patent litigation and damages, US, Europe and/or Asia.

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U.S. INTERNATIONAL TRADE COMMISSION

Chair: Robert Giles, Qualcomm Incorporated

***Vice Chair: Sarah Hamblin, Adduci, Mastriani & Schaumberg, LLP;
Elizabeth A. Niemeyer, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP***

Secretary: David Scannell, Morrison & Foerster, LLP

Board Liaison: Dan Lang, Cisco Systems, Inc.

Committee Charter

The U.S. International Trade Commission Committee will develop materials and programs to educate intellectual property owners about the opportunities, costs, challenges, and best practices for using Section 337 to enforce intellectual property rights through the U.S. International Trade Commission. It will review changes in Section 337 law and practice affecting the rights of intellectual property owners and will inform IPO members about those changes. It will also seek to identify opportunities for improvement in the current statutory, procedural, and enforcement framework and to respond to, recommend and promote changes that would enhance its value for intellectual property owners through, e.g., submission of comments and educating the public about ongoing developments. Examples of topics to be considered include establishing domestic industry under a variety of business models, the comparative costs and benefits of Section 337 actions, the benefits and restrictions of protective orders, the scope of discovery, the scope of the Commission's jurisdiction, and the requirement of proof of injury in actions arising under the common law. The Committee will interface with other IPO committees and appropriate external organizations.

Committee Agenda for 2016

The ITC Committee has identified the following projects and goals for 2016:

Ongoing Activities for 2016

1. The ITC Committee is in the process of planning a full-day program titled "Advanced ITC Litigation Conference." This program is designed for in-house professionals who would like a more sophisticated analysis of current issues under the statute and how to better manage proceedings at the ITC. The event is scheduled to occur in late May to early June, 2016, in Chicago, Illinois. We anticipate attendance and participation by numerous in-house professionals, and one or more current ITC Administrative Law Judges, following last year's format.
2. The ITC Committee anticipates submitting a proposal for an annual meeting breakout session and hopes to work with one or more other committees to submit a proposal jointly.
3. Continuing previous efforts, the ITC Committee will promote new membership, particularly from the corporate arena. To achieve this goal, the Committee will make extra effort to seek out opportunities to consult and work with other organizations with interests similar to those of the IPO in order generate cross-membership. As part of those efforts, the Commission selected Chicago as a venue for its advanced training session as an underserved geographic area for Section 337 conferences and a region that is robust in its existing IPO corporate membership.

New Activities for 2016

1. The ITC Committee will consider planning/presenting a webinar and/or CLE program addressing the major areas of ITC practice that have evolved in the last year. Given the rapidly evolving landscape of ITC litigation, it is anticipated that within the span of a year sufficient new developments will have occurred to warrant additional webinars/presentations.

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2. In an effort to increase the depth and breadth of Section 337 practice, the ITC Committee will identify potential topics for white papers and webinars, including, but not limited to:
 - a. the adjudication and enforcement of violations of Section 337 based on allegations of infringement that include electronic data in view of the Federal Circuit's decision in *ClearCorrect Operating LLC v. Int'l Trade Comm'n.*;
 - b. the ITC's pilot programs regarding dispositive issues and advisory opinions on redesigns, including the interplay with U.S. Customs and Border Protection's ("CBP") consideration of redesigns;
 - c. the upcoming rulemaking by the CBP Intellectual Property Rights Branch regarding *inter partes* proceedings
 - d. the changing landscape of how the economic prong of the domestic industry requirement is fulfilled in Section 337 litigation;
 - e. the effects that the America Invents Act is having on ITC practice; and
 - f. the effect that new adjudicators at the Administrative Law Judge, Commission, and Federal Circuit levels will have on ITC practice.
3. To build on its work related to the enforcement of Commission-issued exclusion orders, the ITC Committee will examine ways in which such enforcement can be made more effective, including an IPO initiative to increase funding for Customs.
4. In an effort to streamline proceedings at the ITC and to conserve the ITC's resources, the ITC Committee will seek out initiatives that could be used to improve ITC procedures and increase efficiency.
5. The ITC Committee will review Commission notices and potentially submit comments when solicited by the Commission and approved by IPO.
6. In order to accomplish its goals for the year, the ITC Committee will continue to hold regular conference calls.

Membership Initiatives for 2016

1. The ITC Committee will continue to promote new membership, particularly from the corporate arena including encouraging past members to continue their involvement and encourage other individuals to join the committee. The ITC Committee will seek opportunities to consult and work with other organizations with interests similar to those of the IPO in order generate cross-membership.

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LITIGATION

Chairs: Laurie Gathman Kowalsky, Koninklijke Philips N.V.;
Michael Timmons, Johnson & Johnson

Vice Chairs: David W. Long, Essential Patent LLC;
Eley O. Thompson, Foley & Lardner, LLP

Secretary: Brian Horne, Knobbe Martens, LLP

Board Liaison: Richard F. Phillips, Exxon Mobil Corp.

Committee Charter

It is very important to intellectual property owners that litigation involving their intellectual property be conducted fairly, efficiently and expeditiously. The committee will investigate ways to achieve those objectives and recommend actions to achieve positive change in patent litigation in the US. Areas of potential focus include: (a) judicial practices and procedures; (b) emerging case law; and (c) relevant statistical assessment and best practices for cost effective patent litigation management. In addition to focusing on paths to improving the litigation process and outcomes, the committee scope would include developing informational resources for the use of intellectual property owners and their management regarding the complexity, cost and risks of intellectual property litigation.

Committee Agenda for 2016

1. **Committee Meetings:** The full Committee will conduct telephonic meetings, generally at 3:00 pm Eastern on the third Thursday of the month. The Committee will also conduct ad hoc meetings among Committee or subcommittee members as necessary.
2. **Model Rules:** The Committee will continue to study model patent rules from several prominent districts and develop a set of model rules that could be utilized by districts that lack local patent rules.
3. **Education Sessions:** The Committee will develop presentations to be delivered at regular committee meetings, IPO Chat Channel webinars, or the IPO annual meeting. The committee will monitor the effect of recent changes to the Federal Rules, including pleading and discovery standards.
4. **Interplay Between IPR and District Court Litigation:** The Committee has been working with the U.S. Post-Grant Patent Office Practice Committee to develop content concerning strategies around AIA proceedings, including the ability to amend claims. However, because it appears that Congress will not propose legislation during this term, the committee does not expect to propose a formal resolution.
5. **ADR:** The committee will address issues relating to various alternative dispute resolution proceedings, including arbitration, mediation, and use of special masters.
6. **Uniformity of Privilege:** The committee will investigate the privilege afforded to communications with patent agents and foreign attorneys. The committee may create educational materials, including a white paper or presentation. The USPTO has already contacted the committee seeking speaking opportunities.
7. **Pending Legislation:** The committee will monitor pending legislation and if necessary offer resolutions to the board on proposed IPO positions on such legislation.

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INDUSTRIAL DESIGNS COMMITTEE

Chair: Quin Hoellwarth, Apple Inc.

Vice Chairs: Brent M. Dougal, Knobbe, Martens, Olson & Bear, LLP
Elizabeth D. Ferrill, Finnegan, LLP

Secretary: Anthony Prenol, Blake, Cassels & Graydon, LLP

Board Liaison: William J. Coughlin, Ford Global Technologies LLC

Committee Charter¹

The IPO Industrial Designs Committee will focus on identifying challenges in owning Design Rights around the world. The Committee will also focus on educating IPO members, the judiciary and other stakeholders regarding the value of Design Rights ownership, the impact of relevant changes in the legal landscape of each of the various jurisdictions, and any new proactive measures owners and practitioners should take to maximize the potential benefits from Design Rights ownership. In doing so, the Committee will monitor legislation, case law, and rule changes, and will proactively submit comments and recommendations for protecting Design Rights in various jurisdictions, particularly the United States, Europe, Japan, China, and Korea. Further, the Committee will coordinate its activities with other relevant IPO Committees.

