



**Intellectual<sup>®</sup>  
Property  
Owners  
Association**

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**2017 Standing IP Committee  
Leadership Meeting**

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**W Hotel  
Washington, DC  
15 March 2017**

# AGENDA

## IPO COMMITTEE LEADERSHIP MEETING

Wednesday, 15 March 2017

8:30 a.m. – 12:00 p.m.

W HOTEL – Great Room

WASHINGTON, DC

(CONTINENTAL BREAKFAST AVAILABLE AT 7:30 A.M.)

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- 8:30 a.m. Welcome Remarks by Kevin Rhodes, IPO President
- 8:35 a.m. Remarks by Mark Lauroesch, IPO Executive Director
- 8:40 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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## **ANTITRUST & COMPETITION LAW COMMITTEE**

**Chair:** Colene Blank, 3M Innovative Properties Co.

**Vice Chair:** Monte Cooper, Orrick, Herrington & Sutcliffe, LLP

**Secretary:** Jordan Sigale, Dunlap Coddling, PC

**Board Liaison:** Buckmaster de Wolf, General Electric Co.

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### **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 in conjunction with the Standards Setting Committee, 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 FTC policy regarding patent assertion entities, 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) in conjunction with the Pharmaceutical & Biotechnology Issues Committee.

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 2017:**

The committee is proposing activity in several area that might be of interest to our members.

1. The Committee is interested in preparing a summary of antitrust/competition law legal standards, enforcement actions, and highlight changes in the law from around the world. We would separate the work into regional areas. The goals would be to offer IPO members and the board a tool for use in advising companies who own IP on effective uses and risks. Proposed outcome – informational white paper delivered to the board prior to Asia fact finding trip.

2. The Committee is planning to summarize standards used around the world for the review of mergers and acquisitions. There have been updates in laws, such as HSR, and guidance around the world. The goals would be a comprehensive international primer for

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members to understand how IP is reviewed around the world in the context of mergers and acquisitions. The Committee will decide on and recommend the best way to disseminate the results.

3. The Committee is interested in activity at the FTC. We propose coordinating a webinar for the members with a presentation by experts in the FTC to discuss the changes and outlook on enforcement with a new FTC Chairperson and new Commissioners. We would anticipate the work to follow new appointments at the FTC.

4. The combined FTC/DOJ licensing guidelines have been issued, and the committee will prepare a summary of the guidelines and any changes. The Committee will decide on and recommend the best way to disseminate the results.

5. The Committee is also interested in the history of positions taken by the new Attorney General and Commerce Secretary related to enforcement of antitrust, especially the overlap with IP. The Committee will review for any guidance, and will raise it to the members if deemed interesting and relevant.

6. Members of the Committee have expressed interest in preparing guidelines for non-antitrust attorneys to spot issues in the space where IP overlaps with antitrust. The Committee will review the landscape, and will raise it to the members if deemed interesting and relevant.

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## STANDARDS SETTING COMMITTEE

*Chair: Amy Marasco, Microsoft*

*Vice Chair(s): Jonathan Retsky, Winston & Strawn*

*Secretary: Valentina Boyet, SAP*

*Board Liaison: Timothy Loomis, Qualcomm*

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### **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 standard 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 an appropriate balance between the rights of intellectual property owners and other industry standard stakeholders.

### **Committee Agenda for 2017:**

Toward the end of 2016, the IPO Executive Committee asked the Committee to prepare a white paper to help the Executive Committee better understand (a) where the Committee can reach consensus with regard to certain standard-essential patents (SEPs)-related issues and (b) some of the issues where the Committee membership hold considerably divergent views. The Committee has begun this project and is targeting a completion date in early 2017.

Due to the increasing interaction between standards and open source software (OSS), the Committee plans to devote additional resources to better understand that interaction and potential implications. This issue is attracting greater attention as a number of prominent standard-setting organizations (SSOs) are considering the different ways OSS is being (or can be) used as part of their standardization efforts. This interaction between standards and OSS may raise related governance issues at SSOs, including whether these organizations' policies and procedures (including those related to patents and copyrights) sufficiently address any related issues.

The Committee learned through its liaison activities with the Open Source Committee that both Committees share an interest in this topic. Rather than have each Committee discuss the issues in isolation and possibly develop separate related papers or proposed statements, the two Committees launched a joint project to develop a white paper that could be used to educate the IPO community (and possibly others) on this topic.

In accordance with its charter, the Standard Setting Committee also will continue to review and discuss ongoing developments in connection with the global debates regarding many issues associated with SEPs, including (but not limited to):

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- the effect of a F/RAND licensing commitment,
- the application of competition law, and
- proposals that SSOs seek greater transparency regarding SEPs through arguably greater disclosure obligations.

The Committee will continue to monitor activities at prominent SSOs, recent case law, and positions articulated by government authorities. The Committee also will continue to coordinate with the Antitrust Committee on these issues as appropriate, as that Committee's members share a strong interest in some of these issues.

Finally, the Committee will continue to monitor standards-related issues that are of interest to the Committee and prepare proposed IPO positions as needed.

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## **CORPORATE IP MANAGEMENT COMMITTEE**

**Chair:** *Shawn Foster, ExxonMobil*

**Vice Chair:** *Neil Kardos, Harrity & Harrity, LLP*

**Secretary:** *Scott Weingust, Stout Risius Ross*

**Board Liaison:** *Curtis Rose, Hewlett Packard Enterprise*

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### **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 2017:**

1. Administer and Present Results of IPO Corporate IP Management Benchmarking Survey
  - a. The most recent IPO Benchmarking Survey was presented at the 2013 annual meeting
  - b. We are in the process of distributing the survey questions to IPO member companies
  - c. We plan to develop a presentation for the 2017 annual meeting based on the survey results
2. Integrate the Corporate IP Management Practices Project and Benchmarking Survey
  - a. We plan to identify synergies between the Practices project and the Benchmarking Survey to expand the Committee's ability to report on trending/best practices for IPO members.
  - b. Identify an additional 8-12 companies (possibly industry-specific) for in-depth senior IP counsel interviews on best practices.
3. Identify and offer programs at monthly committee meetings
  - a. Best practices (from survey and interviews)
  - b. Patent practice management (IP Data Analytics, Patent Portfolio Analysis, Int'l Claiming)
  - c. Competitive Intelligence

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## IP LICENSING COMMITTEE

**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

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### **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 2017:**

The Committee plans to continue monthly training sessions during 2017. Based on feedback from the Committee's business meeting at the 2016 IPO Annual meeting, the Committee plans to develop a collaborative approach to generating topics and presentation schedules, while maintaining broad coverage of topics and skill levels. 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 has formed a licensing case law sub-committee, to track case law developments of interest to licensing practitioners and provide reports to the Committee as needed throughout the year. The sub-committee provided its first report at the February committee meeting. The Committee will continue to encourage the formation of other sub-committees on specific topics as needed.

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## TRADE SECRETS COMMITTEE

**Chair:** *Kenneth Corsello, IBM Corporation*

**Vice Chair:** *Victoria Cundiff, Paul Hastings LLP*

**Secretary:** *Bryan Bortnick, IBM Corporation*

**Board Liaison:** *Karen Cochran, Shell International B.V.*

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### **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](http://www.ipo.org), etc.

### **Report:**

#### • **Key Accomplishments**

- Continued to monitor domestic and foreign legislative trade secret developments.
- 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. So far in 2017, we had a presentation in February by Joshua Rich of McDonnell Boehnen Hulbert & Berghoff LLP on “NY v Aleynikov: NY Penal Code, Federal Criminal Law Unprepared to Deal with Source Code Theft.”

#### • **Recommendations for Committee Activities in 2017**

- Monitor legislative developments by EU member states in compliance with the EU Trade Secrets Directive, which requires member states to be compliant by May of 2018.
- Monitor judicial developments in cases brought under the Defend Trade Secrets Act, and provide education for IPO members.
- Propose presentation for IPO annual meeting on the first year of the Defend Trade Secrets Act.

