



IPO

**2019 Standing IP Committee
Leadership Meeting**

**Hyatt Regency Hotel
Austin, Texas
8 March 2019**



AGENDA

IPO COMMITTEE LEADERSHIP MEETING

Friday, 8 March 2019
8:30a.m. – 12:00p.m. CT

Hyatt Regency Hotel, Texas Ballroom
Austin, Texas
(Continental Breakfast Available at 7:30a.m. CT)

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- 8:30a.m. Welcome Remarks by Henry Hadad, IPO President
- 8:35a.m. Remarks by Mark Lauroesch, IPO Executive Director
- 8:40 a.m. Presentations from the Standing IP Committees (2 mins. each)

I. Business Issues Division

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

II. Copyright Law Division

- a. Copyright Law and Anti-Piracy

III. International IP Law and Practice Division

- a. Asian Practice
- b. Canadian Practice
- c. European Practice
- d. International Patent Law and Trade
- e. International Trademark Law and Practice
- f. Latin American Practice

IV. Litigation and Dispute Resolution Division

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

V. Patent Division

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

VI. Professional Division

- a. Women in IP Law

VII. Trademark Division

- a. Anti-Counterfeiting
- b. U.S. Trademark Law
- c. U.S. Trademark Office Practice

- 9:55a.m. Amicus Brief Committee Report
- 10:00a.m. Panel – Committee Best Practices – **Samantha Aguayo**, Moderator
Jimmy Chen (Qualcomm), Chair, Asian Practice Committee
Wendy Larson (Pirkey Barber PLLC), Vice Chair, U.S. Trademark Law Committee
Michael Kahn (Akin Gump), Secretary, Litigation Committee
Brian Suffredini (United Technologies), Board Liaison, U.S. Post-Grant Patent Office Practice Committee
- 10:30a.m. Networking/Collaboration Discussion with Committees of Your Choice
- 12:00p.m. Adjournment

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2019 IPO STANDING IP COMMITTEE LEADERSHIP MEETING

HYATT REGENCY HOTEL (AUSTIN, TEXAS)

8 MARCH 2019

Corporate IP Management Committee

Chair: Jeffrey Fougere, Hewlett Packard Enterprise

Vice Chair: Neil Kardos, Harrity & Harrity

Vice Chair: Ambar Nayate, Shumaker & Sieffert

Secretary: Brian Hubbard, Condo Roccia Koptiw

Board Liaison: Daniel Enebo, Cargill, Incorporated

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 2019

1. The committee will train committee members on the value of Artificial Intelligence (AI) tools and the types of AI tools that are available. A sub-committee will further dive into this topic and publish their findings for the larger IPO
2. The committee will form a sub-committee to discuss training material that can help in-house counsel understand and “talk the language” of company executives to assist company executives in understanding the role of IP within their companies.
3. The committee will form a sub-committee to formulate a “tool-kit” to help new in-house counsel, including Chief IP counsels, hit the ground running when starting in their companies.

2019 IPO STANDING IP COMMITTEE LEADERSHIP MEETING

HYATT REGENCY HOTEL (AUSTIN, TEXAS)

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IP Licensing Committee

Chair: Jennifer Carnahan, Dow Chemical Co.

Chair: Andrew Wojnicki, IBM Corporation

Vice Chair: Christopher Smith, Brooks Kushman P.C.

Secretary: Adrian Cyhan, Dinsmore & Shohl LLP.

Board Liaison: Bill Krovatin, Merck & Co Inc.

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; Post-Expiration Royalty Considerations; and IP Contract That Are Unenforceable or Result in Unintended Consequences. The Committee interfaces, when applicable, with other committees on issues pertaining to standards, anti-trust, and other areas of mutual interest.

Report:

1. **Key Accomplishments:** The Committee continued to provide topical presentations at its monthly meetings, from guest speakers as well as Committee members, spanning a range of topics and skill levels. The Committee continued its licensing case law sub-committee, which provided one of the monthly presentations. The committee participated in addressing an RFC from NIST on federally funded technology transfer. The committee also created and implemented a member survey, reviewing the results and soliciting comments and improvement suggestions at the IPO Annual Meeting.
2. **Recommendations for Committee Activities in 2019:** The Committee plans to continue monthly training sessions during 2019. The Committee plans to implement suggestions from the Committee's business meeting at the 2018 IPO Annual meeting, such as simplifying content requirements for monthly presentations, and increasing communication and participation with other IPO committees. 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 2019 Annual Meeting. The Committee will continue tracking case law developments via the licensing case law sub-committee.

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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: *Buckmaster de Wolf, General Electric Co.*

Committee Charter

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

Committee Agenda for 2019

1. Continued to monitor domestic and foreign trade secret developments.
 - a. Monitor legislative developments by EU member states in compliance with the EU Trade Secrets Directive, which requires member states to be compliant by June of 2018.
 - b. Monitor judicial developments in cases brought under the Defend Trade Secrets Act.
2. Propose resolution, for consideration by the IPO Board, supporting amendment of 28 U.S.C. § 1782, which relates to discovery assistance by U.S. courts to foreign tribunals. This amendment would achieve international evidence parity and provide protection of trade secrets of U.S. companies subject to a petition under § 1782.
3. Actively promote 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.
4. Educate IPO members about developments in trade secrets law, trade secret litigation, and corporate trade secret management programs, such as industry practices for identifying and cataloging trade secrets.
 - a. On January 30, 2018, vice chair Vicky Cundiff was a panelist on IPO Chat Channel webinar on "Settling Trade Secret Disputes."
 - b. Explore use by IPO members of a survey offered by CREATE.org that measures the maturity of a company's approach to the people, process and technology related to trade secret protection.
5. Work with the IPO Copyrights and Software Committees on considering the rules for protecting the trade secrets contained in software deposits at the Copyright Office.

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Copyright Law & Anti-Piracy Committee

Chair: Terry Carroll, IBM Corp.

Vice Chairs: Jenevieve Maerker, Foley Hoag LLP

Secretary: Lesley C. Boveri, SAP SE

Board Liaison: Matthew Sarboraria, Oracle Corporation

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 2019

1. Continue to monitor and provide input on potential legislation and regulatory proceedings and secondary sources regarding copyright issues, including but not limited to Copyright Office modernization, Copyright Office leadership, orphan works, small claims, exemptions to the prohibition against circumvention of technological measures protecting copyrighted works, statutory damages, first sale in embedded software, DMCA notice and takedown safe harbor and other potential copyright legislation, the proposed ALI Restatement of Copyright, and advise the IPO Board regarding positions on any such proposed legislation, regulations or secondary source.
2. Plan and propose session topics on copyright law for 2019 IPO Annual Meeting.
3. Continue to monitor relevant copyright cases, legislation, U.S. Copyright Office policies, and activities of the U.S. 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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Asian Practice Committee

Chair: Jimmy Cheng, Qualcomm Inc.

Chair: Michelle Shen, Medtronic

Vice Chair: Robert Siminski, Harness, Dickey & Pierce, P.L.C.

