Dear Director Iancu:

Thank you for taking the time to meet recently with a group of our ABA-IPL Section leaders allowing an introduction of the newly elected officers attending. The views expressed herein are presented on behalf of the Section of Intellectual Property Law. They have not been approved by the House of Delegates or the Board of Governors of the American Bar Association (ABA) and, accordingly, should not be construed as representing the position of the Association.

As we mentioned in our meeting, the Section of the Intellectual Property Law Council met in August during the ABA Annual Meeting and passed several resolutions on various topics of interest to the intellectual property community:

**ABA-IPL Resolutions passed at 2019 ABA Annual Meeting – San Francisco**

RESOLVED, that the American Bar Association Section of Intellectual Property Law (“the Section”) supports in principle amending 15 U.S.C. §1062(b) to remove the mandated six-month response time for applicants and registrants to respond to United States Patent and Trademark Office ("Office") Office Actions; and

FURTHER RESOLVED, the Section supports in principle allowing the Office to prescribe by rulemaking response times other than six months for certain limited types of inquiries and preliminary refusals, provided that the Office gives appropriate notice to stakeholders and sets strict guidelines that identify the response times applicable to each inquiry or preliminary refusal in order to avoid the imposition of inconsistent deadlines due to discretion exercised by individual examiners.
RESOLVED, that the American Bar Association (‘ABA’) Section of Intellectual Property Law (the “Section”) opposes in principle any amendment to the Lanham Act that would permit United States Patent and Trademark Office (the “Office”) to withdraw registration certificates after issuance, returning the marks to application status and allowing for subsequent Office Action(s) refusing registration on grounds that should have been raised during the initial examination, whether in response to an ex parte request or sua sponte by the Office.

FURTHER RESOLVED, that the Section supports in principle that the validity of trademark registrations that have already been issued by the Office should be determined by the Trademark Trial and Appeal Board (“TTAB”) or a court of competent jurisdiction.

WHEREAS, in fiscal year 2018, the Trademark Trial and Appeal Board of the United States Patent and Trademark Office (the “Board”) issued 585 ex parte and inter partes decisions on the merits, 39 (approximately 6.6%) of which were designated “Citable as Precedent”;

WHEREAS, in fiscal years 2013-2018, the Board issued a total of 233 precedential ex parte and inter partes decisions, which was an average of just 4-6% each year;

RESOLVED, that the Section of Intellectual Property Law of the American Bar Association (‘the Section’) supports, in principle, the Trademark Trial and Appeal Board (the “Board”) designating significantly more precedential ex parte and inter partes decisions in accordance with its authority to designate as precedential, including multi-issue decisions.

RESOLVED, that the Section of Intellectual Property Law opposes in principle legislation whereby the existence of more than one validly issued patent directed to related subject matter (e.g., a group of related patents covering the same or similar technical content) creates a presumption of anti-competitive behavior that diminishes or compromises the patent owner’s valid patent term and right to enforce all valid patents.

RESOLVED, that the Section of Intellectual Property Law opposes, in principle, legislation that provides for compulsory licensing of a patented product or process based on arbitrary criteria associated with the field of the patented technology.

RESOLVED, Section of Intellectual Property Law opposes, in principle, legislation that would place limitations on the number of patents that a patentee has a right to enforce in litigation; and

FURTHER RESOLVED, the Section opposes in principle legislation that would place arbitrary limitations on the number of patents that a patentee has a right to enforce in
RESOLVED, Section of Intellectual Property Law opposes, in principle, legislation that would arbitrarily shorten the term of a validly issued patent based solely upon the field of technology to which the patent claims are directed.

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RESOLVED, Section of Intellectual Property Law opposes, in principle, legislation that would arbitrarily eliminate the statutory presumption of validity of an issued patent based upon the field of technology to which the patent claims are directed.

* * * *

RESOLVED, that the ABA-IPL Section supports, in principle, that district courts should consider issuing a stay of litigation after the Patent Trial and Appeal Board (PTAB) issues a final written decision under 35 U.S.C. § 318(a) cancelling patent claims asserted in the litigation, pending appeal of the PTAB decision.

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RESOLVED, that, the ABA-IPL Section supports, in principle, that 35 U.S.C. §§ 315(e)(2) and 325(e)(2) do not estop a petitioner from raising grounds in a district court litigation that it successfully relied on in an AIA trial, if the district court does not stay the litigation pending exhaustion of all appeals of the relevant post-grant trial proceedings.

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RESOLVED, that the ABA-IPL Section supports, in principle, limiting petitioner estoppel under 35 U.S.C. §§ 315(e)(2) and 325(e)(2) to claims that the Patent Trial and Appeal Board found were patentable.

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Thank you again for your time. Should you have any questions, please do not hesitate to contact me.

Sincerely,

George W. Jordan III
Chair, ABA Section of Intellectual Property Law