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## **COPYRIGHT LAW AND ANTI-PIRACY COMMITTEE**

*Chair: Terry J. Ilardi, IBM Corp.*

*Vice Chair(s): Katherine C. Spelman, Lane Powell PC*

*Secretary: Jenevieve J. Maerker, Foley Hoag LLP*

*Board Liaison: Matthew Sarboraria, Oracle Corporation*

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### **Committee Charter:**

The Committee will focus on determining what issues and topics regarding copyright law and practice are of greatest concern to the IPO membership and establish positions on those issues and topics that would most benefit IPO members. The Committee will be following significant bills in the U.S.'s Congress on copyright law and procedure, and taking positions where appropriate and consistent with the interests of IPO members. The Committee will also follow U.S. Copyright Office rule-making efforts of interest to intellectual property 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, the Committee will consult and coordinate with the leadership of our sister committees. The Committee will also address such issues as the IPO Board of Directors asks this committee to consider.

### **Committee Agenda for 2017:**

As reflected above, the Committee proposes to make the following revisions to its charter:

(1) Change the name of the committee in the first sentence from "Copyright Law and Practice" to "Copyright Law and Anti-Piracy" to reflect the current name of the committee; (2) Change "towards" to "toward" in the last sentence of the first paragraph; and (3) Delete the phrase "within the Copyright Division" from the first sentence of the second paragraph, as there is only one other committee in the Copyright Division, and we also coordinate with the leadership of other committees outside of the Copyright Division where appropriate.

The Committee has held two monthly committee conference calls so far in 2017; has prepared and submitted on behalf of IPO a letter to the House Judiciary Committee commenting on proposed Copyright Office legislative reforms; and is in the process of preparing comments on behalf of IPO to the Copyright Office regarding the qualifications of the next Register of Copyright.

The Committee anticipates the following activities for the remainder of 2017:

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

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- 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 2017 IPO Annual Meeting. The Committee is communicating with the International Trademark Committee regarding a potential collaboration to propose a committee breakout session on varying legal strategies for owners to protect their IP through the use of copyright law, trademark law, or both across international jurisdictions.
  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 COMMITTEE

*Chairs: 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*

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### Committee Charter:

The Committee studies and, when appropriate, reports on issues relating to open source licensing, governance, and 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](http://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 2017:

For 2017 the Committee plans to:

- Continue to meet and discuss issues relating to open source licenses
- Monitor new litigation relating to Open Source Licensing
- Draft a white paper with the intersection of Open Source and Standards with the Standards Committee
- Propose a presentation for the Annual Meeting regarding Open Source Issues
- Discuss Open Source Best practices
  - Representations, warranties, and indemnifications
  - Responding to customer inquiries
  - Responding to reseller inquiries
  - Consumption of Open Source software
  - Contribution to Open Source projects
  - Production of Open Source Products
- Discussion of explicit and implicit patent licenses in open source

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- Explore presenting at an IPO Chat Channel

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## **ASIAN PRACTICE COMMITTEE**

**Chair:** *Lawrence T. Welch, Eli Lilly*

**Vice Chair(s):** *Robert Siminski, Harness Dickey; Jimmy Cheng, Qualcomm Inc.; Steven Bauer, Medtronic; Michael D'Aurelio, Thomas, Horstemeyer*

**Secretary:** *Michelle Shen, Medtronic; Brad Chin, Bracewell, LLP*

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

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### **Committee Charter:**

The Committee will identify, monitor, study, and recommend IPO positions regarding intellectual property acquisition, licensing, and enforcement issues in Asian countries such as Japan, China, India, Korea and Taiwan. The Committee will also disseminate and exchange information and views among members of IPO regarding intellectual property problems in Asia. Regular activities of the committee will include:

- Organizing IP Dialog visits to Asia
- Participating in and organizing/conducting seminars and conferences within the United States and Asia directed to Asian IPR
- Developing white papers addressing acquisition, licensing, and enforcement aspects of Asian IPR
- Making recommendations to the IPO Board on potential collaborations between IPO and Asian trade associations such as PPAC
- Responding to requests for comments on proposed new IPR laws in Asian countries on behalf of IPO

### **Committee Agenda for 2017:**

- We are planning a return IP Dialog (formerly Fact Finding) trip to China and Korea tentatively scheduled for the week of October 22<sup>nd</sup> through October 27<sup>th</sup>.
- We will continue our monthly conference calls, with occasional guest speakers on Asian IP topics of interest.
- We will submit comments with respect to proposed changes in the patent laws, antimonopoly laws, and other IP Laws of various Asian jurisdictions including China, Korea, Japan, India, Indonesia, and other Asian jurisdictions as opportunities to submit comments may present.
- We are planning a CLE event that presents a comparative review of the IP Laws of major Asian jurisdictions such as China, Japan, Korea, Taiwan, and India as well as the United States. The plan is to try to make this a repeated event held every year or every other year. This event is tentatively planned for the summer of 2018 so as to provide lead time to be able to obtain participation from judges and IP Office Officials of the various countries.

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## CANADIAN PRACTICE COMMITTEE

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

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

**Recordions Secr ter:** *Beverley Moore, Borden Ladner Gervais LLP*

**Board Liaison:** *Brian Suffredini, VP Chief Patent Counsel, United Technologies*

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### 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.

### Key Initiatives:

#### Pharmaceutical Patent Issues

- Advocacy on utility law jurisprudence
- CETA implementation (Bill C-30)
  - right of appeal for brands
  - patent term restoration
  - Amendments to *PM(NOC) Regulations*
  - Dual litigation
  - Engage Industry Canada along with IPIC regarding potential changes to the Patent Act
- Monitoring competition issues relating to pharm patents
- PMPRB Issues
  - Review of Proposed Guidelines
  - *Ad Hoc* review of decisions
- Section 8 and claims after unsuccessful PMNOC proceedings
- Biosimilar law and policy
- Price of Pharmaceuticals
  - changing the patentability conditions and/or creating special categories of inventions is not the way to address pharmaceutical pricing
  - partner with other committees on this

#### Copyright Issues

- New border enforcement provisions (addressing counterfeiting goods)

#### Trademark Issues

- New border enforcement provisions
- Issues relating to new CA Trademarks Act:
  - Removal of "use" requirement for registration of marks

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- Institution of Nice classification system
- Changes to Trademarks Regulations (in relation to new Act)

### Other Issues to Monitor

- Passage of Patent Rules/Watch for consultation period
  - Removal of 1-year reinstatement period;
  - Restoration of priority
  - New incorporation by reference provision
- Changes to MOPOP and CIPO practices; including:
  - Diagnostic method claims
- Attorney-Client privilege for patent professionals
- Changes to Industrial Design Rules (in relation to New Act)
- Difficulty in patenting software
- Unavailability of Injunctions
- The set-up of a “College” to regulate patent and trade-mark professionals and its rules

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## EMERGING TECHNOLOGIES AND TRADE COMMITTEE

**Chair:** Allison Mages, *General Electric*

**Vice Chair(s):** Bryan Vogel, *Robins Kaplan LLP*

**Secretary:** Jeff Gordon, *Borden Ladner Gervais LLP*

**Board Liaison:** Micky Minhas, *Microsoft*

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### **Committee Charter:**

The 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, and 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 2017:**

- Big Data Seminar in April 2017, in collaboration with other IPO Committees to explore IP protection of big data analytics, including country-specific issue and challenges.
- Explore emerging IP issues related to Additive Manufacturing.
- Provide submissions, testimony, and targeted outreach on trade related issues. 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.
- Engage at WIPO, other UN specialized agencies, and the WTO to monitor and influence IP norm-setting activity, in collaboration with the International Patent Law and Practice Committee. Prior to major meetings of interest, outreach to USPTO and other national patent offices, to focus on key IPO issues.
- Organize a series of discussions and guest speakers on emerging technologies, including additive manufacturing and clean/green technology.
- Organize proposal(s) for break-out session(s) at IPO's Annual Meeting relating to emerging technologies.
- 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 COMMITTEE

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

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

Matthew Georgiou, Carpmaels & Ransford LLP

**Secretary:** David Black, Schwegman Lundberg & Woessner

**Board Liaison:** Dennis Skarvan, Caterpillar Inc.

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### Committee Charter:

The European Practice Committee is the Voice of Europe within the global organization of IPO and a Voice of IPO toward 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 2017:

#### Meetings:

Monthly calls will be held on a regular basis including a 20 min. presentation of either one committee member or a guest speaker.