Vice Chair: Michael D'Aurelio, Thomas|Horstemeyer, LLP

Vice Chair: Ann Chen, Eli Lilly and Company

Secretary: Brad Chin, Bracewell LLP

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

Committee Charter

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

- Organizing IP Innovation Dialogue visits to Asia
- Organizing/conducting/participating in seminars and conferences within the United States and Asia directed to Asian intellectual property rights (IPR)
- Making recommendations to the IPO Board on potential collaborations between IPO and Asian legal/trade associations such as China IP Law Society and PPAC (Patent Protection Association of China)
- Preparing and drafting comments on proposed new IPR legislation, regulations, and policies in Asian jurisdictions on behalf of IPO

Committee Agenda for 2019

1. An IP Innovation Dialogue trip to China tentatively scheduled for late October/early November.
2. A special day-long conference with the China IP Law Society, in conjunction with the IP Innovation Dialogue trip.
3. Submission of comments with respect to proposed changes in the patent/trademark laws, antimonopoly laws, and other IP-related laws, rules, and regulations of various Asian jurisdictions.
4. Monthly conference calls, with occasional guest speakers, on Asian IP topics of interest.
5. A CLE breakout session during the IPO Annual Meeting directed to a review of the IP landscape of one or more Asian jurisdictions.

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Canadian Practice Committee

Chairs: Arvie Anderson, Eli Lilly and Co.

Brian Walsh, Bristol-Myers Squibb

Vice Chair: Santosh Chari, Blake, Cassels & Graydon LLP

Secretary: Diane Yee, Johnson and Johnson

Board Liaison: Robert Deberardine, Chief Patent Counsel, Johnson and Johnson

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 will also study and report on issues relating to Canadian antitrust and competition laws impacting intellectual property owners and seek to educate IPO members about these issues. 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.

Committee Agenda for 2019

Schedule of Canadian Practice Committee conference calls and meetings - Monthly Conference Calls

Key Initiatives

Trade

1. "NAFTA 2.0" Implementation (PTA, Copyright term increase, Collective Marks, Domain Names, Industrial Designs and Biologic Data Protection)
2. TPP Canada Implementation
3. CETA implementation

New Patent Act and Patent Rules Issues

1. Removal of right to reinstatement and right of late entry into PCT National Phase
2. New obligations on patent rights holders in issuing Written Demands to infringers
3. Introduction of prosecution history estoppel (in relation to claim construction)
4. Maintenance Fees
5. Ability to request Restoration of Priority
6. Delayed Requirement for Translation of national entry specification
7. Certified Copy of Priority Document
8. 27/7/365 Filing
9. Shortened Prosecution Timelines
10. Expansion of scope of prior user rights

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Pharmaceutical Patent Issues

1. Monitor development of Non-Infringing alternative argument
2. CIPO Policy on Diagnostic Method Patents (in particular, the refusal of diagnostic claims using the unchallenged “problem/solution” analysis)
3. Amendments to Patent Rules (CETA implementation)
 - a. CSPs and the manufacturing “Export” exception
 - b. Patent enforcement and Section 8
4. Monitoring competition issues relating to pharma patents
5. PMPRB Issues/Amendments
 - a. Comment upon and monitor proposed Guidelines
 - b. *Ad Hoc* review of decisions
 - c. changing the patentability conditions and/or creating special categories of inventions is not the way to address pharmaceutical pricing
 - d. partner with other committees on this
6. Section 8 and claims after unsuccessful PMNOC proceedings
7. Biosimilar law and policy
8. Price of Pharmaceuticals

Copyright Issues

1. New border enforcement provisions (addressing counterfeit goods)

Trademark Issues

1. New border enforcement provisions
2. Issues relating to any new CA Trademarks Act amendments:
 - a. Removal of “use” requirement for registration of marks
 - b. Institution of Nice classification system and additional filing and renewal costs
3. Changes to Trademarks Regulations (in relation to new Act)

Other Issues to Monitor

1. Standard of disclosure for confidential business information (CBI)
2. Divisional/Double Patenting Practice (Lack of US-Style Terminal Disclaimer Practice)
3. Test for Obviousness in Canada and Relevant Prior Art (CIBA leave application)
4. Changes to MOPOP relating to CIPO interpretation of new Act and Rules and new case law
5. Issues relating to patenting of computer implemented inventions (CIPO’s unchallenged policy of using “problem/solution” approach)
6. Insufficient injunction Relief
7. Monitor for legislation on the set-up of a “College” to regulate patent and trade-mark professionals and its rules

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European Practice Committee

Chair: *Gautier Engisch, Procter & Gamble*

Chair: *Manisha A. Desai, UCB Biopharma SPRL*

Vice Chair: *Aloys Hüttermann, Michalski · Hüttermann & Partner*

Vice Chair: *James Signor, Leydig, Voit & Mayer Ltd.*

Vice Chair: *Matthew Georgiou, Carpmiels & Ransford LLP*

Secretary: *David Black, Schwegman, Lundberg & Woessner, P.A.*

Board Liaison: *Thomas Smith, GlaxoSmithKline*

Committee Charter

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

Committee Agenda for 2019

Meetings:

1. The Committee will continue to hold monthly teleconferences, which will include substantive topics on IP practice in Europe.
2. The 8th European conference will be held in Basel on 2 May 2019. The title of this year's conference is: "The ever-changing IP Landscape: Patents, Trademarks and Trade Secrets in 2019 and beyond," and will include sessions on data protection, equivalents in patent law, and current issues in patent and trademark law. Confirmed speakers include Hon Judge Prof. Dr. Klaus Grabinski, Bundesgerichtshof; Prof. Dr. Ulrich Hildebrandt, SKW Schwarz and Robert Stanley, Novartis.

Advocacy Activities:

Our Committee will continue to monitor legislative and juridical activities in Europe and will decide whether it advocates for IPO to be involved through submissions or amicus briefs as opportunities arise.

1. The Committee responded to an invitation from the European Patent Office to comment on the EPO Strategic Plan, 2019-2023.

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2. In collaboration with the Industrial Designs Committee, the Committee will prepare and submit a response to a public consultation on design protection in the European Union.

Continued Recruitment Activities:

1. We plan to continue to seek new membership with European companies and European law firms and plan to appeal directly to IPO Board members to encourage corporate IP attorneys to participate in committee activities.
2. We will continue to encourage our members to actively collaborate with the International Practice Committee on articles for the newsletter and actively contribute European news items to the IPO Daily News, thus continuing to ensure interest amongst the US practitioners in the European IP scene.

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International Patent Law & Trade Committee

Chair: Stephen Bauer, Medtronic

Vice Chair: Janet Cord, Ladas & Parry LLP

Vice Chair: Mark Guetlich, Viziv Technologies, LLC

Vice Chair: Ognian V. Shentov, Jones Day

Secretary: Mark W. Croll, Leydig, Voit & Mayer, Ltd.

Board Liaison: Todd N. Spalding, Alexion Pharmaceuticals

Committee Charter

The Committee will focus on developing and proposing IPO positions (coordinating with other committees and IPO members), awareness (white papers and education) and monitoring developments in:

1. Intellectual property in the context of trade, such providing comments to the U.S. Trade Representative (USTR) for the annual Special 301 Report, bilateral trade agreements (e.g., USMCA/NAFTA), and WTO;
2. WIPO and international patent filing including improving the cost efficiency of international patent portfolios;
3. Genetic resources and traditional knowledge 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; and
4. Global assignment, which is an IP5 Patent Harmonization Experts Panel initiative to streamline recording ownership of patents, utility models, provisional applications, and priority rights around the world.

The Committee will accomplish these multiple foci through its subcommittee structure:

Subcommittee	Chair(s)
Genetic Resources and Traditional Knowledge	Bill Warren
Global Assignment	Phil Soo
Trade	Steve Bauer (Co-Chair); Open (Co-Chair)
WIPO and International Filing	Mark Guetlich

Committee Agenda for 2019

In 2019, we intend to consolidate the new approach to preparing the Special 301 Report which involves actively reaching out to the other IPO committees. Additionally, we will support the sub-committee on the global assignment developing a global assignment document before the IP5 meeting in the Summer 2019. We will also continue our focus on educating membership on current international patent law issues and will assist the IPO regarding its efforts to increase its international strategic focus. The Committee will develop the subcommittee organization outlined above.