Committee Agenda for 2016

1. Promote Design Protection Rights around the world and oppose legislation, lobbying and policies that propose to eliminate or minimize design protection (e.g., Replacement parts, Pre-Grant Publication, New Patent Law(s), etc.).
2. Work with patent offices around the world to educate and generate rules, guidelines and policies that are beneficial to protecting designs (e.g., written description, GUI protection, print quality, Hague Treaty, etc.).
3. Reorganize subcommittees covering at the least the following topics: Prosecution/Patent Office; Enforcement; International; Policy; Events; Designer's Perspective; and Complementary Forms of Design Protection.
4. Provide interactive sessions that foster debate about design law and actively participate in design conferences and meetings around the world (e.g., USPTO Design Day).
5. Continue to be a strong committee by developing design related content (e.g., IPO CLE session for the annual meeting and/or IPO Chat Channel).
6. Identify important issues / topics / concepts related to designs around the world, and using a focused and simple approach, develop solutions and work product that are deep and meaningful (e.g., Model Design Patent Jury instructions).

¹ In view of the inclusion of South Korea in the Industrial Design 5 (ID5) initiative, the Committee Charter should be revised to reflect all five members of ID5, including South Korea.

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7. Conduct monthly conference call the third week of every month. The committee has already conducted conference calls on January 21 and February 18, 2016.

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PATENT SEARCH

Chair: Steve Sampson, Caterpillar Inc.

Vice Chair: Ford Khorsandian, Technology & Patent Research International, Inc

Secretary: Carolyn Conrad, Assa Abloy AB

Board Liaison: Rimma Mitelman, Unilever

Committee Charter

The IPO Patent Search Committee will examine topics, and be a resource for information, related to patent searching. It will define and publicize different categories of patent searches (e.g., patentability, validity, infringement, right to practice), analyze techniques and sources for doing such searches, and identify and document best practices for reviewing and applying search results, for example, in business decisions and legal work products. In addition, the committee will work with other standing IPO committees to foster dialog and the sharing of information about subjects related to patent searching. Finally, the Committee will propose ways to educate IPO members, and in particular small businesses, the USPTO, and the general public about technology and subjects related to patent searching.

Committee Agenda for 2016

Commissioning and reviewing a patent search

The IPO Patent Search Committee will continue the preparation of a two (2) part bulletin, or hosting an IPO webinar, that will recommend (part 1) the basic information to be included in a patent search request, the method for conveying this information, and the benefit of follow-up discussions followed by (part 2) what a patent search requestor should look for when reviewing a patent search report and the benefit of follow-up discussions. The purpose of the bulletin will be to educate IP owners regardless of their individual patent search experience. The chair for this subcommittee is Michael Koptiw, of Condo Roccia Koptiw LLP.

Commissioning and reviewing a patent landscape study

The IPO Patent Search Committee will continue the preparation of a two (2) part bulletin, or hosting an IPO webinar, that will recommend (part 1) the basic information to be included in a patent landscape study request, the method for conveying this information, and the benefit of follow-up discussions followed by (part 2) what a patent search landscape requestor should look for when reviewing a patent landscape report and the benefit of follow-up discussions. The purpose of the bulletin will be to educate IP owners regardless of their individual patent landscape study experience. The chair for this subcommittee is Shayne Phillips, of Halliburton.

Refresh the Patent Search Primer

The IPO Patent Search Committee will continue preparing an update to the August 2010 “The Patent Search Primer – Guidelines from Practitioners” white paper; however, the final release of the update will occur AFTER completion and release of the “Commissioning and reviewing a patent search” and “Commissioning and reviewing a patent landscape study” bulletins.

Using patent search results

The IPO Patent Search Committee proposes the creation of a new subcommittee for the purpose of creating a bulletin, or hosting an IPO webinar, that recommends basic considerations for applying patent search results in various contexts such as maximizing the value of search results when making maintenance and/or office action response decisions and preparing opinions of counsel. The purpose of

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the bulletin will be to educate patent practitioners and IP owners regardless of their individual patent search experience. The chair for this subcommittee is Jason Rockman, of Bass, Berry & Sims PLC.

Global Dossier

The IPO Patent Search Committee proposes the creation of a new subcommittee for the purpose of creating a bulletin, or hosting an IPO webinar that updates IPO members on the current status of the IP5 Global Dossier initiative. The bulletin will explain how Global Dossier may be used by IPO members, or their outside counsel, when preparing office action responses or investigating patent family citations or patent application legal status. The chair for this subcommittee is Steve Sampson, of Caterpillar Inc.

Free Patent Search Tools

The IPO Patent Search Committee proposes the creation of a new subcommittee for the purpose of creating a bulletin, or hosting an IPO webinar, that identifies those patent search tools that are currently available to the general public free of charge. The bulletin or IPO webinar will describe the benefits and limitations of the various free patent search tools including both patent office based systems, such as Espacenet, and patent office independent search tools, such as Google Patents. The bulletin, or webinar, will discuss the most popular free patent search tools from the perspective of the IPO Patent Search Committee and provide suggestions for performing basic searches using free tools. The chair for this subcommittee is Lucy Akers, of E. I. du Pont de Nemours and Company.

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PHARMACEUTICAL & BIOTECHNOLOGY ISSUES

Chair: Paul Golian, Bristol-Myers Squibb

Vice Chairs: Mike Fuller, Knobbe Martens,
Grant Drutchas, McDonnell Boehnen Hulbert & Berghoff

Secretary: Kathryn Wade, Kilpatrick Townsend

Board Liaison: Roy Waldron, Pfizer

Committee Charter

The committee will advise the IPO Board of Directors regarding legislative changes, patent office policies, regulatory issues and judicial decisions affecting the pharmaceutical and biotechnology industry. This includes pharmaceuticals subject to the Drug Price Competition and Patent Term Restoration Act (the Hatch-Waxman Act), the Biologics Price Competition and Innovation Act (the BPCIA Act), and international counterpart laws and regulations. The committee's primary goal is to review proposed legislative and regulatory initiatives, and proactively submit comments and recommendations to the Board that reflect the proper balance between generic drug/biosimilar entry and maintaining strong incentives for the discovery, development and protection of new pharmaceutical and biological products. A secondary goal of the committee is to monitor and comment upon judicial decisions and proposed patent practice changes for the education and benefit of IPO members.

Committee Agenda for 2016

The Committee has planned the following agenda in 2016. For each topic, we plan to set up a subcommittee of interested Committee members to study the issue, prepare written recommendations or white papers, propose a Board resolution and/or take other actions as appropriate. We intend to connect with other interested IPO Committees on many of these activities.

1. Advocate for broad patent subject matter eligibility in the U.S. and internationally. Propose IPO amicus briefs in cases of key interest (e.g., *Ariosa v. Sequenom*). Provide comments following the next issuance of USPTO guidance on Patent Subject Matter Eligibility. Partner with the U.S. Patent Office Practice Committee, the U.S. Patent Law Committee, and the Software Related Inventions Committee on other areas pertaining to section 101 issues, including consideration of a legislative fix.
2. Establish a business case subcommittee that furthers the promotion of a strong patent system for pharmaceutical and biotechnology innovation.
3. Review and provide comments on draft patent reform legislation, including changes in pleading requirements, discovery procedures, fee-shifting, willfulness, estoppel arising from PGR, claim construction in PGR and IPR proceedings, and PTA calculation, obviousness double patenting and other issues.
4. Follow developments in biosimilar litigation, including court interpretation of the BPCIA.
5. Follow developments in international patent practice, with a focus on patent legislation (e.g., Indonesia and Turkey) that negatively impacts the pharmaceutical and biotechnology industries (e.g., the adoption of India Section 3(d) like provisions that have been adopted in Argentina and the Philippines). Ensure IPO fact finding participants are educated (via talking points or other

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means) on the impact the patent system has with respect to pharmaceutical and biotechnology innovation.

6. Review the status of other pending legislation, judicial decisions and regulatory proposals that impact the pharmaceutical and biotechnology industry, including those relating to drug importation, biosimilars, authorized generics and “reverse payment” settlements.
7. Review changes globally to patent office regulations, guidance and practices that affect the ability of pharmaceutical and biotechnology companies to obtain and defend patents on related subject matter; and laws, regulations and court practices/conditions that negatively affect the enforceability of pharmaceutical and biotech patents.
8. Develop CLE Proposals for the IPO Annual Meeting.

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SOFTWARE RELATED INVENTIONS

Chair: James T. Hagler, Qualcomm, Inc.

Vice Chairs: Timothy Kang, Mannava & Kang, P.C

Robert P. Lord, Osha Liang, LLP

Secretary: Eli Mazour, Harrity & Harrity, LLP

Board Liaison: BJ Watrous, Apple Inc.

