



# Bulletin Chair's

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## Section Continues to Make a Difference in the IPL World



**From the Chair**  
*William L. LaFuze*  
Section Chair, 2004-2005

Section leadership continues to push forward on many important projects. The Section just co-sponsored its first program with the World Intellectual Property Organization at the United Nations in New York. The program was directed to arbitration and mediation of disputes and attracted about 150 registrants. This program was planned by Todd Dickinson, former Director of the United States Patent and Trademark Office and a current Section Council member. Many thanks to Todd for planning an excellent program that featured WIPO Deputy Director Francis Gurry, David Plant and Robert Sacoff. The Section hopes to put on other jointly sponsored programs with our friends from WIPO in the future.

In mid-April, the Section hosted its 20th Annual Spring IPL Conference during cherry blossom season in Washington, DC. This program had an all-star faculty that discussed the hottest topics in IP law. Hope you made it there!

The Section has just published a book on IP Valuation, *Fundamentals of Intellectual Property Valuation: A Primer for Identifying and Determining Value*. Wes Anson and Donna Suchy were instrumental in getting this book organized, written and completed. This book is very well done and has already sold 1,000 copies in the month of March alone. Many thanks to Wes and Donna for their hard work in getting this publication off the press. To order your copy, go to [www.abanet.org/abapubs/books/5370143](http://www.abanet.org/abapubs/books/5370143) or call 800/285-2221. Special introductory pricing is available for a limited time – so hurry!

The Section has been hard at work on patent law improvement and reform. Over the last several weeks, the Section has been working with other major groups interested in patent law reform, such as the American Intellectual Property Law Association, the Biotechnology Industry Organization, the Intellectual Property Owners Association, and the Business Software Alliance in an attempt to reach a consensus of the specifics on a patent law reform/improvement bill. The efforts of these organizations to come up with a consensus bill continue. Among the major issues being addressed are: post grant opposition, first inventor to file, the definition of prior art, elimination of best mode, assignee filing of patent applications, publication of all patent applications after 18 months, PTO funding and fee diversion, willful infringement, inequitable conduct, prior user rights, double patenting, injunctions, pre-grant citation of prior art, the standard of proving invalidity regarding art not considered by the examiner, and expanded inter-partes reexamination.

The Section was invited to testify at the first of the House IP Subcommittee Hearings on April 20, 2005, along with representatives from the Intellectual

Property Owners Association, the Business Software Alliance, and Genetech. I testified on behalf of the American Bar Association with respect to the issue of first-inventor-to-file, and with respect to other issues raised by the Committee Print draft bill on Patent Quality Improvement on behalf of the Section of Intellectual Property Law. A complete copy of the Committee Print can be found at [www.abanet.org/intelprop/home/DraftPatentStatuteDDC.pdf](http://www.abanet.org/intelprop/home/DraftPatentStatuteDDC.pdf) and the testimony I gave at the hearing can be found at [www.abanet.org/intelprop/LaFuze\\_Testimony\\_4-20-05.doc](http://www.abanet.org/intelprop/LaFuze_Testimony_4-20-05.doc).

I have the privilege of working with a wonderful group of intelligent, hard-working, fun-loving volunteers who are willing to devote their time to give back to the profession that supports their livelihood. What a joy this experience has been! Thanks to all the many volunteers who have made my job as chair so rewarding.

Our next major event is the 2005 Summer IPL Conference scheduled in San Francisco on June 22-25. We have a great program planned in a wonderful setting, so put this important event on your calendar and plan to attend. Go to [www.abanet.org/intelprop/summer2005](http://www.abanet.org/intelprop/summer2005) for more information and to register.

## IP Valuation Primer: Get Your Discount While You Can!

In today's increasingly complex and highly regulated business environment, the accurate and complete valuation of intellectual property is essential. The Section recently released *Fundamentals of Intellectual Property Valuation: A Primer for Identifying and Determining Value*. Written by experts in the area, this primer answers some of the most frequently asked questions about identi-

ifying the value of the primary types of intellectual property and other intangible assets. It also looks at the primary, traditional, and not-so-traditional methods of valuing these assets, and includes case studies and situations where valuation is required.

*Fundamentals of Intellectual Property Valuation* answers some of the most frequently asked questions about IP and valuation, including: 1) What is a piece of intellectual property, and what is an intangible asset? 2) When are they the same and when are they different? 3) What are the different groups of intellectual property and how are they described and valued? 4) Do pieces of intellectual property have value? 5) Do they all have value? If not, why not? 6) Is it true that sometimes a given piece of IP can have great value and at other times no value at all, and if so, how can this be?

To learn more about the primer and to order your copy at a special (limited time only!) discounted price, go to [www.abanet.org/abapubs/books/5370143](http://www.abanet.org/abapubs/books/5370143) or call the ABA Member Service Center at 800/285-2221 and ask for product code 5370143.

## HIPLA Announces Election Results

The Houston Intellectual Property Law Association (HIPLA) recently announced the election of its new officers and directors, which includes Section Secretary Gordon T. Arnold as HIPLA President. The full list of nominations is:

### Officers

President: Gordon T. Arnold, Arnold & Ferrera, L.L.P.

President-Elect: Albert B. Kimball, Jr., Bracewell & Giuliani LLP

Secretary: Stephen Koch, ExxonMobil Chemical Company

Treasurer: Charles Walker, Fulbright & Jaworski

### New Directors (Terms Expiring 2007)

Norma Bennett, Weil, Gotshal & Manges LLP

Collin Rose, Conley Rose, P.C.

Steve Spears, Howrey

### Directors with Terms Expiring 2006:

Jennifer Adamson, Shell Oil Company

Anthony Matheny, Andrews Kurth, LLP

Richard Phillips, ExxonMobil Chemical

HIPLA has a number of projects to increase the understanding of intellectual property and related areas of the law. It promotes and assists in the growth and promotion of programs designed for discussion, exchange of ideas, and possible solutions to various common problems. This is accomplished in part through monthly lunch meetings, an annual institute in conjunction with the University of Houston, the Giles Rich Moot Court Competition, an active *amicus* committee, and others. HIPLA also promotes friendly relations through regular events designed to allow the members to become better acquainted in informal settings.

For more information on HIPLA's projects, go to [www.hipla.org](http://www.hipla.org).