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International Trademark Law & Practice Committee

Chair: Matthew G. Owen, Caterpillar Inc.

Vice Chair: Dr. Victoria Longshaw, Houlihan² Patent & Trade Mark Attorneys

Secretary: Frances Jagla, Lane Powell PC

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

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 2019

Members of the Committee meet monthly via teleconference.

Members of the Committee are identifying topics for a white paper similar in format and international scope to the paper on “Protection of Graphic Logo Trade Marks Around the World – Copyright or Trade Mark Enforcement? An International Survey of Twenty (20) Countries” published in 2017 and to the White Papers and Annual Meeting Presentations on Shape Trade Marks (in 2015), Bad Faith Filings (in 2013), Famous Marks (in 2011), and Colour Marks (in 2009).

The Committee will work with the International Patent Law and Trade Committee to provide analysis of issues related to the grant and continued validity of trademarks filed in bad faith in India, China, and other significant markets with an eye towards inclusion in next year’s Special 301 Report.

In 2018, the Committee prepared comments on proposed amendments of the Trademark Law of the People’s Republic of China. This year, the Committee has been informally invited to provide comments on administrative enforcement in China. In addition, 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: Sharon E. Hayner, Johnson & Johnson

Vice Chair: Ricardo Nunes, Daniel Legal & IP Strategy

Secretary: Breno Akherman, Daniel Legal & IP Strategy

Board Liaison: Michael C. Lee, Google Inc.

Committee Charter

To identify, monitor, study and recommend IPO positions regarding intellectual property acquisition, licensing and enforcement issues in Latin America with initial emphasis on Mexico, Brazil, Columbia, and Argentina. To also disseminate and exchange information and views among corporate members of IPO regarding intellectual property problems in Latin America. This committee will also study and report on issues relating to Latin American antitrust and competition laws impacting intellectual property owners and seek to educate IPO members about these issues. Regular activities of the committee will include:

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

Committee Agenda for 2019

The committee's expectations/plans for the year of 2019 are:

1. Attracting more participants to the committee, giving more emphasis to in-house counsels.
2. Better engaging the current participants and new participants to the committee's activities.
3. Planning an additional in-person meeting of our members (other than the one at the annual meeting), in Latin America, during a relevant local IP congress/event.
4. Inviting inside and outside speakers to make presentations during the monthly calls addressing updates and relevant topics in their jurisdictions.
5. Gathering up with another committee to host a breakout session during the IPO annual meeting.

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Damages & Injunctions Committee

Chair: Tom Brown, Dell Inc.

Vice Chair: Karen Weil, Knobbe, Martens, Olson & Bear, LLP

Secretary: Jenna Pellicchia, Akin Gump Strauss Hauer & Feld LLP

Board Liaison: Thomas R. Beall, Corning Incorporated

Committee Charter

The Damages & Injunctions Committee intends to identify and discuss the various legal and economic theories of intellectual property damages currently accepted by the courts, including the elements necessary to prove damages under those theories. The Committee will strive to examine, compare and contrast the damages frameworks in various intellectual property fields. Damages theories discussed will include reasonable royalty, lost profits, price erosion, and any other theory of damages that may be allowed by the courts.

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 2019

- 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, as well as decisions from the regional Circuits and the Supreme Court, that are likely to significantly affect intellectual property litigation.
- Continue the process of completing a white paper on the status of apportionment law.
- Continue to work with IPO leadership on appropriate resolutions regarding damages and injunctions.
- Work with IPO leadership to develop and promote CLE programing for the Annual Meeting, the Committee, and the broader IPO membership that addresses issues of note to the legal community concerning damages and injunctions.
- Work with IPO leadership to plan an in-person meeting that would be a hybrid of the previous summits put on by the Damages & Injunctions Committee and the ITC Committee's "Advanced Litigation Class."
- Continue to evaluate relevant issues in damages and injunctions law and draft white papers on such issues.

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Litigation Committee

Chair: Laurie Gathman Kowalsky, Koninklijke Philips N.V.

Chair: Kirby W. Lee, Ecolab Inc.

Vice Chair: Eileen M. Hunter, 3M Innovative Properties Co.

Vice Chair: Brian Horne, Knobbe, Martens, Olson & Bear, LLP

Vice Chair: Eley O. Thompson, Foley & Lardner LLP

Secretary: Michael Kahn, Akin Gump Strauss Hauer & Feld

Board Liaison: Steve Caltrider, Eli Lilly & Co.

Committee Charter

It is very important to intellectual property owners that litigation involving their intellectual property rights 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 and related proceedings in the U.S. Areas of potential focus include: (a) judicial practices and procedures; (b) emerging case law; (c) litigation management and best practices for in-house counsel; and (d) relevant statistical assessment of cost effective patent litigation. In addition to focusing on paths to improving the litigation process, the committee scope includes developing information resources for intellectual property owners and their management regarding the complexity, cost and risks of intellectual property litigation.

Committee Agenda for 2019

- 1. Venue:** The Committee will continue its work on addition portions of a venue resolution. In 2018, the Committee successfully proposed a resolution concerning motions to transfer for foreign defendants. Additional work will continue with respect to the impact of retail sales and also declaratory judgment actions.
- 2. 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.
- 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. Discovery and Data Security:** The subcommittee by that name will explore the establishment of a set of standards useful as a resource for parties at the outset of discovery to ensure that party data is treated during discovery in the same or similar manner to how corporate data is treated in the ordinary course.

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5. **Injunctive Relief:** A joint project between the Litigation Committee and the Damages Committee concerning the state of injunctions and the standard for permanent injunctions in patent infringement cases.
6. **Interplay Between IPR and District Court Litigation:** The Committee will continue to work with the U.S. Post-Grant Patent Office Practice Committee to track the developing guidance concerning the scope of estoppel.
7. **Opinions of counsel and avoiding enhanced damages:** The Committee will examine the relationship between clearance policies and willfulness including analysis and development of possible best practices in light of prevailing law.

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U.S. International Trade Commission Committee

Chair: Brett Bachtell, Qualcomm Incorporated

Vice Chair: Sarah Hamblin

Vice Chair: Elizabeth A. Niemeyer, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

Secretary: Dan Valencia, Covington and Burling, LLP

Board Liaison: Scott Barker, Micron Technology, Inc.

Committee Charter

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

Committee Agenda for 2019

The ITC Committee has identified the following projects and goals for 2019:

A. Ongoing Activities for 2019

1. The ITC Committee anticipates submitting one or more proposals for an annual meeting breakout session and hopes to work with one or more other committees to submit a proposal jointly.
2. Continuing previous efforts, the ITC Committee will promote new membership, particularly from the corporate arena. To achieve this goal, the Committee will encourage members to reach out to their networks and encourage contacts with interest in ITC practice to join the IPO and/or the committee.
3. The ITC Committee will continue to consider and promote topics for the IPO chat channel that substantively address interesting developments and hot topics affecting ITC practice and practitioners.
4. The ITC Committee will consider organizing informal "brown-bag lunches," allowing nearby members to have in-person discussions on interesting topics, as schedules allow.
5. In an effort to increase the depth and breadth of Section 337 practice, the ITC Committee will continue to identify potential topics for white papers and informal seminars, including, but not limited to:

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- the ITC's 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 pending 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 changes in personnel at the Commission on current practice and caseloads;
 - 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.
6. To build on its work related to the enforcement of Commission-issued exclusion orders, the ITC Committee will continue to examine ways in which such enforcement can be made more effective, including an IPO initiative to increase funding for Customs.
 7. In the interest of streamlining proceedings at the ITC and conserving the ITC's resources, the ITC Committee will continue to seek out initiatives for proposal that could be used to improve ITC procedures and increase efficiency.

