

SECTION OF INTELLECTUAL PROPERTY LAW

PAST ACTION BOOK

2010-2011

(as of August 23, 2010)

PAST ACTION BOOK

Section of Intellectual Property Law

Preface

This Book is designed to assist the work of Section Committees. It is intended to be used by the Committee Chair to ascertain past actions bearing on the Committee's work. Included are all policy positions of the American Bar Association originating from past actions of this Section. Also included are all passed Section level resolutions, plus all defeated Section level resolutions, for the years 2005-2006, and those older resolutions which have specifically been retained. After each year, this Book is updated by adding new resolutions according to their subject classification and removing those resolutions over 10 years old - other than those approved by ABA or those specifically retained by the Section.

Resolutions in the Book are classified by subject matter. To locate relevant Resolutions, first refer to the Index and find the appropriate index number, then review the resolutions under this number in the Book. The action taken and the citation for the resolution appear after the index number at the top of each resolution.

For example, "201 (Passed 1967 SP 90 - ABA 1967 - R9)" is interpreted as follows: "201" is the subject classification; "Passed" refers to the action taken by the Section (and ABA if applicable); "1967 SP 90" is the citation to the year and page of the Summary of Proceedings, with the page being the page where the vote on the resolution is recorded; "ABA 1967" specifies the year of ABA approval; "R 9" specifies the resolution number. An "SP" reference denotes citation in the Summary of Proceedings; an "S. SP" reference denotes the citation in a Special Summary of Proceedings; "CR" reference denotes the citation in the Committee Reports; and an "AR" reference refers to the Annual Report publication, which replaced the Committee Reports and Summary of Proceedings beginning in 1991. Starting in 1979, the resolutions were numbered by committee number, thus R101-1 refers to the first resolution of Committee 101. Resolutions which came to the floor other than as a result of Committee reports are designated with the letters NR (new resolution). Thus, NR1 would be "new resolution 1". Resolutions which derived from a Task Force are denoted TF, and resolutions which derived from a Special Committee are denoted as SC.

Starting in 2002, as the Annual Report is published electronically, page numbers will no longer be inserted, as resolutions are searchable by year and then resolution number. For instance, "[214](#) (Passed 2003-R108-9)" is a resolution from Committee 108 in the 2002-2003 Association year and can be found by going to the Table of Contents and clicking on the appropriate link.

No cross-indexing of resolutions is provided. Thus, familiarization with the INDEX is necessary to avoid overlooking a relevant past action.

A record of all Section past actions over 10 years old (except those approved by ABA, or those retained by the Section which remain in the current Past Action Book) are maintained by our Section Director at ABA headquarters in Chicago in the various Past Action Books. The Section Director also maintains the Supplemental Past Action Booklet which includes Section resolutions which were tabled, recommitted, or rested as committee reports.

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205 (Passed 1995 AR84-R101-5; **Retained as Amended 2006**)

Section opposes, in principle, that the ~~Commissioner of Patents and Trademarks~~ Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office have legislative rulemaking authority with respect to patent issues, and specifically, opposes any interpretation of 35 U.S.C. §2 as conferring any such authority.

205 (Passed 1995 AR84-R101-6; **Retained as Amended 2006**)

Section opposes, in principle, giving the ~~Commissioner of Patents and Trademarks~~ Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office legislative rulemaking authority in the area of patent law.

205 (Passed by Council 7/2000; ABA 7/2000; **Retained 2010**)

Section approves, in principle, that Congress provide that all revenue generated by fees paid by patent and trademark applicants and owners to the United States Patent and Trademark Office remain with the USPTO without limitation, and Specifically, the Section opposes the withholding or diversion of any such revenue to fund any unrelated programs.

210 (Passed 1979 SP 95-ABA 1980-NR-; **Retained 1998; Retained 2008**)

Section, recognizing that strong patent and trademark systems are vital to the economy of the United States, favors in principle legislation to remove the United States Patent and Trademark Office from the Department of Commerce and make it a separate and independent agency.