We are planning to continue our sixth annual May conference which is scheduled for **18 May 2017** at the Paris Marriott Champs Elysees Hotel and will be hosted by Cyra Nargowalla of Cabinet Plasseraud and Pierre Véron of V & ASSOCIÉS. With thanks to Vice Chair Aloys Hüttermann, songwriters Kenneth Gamble and Leon Huff, the O'Jays, Martha Reeves and Heavy D, our theme this year is "**Now that We've Got IP What Are We Going To Do With It?**" We have invited our colleagues in the Vereinigung von Fachleuten des Gewerblichen Rechtsschutzes (VPP) to attend, and they have agreed to advertise the conference to their large membership in Germany and Europe. Cyra Nargowalla chairs the Spring Meeting subcommittee.

Our committee will help IPO in organizing the first EPO-IPO-Day which will take place on **14 November 2017** at the premises of the EPO in Munich. Gautier English chairs the subcommittee.

For the Annual Meeting, we have invited committee members to submit proposals for break-out sessions. Additionally, we are working directly with other IPO committees on breakout proposals, specifically the Post-Grant and Asian Practice Committees on a

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proposal for a break-out session on “Comparative Post-Grant, Opposition and Revocation Practice in the U.S., Europe and Asia.” and with the Pharma & Biotech Committee and other jurisdictional committees on a session focusing on pharmaceutical patent term extension in various jurisdictions.

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## GENETIC RESOURCES AND TRADITIONAL KNOWLEDGE COMMITTEE

**Chair:** *Manisha A. Desai, Eli Lilly and Company*

**Vice Chair:** *William L. Warren, Eversheds Sutherland*

**Secretary:** *Jennifer H. Burdman, King & Spalding*

**Board Liaison:** *D. Michael Young, Roche Diagnostics*

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### **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 2017:**

The Committee held its first teleconference on February 7, 2017, during which introductions of new and returning members were made, and Jennifer was welcomed as the new Secretary. Updates on recent developments in WIPO and the CBD were shared. The Committee also agreed to the following activities:

- 1) The Committee agreed it is important to compile more information and examples of instances in which IPO members have been required to submit information about use of GR/TK to patent offices, regulatory or other agencies, in satisfaction of the Nagoya Protocol or other national laws. The Committee will prepare a survey that can be shared with IPO members in an effort to compile information about the requirements and associated burdens. We believe this will assist IPO in contributing to more fact-based discussions with the USPTO, as well as in WIPO, the CBD/Nagoya Protocol, and other UN organizations.
- 2) The Committee shared information regarding developing countries' efforts in the CBD/Nagoya Protocol to include "digital sequence information" such as gene sequences within the scope of the Nagoya Protocol. Such expansion of the scope would have far-reaching implications for IPO Members. The Committee will continue to monitor the discussions on this subject and may prepare a Resolution for adoption by the IPO Board, as a means of enhancing IPO's ability to advocate on this issue with the US and other governments.

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- 3) The Committee will endeavor to conduct conference calls at least quarterly, as well as an in-person Committee meeting at the 2017 Annual Meeting.

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## INTERNATIONAL PATENT LAW & PRACTICE COMMITTEE

**Chair:** Anouk Boon, Shell International B.V.

**Vice Chairs:** Janet Cord, Ladas & Parry LLP, Mark Guetlich, Thomas|Horstemeyer, LLP,  
Holger Carl Tostmann, Wallinger Ricker Schlotter Tostmann

**Secretary:** Mark W. Croll, Valipat

**Board Liaison:** Heath Hoglund, Dolby Laboratories

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### Committee Charter:

The Committee will focus on developing IPO positions for international harmonization of patent laws especially with regard to the acquisition and enforcement of patents. The ultimate goal is to obtain a system that provides uniform, objective, predictable, and cost effective prosecution and enforcement of patents globally.

Specifically, the Committee will study proposals from WIPO, national and regional patent offices, and Non-Governmental Organizations (NGOs) aimed at harmonization of patent laws. It will monitor, advise, and provide input to IPO's delegates involved in the WIPO Patent Cooperation Treaty (PCT) reform discussions and initiatives by the Industry Trilateral, IP5, and Group B+ In addition, the Committee will have the objective to disseminate and exchange information and views within the IPO on the above developments especially the effects on an international patent portfolio. The Committee will recommend for adoption by the IPO Board as new proposals are presented.

### Committee Agenda for 2017:

#### Committee Meetings

Monthly meetings will be held which will focus on international filing strategy and cost management. It is the intention to have presentations by our subcommittees as well as guest speakers from WIPO, national and regional patent offices and/or from other IPO committees or board members.

The subcommittees are as follows

- International filing strategy and cost management led by Roger Gobrogge
- WIPO/PCT led by Holger Tostmann
- Global Dossier initiative led by Janet Cord
- Global harmonization led by Mark Guetlich

#### Policy activities

There continues to be a strong interest in further harmonization of global patent laws. Our committee monitors these efforts, including review of proposals by the Industry Trilateral, IP5, and Group B+ meetings, among others.

#### Educational activities

In 2017, we will continue to focus on the key areas of the above-named subcommittees. We will also continue our focus on educating both our own members and the IPO as a

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whole on current harmonization developments and its (potential) effects on filing and prosecution of patents globally.

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### INTERNATIONAL TRADEMARK LAW AND PRACTICE COMMITTEE

**Chair:** *Matthew G. Owen, Caterpillar Inc.*

**Vice Chair(s):** *Elizabeth E. Houlihan, Houlihan<sup>2</sup> Patent & Trade Mark Attorneys*

**Secretary:** *Frances Jagla, Lane Powell PC*

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

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#### **Committee Charter:**

This committee will evaluate the effects of newly implemented international trademark and trade dress related treaties and national laws on international trademark/dress protection, prosecution, and enforcement. The Committee will evaluate the need for legislative and regulatory 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 2017:**

Members of the Committee meet monthly and have already conducted two teleconferences in the First Quarter of 2016 to develop goals for 2017.

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. We are in discussions with the Copyright Law & Anti-Piracy Committee to consider a potential joint-committee breakout sessions for this year's annual meeting on varying legal strategies for owners to protect their trademarks through the use of copyright law, trademark law, or both across international jurisdictions.

The Committee helped provide comments to the Australian Productivity Commission's final report on its Inquiry into Australia's Intellectual Property (IP) Arrangements. The report examines Australia's balance between promoting innovation and protecting intellectual property and makes a number of recommendations to reform Australia's intellectual property system.