B. New Activities for 2019

1. The ITC Committee will review Commission notices and potentially submit comments when solicited by the Commission and approved by IPO.
2. In order to accomplish its goals for the year, the ITC Committee will continue to hold regular conference calls.
3. The ITC Committee will continue to encourage participation from its corporate members to ensure the committee advocates positions desirable to IP owners.

C. Membership Initiatives for 2019

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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Emerging Technologies Committee

Chair: Daniel A. Staley, Caterpillar Inc.

Vice Chair: Bryan J. Vogel, Robins Kaplan LLP

Vice Chair: Ronald G. Embry Jr., Hauptman Ham, LLP

Secretary: Jeff Gordon, Borden Ladner Gervais LLP

Board Liaison: Micky Minhas, Microsoft

Committee Charter

The Emerging Technologies Committee is responsible for exploring the global landscape of technology and promoting intellectual property protection of emerging technologies that impact industries. The Committee will monitor and track judicial, legislative, and regulatory activity related to emerging technologies.

Committee Agenda for 2019

1. Prepare an updated brief, high-level summary of key emerging technologies and issues that might necessitate the need for new or updated IP laws and policies to best serve the owners of those new technologies, along with a projected timeline of expected developments.
2. Contribute proposals for sessions at the IPO Annual Meeting.
3. Prepare white papers on the potential industry and IP impacts of emerging technologies with a focus on potential processes for identification of ET, corporate structures, and enforcement strategies. The focus will be to provide an informative white paper applicable for small, medium, and large corporations.
4. Organize a series of discussions and guest speakers on emerging technologies.
5. Continue to grow agendas of the Additive Manufacturing, Artificial Intelligence and IoT subcommittees and speaker series.
6. Support IPO activities addressing emerging technologies.
7. Look for strategic platforms to express IPO positions relating to trade and IP, including the development of national IP policies around the world.
8. Explore the formation of additional subcommittees to address emerging technologies

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Industrial Designs Committee

Chair: Jaime Lemon, Nike, Inc.

Vice Chair: Elizabeth Diane Ferrill, Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

Vice Chair: Bart Fisher, Caterpillar Inc.

Vice Chair: Anthony Michael Prenol, Blake, Cassels & Graydon LLP

Secretary: Danial A. Gajewski, Sterne, Kessler, Goldstein & Fox, PLLC

Board Liaison: Louis Foreman, Enventys

Committee Charter

The IPO Industrial Designs Committee will focus its work on identifying challenges in industrial design intellectual property (IDIP) ownership. The Committee will also focus on educating IPO members, the judiciary and other stakeholders regarding the value of IDIP 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 IDIP ownership. In doing so, the Committee will monitor and review United States and foreign jurisdiction legislation, case law, and rule changes, and will proactively submit comments and recommendations for protecting IDIP in various jurisdictions, particularly the United States, Europe, Japan and China. Further, the Committee will coordinate its activities with other relevant IPO Committees.

Committee Agenda for 2019

- Submitting a proposal to IPO for a design-patent focused “mini” track at the IPO Annual Meeting for 2019;
- Revision of IPO’s Model Design Patent Jury Instructions;
- Assessing/acting with respect to USPTO proposals/rules (included proposed updates to MPEP, inconsistent examination practices and patent printing errors);
- Convening a task force to study of changes needed to allow US Customs to enforce design patents at the US border;
- Continued planning and sponsorship of Design Day 2019;
- Consider and comment on resolutions that promote design protection;
- Developing CLE sessions; and
- Conducting subcommittee-level projects considering design specific issues in depth for presentation to the committee and larger IPO if appropriate.

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Patent Search Committee

Chair: Steve Sampson, Caterpillar Inc.

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

Secretary: Mark A. Harper, Burriss Law, PLLC

Board Liaison: KaRan Reed, BP America, Inc.

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 USPTO, as well as other 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 and/or international patent authorities, where 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 2019

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.

Free patent search tools

The IPO Patent Search Committee is continuing its efforts to inform IPO members regarding patent search tools that are currently available to the public free of charge. During 2019, the Free Patent Search Tools subcommittee will investigate both Espacenet and PatentScope and begin drafting associated IPO bulletins. The chair and co-chair for this subcommittee are Ellen Krabbe, of Fresco Services, and Cynthia Barcelon-Yang, of Bristol-Myers Squibb.

AI and prior art searching

The IPO Patent Search Committee will investigate the topic of artificial intelligence (AI) with respect to patent searching. The new AI and Prior Art Searching subcommittee will examine the way AI is currently applied to patent information in general, including the problem of identifying relevant prior art and determining appropriate patent classifications. The chair for this subcommittee is Mark Harper, of Burriss Law PLLC.

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Pharmaceutical & Biotechnology Issues Committee

Chair: Paul Golian, Bristol-Myers Squibb

Vice Chair: Grant Drutchas, McDonnell Boehnen Hulbert & Berghoff

Vice Chair: Beverley Moore, Borden Ladner Gervais

Secretary: Kathryn Wade, Kilpatrick Townsend & Stockton

Board Liaison: Cara Coburn, Genentech

Committee Charter

The committee will advise the IPO Board of Directors regarding legislative changes, patent office policies, regulatory issues and judicial decisions affecting the pharmaceutical and biotechnology industry. This includes pharmaceuticals subject to the Drug Price Competition and Patent Term Restoration Act (the Hatch-Waxman Act), the Biologics Price Competition and Innovation Act (the BPCIA Act), and U.S. counterpart laws and regulations. The Committee's primary goal is to review proposed legislative and regulatory initiatives, and proactively submit comments and recommendations to the Board that reflect the proper balance between generic drug/biosimilar entry and maintaining strong incentives for the discovery, development and protection of new pharmaceutical 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 2019

The committee has planned the following agenda in 2019. 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. Closely follow developments on subject matter eligibility under section 101, including additional USPTO guidelines and court decisions, and consider proposals for IPO Board of Directors' consideration, such as additional USPTO comments, amicus briefs and possible legislative action. Work with the U.S. Patent Practice Committee, the U.S. Patent Law Committee and the Software Related Inventions Committee on areas pertaining to section 101 issues, including consideration of proposed legislation.
2. Propose IPO amicus briefs in cases of key interest, both in the U.S. and internationally.
3. Review and provide comments on draft patent reform legislation, including changes in venue, patent eligibility, obviousness-double patenting, PTA calculations, international exhaustion, pleading requirements, discovery procedures, fee-shifting, willfulness, estoppel arising from PGR, claim construction in PGR and IPR proceedings, and other issues.
4. Monitor how PTAB decisions are affecting the pharmaceutical and biotechnology industry.

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5. Follow developments in international patent practice and patent office regulations, with a focus on patent and regulatory legislation that negatively impacts the pharmaceutical and biotechnology industries. 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. Develop CLE Proposals for the IPO Annual Meeting.
8. Consider ways to increase IPO membership and activity by companies and stakeholders interested in IPO’s mission to foster high quality IP rights and effective, harmonized systems to obtain and enforce IP rights, such as smaller pharmaceutical development companies and universities with significant pharmaceutical and biotechnology research interests.