210 (Passed 1983 SP 73-R403-1; **Retained 1998; Retained 2008**)

Section favors in principle limiting the Manual of Patent Examining Procedure (MPEP) and the Trademark Manual of Examining Procedure (TMEP) to Examiner's guides without the force of law or regulation; and Specifically, the Section favors use of the following legend on the title pages of the MPEP and TMEP: "This Manual is prepared by the Patent & Trademark Office as a guide to Examiners in performing their duties, and does not have the force of law or the force of Office rules of practice."

210 (Passed 1988 SP 36-R103-9; ABA 1989; Amended by Section & ABA in 1998 - Added Language Underscored)

Section favors in principle that any person selected to be Commissioner or Deputy Commissioner of Patents and Trademarks be a lawyer having experience in patent and trademark law, knowledgeable of both domestic and international laws concerning these matters, and well qualified to represent the United States Patent and Trademark Office domestically and to advocate United States positions on patent and trademark matters internationally and that such person have management skills sufficient to oversee the operations of the Patent and Trademark Office.

210 (Passed 1991 AR296-R651-8; **Retained 2002**)

Section favors in principle that the Patent and Trademark Office be exempt by law from general government spending, funding and personnel ceiling cuts or restrictions.

210 (Passed 1991 AR296-R651-9; **Retained 2002**)

Section favors in principle that the Patent and Trademark Office be given by law reasonable administrative flexibility in regard to (a) borrowing funds for major capital expenditures (b) personnel matters (c) salaries (d) procurement (e) accounting methods, and (f) other matters necessary to operate in a business-like basis.

210 (Passed 1991 AR301-R655-1; **Retained 2002**)

Section favors in principle legislation which would convert the Patent and Trademark Office to a Government corporation independent of the Department of Commerce with a chief operating officer who is a person having considerable experience in the field of patent and trademark law, the chief operating officer being appointed by the President, with the advice and consent of the U.S. Senate, and being the U.S. Commissioner of Patents and Trademarks and appointed for a fixed term of years, the corporation having operating and financial flexibility similar to that of a private corporation, the corporation having a board of directors which would include a substantial portion of members from the private sector with experience in patent and trademark law, and the legislation providing that, with respect to patent and trademark matters, the chief operating officer be the chief spokesman for the United States of America, with the approval of the Department of State, in meetings with foreign nations.

210 (Passed 1/93 AR31-R103-1; **Retained 2004**)

Section favors in principle modifying the patent law to:

- (1) Confirm the Commissioner's authority to adopt and publish interpretations of patent law;
- (2) Authorize the Commissioner to refuse to issue a patent after a decision by the Board of Patent Appeals and Interferences in an ex parte appeal, with a written justification based on a published Commissioner's interpretation of the law including interpretations issued after the decision; and with a right of appeal or remedy by civil action by the applicant in the event of such a refusal;
- (3) Provide that the Commissioner, Deputy Commissioner and Statutory Assistant Commissioners should no longer be members of the Board; and
- (4) Provide that the Commissioner should no longer have the authority to appoint panels of the Board. Panels should be appointed by the Chair and Vice-Chair of the Board by a random selection process which takes due consideration of the technology background of the Board members and the subject matter of the case on appeal.

210 (Passed by Council 1/93 AR31-R103-2; **Retained 2004**)

Section favors in principle that the Patent and Trademark Office be excluded from any across-the-board budget cut or personnel ceiling limitation effective throughout government.

210 (Passed 1995 AR446-R655-1; **Readopted 2006**)

Section favors in principle legislation that would establish the Patent and Trademark Office as a government corporation independent of the Department of Commerce, with operating and financial flexibility similar to that of a private corporation, and Specifically, the Section generally favors H.R. 1659, (1995) (Moorhead), 104th Cong., 1st Sess.

210 (Passed 1995 AR508-R803-5; **Readopted 2006**)

Section opposes elimination of the cost of living limitation on annual adjustments to patent and trademark fees, as presently set forth in 35 U.S. C. 41(f) and the Trademark Act, and Specifically, opposes Section 205(c) of H.R. 1756 (1995) (Chrysler), 104th Congr., 1st Sess., and Section 205 (c) of S. 929 (1995) (Abraham), 104th Congr., 1st Sess.