Committee Charter

The Committee will advise the President, the Executive Director and the Board of Directors of IPO regarding issues relating to the USPTO practices and substantive law for software, business method and other computer-implemented inventions. The Committee will continue their open communication with members of the USPTO to discuss the present practice and procedures of the USPTO with regard to Software and Business Method Patents and explore possible enhancements to these practices and procedures. The committee will continue to review the state of the law in the United States, Europe and other countries and geographies and any future proposed legislative initiatives and if appropriate submit recommendations regarding such initiatives.

Committee Agenda for 2016

This year, we are going to continue to focus on identifying challenges and solutions for those seeking intellectual property rights for software related innovations. The following is a sampling of what we covered or plan to cover during our monthly calls in 2016:

- Ongoing updates on proposals for US legislation to deal with § 101 issues
- Presentation by **Robert Bahr, Deputy Commission for Examination Policy at USPTO** regarding developments at the USPTO
- Presentation regarding drafting software patents
- Presentation, by in-house counsel, regarding evolving strategies for building patent portfolios

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U.S. PATENT LAW

Chair: *Scott Pojunas, Hewlett Packard Enterprise*

Vice Chairs: *Gary Ropski, Brinks Gilson & Lione; Ognian Shentov, Jones Day*

Secretary: *Shaun Zhang, Hewlett Packard Enterprise*

Board Liaison: *Gary Ganzi, Evoqua Water Technologies LLC*

Committee Charter

The committee will advise the President, the Executive Director and the Board of Directors of IPO regarding legislative changes to United States patent law. The committee will review proposed legislative initiatives and proactively submit recommendations for legislative changes that would enhance United States patent law. The committee will educate IPO members regarding the provisions of enacted legislation.

Committee Agenda for 2016

In January and February, the leadership team developed a strategy for 2016 and established a more formal structure for the committee, including three new subcommittees. The following summary details the charter for each of the subcommittees, highlights current projects, and addresses other committee initiatives.

- 1. Proposed Patent Legislation Subcommittee:** This subcommittee will proactively develop legislative proposals to enhance U.S. patent law. The subcommittee is currently working on the following initiatives:
 - Inequitable Conduct:** The subcommittee is exploring whether to codify the judicially-created inequitable conduct doctrine, such as the standard set forth in *Therasense*.
 - Participation in § 101 Task Force:** Last year, IPO launched the § 101 Task Force based in part on a proposal presented to the IPO Board of Directors by the U.S. Patent Law Committee. Members of our committee continue to actively participate in the Task Force, including Marian Underweiser from IBM, who is Chair of the Task Force.
- 2. Pending Patent Legislation Subcommittee:** This subcommittee will monitor pending legislation, educate the committee on such legislation, and propose IPO positions on patent law issues in pending litigation. The subcommittee is currently working on the following initiative:
 - Trans-Pacific Partnership:** The subcommittee is analyzing the IP provisions of this trade agreement, which the U.S. signed with 11 other nations on February 4, 2016. In particular, the subcommittee is evaluating whether legislation will be necessary to align U.S. patent laws with the treaty.
- 3. Education Subcommittee:** This subcommittee will educate the committee on patent law developments, such as enacted legislation, case law, rules, and USPTO initiatives. The subcommittee will also be responsible for suggesting topics and organizing panels for IPO conferences. At our March committee meeting, the subcommittee will summarize the *Halo* and *Stryker* cases on willfulness and provide a recap of the Supreme Court oral arguments held on February 23.

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4. **Collaboration with Other Committees:** Our leadership team contacted leaders from other committees, including the U.S. Patent Office Practice, U.S. Post-Grant Patent Office Practice, and Litigation committees. Given the broad range of expertise on our committee, we plan to assist these committees with their initiatives.

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U.S. PATENT OFFICE PRACTICE

Chair: Kaveh Rashidi-Yazd, Siemens Corporation

Vice Chairs: Courtenay C. Brinckerhoff, Foley & Lardner

Sunjeev Singh Sikand, RatnerPrestia

Peggy Focarino, Oblon, McClelland, Maier & Neustadt, L.L.P.

Secretary: Aamir Haq, Hewlett Packard Enterprise

Board Liaison: Manny W. Schechter, IBM Corp.

Committee Charter

The Committee will work to improve patent office practices in the USPTO. To that end, the Committee will:

1. Study and report on changes in patent practice proposed by the USPTO for adoption, with special attention to pre-grant practice. When appropriate, the Committee will recommend to the IPO comments on such suggested changes in patent practice;
2. Survey the Committee membership for feedback on and changes to patent practice that can be recommended to the USPTO for implementation. Collect, analyze and report to appropriate USPTO officials feedback including suggestions and proposals for changes to patent practice and develop recommendations for changes in the Patent Statute. The Committee will identify the most important changes and will work with relevant government officials and the appropriate legislative bodies to have such changes implemented;
3. Foster additional dialog between the IPO and the Patent Office by holding periodic meetings with the Commissioner and other executives;
4. Work with other Patent Division Committees to conform/harmonize U.S patent practice to international standards, and to coordinate other activities relevant to this Committee's charter with those Division Committees; and
5. Organize, sponsor and co-sponsor educational sessions on patent practice, including assisting in IPO's Patent Bar & Office Dialog Summit (formerly known as "PTO Day") planning activities.

Committee Agenda for 2016

1. Continue the committee's efforts to hold at least one in-person meeting with USPTO officials to discuss patent office practice.
2. Review and respond to proposed rules changes by the USPTO as they are published in the Federal Register.
3. Communicate IPO's interest in working closely with USPTO's evolving leadership.
4. Monitor and comment on USPTO quality initiatives, effects on appeal and pendency, and the key role played by Supervisory Patent Examiners.
5. Offer suggested IPO policy positions on patent practice, and work closely with other IPO Committees and PPAC on issues of patent office practice, particularly related to examination practices under the AIA.
6. Sponsor IPO Annual Meeting topics, participate in web-based seminar panels, and prepare reports and papers.
7. Participate on IPOEF's Patent Bar & Office Dialog Summit Program Committee.

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Year-to-date Activities

Thus far in 2016, the Committee has:

1. Conducted teleconferences in January and February;
2. Participated in the Patent Bar & Office Dialog Summit program committee - a number of our Committee members are expected to participate as panelists;
3. Conducted a vote and submitted to the IPO Board a Resolution on Modernization of the U.S. Patent Examination System (approved at January 2016 Board Meeting);
4. Created a subcommittee to look into issues regarding the USPTO's December 2015 power outage issues (and the USPTO Director's authority to declare a Federal Holiday);
5. Prepared and submitted comments to the USPTO including patent quality-related topics for study in response to the USPTO's Fed. Reg. Notice regarding "Request for Submission of Topics for Quality Case Studies";
6. Met with Patent Law Committee to discuss joint initiatives; and
7. Continued to prepare proposals for a legislative fix to Patent Act Section 101 along with other committees.

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U.S. POST-GRANT PATENT OFFICE PRACTICE

Chair: Bernard Graves, Eastman Chemical Co.

Vice Chairs: Eric Cohen, Brinks Gilson & Lione
Erika Arner, Finnegan

Kevin Greenleaf, Dentons US

Secretary: Eleanor Yost, Goodwin Procter

Board Liaison: Henry Hadad, Bristol-Myers Squibb Co.

Committee Charter

The Committee's areas of responsibility include all aspects of post-grant patent practice in the U.S., including interferences, post-grant review, inter partes review, inter partes reexamination, ex parte reexamination, supplemental examination, derivation proceedings, transitional program for covered business method patents, and reissue proceedings.

The Committee plans to continue to study issues raised by the IPO Board of Directors ("Board"), the Director of the United States Patent and Trademark Office (via rulemaking proposals), the Patent Trial and Appeal Board, and the members of the Committee, related to post-grant proceedings in the United States Patent and Trademark Office.

Further the Committee will continue to consider decisions, legislation, and proposed rule changes concerning formal and substantive issues concerning such proceedings. In addition, the Committee may make recommendations to the Board concerning the "just, speedy, and inexpensive" administration of post-grant proceedings. After receiving approval from the Board, the Committee will report any approved recommendations to the U.S. Patent and Trademark Office, the Trial Division, or the Patent Trial and Appeal Board, as appropriate, on behalf of the IPO.