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Software Related Inventions Committee

Chair: Scott Pojunas, Google Inc.

Vice Chair: Joshua L. Simmons, Kirkland & Ellis, LLP

Vice Chair: Eli Mazour, Harrity & Harrity, LLP

Secretary: X. Christina Huang, 3M Innovative Properties Co.

Board Liaison: Brett Alten, Hewlett Packard Enterprise

Committee Charter

The Committee will advise IPO's President, Executive Director, and Board of Directors regarding legal issues relating to software, business method, and other computer-implemented inventions. The Committee's focus will include judicial decisions, proposed legislation, and regulatory practices in the United States, Europe and other countries and geographies. The Committee will take a holistic view, partnering as appropriate with other committees, to study and recommend changes to the laws governing software.

Committee Agenda for 2019

We are excited to start the new IPO year. Our overall goal this year is to continue to focus holistically on software-related issues, both within the USPTO, in the federal courts, and elsewhere, and both with regard to patent issues and other intellectual property protections.

The Committee completed the Patent Eligibility Tool and White Paper project reporting how Section 101 of the Patent Act has been interpreted with regard to software, with the paper published to the [IPO Law Journal](#) in January 2019. Del Jordan of Jordan IP Law led our subcommittee on this effort. The white paper is intended to assist practitioners in navigating the patent eligibility landscape from a software perspective. The paper, which is a functional tool available in spreadsheet and PDF formats, analyzes key Federal Circuit cases involving 35 U.S.C. § 101 and "abstract idea" considerations. A particularly innovative aspect of the tool is the ability to quickly locate the most relevant cases based on the type of software involved. The analysis includes practice tips and takeaways, as well as related information such as representative claims, art unit and examiner. We already have received praise for the project, and are using it ourselves!

In addition to the Patent Eligibility Tool and White Paper project, the Committee is focusing on three other projects in 2019. Each project will be conducted by a subcommittee. First, the Non-Patent Protection Subcommittee, led by Kevin Canning of Nelson Mullins, will develop a consideration checklist for agreements and terms to be used in the context of software evaluation from both the receiver and discloser perspectives. The project deliverables will include alternative provisions in the agreement with associated operational best practices, for example, the confidential information use limitations and the operational plans. Additionally, the Non-Patent Protection Subcommittee members will continue to attend committee meetings of the Copyright & Anti Piracy, Open Source, IP Licensing and Trade Secrets committees as non-voting members to ensure close coordination between this Committee and others.

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Second, the International Patent Eligibility Subcommittee, led by Del Jordan of Jordan IP Law, will work on a project for a report that will provide practical guidance to IPO members regarding the state of subject matter eligibility for software in international jurisdictions. To accomplish this goal, the Subcommittee will include international members of the Committee in addition to members in the U.S. Hopefully, this will be as successful as the Patent Eligibility Tool and White Paper project and will increase participation of the international members.

Third, the Education Subcommittee, led by Sameer Vadera of Kilpatrick Townsend, will continue educational programming for its members and IPO more generally. Among the topics that the Committee may have presenters on in 2019 are:

- Legislative initiatives on patent quality;
- Big data and artificial intelligence tools for practitioners;
- Copyright issues related to software;
- Global patent law related to artificial intelligence;
- Trade Secret protection under the Defend Trade Secrets Act;
- The latest issues in licensing and technology transfer;
- Design patents in GUI (Graphical User Interface) space;
- The new USPTO guidelines on Section 112 and its implications to software-related inventions;
- Committee member discussion sections on selected topics; and
- Other policy issues.

The Committee also is contemplating a project on IP protection for data, and will begin to survey its members in the coming months on what form of deliverable that project may take. It also intends to propose a CLE breakout at the IPO Annual Meeting and identify divisive policy issues that may warrant additional consideration from the Committee.

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Standards Setting Committee

Chair: James Harlan, InterDigital, Inc.

Vice Chair: David Long, Essential Patent LLC

Secretary: Valentina Boyet, SAP

Board Liaison: Heath Hogle, Dolby

Committee Charter

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

Committee Agenda for 2019

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 standard-essential patents (SEPs), including (but not limited to):

- The availability of alternative dispute resolution is a means to resolve SEP licensing disputes, particularly related to a common set of principles or guidelines as well as global remedies and applicability via the New York Convention;
- The relation between technical standards development and open source software development, specifically, what is the best long-term software collaboration model that suits standards development and what incentives need to be preserved to motivate research-backed contributions in scientific areas; and
- the application of competition law.

The Standard Setting Committee also will continue to make efforts to coordinate with other Committees on the SEPs-related and other issues as appropriate. For example, the Standard Setting Committee has been tracking a number of standards-related policy issues in China and Japan and has been able to synch with the Asian Practice Committee on topics of mutual interest.

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

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U.S. Patent Law Committee

Chair: Marian Underweiser, IBM Corp.

Vice Chair: Shaun Zhang, Goldman Ismail Tomaselli Brennan & Baum LLP

Vice Chair: Paul Parins, Kagan Binder, PLLC

Secretary: Larry Williams, Thompson Hine LLP

Board Liaison: Gary Ganzi, Evoqua Water Technologies LLC

Committee Charter:

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

Committee Agenda for 2019:

In January and February, the leadership team developed our strategy for 2019 and decided to maintain our existing committee structure, including four formal subcommittees and a number of other task forces and working 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 will proactively develop legislative proposals to enhance U.S. patent law. The subcommittee is currently working on the following initiatives:
 - a. **Inequitable Conduct:** The subcommittee is continuing to explore whether to codify the judicially created inequitable conduct doctrine, especially in light of the Federal Circuit decision in *Regeneron v. Merus*.
 - b. **§ 101 Resolution:** The Board of Directors passed a resolution in favor of amending § 101 based on the work of the § 101 Task Force. Members of our committee actively participated, including Marian Underweiser, who served as Chair of the § 101 Task Force. This year, the task force will be maintained for work on new eligibility issues, and new projects or requests from the Board or IPO leadership in this active area of the law.
 - c. **Secret Prior Art Task Force:** The Supreme Court, in *Helsinn v. Teva*, held that sales conducted in secret may nonetheless be novelty-destroying under the AIA version of § 102. This task force will study the *Helsinn* decision and legislative history of the relevant provision of the AIA with a goal of discussing the impact of the decision on IPO membership organizations and what, if any, recommendations the Committee should provide the Board regarding this decision.

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2. **Pending Patent Legislation Subcommittee:** This subcommittee, led by Heather Champion Brady, Johnson & Johnson, 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:
 - a. **Monitor Activity of New Congress and Administration:** The subcommittee is analyzing the positions and activities of the 116th Congress and the presidential administration to identify potential impacts on patent law. We will monitor and evaluate the actions and positions of Director Iancu, who has shown a willingness to interface with IP stakeholders to engage in meaningful reform, and how these actions and positions affect IP owners.
3. **Education Subcommittee:** This subcommittee, led by Dan Roth, McCracken & Gillen LLC, 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.
4. **Artificial Intelligence Joint Subcommittee:** This subcommittee, led by Kyle Trout of Koninklijke Philips N.V., will proactively monitor legal developments involving AI and educate the committee of such developments. Also, this subcommittee may develop legislative proposals involving AI and intellectual property, including developing a proposed framework of *sui generis* rights for trained models.
5. **Patent Quality Task Force:** This task force, led by Marian Underweiser, IBM Corp. will explore ideas and initiatives that IPO can pursue to improve patent quality.
6. **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, Emerging Technologies, and Litigation committees, to assist these committees with their initiatives and to seek assistance and guidance on our initiatives as necessary.