## Committee News

### Pro Bono (Committee 509)

Stephen C. Swift, Chair

The Pro Bono Committee has launched an informational page on the Section website at [www.abanet.org/intelprop/probono.html](http://www.abanet.org/intelprop/probono.html). It includes a

directory of organizations that provide pro bono intellectual property services. Participating entities are grouped by state. The information displayed for each entity includes entity name, contact person, services offered, eligibility criteria, etc.

Last year when the former committee chair wrote to the executive directors of the state bars to determine what IP pro bono programs are offered in each state, many responses were received. The committee divided the country into four regions, and assigned a subcommittee chair to each region to determine which IP pro bono programs were available in each region. The subcommittee chairs then gathered the information for each participating pro bono entity.

The committee is currently working on perfecting the pro bono website. The committee thanks the ABA staff, in particular Alice Bare, for their help.

The committee has discussed the possibility of undertaking other projects in the future, but the consensus was that it should first work on perfecting its website. In the future, besides listing non-profit entities, the committee's web pages may list individual attorneys and/or law firms that are willing to provide pro bono help in the area of intellectual property law. However, questions of liability, resources, staffing and overlap with other committees and local bar associations need to be addressed before that can be done.

## Council Selects Resolutions for Summer Conference Debate

The Section Council met on April 26 to discuss resolutions proposed by the Section Committees for adoption as Section policy. From these, the Council selected two from various areas of IP law for debate during this year's Summer IPL Conference. There will be additional presentations on current topics in the field, so a lively debate will be held. The remainder of the proposed resolutions were approved, allowed to rest as committee reports or recommitted to the committees for further consideration.

### Contact Us

William L. LaFuze, Chair  
Fax: 713/615-5317  
[wlafuze@velaw.com](mailto:wlafuze@velaw.com)

Hayden W. Gregory  
Legislative Consultant  
Fax: 202/662-1762  
[gregoryh@staff.abanet.org](mailto:gregoryh@staff.abanet.org)

Betsi Roach, Section Director  
Fax: 312/988-6800  
[iplaw@abanet.org](mailto:iplaw@abanet.org)

Alice Bare, Staff Editor  
Fax: 312/988-6800  
[barea@staff.abanet.org](mailto:barea@staff.abanet.org)

The following resolutions will be debated at the Summer IPL Conference, at the Section Business Session, Thursday, June 23, 2005. To access the committee report that accompanies each proposed resolution, visit the Section website at [www.abanet.org/intelprop/summer2005/business-session](http://www.abanet.org/intelprop/summer2005/business-session). If you have questions, contact the Section at [intelprop@abanet.org](mailto:intelprop@abanet.org), or call 312/988-5598.

### Provide Comments

All members should review the proposed resolutions immediately. If you have any objections to the classification or suggested changes to any proposed resolution, please contact the appropriate committee chair prior to the debate on the resolution (indeed, if possible, prior to the meeting). Each committee chair's address, telephone number and e-mail address can be found on the Section website. If you need help in locating a committee chair, contact the Section office. This procedure should expedite the making of non-controversial changes in form and allow more time for debate on the substantive issues presented by the resolutions.

### Register

Conference information and online registration can be found on the Section website, <http://www.abanet.org/intelprop/summer2005>. Registration brochures for the Summer IPL Conference are in the mail.

Support the Section resolution process and register today to attend the 2005 Summer IPL Conference in San Francisco.

### Rules of Debate

Robert's Rules of Order Newly Revised (10th edition) will govern.

Each resolution will be introduced followed by a four-minute statement in favor of the resolution. The first speaker against will be allowed the same time. If anyone wishes to volunteer for this task please contact Betsi Roach ASAP.

Debate will proceed alternating between pro and con until all speakers for one or the other position have been heard. The time limit for each is one minute. A speaker may speak only once per resolution. No repetition. If your point has been made, please do not try to repeat it.

The Section Parliamentarian, Morton David Goldberg, will advise the Chair on enforcing the rules.

### Procedure For Additional Resolutions to Be Presented

The following procedures will be followed for resolutions presented to the Resolutions Committee for consideration at the 2005 Summer IPL Conference:

1. Each noncommittee report resolution intended for consideration by the Section prior to the Business Session of the Summer IPL Conference must be submitted as an e-mail attachment to the chair of the Resolutions Committee and to the IPL Section Director for receipt no later than May 23, 2005. Resolutions received thereafter will not be considered by the Section prior to the Business Session unless the Section Chair rules otherwise.

Any resolution submitted in this manner should be accompanied by the name and conference address of its proponent. The proponent shall recommend the desired action by the Committee, e.g. "full debate when Committee 102 resolutions are considered," and shall also indicate whether or not a hearing before the Committee is desired.

With respect to each resolution properly before it in accordance with this paragraph, the Committee will make one or more of the following recommendations:

The resolution should be considered by the Section in connection with a specific Committee report, as a special order of business, or as New Business;

The resolution should be amended in some specified manner or that a substitute resolution should be considered.

The resolution should be referred to an appropriate committee for study during the coming year.

The Committee's recommendations will be submitted to the Section Chair for a decision prior to the Business Session.

2. Any resolution to be submitted to the Section as New Business at the Conference must first be submitted to the Resolutions Committee in typewritten form so that a sufficient number of copies may be made before such resolution is considered by the Section. Any such resolution must be accompanied by the name and Conference address of its proponent.

The Committee will consider any such resolutions properly before it and make recommendations in accordance with (1) above. During the Business Session, these recommendations shall be reported to the Section for decision by the Section Chair, subject to approval of the Section.

If requested by the proponent, the Committee will also specify a time and place for a hearing, should the Committee agree that a need for a hearing exists. Failure of a proponent to appear at an announced hearing may, at the Committee's discretion, amount to withdrawal of the subject resolution.

The Section Chair may place on the agenda and announce a time certain when the Resolutions Committee will again report to the Section.

3. Late committee reports containing at least one resolution with a favorable committee vote shall be submitted to the Resolutions Committee at the same time they are submitted to other Section personnel who normally receive such reports. If received by the Committee no later than May 23, 2005, the Committee will make recommendations with respect to any approved resolutions in accordance with paragraph (1) above.
4. Should a proponent wish to submit to the Resolutions Committee a resolution which is the same or substantially the same as one considered but not approved by a committee of the Section, the proponent shall:
- make known to the Resolutions Committee such prior action;
  - make a strong showing of urgency;
  - appear in person before the Resolutions Committee prior to the Council Meeting preceding the Business Session or, if unable to do so, arrange a conference call with the Committee to discuss the resolution; otherwise, the resolution will be referred to the appropriate committee for further study the following year.
5. All resolutions received after the 2005 Summer IPL Conference to be considered at the Business Session of the ABA Annual Meeting will be processed as is set forth above, except that the words "Annual Meeting" are to be substituted for "Conference" whenever appropriate.