Committee Agenda for 2016

- Planning and preparation for IPO-sponsored PTAB practice conference
- Reporting and monitoring of PTAB rule changes
- Advising on PTAB fee changes
- Advising on *Cuozzo v. Lee* at United States Supreme Court
- Monitor and advise on legislation, including possible examination off-ramp
- Monitor and advise on other federal register notices and important cases
- Help develop content for IPO conferences

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WOMEN IN IP LAW

Chair: Laura Sheridan, Google Inc.

Vice Chair: Mercedes Meyer, Drinker, Biddle & Reath, LLP

Vice Chair: Priya Prasad, Exxon Mobil Corp.

Secretary: Shruti Costales, Law Office of Shruti Costales, PLLC

Board Liaison: Barbara Fisher, Lockheed Martin

Committee Charter

The committee will seek to promote the advancement of women in IP law and to increase the diversity of IPO's membership. The committee will develop programming and initiatives on topics relevant to this goal, and will engage with other standing committees to collaborate on items of interest to the membership at large. The committee will interface with women in IP law across the community, including women working in corporations, law firms, universities, and government.

Committee Agenda for 2016

The Women in IP Law Committee is a new committee for 2016. In spite of being a new committee, our membership has grown to 32 members. The committee meets monthly and has had two meetings to date, in January and February. During our February meeting, we had our first outside speaker, Meg Boulware of Boulware & Valoir. Meg shared her experiences as a woman in IP law, and provided data on the representation of women in the profession. Our next meeting is on March 18, and we are thrilled to have Hope Shimabuku, the Director of the Texas Regional USPTO, as our external guest speaker.

In furtherance of our charter, our committee is hosting its first event on March 14, a reception for IPO's Patent Bar & Office Dialog Summit in collaboration with the IPO Education Foundation. The reception is co-sponsored by Drinker Biddle and Schwegman Lundberg & Woessner, thanks to committee members Mercedes Meyer and Susan Yee, respectively. We have invited Sarah Harris, USPTO's General Counsel, to speak at the reception. We are also working with the IPO Education Foundation to plan a Girl Scout IP Patch event in May, potentially in collaboration with the USPTO. We are excited to have events planned for March and May to firmly establish our committee within IPO. Beyond these events, our committee is in discussions with the USPTO to collaborate on their All in STEM initiative, which is a major focus of Director Lee's in 2016.

The committee does not anticipate presenting a report or resolution to the IPO Board of Directors at this time.

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ANTI-COUNTERFEITING

Chair: Philip K. Yu, DuPont

Vice Chair: Monica Riva Talley, Sterne Kessler Goldstein & Fox PLLC

Secretary: Aslam Mohamed, RNA IP Attorneys

Board Liaison: Douglas Norman, Eli Lilly and Co.

Committee Charter

The Anti-Counterfeiting Committee will focus its work on identifying global challenges and enforcement opportunities in anti-counterfeiting. The Committee will also focus on educating IPO members, practitioners, and other stakeholders regarding the costs (reputational, safety, etc.) of counterfeiting, and developing policies and proactive measures to support key issues in global anti-counterfeiting.

Committee Agenda for 2016

Members of the newly reinstated Anti-Counterfeiting Committee have conducted two teleconferences to develop a new charter and goals for 2016 to reflect the new Committee objectives and constituency.

In accordance with the Committee's discussion for the new term, the proposed objectives for 2016 are:

- Surveying IPO members on their counterfeit problems;
- Educating IPO members, practitioners and other stakeholders about:
 - Impact of online and cross-border counterfeiting;
 - Health and safety issues; and
 - Reputational, economic, and other business concerns.
- Presenting resolutions to the IPO Board of Directors for support of key issue(s) in global anti-counterfeiting, including the resolution addressing amendment to the definition of a counterfeit mark 18 USC 2320.
- Monitoring developments in legislation, regulation and enforcement in key markets.

Also, the Committee will coordinate its activities with other IPO Committees, as well as external experts, to improve its reach to IPO members.

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DOMAIN NAMES & SOCIAL MEDIA

Chair: Jake D. Feldman, Johnson & Johnson

Vice Chairs: David A. Einhorn, Baker & Hostetler LLP
Joshua S. Jarvis, Foley Hoag LLP

Secretary: Anne E. Naffziger, Leydig, Voit & Mayer, Ltd.

Board Liaison: Steven Wildfeuer, RELX Group Plc

Committee Charter

The Committee plans to investigate issues and take actions to further the interests of IPO members with respect to domain names and social media issues. Specifically, with respect to domain names, the Committee plans to monitor and seek to influence the activities of the Internet Corporation for Assigned Names and Numbers (ICANN) and with various domain registries with respect to existing TLDs and with respect to the creation and launch of new gTLDs including, but not limited to, whether the creation, allocation, launch, and operation of new gTLDs are fair and are accompanied by appropriate intellectual property rights protection mechanisms (e.g., IP claims, sunrise claims, dispute resolution procedures, etc.). The Committee will also monitor developments with respect to the transfer of control of NITA functions to ICANN and consider what efforts would be valuable to the IPO community to ensure a fair and free Internet. The committee also plans to monitor the Trans-Pacific Partnership Agreement, as it relates to domain names.

Where appropriate, the Committee will make recommendations to IPO for submission to ICANN, and/or participation with ICANN's processes, as well as other governmental and regulatory bodies. The Committee will also monitor developments regarding the UDRP and other dispute resolution procedures, developments of the Anti-cybersquatting Consumer Protection Act, and other resources available to trademark owners to assist them in re-capturing infringing domain names from cybersquatters.

With respect to social media issues, the Committee plans to stay abreast of developments in this space and regularly devote a section of its monthly call to "hot topics" in social media. Other areas of exploration will include general education of the membership on legal issues in social media, practical guidance on the use of third party content on social media, best practices for enforcing rights through social media, issues involving employee use of social media, issues relating to trademark bullying in social media, and the development of company social media policies.

The Committee plans to keep IPO membership apprised of new and continuing developments in these areas, and plans to poll IPO's members periodically to determine their interests in these issues and address additional topics as they are raised and agreed upon by its members. The Committee will develop project teams to execute upon these topics and will coordinate its work as appropriate with other committees in IPO's Trademark Division.

Committee Agenda for 2016

The Committee continues to closely monitor ICANN's new gTLD program, send a representative to attend ICANN meetings (when possible/practical), and prepare comments and letters for IPO leadership to send to ICANN and the U.S. government to influence gTLD policy and implementation, where and when necessary. In 2016, the Committee plans to continue these critical activities, as well as address other domain name-related issues as they arise.

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For 2016, David Einhorn is the official IPO liaison to the Intellectual Property Constituency (IPC) of ICANN, and Joshua Jarvis intends to monitor and participate in IPC activities as necessary.

The Committee anticipates continuing to participate in the ICANN comment process throughout 2016. The Committee will also be coordinating with ANA and CRIDO and other intellectual property rights organizations with respect to gTLD issues, will continue to participate in relevant meetings of the NTIA, and will draft positions letters to NTIA when appropriate.

The Committee intends to monitor legal issues related to social media generally, as well as existing and emerging social media platforms specifically, and identify intellectual property concerns critical to the IPO membership. The Committee will continue to explore how best to provide assistance to brand owners in the field of social media, whether through policy or through education. Project teams will consider developing educational materials for IPO brand members to assist in developing strategies for enforcing rights of brand owners in this quickly evolving social media space.

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U.S. TRADEMARK LAW

Chair: Valerie Verret, Exxon Mobil Corporation

Vice Chairs: Erin S. Hennessy, Bracewell LLP;

Wendy Larson, Pirkey Barber PLLC

Secretaries: Alicia Morris Groos, Norton Rose Fulbright US LLP;

Jennifer Ashton, Bracewell LLP

Board Liaison: Steven W. Miller, Procter & Gamble Co.

Committee Charter

The Committee will identify and comment upon federal and state legislative activities that would or are likely to significantly affect U.S. trademark law and practice. The Committee will also work in cooperation with the Amicus Brief Committee to identify opportunities for the IPO to consider filing *amicus* briefs in trademark cases in appropriate circumstances. Where appropriate, the Committee will recommend positions that the IPO executive leadership may choose to advocate. The Committee will poll its membership on topics to be considered and will coordinate its efforts with other committees as appropriate.