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 COMMITTEE

**Chair:** Roberto Ribeiro, Sanofi

**Vice Chair:** Ricardo Nunes, Daniel Legal and IP Strategy

**Secretary:** Maria Isabel Giacchetti, Sanofi

**Board Liaison:** Thomas P. McBride, Monsanto Co.

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### **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 2017:**

- **Key Accomplishments of 2016:** (i) held conference calls with our members every month; (ii) provided our members with updates on important developments in Latin America, monitoring important lawsuits and pending bills; (iii) organized conference calls with Latin American authorities in the IP field, including the Vice-President of the Brazilian PTO and the USPTO attachés for Latin America; (iv) prepared a guideline on patent and trademark prosecution and litigation, delivered during the Annual Meeting in September; and (v) continued to collaborate with the group in charge of assisting IPO with the preparation of the comments to be submitted to the USTR “Special 301 Report”.
- **Recommendations for Committee Activities in 2017:** (a) Carrying out a Fact-finding trip to one country relevant to IPO in Latin America (likely Mexico); (b) implement initiatives to increase the number of members coming from private companies owning IP rights; (c) update and enlarge the publication Guideline for Patents and Trademarks in Latin America recently published to encompass at least one more country; and (d) monitor and discuss relevant threats and opportunities in the legal environment in the Region.

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## DAMAGES AND INJUNCTIONS COMMITTEE

*Chair: Tom Brown, Dell, Inc.*

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

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

*Board Liaison: Theodore Naccarella, InterDigital Holdings, Inc.*

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### Committee Charter:

The Committee will 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 might be allowed by the courts. It will also examine the developing law in the area of injunctive relief. Papers on these topics will 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 2017:

The Committee plans to undertake the following activities in 2017:

- The Committee has received approval to host a one-day seminar in Chicago on issues pertaining to patent remedies. This seminar is a follow-on to a similar seminar hosted by the Committee on May 24, 2016 in Palo Alto and on May 27, 2015 in Washington, D.C. The preliminary sessions address (1) RECENT DEVELOPMENTS, LONG-TERM TRENDS AND CONTINUING EVOLUTIONS IN PATENT DAMAGES AND INJUNCTIONS LAW; (2) TOOLS OF DAMAGES ESTIMATION; and, (3) PROCESS ISSUES IN DAMAGES TESTIMONY. 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

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the one day seminar on patent remedies may highlight issues on which IPO could make recommendations.

- Identify best practices relating to issues such as attorneys fee requests and exceptional case findings under the recent decisions by the Supreme Court.
- Evaluate the development of a white paper to discuss design patent damages based on the recent *Samsung v Apple* case from the Supreme Court.
- Continue to identify appropriate CLE opportunities for the Annual Meeting, the Committee and the broader IPO membership. Possible topics include:
  - a. The Supreme Court and the law of intellectual property, is the Court reshaping the landscape or merely moving the chairs around the deck?
  - b. The latest case law applying and interpreting the Federal Circuit decisions regarding damages;
  - c. Best practices for establishing a demand for the patented feature when determining an appropriate measure of damages;
  - d. Best practices for determining a royalty base for reasonable royalty damages;
  - e. Best practices for determining damages in SEP, FRAND and RAND litigation;
  - f. Best practices for addressing the causal nexus requirement in cases seeking injunctive relief for multi-featured products;
  - g. Remedies available in internet piracy matters where a service provider's customers infringe a content provider's intellectual property;
  - h. 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;
  - i. Standards for establishing comparable licenses and use of settlement agreements;
  - j. Comparative patent litigation and damages, US, Europe and/or Asia.

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## U.S. INTERNATIONAL TRADE COMMISSION COMMITTEE

*Chair: Robert Giles, Qualcomm Incorporated*

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

*Board Liaison: Scott Barker, Micron Technology, Inc.*

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### **Committee Charter:**

The Committee will develop materials and programs to educate intellectual property owners about the opportunities, costs, challenges, and best practices for using § 337 to enforce intellectual property rights through the U.S. International Trade Commission. It will review changes in § 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 effective enforcement of remedial orders, establishing domestic industry under a variety of business models, the comparative costs and benefits of §337 actions, the benefits and restrictions of protective orders, scope of discovery, 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 2017:**

The ITC Committee has identified the following projects and goals for 2017:

#### **A. Ongoing Activities for 2017**

1. The ITC Committee is in the process of proposing a full-day program titled "The Fourth Annual 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 March to early June, 2017, in the San Francisco-Bay area in California. We anticipate attendance and participation by numerous in-house professionals, and one or more current ITC Administrative Law Judges, following the previous years' 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 the SF-Bay as a venue for its advanced training session as a geographic area rich with potential IPO corporate members.

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## **B. New Activities for 2017**

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.
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:
  - expected new rules from the Commission, which were previously the subject of a notice of proposed rule making;
  - 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;
  - the upcoming rulemaking by the CBP Intellectual Property Rights Branch regarding *inter partes* proceedings, a project that has been percolating for a few years;
  - the changing landscape of how the economic prong of the domestic industry requirement is fulfilled in Section 337 litigation;
  - the expected caseload of the Administrative Law Judges and the Commission;
  - the potential impact of various proceedings on Section 337 investigations, including hearings and oral arguments before the Commission;
  - 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.

## **C. Membership Initiatives for 2017**

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 COMMITTEE

**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.*

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### 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 2017:

- 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 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's Education sub-committee will conduct telephonic meeting, generally at 3:00 pm Eastern on the fourth Thursday of the month. The Education Committee will develop presentations to be delivered at regular committee meetings, IPO Chat Channel webinars, or the IPO annual meeting.
- 4. Interplay Between IPR and District Court Litigation:** The Committee will continue to work with the U.S. Post-Grant Patent Office Practice Committee, including in connection with (1) so-called "off ramp" legislation facilitating the use of re-exam and reissue in IPRs and (2) estoppel effects.
- 5. Uniformity of Privilege:** The Committee will continue to monitor, analyze and comment on rules changes pertaining to privileged communications between clients and patent practitioners.
- 6. Pending Legislation:** The committee will monitor pending legislation and if necessary offer resolutions to the board on proposed IPO positions on such legislation. This will include work with the Post-Grant and Patent-Office Committees to address pending legislation to limit *Chevron* deference.

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7. **Federal Rules:** The Committee will monitor the effect of recent changes to the Federal Rules, including pleading and discovery standards.
8. **Venue:** The Committee will continue to monitor the venue challenge in *TC Heartland, LLC v. Kraft Foods Group Brands, LLC*.

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## INDUSTRIAL DESIGNS COMMITTEE

**Chair:** *Thibault Fayette, Nike, Inc.*

**Vice Chair(s):** *Elizabeth D. Ferrill, Finnegan LLP*

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

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

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### **Committee Charter:**

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 2017:**

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 and WIPO to educate and generate rules, guidelines and policies that are beneficial to protecting designs (e.g., written description, GUI protection, portion claiming, 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 Chat Channel and/or CLE session for the annual meeting).
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

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deep and meaningful (e.g., Considerations for identifying the article of manufacture under 35 U.S.C. § 289 when the article is a less than the complete product sold ...)", Model Design Patent Jury instructions).

7. Conduct monthly conference call the third week of every month. The committee has already conducted conference calls on January 19 and February 16, 2017.

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## **PATENT SEARCH COMMITTEE**

**Chair:** Steve Sampson, Caterpillar Inc.

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

**Secretary:** Mark Harper, Dinsmore & Shohl LLP

**Board Liaison:** Elizabeth Ann Lester, Equifax, Inc.

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### **Committee Charter:**

This Committee will examine topics, and be a resource for information related to patent searching. It will define and publish different category guidelines related to patent searching (e.g., patentability, validity, infringement, right to practice), analyze techniques and sources for doing such searches, and outline best practices related to patent searching. The Committee will provide feedback on major patent offices' initiatives related to public availability of patent data as well as new patent examination search methodologies. It will examine search-related matters, in cooperation with other IPO committees when appropriate. In addition, the Committee will review the availability of search-related information from patent information suppliers and foreign countries to foster dialog about subjects related to patent searching. The Committee will propose ways, through published documents, to educate IPO members about subjects related to patent searching.

### **Committee Agenda for 2017:**

#### **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 Steve Sampson, of Caterpillar Inc.

#### **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 Steve Sampson, of Caterpillar Inc.

#### **Using patent search results**

The IPO Patent Search Committee will continue creating a bulletin, or hosting an IPO webinar, that recommends basic considerations for applying patent search results in

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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 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 Rockman IP Law.