## 2004-2005 PROPOSED RESOLUTIONS

With Classifications Made by Council on April 26, 2005

### PROPOSED RESOLUTION 102-1:

#### Patent Cooperation Treaty

*Class 2 Approve - by Council on September 14, 2004.*

RESOLVED: Section of Intellectual Property Law opposes in principle any increases in PCT fees not adequately supported by an appropriate and justifying analysis, and specifically opposes the proposed readjustment of the International Filing Fee contained in document PCT/A/33/5 dated August 20, 2004 proposing an increase in the International Filing Fee of 12%.

### PROPOSED RESOLUTION 102-2:

#### Substantive Provisions For Implementation Of a First-Inventor-To-File Standard (Omnibus Resolution)

*Class 2 Approve - by Council on January 23, 2005*

RESOLVED, that the Section supports, in principle, in the context of ratification of an international harmonization treaty involving at least Japan or major European countries that mandates U.S. adoption of a first-inventor-to-file system, eliminating from U.S. patent law:

- (1) abandonment as set forth in 35 U.S.C. §102(c) as a basis for a loss of right to patent;
- (2) premature foreign patenting as set forth in 35 U.S.C. §102(d) as an element of prior art or a basis for a loss of right to patent;
- (3) an inventor's forfeiture of his or her right to patent an invention once placed "in public use or on sale" as set forth in 35 U.S.C. §102(b) by providing that no such loss of right to patent an invention can arise unless the invention had become reasonably and effectively accessible to persons of ordinary skill in the art more than one year before the inventor sought a patent for the invention;
- (4) prior art as set forth in 35 U.S.C. §102(f), under which non-public knowledge of the inventor, not otherwise qualifying as prior art, can render an invention made by such inventor obvious, by:
  - (A) repealing section 102(f) and
  - (B) codifying elsewhere in Title 35 that the right to seek and obtain a patent is solely

the right of the individual or individuals who made the invention for which a patent is sought (or, where applicable, the assignee of such inventor);

- (5) the provisions currently in 35 U.S.C. §102(g) providing that "secret prior art" (and/or loss of right to patent) can exist as from the date an invention of another inventor was made;
- (6) the provisions currently in 35 U.S.C. §§102(a), (e), and (g) that permit the inventor to rely upon proofs of dates of invention in order to eliminate as prior art to an invention subject matter that would otherwise represent prior art relative to the effective filing date for the invention;
- (7) the geographic restrictions on prior art currently in 35 U.S.C. §§102(a) and (b) that require proofs of knowledge or use in the United States;
- (8) the English language requirement currently in 35 U.S.C. §102(e), relating to published international applications for patent that can qualify as prior art as of their respective filing dates; and
- (9) the requirement to disclose the "best mode" as set forth in 35 U.S.C. §112, first paragraph, and

SPECIFICALLY, the Section supports treaty implementing legislation providing for the adoption of a first-inventor-to-file rule under which, after eliminating existing "loss of right to patent" provisions currently in 35 U.S.C. §102 in the manner set forth above, prior art for determining both novelty and non-obviousness of a claimed invention in an application for patent would exist (subject, however, to the existing judge-made law on "obviousness-type double patenting") when and only when:

- (1) the claimed invention was known (by virtue of being patented or described in a printed publication or otherwise known);
  - (A) before the effective filing date of the claimed invention, other than through disclosures made by the inventor or by a joint inventor or by others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, or
  - (B) more than one year prior to the effective filing date of the claimed invention, or
- (2) the claimed invention was described in a U.S. patent, or in a U.S. nonprovisional or international application for patent, published as provided in Title 35 or the

Patent Cooperation Treaty, in which the application or the patent names another inventor and was effectively filed before the effective filing date of the claimed invention;

PROVIDED, FURTHER, with respect to determining novelty and non-obviousness in accordance with items (1) and (2) in the foregoing clause, that:

- (1) subject matter developed by a person other than the inventor that would have qualified as prior art under item (2) above but not under item (1) above would not be prior art to a claimed invention where the subject matter and the claimed invention were, not later than the effective filing date of the claimed invention, owned by the same person or subject to an obligation of assignment to the same person;
- (2) subject matter would be regarded as known for the purposes of item (1) above only when it becomes reasonably and effectively accessible, either through its use or through its disclosure by other means where;
  - (A) reasonable accessibility requires that the subject matter can be accessed by persons of ordinary skill in the art to which the subject matter pertains without resort to undue efforts and
  - (B) effective accessibility requires that its content can be comprehended by persons of ordinary skill in the art to which the subject matter pertains without resort to undue efforts; and
- (3) until a twelve-month grace period becomes effective under the patent laws of the member states of the European Patent Convention and in the patent law of Japan, the grace period under which disclosures made directly or indirectly by the inventor would only apply to disclosures made up to twelve months preceding the effective filing date in the United States; and that the following past actions of the Section inconsistent with this resolution are rescinded and, for past actions that are a position of the Association, the Section recommends rescission by the House of Delegates:
  - (A) 1992 AR124-R108-9 (opposition to elimination of "best mode");
  - (B) 1967 S.SP 76-ABA 1967 (opposition to foreign knowledge or use as prior art), for which the Section additionally supports and recommends rescission of the resolution by the Association;

- (C) 1983 SP 52-R108-4 (removal of co-worker “secret” prior art, except for prior-art based on filing of patent/published application of co-worker inventor);
- (D) 1984 SP 37-R101-7 (removal of co-worker “secret” prior art, 35 U.S.C. §102(f) and 35 U.S.C. §102(g), but not prior-art based on filing of patent/published application of co-worker inventor under 35 U.S.C. §102(e));
- (E) 1992 AR125-R108-10A (right of inventor in prior art patent to prove prior invention as prior art under 35 U.S.C. §102(g) to same degree as prior inventor who did not seek a patent for the invention), and
- (F) 2002 AR104-R101-11 (excluding from “on sale” bar sales to the patentee).