210 (Passed by Council Mail Poll 12/95; AR60-R704-3; **Readopted 2007**)

Whereas, it is widely agreed that Examiner Interviews are among the most effective techniques to advance prosecution of a patent application, but that one of their greatest disadvantages is cost; Now Therefore Be It Resolved, that the Section of Intellectual Property Law favors in

principle expansion by the Patent and Trademark Office of the opportunities for video conferencing to conduct Examiner interviews.

210 (Passed 2004-R103-17)

Section favors, in the principle, the adoption by the USPTO of a Mission Statement that recognizes the dual responsibilities of the USPTO to patent applicants and to the public in its proper administration of the applicable patent laws of the United States.

210 (Passed 2005-R103-1)

Section 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.

210 (Passed 2005-R103-2)

Section 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.

210 (Passed by Council 11/2006-TF-H1)

Section opposes, in principle, giving the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office legislative rulemaking authority with respect to patent issues, and, Section opposes any provisions of S. 3818, 109th Congress, 2d Sess. (2006) (Hatch-Leahy), or similar legislation, conferring any such authority.

214 (Passed 1979 SP 72-R103-4; **Retained 1999; Retained 2009**)

Section favors in principle adequate funding for the Patent and Trademark Office to permit high quality examination and reasonably prompt disposition of patent applications and to provide adequate services to the public, and submits that patent-related fees should be set at a level appropriate to cover a reasonable portion of costs while not being at such a level as to discourage inventors.

214 (Passed 1983 SP 81-R409-1; **Retained 1998; Retained 2008**)

Section favors the principle that small entity status under the PTO two-tier fee system should not be denied an independent inventor, with respect to an application for patent on an invention, solely on the basis that a shop right in the invention is possessed by a party who cannot qualify for small entity status, provided that the inventor neither receives nor is entitled to receive any remuneration from the nonqualifying party for its use of the invention and that the inventor does not have a substantial interest in either the ownership or the income of the nonqualifying party.

214 (Passed 1991 AR96-R108-9; **Retained 2002**)

Section opposes, in principle, special fees to be levied on those who frequently file applications for patents or trademark registration.

214 (Passed 1991 AR96-R108-10; **Retained 2002**)

Section opposes, in principle, special fees to be levied on lawyers or agents who practice in the patent and/or trademark and/or copyright fields.

214 (Passed 1991 AR296-R651-1; **Retained 2002**)

Section favors in principle reduced patent fees or the equivalent for appropriately entitled small entities under existing 35 U.S.C. §41(h)(1).

214 (Passed 1991 AR296-R651-2; **Retained 2002**)

Section favors in principle that the cost of reduced patent fees for small entities not be supported from fees paid by large entity patent applicants; and Specifically, the Section opposes the fee levels prescribed in H.R. 1613, 102nd Cong., 1st Sess.

214 (Passed 1991 AR296-R651-5; **Retained 2002**)

Section favors in principle maintaining the existing 60 day notice requirement in 35 U.S.C. §41(g) and in §31(a) of the Trademark Act of 1946, as amended (15 U.S.C. §1113), before fee changes become effective; and Specifically, the Section opposes the amendments contained in Section 4(c) and 4(g) of H.R. 1613, 102nd Cong., 1st Sess.

214 (Passed 1991 AR296-R651-6; **Retained 2002**)

Section favors in principle maintaining the prohibition in 35 U.S.C. §42(c) against using trademark fees to support non-trademark operations; and Specifically, the Section opposes the amendments contained in Section 4(f) of H.R. 1613, 102nd Cong., 1st Sess.

214 (Passed 1992 AR342-R651-2; **Retained 2003**)

Section favors in principle that all fee income received by the PTO be maintained in a special interest bearing account available to the PTO as needed to fund the services provided by the PTO and opposes any sequestering of fee income in such an account.

214 (Passed 1992 AR342-R651-3; **Retained 2003**)

Section favors in principle that no fee income received by the PTO be used to fund any program of any other agency or bureau or any program within the PTO not related to providing patent or trademark services to users.

214 (Approved by Council 1/97; AR23-R154-1; **Retained 2007**)

Section opposes in principle the collection of fees by any patent office of any country in excess of those required to maintain the patent office.