### **Global Dossier**

The IPO Patent Search Committee created the IP5 Global Dossier subcommittee during 2016 for the purpose of preparing a bulletin that updates IPO members on the current status of the IP5 Global Dossier initiative. The proposed 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. A draft bulletin was completed and shared with the USPTO for comment during 2016 and the final version is near completion. The chair for this subcommittee is Steve Sampson, of Caterpillar Inc.

### **Free Patent Search Tools**

The IPO Patent Search Committee has completed creation of a bulletin that identifies several patent search tools that are currently available to the general public free of charge. This bulletin describes the benefits and limitations of several 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 was completed on February 20, 2017 and submitted to the IPO Board for distribution approval. The chair for this subcommittee is Ellen Krabbe, of Fresco Services.

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## PHARMACEUTICAL AND BIOTECHNOLOGY ISSUES COMMITTEE

**Chair:** Paul Golian, Bristol-Myers Squibb

**Vice Chair(s):** Mike Fuller, Knobbe Martens and Grant Drutchas, McDonnell Boehnen

**Secretary:** Kathryn Wade, Kilpatrick Townsend & Stockton

**Board Liaison:** Roy Waldron, Pfizer

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### **Committee Charter:**

The Committee will advise the IPO Board 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 non-U.S. counterpart laws and regulations. The Committee will identify amicus opportunities in the U.S., Europe, and elsewhere on key matters impacting the pharmaceutical and biotechnology industry. 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 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 2017:**

The Committee has planned the following agenda in 2017. 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. Provide comments following the next issuance of USPTO guidance on Patent Subject Matter Eligibility. Partner with the U.S. Patent Practice Committee, the U.S. Patent Law Committee, and the Software & Business Methods Committee on other areas pertaining to section 101 issues, including consideration of a legislative fix.
2. Follow developments in biosimilar litigation, including court interpretation of the BPCIA.
3. Review and provide comments on draft patent reform legislation, including changes in venue, international exhaustion, 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.

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4. Monitor how the PTAB decisions are affecting the pharmaceutical and biotechnology industry.
5. Follow developments in international patent practice, with a focus on patent legislation that negatively impacts the pharmaceutical and biotechnology industries. Monitor how the UN HLP report wends its way through multilateral organizations and international laws and policies. Ensure IPO fact finding participants are educated (via talking points or other 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 COMMITTEE**

**Chair:** James T. Hagler, *Qualcomm Incorporated*

**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*

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### **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 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 2017:**

In 2017, the committee will continue to follow the impact from the Alice v. CLS Bank case on the patentability of software in the US, as well as explore patentability of software in foreign jurisdictions. The committee will continue to monitor legislation, court decisions, and PTO guidelines and practices regarding section 101 patentability. The committee will be ready to provide input as desired to influence the outcome, and discuss best practice tips for obtaining patent allowance in view of the results. Already in 2017, the committee is working with the US Patent Law committee to form a subcommittee on Joint Artificial Intelligence, and have reviewed Ex-Parte Appeals Statistics to determine best practices for filing an appeal.

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## U.S. PATENT LAW COMMITTEE

*Chair: Scott Pojunas, Hewlett Packard Enterprise*

*Vice Chair(s): Gary Ropski, Brinks Gilson & Lione; Ognian Shentov, Jones Day*

*Secretary: Shaun Zhang, McAndrews, Held & Malloy*

*Board Liaison: Gary Ganzi, Evoqua Water Technologies*

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### 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 2017:

In January and February, the leadership team developed our strategy for 2017 and decided to maintain our existing committee structure, including three formal subcommittees and a number of other task forces and work groups. 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, led by Marian Underweiser of IBM, 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 continuing to explore whether to codify the judicially created inequitable conduct doctrine.

**§ 101 Resolution:** The Board of Directors recently passed a resolution based on the work of the § 101 Task Force. Members of our committee actively participated, including Marian Underweiser, who served as Chair of the Task Force.

**Proposed Resolution Regarding Laches:** A working group within the subcommittee led by Gary Ropski investigated and prepared a draft resolution calling for the codification of laches defense in patent litigation, if the Supreme Court's decision in *SCA Hygiene* eliminates laches as a defense in patent cases.

2. **Pending Patent Legislation Subcommittee:** This subcommittee, led by Andreas Baltatzis of KramerAmado, will monitor pending legislation, educate the committee on such legislation, and propose IPO positions on patent law issues in pending legislation. The subcommittee is currently working on the following initiative:

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**Monitor Activity of New Congress and Administration:** The subcommittee is analyzing the positions and activities of the 115th Congress and new presidential administration to identify potential impacts on patent law. The subcommittee recently collaborated with the Litigation committee to analyze past IPO resolutions on patent reform and, based on this work, co-presented a resolution on attorney fees at the January IPO Board meeting.

3. **Education Subcommittee:** This subcommittee, led by Matt Hertko of Jones Day, 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 February committee meeting, the subcommittee hosted a guest speaker on the *Apple/Samsung* litigation regarding design patents. Future topics include venue in light of the *TC Heartland* Supreme Court case.
4. **Artificial Intelligence Joint Subcommittee:** Several members of our committee, including Oggie Shentov who co-led an artificial intelligence panel at last year's Annual Meeting, are participating in a joint subcommittee on artificial intelligence to investigate issues such as patent eligibility for inventions created by AI.
5. **Collaboration with Other Committees:** Our leadership team will continue to reach out to leaders from other committees, including the U.S. Patent Office Practice, U.S. Post-Grant Patent Office Practice, and Litigation committees, to assist these committees with their initiatives. In April, our committee will collaborate with the Emerging Technologies and Trade committee to deliver a joint webinar on IP protection in big data.

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## **U.S. PATENT OFFICE PRACTICE COMMITTEE**

**Chair:** *Kaveh Rashidi-Yazd, Siemens Corporation*

**Vice Chairs:** *Courtenay C. Brinckerhoff, Foley & Lardner LLP; Sunjeev S. Sikand, RatnerPrestia; Kevin Greenleaf, Dentons*

**Secretary:** *Aamir Haq, Hewlett Packard Enterprise*

**Board Liaison:** *Manny W. Schechter, IBM Corp.*

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### **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 Board comments on such suggested changes in patent practice;
2. Survey the Committee's membership for feedback on and changes to patent practice that can be recommended to the USPTO for implementation. It will collect and analyze suggestions and proposals for changes to patent practice and develop recommendations for changes in the Patent Statute.
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 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.

### **Committee Agenda for 2017:**

1. Work closely and establish good rapport with incoming USPTO leadership, and use appropriate opportunities to communicate IPO's interests.
2. Hold at least one in-person meeting with USPTO leadership to discuss patent office practice.
3. Review and respond to proposed USPTO rule changes as they are published in the Federal Register, and respond to other USPTO requests for stakeholder input.
4. Monitor and comment on USPTO patent 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.

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7. Monitor executive orders and legislation affecting the USPTO, e.g., HR 5 (Regulatory Accountability Act)

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### U.S. POST-GRANT PATENT OFFICE PRACTICE COMMITTEE

**Chair:** *Bernard Graves, Eastman Chemical Co.*

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

**Secretary:** *Eleanor Yost, Carlton Fields*

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

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#### **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, the Director of the USPTO (via rulemaking proposals), the Trial Division of the Board of Patent Appeals and Interferences ("Trial Division") and its successor Patent Trial and Appeal Board, and the members of the Committee, related to post-grant proceedings in the USPTO.

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 might make recommendations to the Board concerning the "just, speedy, and inexpensive" administration of post-grant proceedings.