### PROPOSED RESOLUTION 102-3:

#### Grace Period

##### *Class 3 – Rest as Committee Report*

RESOLVED, that the Section supports, in principle, in the context of ratification of an international harmonization treaty involving at least Japan or major European countries that mandates U.S. adoption of a first-inventor-to-file system, the adoption of an “international style grace period,” and SPECIFICALLY, the Section supports treaty implementing legislation which supports the adoption of a grace period in which a disclosure of information anywhere in the world which would otherwise affect the patentability of an invention shall not affect the patentability of an invention claimed in an application where the information was disclosed directly or indirectly by the inventor, or by a third party which obtained the information directly or indirectly from the inventor, during the 12 months preceding the filing date, or where priority is claimed, the priority date of the application.

### PROPOSED RESOLUTION 102-4:

#### Absolute Novelty

##### *Class 3 – Rest as Committee Report*

RESOLVED, that the Section supports, in principle, in the context of ratification of an international harmonization treaty involving at least Japan or major European countries that mandates U.S. adoption of a first-inventor-to-file system, the adoption of a definition of prior art that has no geographic restrictions, and SPECIFICALLY, the Section supports treaty implementing legislation defining prior art as disclosure anywhere in the world which is reasonably and effectively accessible to persons of ordinary skill in the art, and that the following past action of the Section inconsistent with this resolution is rescinded.

### PROPOSED RESOLUTION 102-5:

#### Secret Prior Art

##### *Class 3 – Rest as Committee Report*

RESOLVED, that the Section supports, in principle, in the context of ratification of an international harmonization treaty involving at least Japan or major European countries that mandates U.S. adoption of a first-inventor-to-file system, applying previously filed, subsequently published prior art as of its effective filing date for the purposes of both novelty and obviousness, and SPECIFICALLY, the Section supports treaty implementing legislation defining prior art to require that patents and published applications (including International applications published in any language) filed as national applications in the United States or filed under the Patent Cooperation Treaty, in which the application or the patent names another inventor, shall have a prior art effect from their effective filing date and can be used for the purposes of both novelty and obviousness, so long as the subject matter of the prior art and the subject matter of the claimed invention do not name the same inventor or, not later than the filing date of the claimed invention, are owned by the same person or subject to an obligation of assignment to the same person, but subject to the existing judge made law on obviousness-type double patenting, and that the following past actions of the Section inconsistent with this resolution are rescinded:

- (A) 1983 SP 52-R108-4 (removal of co-worker “secret” prior art, except for prior-art based on filing of patent/published application of co-worker inventor);
- (B) 1984 SP 37-R101-7 (removal of co-worker “secret” prior art, 35 U.S.C. §102(f) and 35 U.S.C. §102(g), but not prior-art based on filing of patent/published application of co-worker inventor under 35 U.S.C. §102(e)).

### PROPOSED RESOLUTION 102-6:

#### Loss of Rights

##### *Class 3 – Rest as Committee Report*

RESOLVED, that the Section supports, in principle, in the context of ratification of an international harmonization treaty involving at least Japan or major European Countries that mandates U.S. adoption of a first-inventor-to-file system, the elimination of “loss of Right to patent” provisions currently in 35 U.S.C. §102, and SPECIFICALLY, the section supports treaty implementing legislation which would eliminate:

- a) abandonment as set forth in 35 U.S.C. 102 (c) as a basis for a loss of right to patent;
- b) premature foreign patenting as set forth in 35 U.S.C. 102(d) as an element of

prior art or a basis for a loss of right to patent;

- c) an inventor’s forfeiture of his or her right to patent an invention once placed “in public” use or “on sale” as set forth in 35 U.S.C. 102(b) by providing that no such loss of right to patent an invention can arise unless the invention had become reasonably and effectively accessible to persons of ordinary skill in the art more than one year before the inventor sought a patent for the invention; and
- d) prior art as set forth in 35 U.S.C. 102(f) under which non-public knowledge of the inventor, not otherwise qualifying as prior art, can render an invention made by such inventor obvious, and that the following past actions of the Section inconsistent with this resolution are rescinded:
  - (A) 1992 AR125-R108-10A (right of inventor in prior art patent to prove prior invention as prior art under 35 U.S.C. §102(g) to same degree as prior inventor who did not seek a patent for the invention), and
  - (B) 2002 AR104-R101-11 (excluding from “on sale” bar sales to the patentee).

### PROPOSED RESOLUTION 102-7:

#### Prior User Rights

##### *Class 1 – Full Debate as Amended*

~~RESOLVED, that the Section supports, in principle, in the context of ratification of an international harmonization treaty involving at least Japan or major European Countries that mandates U.S. adoption of a first-inventor-to-file system, the adoption of a “prior user right” and SPECIFICALLY the Section supports treaty implementing legislation that commercial use (including substantial preparations for commercial use) should be recognized as a personal defense to patent infringement, if undertaken in good faith by a person who has reduced the invention to practice prior to the effective filing date of a patent.~~

RESOLVED, that the Section of Intellectual Property Law supports, in principle, in the context of U.S. adoption of a first-inventor-to-file system, legislation expanding the subject matter eligible for “prior user rights” under section 273 of Title 35, U.S.C. to include all categories of patentable subject matter; and SPECIFICALLY, the Section supports enabling legislation that would permit commercial use (including substantial preparations for commercial use) of a patented invention to be recognized as a personal defense to patent infringement, if undertaken in good faith by a person who has reduced the invention to practice prior to the effective filing date of a patent.

**PROPOSED RESOLUTION 103-1:**

**Single Paper Continuation Filing**

*Class 2 – Approve - as Amended*

RESOLVED, that the Section of Intellectual Property Law favors in principle simplifying the filing of a continuation or divisional application filed under 37 C.F.R. § 1.53(b) claiming priority to an application stored in the Office's Image File Wrapper system; and Specifically, the Section favors the filing of such continuation or divisional applications by way of a single paper identifying that a specification including at least one claim and drawings, if necessary, and an executed oath or declaration were filed in the parent application, and requesting that a copy of the specification, drawings and oath or declaration be copied by the Office from the parent application into the electronic files for the continuing application, and that the requirement for filing a copy of the executed oath or declaration from the parent application under 37 C.F.R. § 1.63(d)(1)(iv) be eliminated in connection with the filing of the continuing application when the other provisions of 37 C.F.R. § 1.63(d) are met.