Committee Agenda for 2016

- The Committee has scheduled monthly conference calls for the third Thursday of the month at 3:00 pm ET. The Committee has had two calls so far in 2016 as well as one special call to discuss a proposed board resolution.
- The Committee will submit a resolution for the Board to consider at its March meeting recommending that the Board support amending the Lanham Act remedies section to provide a presumption of irreparable harm upon a finding of a likelihood of confusion or dilution. As part of the project, the Committee has researched the relevant case law and considered similar positions taken by the AIPLA and the ABA.
- The Committee has formed working groups to evaluate the following new projects:
 1. Analyze recent cases involving trade dress to determine if recent decisions have effectively reduced protection for trade dress;
 2. Collaborate with the Anti-Counterfeiting Committee on addressing the challenges of combating gray market goods; and
 3. Research court decisions for any judicial determinations that a trademark owner is a “bully” to evaluate whether further education or action should be taken.
- In addition, the Committee anticipates working on the following projects:
 1. Following developments in the *Pro-Football v. Blackhorse* and *In re Tam* cases for potential opportunities to recommend legislative changes or Amicus Brief Committee consideration.
 2. Surveying parody cases and reporting on new developments on monthly committee calls as appropriate.
 3. Considering options for combatting genericide and evaluating whether to offer an IP Chat Channel Topic or an Annual Meeting presentation on the subject.

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4. Suggesting topics for a 90 minute presentation or panel at the IPO Annual Meeting in New York in September.

It is anticipated that there will be numerous occasions during the year for the Committee to collaborate with other IPO Committees, including the U.S. Trademark Office Practice Committee, Anti-Counterfeiting Committee, Domain Names and Social Media Committee, and International Trademark Law and Practice. The Committee Chair and Vice-Chairs expect to reach out to the leadership of those committees to coordinate on areas of interest to the various committees.

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U.S. TRADEMARK OFFICE PRACTICE

Chair: Tara Rosnell, Procter & Gamble

Vice Chair: Allison Strickland Ricketts, Fross Zelnick Lehrman & Zissu, PC

Secretary: Chris Graff, Pirkey Barber, PLLC

Board Liaison: Steven J. Shapiro, Pitney Bowes Inc.

Committee Charter

The Committee will study and report on issues relating to the quality, timeliness, budget and efficiency of the U.S. Patent and Trademark Office. The Committee plans to continue to explore ways to streamline and improve trademark registrations and will make recommendations for appropriate legislation, practice, and rules changes to effect such registration improvement. Among other things, the committee will look at the USPTO funding process, will monitor the USPTO Trademark Public Advisory Committee and will track pertinent U.S. legislation. The Committee may look at foreign legislation and processes in evaluating recommendations for legislative, rules and practices changes. The Committee plans to address additional topics as they are raised and agreed upon by its members. The Committee will coordinate its work with appropriate committees.

Committee Agenda for 2016

The Committee will send representative Allison Strickland Ricketts to the March 3 external stakeholder forum to discuss the look and feel of TTABVue, TTAB's electronic docketing system.

The Committee will send representatives Allison Strickland Ricketts and Vanessa Pierce Rollins to the meeting of IP Associations on March 11 at the IPO office.

The Committee will send representatives to participate in a face to face meeting with the Commissioner of Trademarks in June, as well as assist with the planning of PTO day.

The Committee will continue to assist the U.S. Trademark Office with projects for which they seek public input by participating in focus groups or roundtable discussions as well as submitting comments to Federal Register Notices, Proposals and Requests for comment when appropriate.

The Committee will send representatives Allison Strickland Ricketts and Tara Rosnell to participate in a focus group organized by Deloitte Consulting on behalf of the USPTO to better understand the USPTO consumer experience.

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AMICUS BRIEF COMMITTEE

Chair: Steven W. Miller, Procter & Gamble Co.

***Vice Chair(s): Meg Boulware, Boulware & Valoir; Paul H. Berghoff,
McDonnell Boehnen Hulbert & Berghoff LLP***

Committee Charter

The IPO Amicus Brief Committee shall assist the Board of Directors in determining whether the organization should file an amicus brief related to an important intellectual property issue pending a judicial or administrative matter. In general, the committee will first decide whether an issue significantly impacts the value of intellectual property rights or the ability of owners of intellectual property to enforce such rights. In making its recommendation to the Board, the committee will not only consider the interests of owners of intellectual property, but also the rights of the public. If the committee recommends IPO participation in a matter, and the Board approves, the committee shall then ensure that an appropriate brief is drafted, approved, and submitted to the court or administrative agency.

Committee Agenda for 2016

Currently in the committee:

- 30 requests were received during the past year. This number includes cases in which certiorari or en banc rehearing was granted, as the Committee reviews all such cases.
- 12 briefs filed since the last Committee Leadership Meeting:
 - *SCA Hygiene Products AB v. First Quality Baby Products, LLC*
 - **Issue:**
 1. Whether *Aukerman* should be overruled so that the defense of laches is not applicable to bar a claim for damages based on patent infringement occurring within the six-year damages limitation period established by 35 U.S.C. § 286 and
 2. Whether the defense of laches should be available under some circumstances to bar an entire infringement suit for either damages or injunctive relief.
 - Filed with assistance from JonesDay at the Federal Circuit on March 6, 2015.
 - *In re Cuozzo*
 - **Issue:**
 1. Whether Congress intended the broadest reasonable interpretation to be used in inter partes reviews, or whether it intended each claim of a patent to be construed as such claim has been or would be in a civil action to invalidate a patent under 35 U.S.C. § 282 and
 2. Whether the America Invents Act granted the USPTO broader rulemaking authority than 35 U.S.C. § 2(b).
 - Brief supporting petition for en banc rehearing filed with assistance from Kelley Drye & Warren LLP and Leydig, Voit & Mayer, Ltd. on April 6, 2015.
 - *Akamai Techs., Inc. v. Limelight Networks, Inc.*
 - **Issue:** Whether direct infringement of a method claim “exists when all of the steps of the claim are performed by or attributed to a single entity” such as in a principal-agent, contractual, or joint enterprise relationship.

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- Brief supporting petition for en banc rehearing filed with assistance from McDonnell Boehnen Hulbert & Berghoff LLP on June 26, 2015.
- *Immersion Corp. v. HTC Corp., HTC America, Inc.*
 - **Issue:** How 35 U.S.C. § 120 applies when a continuation application is filed on the same day as the parent patent issues.
 - Brief supporting Immersion's initial appeal to the Federal Circuit filed with assistance from Covington & Burling LLP on August 12, 2015.
- *Lexmark International, Inc. v. Impression Products, Inc.*
 - **Issue:**
 1. In light of Supreme Court's opinion in *Kirtsaeng* regarding copyright exhaustion, "should this court over rule *Jazz Photo Corp.*...to the extent it ruled that a sale of a patented item outside the United States never gives rise to United States patent exhaustion and
 2. In light of the Supreme Court's opinion in *Quanta Computer*, "Should this court overrule *Mallinckrodt, Inc.*... to the extent it ruled that a sale of a patented article, when the sale is made under a restriction that is otherwise lawful and within the scope of the patent grant, does not give rise to patent exhaustion?"
 - Brief in the en banc rehearing was filed with assistance from RPT Legal Strategies PC on August 19, 2015.
- *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*
 - **Issue:**
 1. Whether a claimed method must be considered as a whole for purposes of determining patent eligibility and
 2. Whether evidence that a claim does not unduly preempt use of ineligible subject matter strongly support patent eligibility?
 - Brief filed supporting the en banc petition with assistance from Heslin Rothenberg Farley & Mesiti, P.C. on August 27, 2015.
- *Cuozzo Speed Techs., LLC v. Michelle K. Lee*
 - **Issue:** Whether the broadest reasonable interpretation of a patent claim is the proper standard for inter partes review.
 - Brief supporting the cert. petition was filed with assistance from Shook, Hardy & Bacon L.L.P. on November 9, 2015.
- *Halo Elecs., Inc. v. Pulse Elecs., Inc. et al. and Stryker Corp., et al. v. Zimmer, Inc. et al.*
 - **Issue:**
 1. Whether the Federal Circuit erred by applying a rigid, two-part test for enhancing patent infringement damages under 35 U.S.C. § 284,
 2. Whether the Federal Circuit improperly abrogated the plain meaning of 35 U.S.C. § 284 by forbidding any award of enhanced damages unless there is a finding of willfulness under a rigid, two-part test, and
 3. Whether a district court has discretion under 35 U.S.C. § 284 to award enhanced damages where an infringer intentionally copied a direct competitor's patented invention, knew the invention was covered by multiple patents, and made no attempt to avoid infringing the patents on that invention.