#### **Committee Agenda for 2017:**

- Preparation and submission of proposal(s) for Break-Out Sessions for 2017 Annual Meeting
- Reporting and monitoring of PTAB rule changes, including expected proposal on remands to the PTAB
- Advising on PTAB fee changes
- Advising on Federal Circuit en banc cases *In re Aqua Products* and *Wi-Fi One v. Broadcom*
- Monitor and advise on legislation
- 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 COMMITTEE

**Chair:** Laura Sheridan, Google Inc.

**Vice Chair:** Shruti S. Costales, HP Inc.

**Vice Chair:** Mercedes K. Meyer, Drinker, Biddle & Reath, LLP

**Vice Chair:** Priya G. Prasad, Exxon Mobil Corp.

**Secretary:** Serena I. Farquharson-Torres, Bristol-Myers Squibb Company

**Board Liaison:** Amelia Buharin, Intellectual Ventures, LLC

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### 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. (\* There are no changes to the Charter from 2016\*)

### Committee Agenda for 2017:

The Women in IP Law Committee is the newest IPO committee. Our membership has doubled from last year, now to 64 members (including one male member!) The committee meets monthly and has had two meetings in 2017. During our January meeting, Jennifer Benenson, General Counsel of Ipsen Pharmaceuticals, shared her experiences as a woman in IP law, and her progression and transition into her current role as general counsel. During our February meeting, Kelsey Milman, Assistant General Counsel of IP at Caterpillar Inc., shared her experiences progressing through various roles at Caterpillar, including managing the trademark group as a patent attorney. Our next meeting is on March 8, and we are thrilled to have our new Board Liaison Amelia Buharin, Chief IP Counsel at Intellectual Ventures LLC, as our external guest speaker. Laurel Beeler, Magistrate Judge from the N.D of California, will speak to the group in May.

This is the second year for the Women in IP Law Committee. We have 6 sub-committees. The IP Patch subcommittee will work with the IPO Education Foundation to develop an IP patch that can reach a broader audience than the Girls Scouts. The Push Forward subcommittee will package research from last year's white papers into a "tool kit" that can be used by IPO firms/corporations to address topics including vague feedback, speaking with influence, and work-life balance. The Push Forward subcommittee will also generate white papers on the following new topics this year – unconscious bias, pay gaps, and additional work-life balance issues. Last year, the Metrics subcommittee added questions to the IPO survey that is distributed by the Corporate IP Management Committee. The subcommittee will review the survey results, with a focus on the newly added questions, to formulate potential topics for future meetings. The Women in IP Speakers List subcommittee will set up a database of speakers. The survey is currently being pushed out to all committee members and will be circulated to the other standing IPO committees. The Mentoring Across Borders subcommittee will create a pool of mentors for IPO members to

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contact. Finally, the Diversity Education subcommittee will assist with webinars and use of the IPO Chat Channel for diversity education to IPO members.

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### ANTI-COUNTERFEITING COMMITTEE

**Chair:** Philip K. Yu, DuPont

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

**Secretary:** Aslam Mohamed, RNA IP Attorneys

**Board Liaison:** Doug Norman, Eli Lilly Co.

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### 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 2017:

Members of the Anti-Counterfeiting Committee have begun this year with a teleconference to review work done in 2016, and develop new goals for 2017 to reflect the Committee's objectives and constituency.

In accordance with the Committee's discussion for the new term, the proposed objectives for 2017 are:

- Report the survey result which was conducted late 2016 to the IPO membership;
- Educating IPO members, practitioners and other stakeholders about:
  - Resources available to combat counterfeits, e.g. developing a repository of information or "tool kits";
  - Leveraging customs process at various ports, and
  - Strategies and best practices for enforcement against on-line counterfeiting.
- Presenting resolutions to the IPO BOD for support of key issue(s) in global anti-counterfeiting, including concerns about the impact of "plain packaging" legislation on counterfeit goods;
- 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 COMMITTEE**

**Chair:** *Jake D. Feldman, Johnson & Johnson*

**Vice Chair(s):** *David A. Einhorn, Baker & Hostetler LLP;  
Joshua S. Jarvis, Foley Hoag LLP*

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

**Board Liaison:** *Creighton Fromer, RELX Group*

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### **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 NTIA 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, and monitor and evaluate the merit of proposed changes to the Federal Rules of Civil Procedure with respect to the use of e-mail for notice and notifications.

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 recapturing 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

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Trademark Division.

### **Committee Agenda for 2017:**

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 2017, the Committee plans to continue these critical activities, as well as address other domain name-related issues as they arise.

For 2017, 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 2017. 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.

The Committee was offered the opportunity to partner with INTA and other organizations in reviewing whether the Federal Rules of Civil Procedure should be amended to allow service by email. A resolution to participate in this process was presented to the IPO Executive Committee, and was approved. This year, further to the IPO Executive Committee's request, we will continue to pursue this opportunity.

The Committee is also investigating whether to challenge or otherwise work with the IPO Executive Committee through the resolution process to challenge or express a point of view on the requirements of certain new gTLDs, like .bible, that went beyond the materials presented to ICANN at the time of application.

The Committee is also considering pitching a session for the IPO Annual Meeting on the rights of publicity, particularly in the social media space.

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### U.S. TRADEMARK LAW COMMITTEE

**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.

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### 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. The Committee will monitor developments related to the use of marks. 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 2017:

- The Committee has scheduled monthly conference calls for the third Thursday of the month at 3:00 pm ET. The Committee has had one call so far in 2017.
- The Committee has formed working groups to evaluate the following new projects:
  1. Evaluate how nominative fair use should be treated and formulate a position.
  2. Research and evaluate impacts of plain/standardized packaging legislation and consider lobbying and outreach efforts.
  3. Formulate a position on whether an infringer's profits should be awarded absent willful infringement.
  4. Consider and evaluate the extraterritorial reach of the Lanham Act and whether a trademark must be used or registered in the US in order to support a claim for unfair competition.
  5. Create a rapid response team to consider and opine on requests from Amicus Committee.
- In addition, the Committee anticipates working on the following projects:
  1. Following developments in the *Pro-Football v. Blackhorse* and *In re Tam* cases and other disparaging/scandalous marks cases;

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2. Collaborating with the Anti-Counterfeiting Committee on addressing the challenges of combating gray market goods;
3. Surveying enforcement cases to evaluate whether trademark owners are being labeled “bullies” by the courts;
4. Surveying parody cases and reporting on new developments on monthly committee calls as appropriate; and
5. Suggesting topics for a 90 minute presentation or panel at the IPO Annual Meeting in San Francisco 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, Anti-Counterfeiting, Domain Names and Social Media, International Trademark Law and Practice, and Latin American Practice Committees. 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 COMMITTEE

**Chair:** Tara Rosnell, Procter & Gamble

**Vice Chair(s):** Allison Strickland Ricketts, Fross Zelnick Lehrman & Zissu, PC

**Secretary:** Chris Graff, Pirkey Barber, PLLC

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

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#### **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 affect 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 2017:**

The Committee will send representatives to participate in a face to face meeting with the Commissioner of Trademarks in June.

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.

If desired, the committee will develop substantive content for and otherwise support an IPO/USPTO Trademark CLE workshop re: "Making Accurate Claims of Use in Commerce."

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## AMICUS BRIEF COMMITTEE

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

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

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### 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.