RESOLVED, that the Section of Intellectual Property Law favors, in principle, with respect to any document available through the USPTO's Patent Image File Wrapper system, the elimination from Title 37, C.F.R. of any requirement that an applicant for patent be required to submit in paper form to the USPTO such a document already available electronically in the Office; and SPECIFICALLY, the Section favors simplifying the filing of a continuation or divisional application under 37 C.F.R. § 1.53(b) by eliminating the requirement for filing a paper copy of the executed oath or declaration from the parent application under 37 C.F.R. § 1.63(d)(1)(iv) when the other provisions of 37 C.F.R. § 1.63(d) are met and when the executed oath or declaration exists in the IFW system as an electronic document.

**PROPOSED RESOLUTION 103-2:**

**Modified Petition To Make Special**

*Not A Valid Resolution – Committee Did Not Approve*

RESOLVED, that the Section of Intellectual Property Law favors in principle that the petitions to make special provided for under 37 C.F.R. § 1.102 be modified to include an additional category of special status; and SPECIFICALLY, the Section favors creating an additional category of special status to be added to MPEP 708.02, specifying that, for a higher fee, an application may be made special as described in MPEP 708.02 VIII without requiring that the applicant meet the requirements of MPEP 708.02 VIII (E) (i.e., "Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111(b)

and (c), how the claimed subject matter is patentable over the references.").

**PROPOSED RESOLUTION 103-3:**

**Changes to Implement the Cooperative Research and Technology Enhancement Act Of 2004 (Create Act)**

*Class 2 – Approve - as Amended*

RESOLVED, that the Section of Intellectual Property Law favors rule changes to implement the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act), provided that the rule changes allow applicants to take advantage of the provisions of 35 U.S.C. § 103(e)(2) without imposing additional procedural requirements.

RESOLVED, that the Section of Intellectual Property Law favors, in principle, providing detailed guidance to inventors through rulemaking to implement the Cooperative Research and Technology Enhancement Act of 2004 (CREATE Act); and SPECIFICALLY, the Section supports rule changes to Title 37, Code of Federal Regulations, that will allow applicants to take advantage of the provisions of 35 U.S.C. § 103(c)(2) in a manner that minimizes procedural requirements.

**PROPOSED RESOLUTION 103-4:**

**Clarifying Applicants' Duty Regarding Advancing Patent Claims**

*Class 2 – Approve – as Amended*

RESOLVED, that the Section of Intellectual Property Law favors clarifying applicants' ethical responsibilities in presenting claims in a patent application; and Specifically, the Section favors improving patent quality and reducing the patenting of claims applicants know or reasonably ought to know are frivolous, and favors such improvement by clarifying applicants' ethical responsibilities regarding advancing frivolous claims in a patent application, such clarification being necessary because of the question posed by 37 CFR § 10.18(b)(2)(ii) of whether the word *claims* means patent claims or merely legal arguments.

RESOLVED, that the Section of Intellectual Property Law favors, in principle, interpreting 37 CFR § 10.18(b)(2)(ii) to clarify that a registered patent attorney's or patent agent's ethical responsibility in presenting subject matter for examination in a patent application precludes the submission for examination of subject matter whose basis for patentability is known, or reasonably ought to have been known, to be frivolous; and SPECIFICALLY, the Section favors an amendment to section 10.18(b)(2)(ii) to define the word "claim" to include both (1) any legal contention or position and (2) subject matter sought to be patented.

**PROPOSED RESOLUTION 108-1:**

**Direct Response to FTC No. 8**

*Class 2 Approve - by Council on January 23, 2005*

RESOLVED, the Section opposes, in principle, the application of intervening or prior user rights based upon the addition of broadened claims in a continuing application; and, SPECIFICALLY, the Section disapproves FTC Recommendation 8 that recommends the enactment of legislation to create intervening or prior user rights to preclude enforcement of claims first presented in a continuing application that are broader than any claim in any application from which the continuing application claims priority, if the accused product or process was developed or used before the broader claims were published.

**PROPOSED RESOLUTION 108-2:**

**Proposed Amendment to Prior User Rights Statute**

*Class 3 – Rest as a Committee Report*

RESOLVED, that the Section approves, in principle, the application of intervening or prior user rights in existence before the effective date of a priority application; and, SPECIFICALLY, the Section supports legislation that would amend 35 U.S.C. § 273 to remove the limitation in this statute that the defense to infringement is restricted to a method in the patent being asserted, which is defined as "a method of doing or conducting business."

**PROPOSED RESOLUTION 108-3:**

**Proposed Amendment to Prior User Rights Statute**

*Class 3 – Rest as a Committee Report*

RESOLVED, that the Section approves, in principle, the application of intervening or prior user rights in existence before the effective date of a priority application; and, SPECIFICALLY, the Section supports legislation that would amend 35 U.S.C. § 273 to remove the requirement in this statute that the prior use be reduced to practice "at least 1 year before the effective filing date of such patent."

**PROPOSED RESOLUTION 108-4:**

**Proposed Amendment To Prior User Rights Statute**

*Class 3 – Rest as a Committee Report*

RESOLVED, that the Section approves, in principle, the application of intervening or prior user rights in existence before the effective date of a priority application; and, SPECIFICALLY, the Section supports legislation that would amend 35 U.S.C. § 273 to provide that the defense to infringement under this statute include "substantial preparation."

### PROPOSED RESOLUTION 155-1:

#### PTO Fees

*Class 3 – Rest as a Committee Report*

RESOLVED that the Section opposes increasing patent and trademark fees or extending the current patent and trademark fee increases absent legislation which prevents diverting such fees to offset spending on programs other than the PTO.

### PROPOSED RESOLUTION 201-1:

#### Dilution

*Class 2 Approve - by Council February 8, 2005*

RESOLVED, that the Section of Intellectual Property Law of the American Bar Association (the “Section”) opposes in principle amending the Federal Trademark Dilution Act of 1995 (the “FTDA”), 15 U.S.C. §1125(c), to make evidence of use as a designation of source a condition for liability; and SPECIFICALLY, the Section opposes amending the FTDA to add the phrase “as a designation of source” so as to require evidence of “use in commerce of a mark or trade name as a designation of source of the person’s goods or services” as a predicate for imposing liability for dilution of a famous mark.