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- Brief filed at the Supreme Court with assistance from McDonnell Boehnen Hulbert & Berghoff LLP on December 16, 2015.
- *The Medicines Co. v. Hospira, Inc.*
 - **Issue:** Whether the “supplier exception” to the on sale bar of 35 U.S.C. § 102(b) constitutes commercial exploitation of the invention to trigger the start time for a product being on sale.
 - Brief in en banc rehearing filed with assistance from Akin Gump Strauss Hauer & Feld LLP on February 5, 2016.
- *European Patent Office Enlarged Board of Appeal Case G1/15*
 - **Issue:** Questions referred to the EBA in this case relate to how priority entitlement is asserted in Europe, particularly in the case of partial priority. The questions also address the issue of “toxic divisionals.”
 - Brief filed with assistance from the IPO European Practice Committee on February 12, 2016.
- *Kirtsaeng v. Wiley*
 - **Issue:** What is the appropriate standard for awarding attorneys’ fees to a prevailing party under § 505 of the Copyright Act?
 - Brief filed at the Supreme Court with assistance from One LLP on March 7, 2016.
- *Cuozzo Speed Techs., LLC v. Michelle K. Lee*
 - **Issue:**
 1. Whether the court of appeals erred in holding that, in IPR proceedings, the Board may construe claims in an issued patent according to their broadest reasonable interpretation rather than their plain and ordinary meaning and
 2. Whether the court of appeals erred in holding that, even if the Board exceeds its statutory authority in instituting an IPR proceeding, the Board’s decision whether to institute an IPR proceeding is judicially reviewable.
 - Brief filed with assistance from Shook, Hardy & Bacon L.L.P. on March 7, 2016.

Please see amicus committee procedures and instructions on submitting a request for an amicus brief on the following page.



Submitting Requests for an Amicus Brief to Intellectual Property Owners Association (IPO)

Materials to be Included in a Request for Amicus Support

Requests by a party in a case must include the following:

- A short paper (no more than three (3) pages) describing the underlying position of the litigants,
- Copies of relevant pleadings, motions, decisions, or other papers to reflect the nature of the controversy,
- The name and email addresses of lead counsel of all parties involved in the litigation, and
- The names of other organizations from which amicus support has also been requested.

THE PARTY REQUESTING AMICUS SUPPORT SHALL SEND A COPY OF THE REQUEST TO LEAD COUNSEL OF ALL OTHER PARTIES INVOLVED IN THE LITIGATION AND INFORM THEM THAT THEY ARE FREE TO MAKE SUBMISSIONS TO IPO WITHIN THREE (3) BUSINESS DAYS OF THE ORIGINAL REQUEST.

Requests by an IPO committee must include the following:

- A short paper (no more than three (3) pages) describing the underlying position of the litigants, the reasons for which the Committee believes IPO should participate as amicus and the position the Committee recommends IPO take in the case,
- Copies of relevant pleadings, motions, decisions, or other papers to reflect the nature of the controversy,
- The name and email addresses of lead counsel of all parties involved in the litigation, and
- If the case is not in an American court, the request should include the name of the relevant court and due dates for amicus briefs.

Submitting Requests:

Please note that the committee needs at least 30 days to review the request and draft and print a brief. Requests submitted within that 30-day period will have a significantly decreased chance of being fulfilled.

Requests are to be submitted via email to the Chair of the Amicus Brief Committee, Steven Miller, in care of Robin Muthig at RMuthig@ipo.org. For more information on procedures, contact Ms. Muthig at (202) 507-4514. Also, for more information see the Amicus Brief Committee Procedures at www.ipo.org/Amicus.

Review and Notification

The Amicus Brief Committee will review completed requests. All requests will be acknowledged when received. If the committee favors the request it will be submitted to the IPO Board of Directors for a vote. The requester and opposing counsel will be notified of the action taken on the request.



2016 IPO Standing IP Committee Policy Manual

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TABLE OF CONTENTS

This manual provides a blueprint for IPO committee operations during the calendar year. It explains how committees are organized and how appointments are made, defines the role of the different types of committee members, highlights the primary responsibilities of committee leadership and outlines the schedule of committee activities and deadlines for the year. For questions about IPO committees, contact the IPO office at (202) 507-4500 or committees@ipo.org.

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I. INTRODUCTION

IPO Governance

Directors

Most members of the Board of Directors (<http://www.ipo.org/index.php/about-ipo/board-of-directors/>) are chief intellectual property counsel for their company. Five members of the Board are regular corporate members of IPO. They are elected for two year terms, which may not be renewed. Sustaining corporate members are elected for two year terms which may be renewed for a second consecutive term. There are 44 sustaining corporate Board members. There is one inventor member of the Board. This individual is elected for a two-year term which may be renewed. Board members are nominated by the Nominations Committee and elected by the IPO membership at the Annual Meeting.

Officers

Officers include the IPO President, Vice-President, Treasurer, and Secretary. The President, Vice-President, and Treasurer are elected by the IPO Board of Directors. The Executive Director serves as the secretary.

Executive Committee

The IPO Executive Committee (<http://www.ipo.org/index.php/about-ipo/committees/executive-committee/>) is a nine-member committee, which has the authority to act on behalf of the Board in between meetings of the Board. It is comprised of the IPO President, Vice-President, Treasurer, immediate past-President, IPO Education Foundation President, and four members elected to the Executive Committee from among the Board members. The four elected members of the committee serve two year terms, which are staggered.

Strategic Plan

The IPO Board of Directors engages in strategic planning exercises every three years. The plan may be executed by various means including task forces.

Nonprofit Status IRC § 501(c)(6)

IPO is a 501(c)(6) nonprofit organization. Internal Revenue Code § 501(c)(6) provides for exemption of business leagues, chambers of commerce, real estate boards, boards of trade, and professional football leagues (whether or not administering a pension fund for football players), which are not organized for profit and no part of the net earnings of which inures to the benefit of any private shareholder or individual. The regulations define a business league as an association of persons having a common business interest, whose purpose is to promote the



common business interest and not to engage in a regular business of a kind ordinarily carried on for profit. Its activities are directed to the improvement of business conditions of one or more lines of business rather than the performance of particular services for individual persons. 26 C.F.R. § 1.501(c)(6)-I; see <http://www.irs.gov/pub/irs-tege/eotopick03.pdf>

Board Meetings

The IPO Board meets five times per year: 1) in January; 2) in conjunction with the IPO Committee Leadership meeting, usually in March (Washington, DC); 3) in May or June (Washington, DC); 4) at the IPO Annual Meeting, in September; and 5) in conjunction with the IPO Education Foundation's Awards Dinner, in December (Washington, DC).

Standing Committees

IPO Committees report to the IPO Board of Directors, which is the governing and policy-setting body of the organization and operates under a certain vision and principles (<http://www.ipo.org/index.php/about-ipo/>).

IPO currently has 31 standing IP committees (subject to change on a yearly basis), organized in eight divisions (see <http://www.ipo.org/index.php/about-ipo/committees/standing-ip-committees-listing/> for the current committees and their leadership):

- Antitrust and Competition Law
- Business Issues
- Copyright
- International IP Law and Practice
- Litigation and Dispute Resolution
- Patents
- Trademarks
- Professional

Each standing IP committee is devoted to some aspect of IP law or business of interest to IP owners. All IPO members are eligible to be appointed to a standing IP committee including any employee, partner, or associate in a member company or law firm. Appointments to committees are made by the IPO President.

Committees are made up of chair(s), vice chair(s), a secretary, members, a board liaison, and a staff liaison.

The IPO President appoints chair(s) and vice chair(s) to each standing IP committee along with a board liaison selected from the IPO Board of Directors. Committee chairs are appointed from IPO's corporate members, and vice chairs are typically selected from IPO's law firm members. The committee secretary is selected by the chair(s) and vice chair(s).



Requests to add individuals to a committee must be submitted to the IPO office (www.ipo.org/committeesignup) for official appointment and to ensure that the member is added to the committee roster. Only IPO members can join an IPO committee. Nonmember participation on an IPO committee is prohibited, except when invited as a special guest speaker.