### Status Report:

- Currently in the committee:
- 31 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.
- 10 briefs filed since the last Committee Leadership Meeting:
  - Sequenom, Inc. v. Ariosa Diagnostics, Inc., et al
    - **Issue:**
      1. Whether a claimed method must be considered as a whole for purposes of determining patent eligibility.
      2. Whether a claimed invention includes sufficiently more than patent-ineligible subject matter and thus is eligible for patenting under 35 U.S.C. § 101, including whether evidence that a claim at issue does not unduly preempt ineligible subject matter is relevant to such an analysis.
    - Filed supporting the cert. petition at U.S. Supreme Court on 18 April 2016 with assistance from Heslin Rothenberg Farley & Mesiti, P.C.
  - SCA Hygiene Products AG v. First Quality Baby Products, LLC et al.
    - **Issue:**
      1. Whether and to what extent the defense of laches may bar a claim for patent infringement brought within the Patent Act's six-year statutory limitations period, 35 U.S.C. § 286.
    - Filed supporting neither party at the U.S. Supreme Court on 22 July 2016 with assistance from Jones Day
  - Astrazeneca Canada Inc. et al v. Apotex Inc. et al
    - **Issue:**

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1. Clarification of the Canadian promise doctrine.
  2. Canadian Supreme Court guidance on how to discern promised utility.
  3. Clarification of the content of the “heightened” disclosure requirement in sound prediction cases.
- Motion for Leave to Intervene in this Canadian Supreme Court case filed on 2 August 2016; Factum of the Intervenor filed on 18 October with assistance from Torys LLP
- Life Technologies Corp. v. Promega Corp.
    - **Issue:**
      1. Whether the Federal Circuit erred in holding that supplying a single, commodity component of a multi-component invention from the United States is an infringing act under 35 U.S.C. § 271(f)(1), exposing the manufacturer to liability for all worldwide sales.
    - Brief filed at the U.S. Supreme Court on 7 September 2016 in support of neither party with assistance from McDonnell Boehnen Hulbert & Berghoff LLP
  - Star Athletica v. Varsity Brands
    - **Issue:**
      1. What is the appropriate test to determine when a feature of a useful article is protectable under section 101 of the Copyright Act?
    - Brief was filed at U.S. Supreme Court in support of the Varsity Brands on 19 September 2016 with assistance from Robins Kaplan LLP.
  - In re Aqua Products, Inc.
    - **Issue:**
      1. When the patent owner moves to amend its claims under 35 U.S.C. § 316(d), may the PTO require the patent owner to bear the burden of persuasion or production, regarding patentability of the amended claims as a condition of allowing them? Which burdens are permitted under 35 U.S.C. § 316(e)?
      2. When the petitioner does not challenge the patentability of a proposed amended claim, or the Board thinks the challenge is inadequate, may the Board sua sponte raise patentability challenges to such a claim? If so, where would the burden of persuasion or of production, lie?
    - Brief filed at U.S. Court of Appeals for the Federal Circuit in support of neither party on 5 October 2016 with assistance from Jones Day.
  - Impression Products, Inc. v. Lexmark International, Inc.
    - **Issue:**
      1. Whether a “conditional sale” that transfers title to the patented item, but specifies post-sale restrictions, avoids application of the

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- patent-exhaustion doctrine, thereby permitting enforcement of the restrictions through an infringement suit.
- 2. Whether the common-law doctrine barring restraints on alienation “makes no geographical distinctions” such that an authorized sale of a patented article outside the U.S. exhausts the U.S. patent rights.
  - Brief filed at U.S. Supreme Court in support of Lexmark on 22 February 2016 with assistance from Venable LLP.
- Wi-Fi One, LLC v. Broadcom Corp.
  - **Issue**
    1. Should this court overrule Achates Reference Publ’g, Inc. v. Apple Inc., 803 F.3d 652 (Fed. Cir. 2015) and hold that judicial review is available for a patent owner to challenge the PTO’s determination that the petitioner satisfied the timeliness requirement of 35 U.S.C. § 315(b) governing the filing of petitions for inter partes review?
  - Brief filed at U.S. Court of Appeals for the Federal Circuit in support of neither party on 22 February 2016 with assistance from Jones Day.

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

## **IPO Amicus Brief Committee**

### **IPO Interest as Amicus:**

To assist IPO in executing its stated policies and positions, the IPO Board of Directors has established an Amicus Brief Committee to oversee how IPO might respond to certain intellectual property disputes moving through the courts. The Committee shall determine IPO's interest as amicus in a matter by making a threshold determination that the matter presented raises a significant issue affecting the value of ownership that attaches to an intellectual property right or the ability of owners of intellectual property rights to effectively and efficiently obtain redress for infringements or threatened infringements on those rights. In general, the Committee shall make recommendations concerning the position IPO should take as amicus in a matter based on the interests of owners of intellectual property rights and adequate and effective protection for such rights, consistent with the rights of the public to freely enjoy public domain subject matter. The Committee shall focus its efforts on those intellectual property and legal issues that broadly impact the ownership of intellectual property, and therefore the Committee will not recommend that IPO act as an amicus in disputes that are narrowly drawn to the interests of the litigants.

### **Membership:**

The Amicus Brief Committee will consist of not more than 20 members. Fifty percent of the members must be members of the IPO Board of Directors. The Chair of the Committee will be a corporate member who is affiliated with a sustaining member of the IPO Board of Directors. If the Committee has a Deputy Chair, the Deputy Chair will be from an IPO corporate member. The Committee shall have two Vice-Chairs, who shall be law firm members of IPO with extensive experience in IP litigation matters. The remaining members of the Committee will be members of the IPO Board of Directors or partners or of counsel in law firm members of IPO. The members of the Committee will serve one calendar-year terms. The IPO President will appoint members to the Amicus Brief Committee. The chair of the Committee may, from time-to-time, recommend members for appointment to the Committee. The membership will reflect a diversity of areas of IP specialization.

### **Purpose:**

The Amicus Brief Committee will –

- (1) attempt to identify judicial and contested administrative matters where IPO should participate as amicus,
- (2) review requests from members of the public, including members of IPO, to determine whether IPO might participate as amicus,

- (3) review every IP case in which the U.S. Supreme Court grants a writ of certiorari, to determine whether IPO might participate as amicus,
- (4) review every IP case in which the U.S. Court of Appeals for the Federal Circuit grants en banc rehearing, to determine whether IPO might participate as amicus,
- (5) report to the IPO Board of Directors on judicial matters where the Amicus Brief Committee recommends that IPO should participate as amicus, proposing positions that should be taken in IPO amicus briefs,
- (6) when the IPO Board of Directors approves IPO participation as amicus, develop the submissions to be made as amicus prior to final approval by the IPO Board of Directors, and
- (7) on behalf of IPO submit amicus briefs approved by the IPO Board of Directors.

### **Committee Procedures:**

- (1) No member of the Committee may participate in any matter before the Committee if the member, or their firm, has a direct interest in the underlying matter before the Committee; this includes a law firm member whose firm represents a party in a matter in non-IP related issues. Members of the Committee who are or represent a party with a direct interest in any matter are required to affirmatively recuse themselves from Committee deliberations.
- (2) Committee discussions and positions in expected briefs should be kept confidential.
- (3) A request to the Committee to determine whether IPO might act as amicus in a controversy must be submitted to the chair via email. The submission must include, as email attachments, copies of relevant pleadings, motions, decisions, or other papers to reflect the nature of the controversy, the nature of the issue or issues of possible amicus interest, and a short paper (no more than three (3) pages) describing the underlying positions of the litigants. In addition, the party requesting amicus support shall provide notice to lead counsel of all parties involved in the litigation and will provide the Chair with the name and email address of such counsel. Requests for amicus support will be shared with opposing counsel who shall be free to make submissions to the Amicus Committee as well, so long as such submissions are made within three (3) business days from the original request. If the requesting party does not notify opposing counsel, the Chair reserves the right to delay consideration of the request until opposing counsel is so informed of the request for amicus support. Finally, the party requesting amicus support from IPO shall inform the Chair of the names of other organizations from which amicus support has also been requested.
- (4) When a request is made that meets the requirements above, and the Chair, the Deputy Chair (if any), and Vice-Chairs believe the merits of the request may warrant further discussion, the Chair will forward the materials received from the requestor to the members of the Committee via email and schedule a teleconference for further discussion among the members of the entire Amicus Brief Committee. IPO reserves the right to file a brief on any issue or position arising from the suit, regardless of whether that position is the one advocated by the initial requester or the opponent.