### PROPOSED RESOLUTION 201-2:

#### Dilution

*Class 2 Approve - by Council February 8, 2005*

RESOLVED, that the Section of Intellectual Property Law of the American Bar Association (the “Section”) favors in principle amending the Federal Trademark Dilution Act of 1995 (the “FTDA”), 15 U.S.C. §1125(c), to make clear that the “fair use” defense to infringement also applies to dilution claims; and SPECIFICALLY, the Section favors amending Section 43(c)(4)(A) of the Lanham Act to insert “, including” so that the section would read as follows: “Fair use of a famous mark by another person, including for purposes of comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.”

### PROPOSED RESOLUTION 201-3:

#### Dilution

*Class 2 Approve - by Council February 8, 2005*

RESOLVED, that the Section of Intellectual Property Law of the American Bar Association (the “Section”) favors in principle leaving to the development of common law the consideration of dilution by blurring; and SPECIFICALLY, opposes any proposal to amend the Federal Trademark Dilution Act of

1995 (the “FTDA”), 15 U.S.C. §1125(c), to set forth factors relevant to consideration of dilution by blurring.

### PROPOSED RESOLUTION 201-4:

#### Dilution

*Class 2 Approve - by Council February 8, 2005*

RESOLVED, that the Section of Intellectual Property Law of the American Bar Association (the “Section”) opposes in principle amending the Lanham Act with respect to the “distinctive and famous” factors currently set forth in the Federal Trademark Dilution Act of 1995 (the “FTDA”), 15 U.S.C. §1125(c)(1); and SPECIFICALLY, opposes any proposal to revise the factors set forth in Section 43(c)(1) of the FTDA.

### PROPOSED RESOLUTION 201-5:

#### Dilution

*Class 2 Approve - by Council February 8, 2005*

RESOLVED, that the Section of Intellectual Property Law of the American Bar Association (the “Section”) opposes in principle decentralizing the location of definitions in the Lanham Act; and SPECIFICALLY, the Section opposes amending the Federal Trademark Dilution Act of 1995 (the “FTDA”), 15 U.S.C. §1125(c), to set forth definitions of “dilution by blurring” and “dilution by tarnishment” in any section other than Section 45 of the Lanham Act, 15 U.S.C. §1127.

### PROPOSED RESOLUTION 201-6:

#### Dilution

*Class 2 Approve - by Council February 8, 2005*

RESOLVED, that the Section of Intellectual Property Law of the American Bar Association (the “Section”) opposes in principle amending the Federal Trademark Dilution Act of 1995 (the “FTDA”), 15 U.S.C. §1125(c), to introduce the concept of “uniqueness” as a requirement for protection; and SPECIFICALLY, opposes amending the FTDA to provide that a mark must be both “famous” and “substantially unique” in order to be entitled to protection against “dilution by blurring.”

### PROPOSED RESOLUTION 201-7:

#### Stop Counterfeiting in Manufactured Goods Act

*Class 2 Approve - as amended*

RESOLVED, that the Section of Intellectual Property Law of the American Bar Association (the “Section”) favors, in principle, legislation prohibiting the trafficking in counterfeit labels, patches and medallions bearing spurious imitations of

registered marks that are intended to be affixed to goods for which the marks are registered and which have not been produced under the authority of the marks’ owners unattached to any goods; and SPECIFICALLY, the Section favors the Stop Counterfeiting in Manufactured Goods Act, H.R. 32, 109<sup>th</sup> Congress, 1<sup>st</sup> Sess. (2005) (Knollenberg).

### PROPOSED RESOLUTION 409-1:

#### Proposed FTC Recommendation 6

*Class 2 Approve - by Council on March 4, 2005*

RESOLVED, that the Section of Intellectual Property Law opposes in principle the statement that the courts and the PTO “consider possible harm to competition - along with other possible benefits and costs - before extending the scope of patentable subject matter”; and SPECIFICALLY, the Section proposes that the courts and the PTO give full effect to Congress’s intent that “anything under the sun that is made by man” is patentable, as well as Congress’s intent that the court’s and the PTO scrupulously ensure that patent applicants fully comply with their bargain with the public -- in exchange for complete and enabling disclosure of a useful, novel, and unobvious invention, patentees will receive meaningful, but limited, exclusive rights.

### PROPOSED RESOLUTION 409-2:

#### Proposed FTC Recommendation 10

*Class 2 Approve - by Council on March 4, 2005*

RESOLVED, that the Section of Intellectual Property Law opposes in principle the statement that the courts and the PTO should “expand consideration of economic learning and competition policy concerns in patent law decision making”; and SPECIFICALLY, the Section proposes that the courts and the PTO give full effect to Congress’s intent that “anything under the sun that is made by man” is patentable, and well as Congress’s intent that the court’s and the PTO scrupulously ensure that patent applicants fully comply with their bargain with the public -- in exchange for complete and enabling disclosure of a useful, novel, and unobvious invention, patentees will receive meaningful, but limited, exclusive rights.

### PROPOSED RESOLUTION 412-1:

#### Geneva Act, Hague Agreement Concerning the International Registration of Industrial Designs

*Class 2 Approve – as Amended*

RESOLVED, that the Section of Intellectual Property Law favors, in principle, the coordination of domestic and foreign protection of industrial designs; and SPECIFICALLY, the Section favors ratification by the United States of the Geneva

Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

**PROPOSED RESOLUTION 601-1:**

**NAS Recommendation 6a**

*Not A Valid Resolution – Committee Did Not Approve*

RESOLVED, that the Section of Intellectual Property Law supports, in principle, the recommendation of the National Research Council of the National Academies relative to reducing litigation cost and increasing predictability of patent infringement litigation outcomes in cases involving willful infringement allegations as set forth in their report, *A Patent System for the 21<sup>st</sup> Century*; and SPECIFICALLY, the Section supports legislation that would implement the following changes to the existing law of willful patent infringement

- (1) elimination of the duty of due care requirement and restriction of willfulness findings to cases involving reprehensible conduct as per Dyk, J. in his separate opinion in *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, --- F.3d --- (Fed. Cir. 2004);
- (2) reprehensible conduct will be evaluated based on the totality of circumstances, including, but not restricted to, whether there was (a) deliberate copying with knowledge of the patent, (b) the absence of a substantial defense at trial, and (c) intentional concealment of the infringement;
- (3) willfulness shall be tried by the court, not a jury, and all findings of fact relevant to willfulness shall be found by the court;
- (4) willfulness shall be considered in conjunction with the court's evaluation of enhanced damages and the award of attorney's fees, but only after liability has been found;
- (5) per the en banc decision in *Knorr-Bremse*, no adverse inference shall be drawn as a result of failure to obtain an opinion of counsel or the failure to produce an opinion of counsel if one is obtained; while the reliance on an opinion of counsel may be considered as part of the totality of circumstances of reprehensibility, an opinion is not required to avoid a willfulness finding;