IPO also maintains a number of board-level Management Committees. Appointment to these committees is usually limited to IPO Board of Directors and is made by invitation only.



II. EXPECTATIONS FOR COMMITTEE LEADERS AND MEMBERS

Committee Chairs and Vice Chairs

Committee chairs and vice chairs are appointed by the IPO President for one-year terms. Chairs and vice chairs are sometimes reappointed for additional terms, but the number of reappointments may be limited to give other members an opportunity to serve as chairs and vice chairs. The current terms end in December of this year. Chairs are selected from corporate members of IPO and vice chairs are generally selected from law firm members, though corporate members may also serve as vice chairs. More than one chair or vice chair may be appointed if the committee has a large membership or significant need due to anticipated project volume.

Although the number and scope of projects undertaken by a given committee will vary, chairs and vice chairs should expect to devote an average of two - three hours a month working with their committee. Committee leaders are strongly encouraged to attend IPO meetings held throughout the year, including the March Committee Leadership Meeting and September IPO Annual Meeting. Chairs and vice chairs should update IPO staff with any changes to contact information during their term.

Committee chairs and vice chairs are encouraged to recruit IPO members to join their committee. Chairs and vice chairs are also responsible for helping to identify potential future leaders on committees.

Committee Secretaries

Committees are required to appoint a committee secretary. Committee secretaries are appointed for one-year terms by the chair(s) and vice chair(s). The role of the secretary is to send out reminders and agendas, take roll, produce the minutes of all committee calls, count and summarize committee votes, and assist committee leadership as directed by the chair(s) and vice chair(s). Secretaries may dial-in to committee calls as the host in the event the staff liaison is not able to open the call.

Committee Members

Committee members are appointed for two-year terms ending in December 2017. Members typically should expect to devote an average of one - two hours a month to work on a standing IP committee. At the end of each two-year period, IPO will delete the committee member lists and solicit new members. Individuals can apply for reappointment to the same committee or appointment to a different committee. Like chair and vice chair appointments, members are appointed by the IPO President.



IPO members can serve as a voting member on one committee. Voting members are expected to participate substantively in discussions, draft letters and resolutions, vote on proposed resolutions and reports, and to dial in to as many calls of the committee as possible. It is the discretion of the chair(s), vice chair(s), and staff liaison to assess if voting members have been actively participating and to reclassify a member as non-voting if active participation is not maintained.

IPO members can serve as a non-voting member on up to three committees. Non-voting members participate in committee calls and receive all communications of the committee, but do not vote on reports and proposed resolutions going to the IPO Board of Directors.

No more than three members of an IPO member company or firm can serve as a voting member on a given committee. In making committee appointments, consideration is given to achieving balance in the number of corporate, law firm, and other member classes on a given committee, as well as achieving industry diversity.

Board Liaisons

Board liaisons are members of the IPO Board of Directors who are assigned annually to each standing IP committee as non-voting members. The Board Liaison acts as a line of communication between the Board and a committee, acting a sponsor and advocate for the committee. Board liaisons should regularly participate in committee calls and communicate with committee leadership. The Board Liaison should help identify projects for the committee that might be of interest to the Board.

Board liaisons are expected to help committees set their agendas to be generally in line with Board views, by keeping committees aware of existing Board resolutions and other positions and encouraging committees to only explore changes in position where a change in circumstance merits revisiting the position. Board liaisons also help committees avoid devoting time to projects to which the Board is not likely to be receptive. Board liaisons are encouraged to highlight significant committee milestones or activities at IPO Board meetings. Upon request by IPO staff, the Board Liaison will brief the IPO Executive Committee on the status of standing IP committee work and projects on calls to occur on an ad hoc basis.

Staff Liaisons

Members of the IPO staff are assigned to each of the standing IP committees as non-voting members. The Staff Liaison participates on committee calls; advises the committee on IPO history on issues the committee may consider pursuing, including prior resolutions or rejections of certain recommendations; contributes substantively on legal, legislative, and management issues; answers questions regarding IPO policy and procedure, strategic plan, vision, principles, and existing positions; and provides assistance to committee leadership as needed. Staff liaisons are expected to work with Board liaisons to guide the committee in selecting projects



and setting the agenda to be generally in line with the Board view while also leeway to explore topics of interest to the committee's members. Staff liaisons will attempt to arrange for a substitute from the IPO staff to join committee calls when the staff liaison is not available. Chairs and vice chairs should communicate with their staff liaison frequently on committee matters.

When necessary staff liaisons may bypass the committee structure with resolutions. In those instances the staff liaison will ask for the committee's view on the staff resolution and if possible will ask for a committee vote.



III. STANDING IP COMMITTEE OPERATIONS

Committee Leader Appointments and First Meetings (January through March)

At the beginning of each calendar year, the IPO President appoints committee chairs and vice chairs. In the event of a delay in appointments, committee leaders from the previous calendar year should continue to lead their committee until new leaders are announced. As in previous years, the expectation for committee leaders is to work together to coordinate committee activities and facilitate committee discussion on a regular and consistent schedule. Throughout the year, committee leaders work closely with the IPO staff liaisons to develop issues to present to the IPO Board of Directors.

In the first few weeks of committee operations, committee chairs and vice chairs should identify committee secretaries and inform their staff liaison of their selection.

In advance of the annual Committee Leadership Meeting, chairs and vice chairs should contact their committee members to determine whether to propose changes to the committee charter and to develop a list of planned activities for the year. Leaders should inform IPO staff of any proposed edits to the charter and submit them to the Executive Director for consideration.

Communicating with Committee Members

Chairs and vice chairs should schedule regular conference calls with their members and share information about issues within the committee's jurisdiction with members. IPO Connect should be used to regularly communicate with committee members because it contains the most accurate, up-to-date roster (and is also the easiest way for members to communicate with each other). Instructions for using this software can be found in Section VI.

Identifying Committee Projects

Committee projects are initiated in several ways. The IPO Board of Directors or Officers may ask a committee to investigate issues or develop recommendations for Board action. Refer to Section V for instructions on developing Board reports and http://www.ipo.org/wp-content/uploads/2016/03/Template_for_Board_Reports.docx for the template for these reports.

The chair(s) and vice chair(s) of a committee are also encouraged to propose projects of interest to their members and within their jurisdiction. Such projects should be consistent with IPO principals and vision. In addition to recommending positions regarding legislation and administrative rulemaking, committees may, for example, undertake legal or business research, prepare informational reports for distribution to the Board of Directors or the IPO membership, organize educational programs to be held during the IPO Annual Meeting or during committee-organized conferences, or propose topics for IPO's IP Chat Channel.

Frequently, IPO staff liaisons ask a committee to react to new developments in IP law. The IPO staff liaison might forward information it receives to committee leadership. Chairs and vice chairs should also monitor developments in the field of the committee's jurisdiction. The IPO Daily News™ often reports on many late-breaking developments.

IPO staff liaisons and board liaisons track and report to the Board the status of committee projects.

Committee Leadership Meeting in Washington, DC

In the spring each year, IPO hosts its annual Committee Leadership Meeting. At this meeting committee chairs and vice chairs will meet with the Board of Directors in Washington, DC. Committee reports will be distributed to all meeting attendees. Committee chairs or vice chairs will discuss their committee's work to date and plans for the remainder of the year.

Committee-Organized CLE Programs

Committees have the opportunity to propose and host CLE programs at the IPO Annual Meeting. A call for proposals will be sent out from the IPO office to all committees in the spring. Speakers for these programs are generally selected from the committee members.

Committee Annual Reports

At the end of November, chair(s) and vice chair(s) are responsible for preparing an Annual Report detailing committee activities. Annual reports should summarize committee activities, suggest future activities to aid incoming members/leadership, and provide general information regarding any developments on IP issues falling within the committee's jurisdiction. These reports are important to highlight which issues IPO should (or should not) continue to focus on within the committee structure and to highlight new issues that might deserve the attention of the Board and the IPO membership. Reports should be submitted to the IPO office by November 15.

Outstanding Committee of the Year Award

This award is presented during the IPO Annual Meeting. The Committee of the Year Award is given in recognition of outstanding service in promoting reliable, effective, and up-to-date intellectual property systems. Winners of the Committee of the Year Award receive the following:

- Recognition by the IPO President at the Annual Meeting at one of the lunches during the meeting.
- A plaque for the chair(s) and vice chair(s) – each leader receives a plaque;
- Recognition on the IPO website and mention in the *IPO Daily News™*; and
- 25% off annual meeting registrations for the committee members and leaders.