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U.S. Patent Office Practice Committee

Chair: Kaveh Rashidi-Yazd, Siemens Corp

Vice Chair: Courtenay Brinkerhoff, Foley & Lardner LLP

Vice Chair: Sunjeev Sikand, RatnerPrestia

Vice Chair: Roland McAndrews, Bookoff McAndrews PLLC

Secretary: Aamir Haq, Hewlett Packard Enterprise

Board Liaison: Manny Schecter, IBM Corp.

Committee Charter

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

1. Study and report on changes in patent practice proposed by the USPTO, with special attention to pre-grant practice. When appropriate, the Committee will propose comments on suggested changes in patent practice.
2. Survey the Committee membership for feedback on and changes to patent practice that can be recommended to the USPTO for implementation; collect, analyze, and report to appropriate USPTO officials feedback including suggestions and proposals for changes to patent practice and develop recommendations for changes in the Patent Act. The Committee will identify the most important changes and support IPO's government relations team where appropriate as they work with relevant government officials and the legislature to have such changes implemented.
3. Foster additional dialog between IPO and the USPTO by holding periodic meetings with the Commissioner for Patents 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
5. Organize, sponsor and co-sponsor educational sessions on patent practice, including assisting in planning IPO's Spring Summit and Annual Meeting.

Committee Agenda for 2019

1. Work closely and establish good rapport with new 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 appeals 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 Annual Meeting topics, participate in panels, and prepare reports and papers.
7. Monitor executive orders and legislation affecting the USPTO

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U.S. Post-Grant Patent Office Practice Committee

Chair: Emily Johnson, Amgen Inc.

Vice Chair: Eric Cohen, Brinks Gilson & Lione

Vice Chair: Eleanor Yost, Carlton Fields

Vice Chair: Todd Walters, Buchanan Ingersoll & Rooney

Secretary: Chris Comiskey, United Technologies Corporation

Board Liaison: Brian Suffredini, United Technologies Corporation

Committee Charter

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

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

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

Committee Agenda for 2019

1. Prepare and submit proposal(s) for Break-Out Sessions for 2019 Annual Meeting
2. Monitor and advise on PTAB rule changes
3. Monitor and advise on PTAB fee changes
4. Advise on Supreme Court decisions regarding PTAB issues
5. Monitor and advise on impact of *SAS Institute* on PTAB cases and Federal Circuit appeals
6. Monitor and advise on legislation
7. Monitor and advise on other federal register notices and important cases
8. Develop content for IPO conferences
9. Hold monthly Committee teleconferences
10. Encourage "next generation" lawyers from IPO members to become active in the committee

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Women in IP Law Committee

Chair: Elisabeth Bradley, Bristol-Myers Squibb Company

Chair: Laura Sheridan, Google LLC

Vice Chair: Krista Kostiew, Cantor Colburn LLP

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

Vice Chair: Rachael Rodman, Ulmer & Berne LLP

Secretary: Tina Dorr, Cantor Colburn LLP

Board Liaison: Henry Hadad, Bristol-Myers Squibb Company

Committee Charter

The Committee will seek to promote the representation and advancement of women in IP law and to improve the diversity of IPO's membership. The Committee will develop programming and initiatives on topics relevant to these goals and will collaborate with other committees on items of interest to the membership. The Committee will engage and interface across the IP community, including those working in corporations, law firms, universities, and government, to achieve these goals.

Committee Agenda for 2019

In 2019, the committee will continue many of the new initiatives started in 2018, as well as focus on additional areas. As an initial matter, the committee is seeking approval of an updated charter that reflects the expanded scope of the committee's work. The committee will also continue its practice of establishing measurable goals to help focus efforts and better assess the impact of those efforts.

The Mentoring Across Borders sub-committee will continue the Group Mentoring program, as well as begin a new round of 1:1 pairs mentoring. The committee anticipates presenting mentoring metrics and accomplishments to the IPO Board of Directors in 2019, as well as recommendations on how to further leverage mentoring within IPO.

The Women in IP Speakers List sub-committee is updating the speakers list and creating a survey to discover potential new speakers, and this list will be distributed to find potential speakers for the Spring and Annual Meetings.

The Push Forward sub-committee will continue to build the library of resources available to the IPO community and address other key issues in furtherance of our committee charter. The sub-committee is also organizing a second IP Chat Channel webinar on the topic of work-life balance.

The Women Inventors sub-committee will gather data from corporations and organizations alpha-testing the Toolkit for Gender Diversity in Innovation, and roll out a revised toolkit for member beta-testing. A final version of the toolkit will be launched at the 2019 Annual Meeting. The sub-committee will also continue working with the USPTO and WIPO to brainstorm ways to join efforts to promote and advance these issues and operate under the recently passed SUCCESS Act (H.R. 6390). Finally, to foster increased engagement and connections among members of the committee, we are launching a book club, and are planning informal committee gatherings around the Summit and Annual Meeting.

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Anti-Counterfeiting Committee

Chair: Sanjiv Sarwate, Dell Inc.

Vice Chair: Alex Bistline, Pirkey Barber PLLC

Secretary: Tim Golder, Allens

Board Liaison: Douglas K. Norman, Eli Lilly and Co.

Committee Charter

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

Committee Agenda for 2019

The Committee has two primary goals for 2019. First, the committee intends to develop a session panel on best practices for online enforcement for the 2019 IPO Annual Meeting. The committee envisions a panel incorporating key stakeholders in online enforcement, including representatives from some of the major online marketplaces (such as Alibaba or eBay). The Committee has already put together a task force to begin planning this panel.

The Committee also intends to explore best practices for mitigating counterfeit risk in procurement / supply chains, with the intention of preparing a white paper on these practices. The Committee has discussed potentially surveying the IPO membership to learn more regarding common supply chain issues to inform the white paper. The Committee envisions the completed white paper serving as an online resource for the IPO membership moving forward.

2019 IPO STANDING IP COMMITTEE LEADERSHIP MEETING

HYATT REGENCY HOTEL (AUSTIN, TEXAS)

8 MARCH 2019

U.S. Trademark Law Committee

Chair: Jake Feldman, Johnson & Johnson

Chair: Valerie Verret, Exxon Mobil Corporation

Vice Chair: Joshua S. Jarvis, Foley Hoag LLP

Vice Chair: Wendy C. Larson, Pirkey Barber PLLC

Secretary: Alicia Morris Groos, Norton Rose Fulbright

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

Board Liaison: Ken K. Patel, Procter & Gamble Co.

Committee Charter

The Committee will identify and comment upon federal and state legislative activities that would or are likely to significantly affect U.S. trademark law and practice. The Committee will investigate issues and take action to further the interests of IPO members with respect to domain names, including monitoring and providing feedback on the activities of the International Corporation for Assigned Names and Numbers (ICANN) and participating in relevant stakeholder groups. 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 as domain names and social media usernames, and will review procedures for resolving disputes related to online ownership and use. More generally, the Committee will explore miscellaneous issues of concern to trademark owners in the online arena, including those related to trademark best practices and enforcement in the online and social media space. 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 2019

1. The Committee has scheduled monthly conference calls for the third Thursday of the month at 3:00 pm ET.
2. The Committee has formed four working groups to facilitate discussion and address issues in the following subject areas:
 - a. Domain Names
 - b. Social Media/Online/Internet Law
 - c. Case Law/TTAB Tracking and Updates
 - d. Rules/Legislation Tracking and Updates
3. In addition, the Committee anticipates working on the following projects:
 - a. Consider submitting additional comments to the Trademark Trial and Appeal Board regarding the standard protective order;

2019 IPO STANDING IP COMMITTEE LEADERSHIP MEETING

HYATT REGENCY HOTEL (AUSTIN, TEXAS)

8 MARCH 2019

- b. Analyzing whether the committee should propose a position on well-known marks to the Board of Directors;
- c. Monitoring the status of *Mission Prods. v. Tempnology* at the U.S. Supreme Court relating to the disposition of a trademark licensee's rights where the licensor is in bankruptcy for which IPO submitted an Amicus brief;
- d. Monitoring ICANN's review of the UDRP and other rights protection mechanisms and considering whether the committee should propose a position reaffirming or advocating expansion thereof;
- e. Monitoring the effects of and policies relating to the implementation of the GDPR, particularly with respect to domain name Whois records; and
- f. Suggesting topics for one or more presentations or panels at the IPO Annual Meeting in D.C. 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, and International Trademark Law and Practice committees. The Committee Chairs and Vice-Chairs expect to reach out to the leadership of those committees to coordinate on areas of interest to the various committees.