**PROPOSED RESOLUTION 601-2:**

*Not A Valid Resolution – Committee Did Not Approve*

RESOLVED, that the Section of Intellectual Property Law supports, in principle, the recommendation of the National Research Council of the National Academies relating to limiting allegations of willful infringement, as set forth in its report, *A Patent System for the 21<sup>st</sup> Century*; and

SPECIFICALLY, the Section supports legislation that would eliminate any “duty of due care” imposed upon a possible infringer unless and until the patent owner (or another party having the right to bring suit for infringement of the patent) provides actual written notice to the possible infringer of its activities alleged to constitute infringement.

**PROPOSED RESOLUTION 601-3**

*Not A Valid Resolution – Committee Did Not Approve*

RESOLVED, that the Section of Intellectual Property Law supports, in principle, the recommendation of the National Research Council of the National Academies relating to limiting allegations of willful infringement, as set forth in its report, *A Patent System for the 21<sup>st</sup> Century*; and SPECIFICALLY, the Section supports legislation that would prohibit findings of willfulness except in cases involving reprehensible conduct on the part of the accused infringer, such conduct to be determined based on the totality of circumstances.

**PROPOSED RESOLUTION 601-4**

*Not A Valid Resolution – Committee Did Not Approve*

RESOLVED, that the Section of Intellectual Property Law supports, in principle, the recommendation of the National Research Council of the National Academies relating to limiting allegations of willful infringement, as set forth in its report, *A Patent System for the 21<sup>st</sup> Century*; and SPECIFICALLY, the Section supports legislation that would prohibit findings of willfulness except in cases involving reprehensible conduct on the part of the accused infringer, such conduct to be determined based on whether there was (a) deliberate copying with knowledge of the claimed subject matter in the patent, (b) the absence of a substantial defense at trial, (c) intentional concealment of the infringement, (d) breach of any applicable duty of due care, or (e) such other facts or circumstances that evidence reprehensibility as may be determined by a court to be relevant to the issue.

**PROPOSED RESOLUTION 601-5**

*Not A Valid Resolution – Committee Did Not Approve*

RESOLVED, that the Section of Intellectual Property Law supports, in principle, the recommendation of the National Research Council of the National Academies relating to limiting allegations of willful infringement, as set forth in its report, *A Patent System for the 21<sup>st</sup> Century*; and SPECIFICALLY, the Section supports legislation that would provide that the issue of willfulness shall be tried to the court, not a

jury, and all findings of fact relevant to willfulness shall be found by the court;

**PROPOSED RESOLUTION 601-6**

*Not A Valid Resolution – Committee Did Not Approve*

RESOLVED, that the Section of Intellectual Property Law supports, in principle, the recommendation of the National Research Council of the National Academies relating to limiting allegations of willful infringement, as set forth in its report, *A Patent System for the 21<sup>st</sup> Century*; and SPECIFICALLY, the Section supports legislation that would provide that an allegation of willfulness could not be considered by a court, except (1) in conjunction with the court's evaluation of the amount of damages and/or the possible award of attorney's fees and (2) after a final judgment of liability has been entered.

**PROPOSED RESOLUTION 601-7**

*Not A Valid Resolution – Committee Did Not Approve*

RESOLVED, that the Section of Intellectual Property Law supports, in principle, the recommendation of the National Research Council of the National Academies relating to limiting allegations of willful infringement, as set forth in its report, *A Patent System for the 21<sup>st</sup> Century*; and SPECIFICALLY, the Section supports legislation to (1) eliminate the duty of due care on a possible infringer and (2) restrict any award of enhanced damages for infringement to cases involving reprehensible conduct on the part of the adjudicated infringer.

**PROPOSED RESOLUTION 601-8:**

**Recommendations on Proposed Amendments to Rule 11**

*Class 2 Approve – by Council on January 24, 2005*

RESOLVED, that the Section of Intellectual Property Law supports the resolutions concerning the proposed amendments to Rule 11 of the Federal Rules of Civil Procedure that will be submitted by the Litigation and Tort Trial and Insurance Practice Sections to the House of Delegates in February 2005.

**PROPOSED RESOLUTION 601-9:**

**Recommendations on Proposed Amendments to Rule 5(E) Concerning E-Filing**

*Class 2 Approve*

RESOLVED, that the Section of Intellectual Property Law supports the Rules Committee of the Federal Judicial Conference's proposed amendment to Rule 5(e) affecting amendments to the Federal Appellate, Bankruptcy, and District Court Rules, which would authorize trial and appellate federal courts to "permit or require" electronic filing.

### PROPOSED RESOLUTION 604-1:

#### NAS Proposals

*Class 2 Approve – by Council on January 23, 2005*

RESOLVED, that the Section of Intellectual Property Law favors in principle that the Court of Appeals for the Federal Circuit continue its practice of encouraging amicus participation in important cases before the court, and SPECIFICALLY, the Section favors that in encouraging amicus participation, the court, to the extent appropriate to the particular case, should draw upon insights from other judicial decisions, independent scholarly analysis, and available and relevant empirical evidence, but need not encourage economic analysis in areas of innovation-related law.

### PROPOSED RESOLUTION 604-2:

#### NAS Proposals

*Class 2 Approve as Amended – by Council on January 23, 2005*

RESOLVED, that the Section of Intellectual Property Law favors in principle the appointment of judges to the Court of Appeals for the Federal Circuit with particular care and appropriate to the court's diverse subject matter jurisdiction, and SPECIFICALLY, the Section favors the appointment of judges to the court of (1) men and women with (±) diverse experience and backgrounds appropriate to the court's diverse subject matter jurisdiction, while maintaining a complement of three or four active judges with extensive pre-court patent law backgrounds, and (2) men and women with experience as federal district court judges with extensive jury trial experience, including patent jury trial experience. ~~but does not favor the appointment of judges to the court with backgrounds in antitrust or finance law or in economics or economic history.~~

### PROPOSED RESOLUTION 604-3:

#### NAS Proposals

*Class 2 Approve – by Council on January 23, 2005*

RESOLVED, that the Section of Intellectual Property Law favors in principle encouraging the Federal Circuit judges to sit by designation on other federal courts and vice-versa, and SPECIFICALLY, the Section favors the Federal Circuit exchanging judges with other federal courts through the designation process in order to give the Federal Circuit judges a better sense of how patent law fits in with other laws influencing innovation, and particularly encourages such exchange to provide Federal Circuit judges with greater exposure to patent jury trials.