IV. FREQUENTLY ASKED QUESTIONS

Q: I was contacted by an IPO member who would like to serve on a committee. What do they do to sign up?

A: Direct that member to sign up online at www.ipo.org/committeesignup. Applications are generally processed weekly. Applicants receive confirmation of appointment in about a week.

Q: Someone applied for my committee, but they aren't showing up in IPO Connect. What do I do?

A: It can take up to 10 business days for a member's application for a committee to be approved. If it has been longer than that or they received a confirmation email but are not receiving committee emails, please contact the IPO office at (202) 507-4500 or committees@ipo.org.

Q: Where can I find my committee's charter and the names of members on my committee?

A: A link to the list of IPO's Standing IP Committees, including membership listings and charters can be found at www.ipo.org/committeelist. A list of committee members is also accessible in IPO Connect on your committee's page.

Q: What do I do if I change companies/firms?

A: Contact your staff liaison with your new information and they will determine if your new company/firm is an IPO member. If it is, we will update our records. If it is not, you will be referred to IPO's membership department.

Q: When does my committee need to submit a document for approval prior to its deadline?

A: Generally two weeks prior to the deadline for submission of letters and comments and three weeks for board reports concerning proposed resolutions. For more on Board reports, see Section V.



V. GUIDE TO DEVELOPING BOARD REPORTS

IPO Board of Directors meetings are scheduled approximately five times per year (see www.ipo.org/committees for the schedule). If a committee develops a recommendation for the Board of Directors to consider, that committee must prepare a written report in advance of the board meeting and conduct a vote of its members. Estimated timeline for developing board reports (subject to change):

Eight or more weeks before the board meeting: The issue should be identified, your staff liaison should be notified, and work on the report should begin.

Four weeks before the board meeting: Committee reports with resolutions should be completed and circulated to the committee for a recorded vote.

Three weeks before the board meeting: Final committee reports, including the record of the committee vote, must be submitted to the IPO office.

Committee reports with resolutions to be presented to the Board should be circulated to committee members in advance of submission to the IPO office and should include the votes (for, abstain, against) of a majority of the committee members.

Such reports should be concise (usually no more than three - four pages) and include the following sections:

- **Issue**
- **Resolution(s)**
- **Past Actions**
- **Background & Proposal**
- **Committee Votes For and Against**

In some instances, before a committee recommendation is placed on the board agenda, the Board Liaison and/or Chair of the committee might be invited to give an oral presentation on a call with the Executive Committee of the IPO Board. The Chair and/or Vice Chair is also often invited to give an oral presentation of their report at a board meeting. Occasionally the IPO Board may consider resolutions that have not originated in an IPO committee.

See http://www.ipo.org/wp-content/uploads/2016/03/Template_for_Board_Reports.docx for the Board Report Template.



VI. USING IPO CONNECT FOR COMMITTEE BUSINESS

IPO Standing IP Committee members can easily communicate with their entire committee using this area of the IPO Website.

How To Login to IPO Connect:

1. Open a web browser and go to <http://connect.ipo.org>
2. Click on "Login to view members only content."
3. Login using the same User and Password you would use for IPO.ORG.
4. If you cannot remember your password, you can request a new one at <http://www.ipo.org/password> (If you are still experiencing problems logging in, please email webmaster@ipo.org to get your password reset)

What Can I Do on IPO Connect?

Check your Committee Roster

IPO Connect is regularly synced with the IPO database. It should be your first stop if you need to see who is currently on your committee.

To check your roster:

1. Sign in to IPO Connect.
2. Click the "Committees" link in the top navigation area.
3. Click on the committee name to view recent activity. To view the full roster, click on the "Members" tab.

Send a Message to the Committee

Messages sent through IPO Connect are delivered in real time to the email address we have on file for each committee member.

To send a message:

1. Sign in to IPO Connect.
2. Click the "Committees" navigation item.
3. Click on your committee name.

4. Click on the “Discussions” tab, and then “+Post New Message” on the right hand side of the page.
5. Give the message a subject.
6. After writing your message using the text editor, click “Send” to send immediately or “Attach” if you would like to attach a document (a document can also be an Outlook calendar invitation).
7. When uploading an attachment, be sure to complete steps 1 and 2 on the form. When you have your document uploaded, click “Finish” at the bottom of the form to finalize the attachment.

Share or Archive a Document

Occasionally, you might want to upload a document to share later with your committee or save it for archival purposes.

To Upload a Document:

1. Sign in to IPO Connect.
2. Click the “Committees” navigation item.
3. Click on your committee name.
4. Click on “Add Document” under “Latest Shared Files” in the bottom left-hand corner of the page.
5. Fill out a Title and Description for the document.
6. Select your committee from the “Library” list.
7. After you upload your document in step 2, be sure to click “Next” at the bottom of the form to add your document.

Send an Outlook Invitation

To ensure high attendance at your monthly calls, we encourage you to send an Outlook iCalendar attachment to your call announcement messages.

To Create the Invitation:

1. Create an outlook calendar item for your committee’s call as you normally would within Outlook, but instead of saving it to your calendar or inviting attendees, click on “Save As” and save it in iCalendar format to your computer desktop.



To Send the Outlook Invitation:

2. Sign in to IPO Connect.
3. Click the “Committees” navigation item.
4. Click on your committee name.
5. Click on the “Discussions” tab, and then “+Post New Message” on the right hand side of the page.
6. Give the message a subject.
7. After writing your message using the text editor, click “Attach” to attach the iCalendar file just as you would any other type of file.
8. When uploading an attachment, be sure to complete steps 1 and 2 on the form. When you have your document uploaded, click “Finish” at the bottom of the form to finalize the attachment.
9. Click “Send.” When committee members open the attachment, it will save to their personal outlook calendar.

Create a Sub-Committee

On occasion, it may be helpful to create a sub-committee to work on a specific project. Once created, a sub-committee will have all the functionalities of the parent committee.

To Create a Sub-Committee:

1. Send an email to your IPO staff liaison.
2. In the email, please include:
 - a. The name of your committee
 - b. The name of the sub-committee you are requesting.
 - c. Which members of your committee should be on the sub-committee.
3. The IPO staff will enter the data and respond when the sub-committee is in place.



VII. TIPS FOR COMMITTEE CHAIRS AND VICE CHAIRS

Establish Regular Communication

Set a schedule for monthly conference calls of your full committee and send reminder messages with a meeting agenda shortly before the calls.

- Make sure all committee members are on the official IPO roster. Direct individuals who inquire about signing up for your committee to www.ipo.org/committeesignup.
- Publish a schedule and attach a calendar invitation to your message. This helps to increase participation. Instructions for sending a calendar invitation via IPO Connect are found in the section “Using IPO Connect for Committee Business.”
- Send out messages with items of interest to committee members somewhat regularly to keep members engaged outside of regular committee calls.
- Committee leaders should communicate outside of full committee calls as needed.
- Hold an in-person committee business meeting during the IPO Annual Meeting.

Adding Committee Members to Committee Email List

IPO’s professional networking site, IPO Connect, includes a discussion group for every committee.

Encourage new committee members to login to IPO Connect to view previous messages and get up to speed with the work of the committee. Refer to the “Using IPO Connect for Committee Business” section in this manual for more information about using IPO Connect.

Be Aware of IPO Report Deadlines

Committees are asked to submit reports two times during the year (for the Committee Leadership Meeting and an Annual Report). Please make sure you are aware of these deadlines and do your best to meet them. Reports to the IPO Board must be submitted three weeks before a board meeting. See Section V.

Organize Subcommittees

Organize subcommittees to work on particular projects and report back to the full committee. This is particularly useful for very large committees and can allow the committee to complete multiple projects and provides active committee members a greater opportunity to get involved in IPO. Chairs should check-in regularly with each subcommittee to ensure that they are on track and working toward the committee’s goals. Contact your staff liaison to request that IPO Connect groups be created for your subcommittees.



Keep in Touch with Your Staff and Board Liaisons

Each committee has a liaison to the IPO Board of Directors to aid the committee in preparing reports and recommendations to the Board and highlight significant milestones in the committee's work. Each committee will also have a staff liaison. Staff liaisons serve as a resource and chairs should endeavor to keep them up-to-date on all committee activities.