2019 IPO STANDING IP COMMITTEE LEADERSHIP MEETING

HYATT REGENCY HOTEL (AUSTIN, TEXAS)

8 MARCH 2019

U.S. Trademark Office Practice Committee

Chair: Jenny Greisman, IBM Corporation

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

Vice Chair: Lauriel Dalier, Sterne, Kessler, Goldstein & Fox PLLC

Secretary: Julia Belagorudsky, Fross Zelnick Lehrman & Zissu, PC

Board Liaison: Ariana Woods, Capital One

Committee Charter

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

Committee Agenda for 2019

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

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.

In particular, the Committee plans to keep participating in ongoing discussions with senior USPTO officials about trademark bar interest in amending regulation 37 CFR 2.88(f) to allow withdrawal of Statement of Use.

In addition, the Committee is preparing to evaluate a Notice of Proposed Rule-Making to be promulgated by USPTO that would require foreign trademark applicants and registrants to be represented by a U.S. licensed attorney when filing trademark documents with the USPTO.

The Committee plans to develop a CLE program to address best practices for filing post- registration declarations of use and specimens of use, and for responding to post- registration audit Office actions that require additional proof of use be provided for audited registrations.

The Committee plans to develop a position on providing an option for pro se applicant to "hide" their email addresses in order to reduce the number of solicitations that are sent to them.

The Committee will collaborate with appropriate IPO committees (e.g., the U.S. Trademark Law Committee and the International Trademark Law Committee) on trademark policy projects.

The Committee will aim to add more members in 2019.

2019 IPO STANDING IP COMMITTEE LEADERSHIP MEETING

HYATT REGENCY HOTEL (AUSTIN, TEXAS)

8 MARCH 2019

Amicus Brief Committee

Chair: Kevin H. Rhodes, 3M Innovative Properties Co.

Vice Chair: Paul H. Berghoff, McDonnell Boehnen Hulbert & Berghoff LLP

Vice Chair: Gregory A. Castanias, Jones Day

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 in 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

- No request currently pending
- 25 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.
- 6 briefs filed in 2018 and 2019 to date:
 - *Nantkwest v. Matal*
 - **Issues:**
 1. Whether 35 U.S.C. § 145's "[a]ll the expenses of the proceedings" provision authorizes an award of the USPTO's attorneys' fees.
 - Filed a brief with Supreme Court in support of plaintiff-appellee on 23 January 2018 with assistance from Jones Day.
 - *WesternGeco LLC v. ION Geophysical Corp.*
 - **Issues:**
 1. Whether the U.S. Court of Appeals for the Federal Circuit erred in holding that lost profits arising from prohibited combinations occurring outside of the United States are categorically unavailable in cases in which patent infringement is proven under 35 U.S.C. § 271(f).
 - Filed a brief with the Supreme Court in support of neither party on 5 March 2018 with assistance from Shook, Hardy & Bacon LLP.
 - *Helsinn Healthcare S.A. v. Teva Pharms. USA, Inc.*
 - **Issue:**
 1. Whether the Federal Circuit erred in finding that "[A]fter the AIA, if the existence of the sale is public, the details of the invention need not be publicly disclosed in the terms of the sale" for the on-sale bar to apply.

2019 IPO STANDING IP COMMITTEE LEADERSHIP MEETING

HYATT REGENCY HOTEL (AUSTIN, TEXAS)

8 MARCH 2019

- Filed a brief with the Supreme Court supporting Helsinn’s petition for certiorari on 30 March 2018 with assistance from Leason Ellis, LLP.
- *Helsinn Healthcare S.A. v. Teva Pharms. USA, Inc.*
 - **Issue:**
 1. Whether, under the America Invents Act, an inventor’s sale of an invention to a third party that is obligated to keep the invention confidential qualifies as prior art for purposes of determining the patentability of the invention.
 - Filed a brief with the Supreme in support of neither party on 23 August 2018 with assistance from Leason Ellis, LLP.
- *Mission Prod. Holdings, Inc. V, Tempnology, LLC, N/K/A Old Cold LLC*
 - **Issue:**
 1. Whether, under §365 of the Bankruptcy Code, a debtor-licensor's "rejection" of a license agreement which "constitutes a breach of such contract," 11 U.S.C. §365(g) terminates rights of the licensee that would survive the licensor's breach under applicable non-bankruptcy law.
 - Filed a brief with the Supreme Court in support of neither party on 12 December 2018 with assistance from Pirkey Barber PLLC.
- *Return Mail, Inc. V. U.S. Postal Serv.*
 - **Issue:**
 1. Whether the government is a “person” who may petition to institute review proceedings under the AIA.
 - Filed a brief with the Supreme Court in support of neither party on 17 December 2018 with assistance from Fish & Richardson P.C.

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



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, Kevin Rhodes, in care of Hannah Denny at hdenny@ipo.org. For more information on procedures, contact Ms. Denny at (202) 507-4498. Also, for more information see the Amicus Brief Committee Procedures at www.ipo.org/Amicus.

Review and Notification

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

January 2019



IPO Standing IP Committee Policy Manual

IPO President

Henry Hadad

Executive Director

Mark W. Lauroesch

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TABLE OF CONTENTS

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

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I. Introduction

IPO Governance

Directors

Most members of the Board of Directors (<http://www.ipo.org/index.php/about-ipo/board-of-directors/>) are chief intellectual property counsel for their company. There are 44 sustaining corporate board members. Sustaining corporate members are elected for two-year terms which may be renewed for a second consecutive term. Five members of the Board are regular corporate members of IPO. They are elected for two-year terms, which may not be renewed. 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 can 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; 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,



but may include corporate members. The committee secretary is selected by the chair(s) and vice chair(s).

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

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



II. Expectations for Committee Leaders and Members

Committee Chairs and Vice Chairs

Committee chairs and vice chairs are appointed by the IPO President for one-year terms. Chairs and vice chairs are sometimes reappointed for additional terms, but the number of reappointments may be limited to give other members an opportunity to serve as chairs and vice chairs. The current terms end in December. 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 can 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. 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 ask the committee members to renew their interest as well as solicit new members. Individuals can apply for reappointment to the same committee or appointment to a different committee.



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 might 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 providing 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 and Executive Committee may bypass the committee structure to develop board resolutions. In those instances, the staff liaison will try to seek the committee's view on the staff resolution if time permits, 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 might 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%20for%20Board%20Reports.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 committee charter. Such projects should be consistent with IPO principles and vision. In addition to recommending positions regarding legislation and administrative rulemaking, committees might, 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 charter. 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 process for drafting IPO comments and letters is depicted below.