### PROPOSED RESOLUTION 701-1:

#### The Application Of Section 271(F) of the Patent Act to Computer Programs

*Class 1 – Full Debate – as Amended*

RESOLVED, that the Section of Intellectual Property Law favors, in principle, that a computer program falls within the scope of the a term “component” in 35 USC § 271(f) can encompass a computer program where the requirements of 35 USC § 271(f) are otherwise met.

### PROPOSED RESOLUTION 703-1:

#### Spyware

*Class 2 – Approve*

RESOLVED, that the Section of Intellectual Property Law favors in principle prohibiting the collection of information about an individual through the use of software installed in such individual's computer unless (i) there has been clear and accurate disclosure of the identity of the party collecting the information or installing the software and a meaningful opportunity for the individual to choose whether to allow such collection or installation, and (ii) the individual is given the ability to revoke any permission for the collection of such information or the installation of such software, and SPECIFICALLY, that the Section of Intellectual Property Law supports H.R. 29, the SPY ACT in its form as proposed by Representatives Bono and Towns.

### PROPOSED RESOLUTION 703-2:

#### Future Panel Discussion on Bioinformatics

*Class 3 – Rest as a Committee Report*

RESOLVED, that the committee should promote within the Section having a panel discussion on bioinformatics at an upcoming Section conference or conference.

### PROPOSED RESOLUTION 1002-1:

#### Utility Patents For Plants And Opposition To Saved Seed Legislation

*Class 2 – Approve – as Amended*

RESOLVED, that the Section of Intellectual Property Law ~~of the American Bar Association~~ opposes in principle any saved seed exemption for plants and seeds patented under 35 U.S.C. §101 et seq.

### PROPOSED RESOLUTION 1002-2:

#### UPOV/PVP Protection For Plants and Strengthening of the UPOV/PVP System

*Class 2 – Approve – as Amended*

~~RESOLVED, that the Section of Intellectual Property Law of the American Bar Association supports in principle the July 2004 American Seed Trade Association (ASTA) Position Statement on Intellectual Property Rights for the Seed Industry, and specifically, the Section is in favor of strengthening the UPOV/PVP system as proposed in the ASTA Position Statement.~~

### PROPOSED REVISED RESOLUTION 1002-2:

RESOLVED, that the Section of Intellectual Property Law favors, in principle, those recommendations contained in the July 2004 American Seed Trade Association (ASTA) Position Statement on Intellectual Property Rights for the Seed Industry that would strengthen the provisions of the UPOV/PVP system for the protection of plant varieties through, and SPECIFICALLY, the Section supports strengthening the provisions of the UPOV/PVP system for the protection of plant varieties through:

- (1) providing compensation for and/or limits on saved seed in all countries,
- (2) making the essentially derived variety (EDV) system more effective,
- (3) revising the breeders' exemption to include a fixed period for each crop during which the breeders' exemption would not be available for PVP protected material, and
- (4) requiring all member countries to adopt to the most current UPOV system.

**2005 Summer  
IPL Conference  
June 22-25, 2005  
San Francisco**

#### Featured Guest Speakers:

**Senator Barbara Boxer (D-Calif.)**

**Hon. Marybeth Peters,  
U.S. Register of Copyrights**

**Hon. Ronald S.W. Lew,  
U.S. District Court for the  
Central District of California**

**Sara Holtz, Principal,  
ClientFocus, Granite Bay, CA**

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# Chair's Bulletin

## Mark Your Calendar!

June 9-10, 2005

### The Berkeley Conference on Antitrust in the Technology Economy

(co-sponsored with the ABA Section of  
Antitrust Law and the Competition Policy  
Center, U.C. Berkeley)  
Berkeley, CA

June 21, 2005

### Practical Tips on Enforcing and Defending Patents

The Palace Hotel  
San Francisco, CA

June 22-25, 2005

### 2005 Summer IPL Conference

The Palace Hotel  
San Francisco, CA

Learn more online: [www.abanet.org/intelprop](http://www.abanet.org/intelprop)

## Summer IPL Conference Coming Up in June



That time of year is almost upon us again. The 2005 Summer IPL Conference will be held June 22-25 at the Palace Hotel in San Francisco.

This conference is an absolute must for Section members and their families.

It provides opportunities for all intellectual property practitioners, members, non-members, the new and the experienced, to gain insights into new developments, debate current issues and share ideas with others interested in improving the protection of intellectual property nationally and internationally.

The educational programs will feature the latest developments in IP law presented by leading authorities in the field. The Business Session will include reports from the Section's substantive committees for analysis, de-

bate and adoption of resolutions that will be the foundation of Section and ABA positions, Congressional testimony, and statements to the PTO and international IP bodies on intellectual property law issues for years to come. CLE credit will be available for both the educational programs and the Business Session.

The beautiful, enticing, and ever-popular city of San Francisco provides a spectacular backdrop for what promises to be a truly memorable conference with a comprehensive mix of educational programs, networking opportunities, committee meetings, social events, exhibits, sporting tournaments and exciting and memorable tours.

For further information on the Summer IPL Conference in San Francisco and to register online, visit the website at [www.abanet.org/intelprop/summer2005](http://www.abanet.org/intelprop/summer2005), or phone 312/988-5598.

## Practical Tips Program to Precede Summer Conference

A Practical Tips Program will also be offered in San Francisco, on June 21. This particular program, Practical Tips on Enforcing and Defending Patents, focuses on the enforcement and defense of patents in court. As a special benefit to those attending the program, a number of "model" documents typically used in patent litigation will be made available for future reference and possible adaptation for later use. These documents have been prepared by some of the nation's leading patent litigation attorneys and cover a wide variety of subjects including: litigation checklists, sample discovery requests, protective orders, case management orders, jury instructions, and trial/appellate papers. Go to [www.abanet.org/intelprop/2005tips\\_sf](http://www.abanet.org/intelprop/2005tips_sf) for full details.

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