- (5) After a full discussion of the matter, the Committee will undertake a final vote concerning a recommendation to the IPO Board of Directors of the position that IPO should undertake with respect to the amicus request. The Committee will not recommend to the IPO Board of Directors the participation of IPO as an amicus except upon a two-third's vote of the membership of the Committee who are participating in the teleconference.
- (5) If the IPO Board of Directors authorizes IPO to participate as amicus in a matter, the chair shall appoint one or more members of the Committee to serve as a drafting committee for any submissions that IPO as amicus might make in connection with the matter. The draft submission will be circulated by the drafting committee to the IPO Board of Directors for approval.
- (6) With approval from the IPO President, the IPO Executive Committee may recommend to the IPO Board of Directors that IPO participate as amicus in a case and propose the position(s) to be taken in such a brief, without consulting the Amicus Committee.

#### **IPO Board of Director Approval Procedures:**

If the Amicus Brief Committee determines that it would support the filing of an Amicus Brief, the Committee will provide a clear, written explanation of why the filing of a brief is in the general interest of IPO. The IPO Board of Directors shall receive recommendations from the IPO Amicus Brief Committee for participation of IPO as amicus and submit these recommendations to the Board for approval when the Board determines that the recommendation properly reflects IPO's potential interest as amicus and the matter is of sufficient interest to merit amicus participation by IPO. A three-quarters vote of the Board is required for approval.



## **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](mailto: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](http://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.

3 January 2017



## **IPO Standing IP Committee Policy Manual**

**IPO President**

Kevin H. Rhodes

**Executive Director**

Mark W. Lauroesch

**Deputy Executive Director**

Jessica K. Landacre

**Intellectual Property Owners Association (IPO)**

1501 M Street, NW

Suite 1150

Washington, DC 20005

(202) 507-4500

[committees@ipo.org](mailto:committees@ipo.org)

[www.ipo.org/committees](http://www.ipo.org/committees)



## 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](mailto: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 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 has a number of 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](http://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.

Chairs and vice chairs should communicate regularly with their board and staff liaisons for guidance regarding existing board resolutions and other positions, past board rejections of certain recommendations, whether changes in circumstance merit revisiting a position, and projects to which the Board is not likely to be receptive. 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](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.

The preparation process for drafting IPO comments and letters is depicted below.



**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**

In 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 10.

### **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.
- A plaque for the chair(s), vice chair(s), secretary, and board liaison – 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](http://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](mailto: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](http://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](http://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.

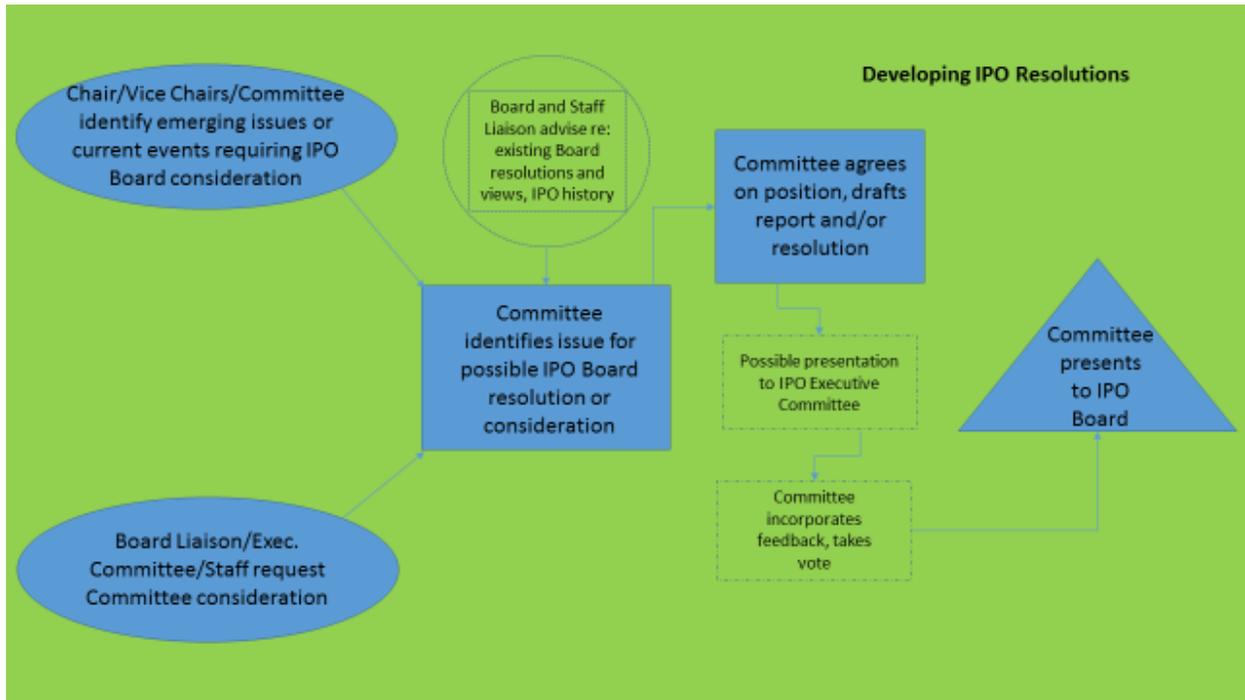
Such reports should be concise (usually no more than three - four pages) and include the following sections:

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

The preparation process for developing an IPO resolution for consideration by the board is depicted below.





## 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](mailto: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](http://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.

IPO's Standing IP Committees have two options for hosting webinars: committee-sponsored webinars and IP Chat Channel webinars. These two approaches have some key differences that are outlined below.

### **IP Chat Channel Webinars**

IPO's IP Chat Channel is a weekly one-hour webinar series on current IP topics that is produced in cooperation with host Pamela Sherrid, an IPO contractor. IPO encourages committee proposals for IP Chat Channel webinars that are likely to appeal to a broader audience than committee members.

- The committee submits the topic and speakers directly to IPO for approval through your staff liaison.
- Once the topics and speakers are approved, Pamela Sherrid will work with the speakers to coordinate the date/time, presentations, and materials.
- Committees will receive recognition for their role in planning the webinar.
- Attendees include IPO members and members of the general public. IPO promotes these webinars.
- IP Chat Channel webinars are registration-based with a per user, per webinar fee. Webinars are available on an unlimited basis to annual pass holders.
- IPO applies for CLE credit for registered attendees at live webinars in most states (visit [www.ipso.org/ipchatchannel](http://www.ipso.org/ipchatchannel) for more information on CLE).
- Webinars are recorded and available for purchase on-demand on the IPO website.
- Those interested in guest hosting an IP Chat Channel webinar should email your committee staff liaison the following information:
  - Name of committee
  - Name of a primary contact on the committee
  - Proposed topic
  - Suggested speakers

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### **Committee-Sponsored Webinars**

Committee-sponsored webinars are planned and executed entirely by the committee. IPO has WebEx online meeting software that is available to host these types of events. For committees that would like to have the most control over the content of the webinar, this is the best approach.

- The content is generated and controlled solely by the committee.
- Speakers are generally committee members; on occasion a webinar will be hosted with a guest speaker who is not a member of the committee.
- Attendees are members of your or of other committees; these types of webinars are not advertised to the general membership or others outside IPO committees.
- These webinars are free for attendees and do not require advance registration.
- IPO will **not** apply for CLE credit for attendees or speakers.
- Those interested in hosting a committee-sponsored webinar should contact Colleen Wellington-Caban in the IPO office at [cwellington-caban@ipo.org](mailto:cwellington-caban@ipo.org) with the following information:
  - Name of committee
  - Webinar topic
  - Proposed date, start time and end time
  - Name of webinar moderator and primary contact person to be the liaison with the IPO office on webinar logistics