214 (Approved by Council 7/2000 E-mail vote; 2001AR25; ABA 00A301)

ABA favors in principle that Congress provide that all revenue generated by fees paid by patent and trademark applicants and owners to the United States Patent and Trademark Office remain with the United States Patent and Trademark Office without limitation, and Specifically, the Association opposes the withholding or diversion of any such revenue to fund any unrelated programs.

214 (Passed 2003-R103-8)

Section opposes, in principle, granting discretion to the Director to establish fees for searching a patent application; and Specifically, the Section opposes the provisions of section 2 (c) of H.R. 1561, 108th Cong., 1st Sess. (2003) (Smith-Berman, "United States Patent and Trademark Office

Fee Modernization Act of 2003”) to the extent that those provisions permit the Director to establish search fees.

214 (Passed 2003-R108-9)

Section supports fee increases contained in the proposed bill to the extent they go to PTO exclusively.

214 (Passed 2004-R108-6)

Section favors in principle adequate funding for the Patent and Trademark Office to permit high quality examination and reasonably prompt disposition of patent applications and to provide adequate services to the public, and the use by the PTO of all of its user fees.

214 (Passed by Council Conference Call 9/04-R102-1)

Section 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%.

214 (Passed by Council Conference Call 3/2007; R 102-2)

Section opposes, in principle, substantial increases in the fees of the U. S. Patent and Trademark Office (PTO) for its services as an International Search Authority for Patent Cooperation Treaty (PCT) applications when such increases would be inconsistent with the PTO setting of its fees for similar services for national applications and such increases would be burdensome on both small entities and corporate filers of PCT applications; and
NOW THEREFORE, the Section opposes the adoption of the increases in International Search Fees that the PTO proposes in 72 Fed. Reg. No. 32, p. 7583 (February 16, 2007).

214 (Passed 2007-Patent Law Reform Task Force TF-07-07)

Section re-confirms its opposition, in principle, to the diversion of PTO revenue; and
NOW THEREFORE, the Section favors, in principle, legislation, such as the provisions of S. 1145, 110th Congress, as reported on July 19, 2007 by the Senate Committee on the Judiciary, or similar legislation, which establishes a PTO revolving fund, into which all fees collected by the Office shall be deposited, and the amounts in which shall be available for use by the Director of the PTO without further appropriation, or fiscal year limitation.

214 (Passed 2007-Patent Law Reform Task Force TF-07-08)

Section opposes, in principle, granting fee setting authority to the Director of the PTO; and
NOW THEREFORE, the Section opposes legislation, such as Section 9 of S.1145, 110th Congress, as reported on July 19, 2007 by the Senate Committee on the Judiciary, or similar legislation, which gives the Director the authority to set or adjust by rule any fee established or charged by the PTO.

216 (Passed 1939 SP 29-ABA 1939; **Retained 1997; Retained 2007**)

Section recommends that after a specified date to be fixed by the Commissioner of Patents, no one shall be registered to practice before the Patent Office who is not a member of the Bar.

216 (Passed 1956 SP 33-ABA 1956; **Retained 1997; Retained 2007**)

Section approves the principle of restricting future admission to practice before the Patent Office to members of the bar.

216 (Passed 1983 SP 25-R503-1; **Retained 1998; Retained as Amended 2008**)

Section favors in principle sufficient penalties under law to discourage unauthorized practice before the Patent and Trademark Office; and Specifically, favors amending 35 U.S.C. §33 to (1) increase the fine from ~~\$1,000 to \$5,000~~ \$5,000 to \$10,000 and (2) provide that any party who pays a fee for services in connection with the preparation or prosecution of a patent application to a party who is in violation of 35 U.S.C. §33 may bring a civil suit against said party, and recover reasonable attorney fees.

216 (Passed 1984 SP 63-R502-1; **Retained 2000**)

Section opposes in principle the adoption by the U.S. Patent and Trademark Office of any disciplinary rule requiring a practitioner to engage in conduct proscribed by a State disciplinary rule governing the conduct of that practitioner; and Specifically, the Section urges that the Patent and Trademark Office amend 37 C.F.R. §10.85(b)(1) by adding at the end thereof "provided that the practitioner is not prohibited from doing so by the rules governing professional conduct in the State of the practitioner's principal office."