Committee Leadership Meetings

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. 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 8 November.

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 <https://www.ipo.org/index.php/about-ipo/committees/standing-committees-landing-page/>. Applications are generally processed weekly. Applicants receive confirmation of appointment in about a week.

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

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

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

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

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

A: Please email committees@ipo.org explaining your change including your new information. It will be determined 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 final board reports concerning proposed resolutions. For more on board reports, see Section V.

V. Guide to Developing Board Reports

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

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

Five 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.

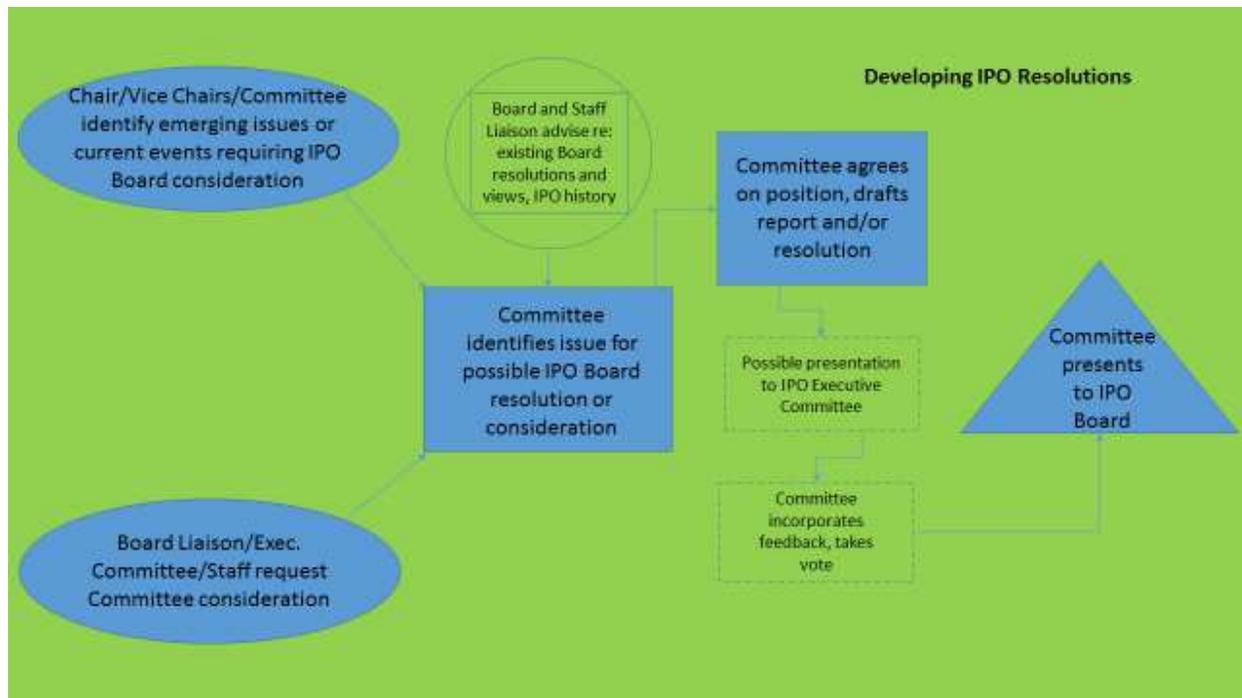
Committee reports with resolutions to be presented to the Board should be circulated to committee members in advance of submission to the IPO office and should include the votes (for, abstain, against) of a majority of the committee members.

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 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%20for%20Board%20Reports.docx) for the Board Report Template.

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



Tips on Presenting Resolutions to the IPO Board

- Summary of Process at the Meeting: After you join the meeting, you will be introduced and the board members will be referred to the page in their board materials where your proposed resolution is located. You will be asked to present the proposed resolution on behalf of your committee followed by questions from board members.
- Be concise: The Board covers many topics during its meeting, so getting to the point and being concise is important. Your presentation should be less than five minutes in most instances.
- Audience: The Board comprises leaders from large companies that often have views on the topics you plan to address. Some board members have been part of delegations addressing the issue in Congress. There can be differences in views among the board members and potentially among members of your committee. It can be important to try to identify middle ground to help build consensus. Don't emphasize the divisive areas if they are not material.
- Be Prepared: During the question period, you might be asked about process and your sense of the committee's views on alternatives not in the resolution. Amendments may be offered. It is important to be well prepared on the process and potential alternatives so that you can assist the Board in its deliberations.
- Some common topics raised by the Board: Board members might have specific concerns or ask if the committee considered certain alternative wording or approaches. The language of the resolution should be as clear as possible because it might be utilized separate from the report. Timing of the proposal relative to other Board or

governmental actions might be raised, testing the need to adopt the resolution immediately or await potential future events.

- Some typical content of a presentation includes:
 - Context: It is often helpful to provide overall context for the proposed resolution including precipitating events and relevant prior activities.
 - Background: It is often helpful to explain a little about the important issues raised and addressed by the committee. Explain the process followed at the committee level, including back-and-forth negotiations. This part of the presentation should be concise.
 - Resolution: Highlight specific, critical language in the resolution, especially if there was debate about how to handle certain issues.
 - Committee voting: Discuss the results of the committee's vote, including the level of participation.
- Objective of the presentation: The objective of a resolution is to make a policy statement that can garner broad consensus from the IPO Board. The resolution might change at the Board level, so flexibility can be important in your presentation. Have fun!



VI. Using IPO Connect for Committee Business

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

How To Login to IPO Connect:

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

What Can I Do on IPO Connect?

Check your Committee Roster

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

To check your roster:

1. Sign in to IPO Connect
2. Click the “Committees” link in the top navigation area
3. Click on the committee name to view recent activity
4. 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
8. 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
9. When you have your document uploaded, click “Finish” at the bottom of the form to finalize the attachment
10. Click “Send”
11. When committee members open the attachment, it will save to their personal outlook calendar

Create a Sub-Committee

On occasion, it can 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 <https://www.ipo.org/index.php/about-ipo/committees/standing-committees-landing-page/>.
- 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 so you can timely meet them. Reports to the IPO Board must be submitted three weeks before a board meeting. See Section V.

Organize Subcommittees

Organize sub-committees 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 sub-committee 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 sub-committees.

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.



Intellectual
Property
Owners
Association

02/27/2019

IPO Standing IP Committee Leaders

Legend: BDL= Board Liaison CH= Chair SEC= Secretary VC= Vice Chair

Anti-Counterfeiting Committee

BDL	Kelsey L. Milman	Caterpillar Inc.	Milman_Kelsey_L@cat.com	(309) 494-6843
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VC	Alexandra Bistline	Pirkey Barber PLLC	abistline@pirkeybarber.com	(512) 482-5239

Asian Practice Committee

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Copyright Law & Anti-Piracy Committee

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VC	Jenevieve J. Maerker	Foley Hoag LLP	jmaerker@foleyhoag.com	617-832-3031

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Damages and Injunctions Committee

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Emerging Technologies Committee

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Open Source Committee

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U.S. Trademark Law Committee

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Women in IP Law Committee

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Total: 141



Expected Attendance
 Committee Leadership Meeting
 8 March 2019
 Hyatt Regency, Austin, Texas

Amicus Brief Committee				
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Anti-Counterfeiting Committee				
VC	Alexandra	Bistline	Pirkey Barber PLLC	abistline@pirkeybarber.com
Asian Practice Committee				
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Canadian Practice Committee				
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European Practice Committee				
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