216 (Passed 1988 SP 47-R103-11; **Retained 1999; Retained 2009**)

Section favors in principle the proposition that a patent applicant's duty of disclosure of material information to the Patent and Trademark Office shall be satisfied by (i) disclosing that material information to the patent examiner at any time prior to the conclusion of prosecution before the patent examiner or (ii) the patent examiner's citing and/or considering that material information at any time prior to the conclusion of prosecution before the patent examiner.

216 (Passed 1988 SP 50-R103-13; **Retained 1999; Retained 2009**)

Section favors in principle the proposition that a patent application should not be stricken, that a claim in a patent application should not be rejected, and that an issued patent should not be held invalid or unenforceable for fraud on, or inequitable conduct in, the Patent and Trademark Office based upon the patent applicant's failure to disclose, or to disclose timely, material information to the Patent and Trademark Office if the patent examiner cites and/or considers that information prior to the conclusion of the prosecution before the patent examiner.

216 (Passed 1988 SP 54-R103-14; **Retained 1999; Retained 2009**)

Section favors in principle the Patent and Trademark Office deferring to federal courts all determinations, except in disciplinary proceedings, of whether there has been a violation of any duty of disclosure established in Title 37 of the Code of Federal Regulations, Part 1 (Rules of Practice in Patent Cases).

216 (Passed 1991 AR93-R108-3; **Retained 2002**)

Section reaffirms in principle its approval of revision of the patent laws to permit the owner of an invention, whether or not the owner is the inventor, to file a patent application covering that invention provided that the inventor or inventors be named in the application; and Specifically, the Section favors that such a revision provide that any person to whom an inventor has assigned or agreed, in writing, to assign an invention, may make application for patent on behalf of and as agent for the inventor, and provide further that the Commissioner may grant a patent to such person upon such notice to the inventor as the Commissioner deems sufficient.

216 (Passed 1991 AR237-R403-8; **Retained 2002**)

Section favors, in principle, amendment of 37 C.F.R. §1.56, to provide that a duty to supply information material to patentability to the Patent and Trademark Office shall exist with respect

to each pending claim until the claim is cancelled, or withdrawn from consideration, or the application becomes abandoned, that information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application, and that there is no duty to submit information which is not material to the patentability of any existing claim.

216 (Passed 1991 AR237-R403-9; **Retained 2002**)

Section favors, in principle, amendment of 37 C.F.R. §1.56, to provide that the requirements of a duty to supply information material to patentability to the Patent and Trademark Office shall be deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office.

216 (Passed 1991 AR296-R651-3; **Retained 2002**)

Section favors in principle that small entities be restricted to more closely match those applicants with a significant need for reduced PTO fees.

216 (Passed 1992 AR121-R108-4; **Retained 2003**)

Section opposes, in principle, amendment of Title 35 to change the requirement of Section 112 that an application contain a written description sufficient to constitute an enabling disclosure.

216 (Passed 1993 AR123-R108-19; **Archived 2004**)

Section opposes in principle modification of the patent laws, including paragraph (a) of Section 102, Title 35, in such manner as to preclude ante-dating a prior art reference or references other than a previously filed application of another which claims the invention cited during prosecution of an application by filing an affidavit like that provided for in Rule 131 of the Rules of Practice or to preclude a patentee, during litigation, from ante-dating non-secret activities of others which occurred less than one year before the effective U.S. filing date of the patent.

216 (Passed 1993 AR126-R108-26; **Archived 2004**)

Section opposes in principle modification of the patent laws, including 35 U.S.C. §132, in such manner as to permit amendment of an application to add new matter to the disclosure even if the effective date for priority and/or prior art purposes becomes the date of filing such amendment.

216 (Passed 1993 AR355-R507-1; **Retained 2004**)

Section favors in principle an amendment to 37 C.F.R. §10.34(a) to affirmatively approve the use of the term "intellectual property law" or a substantially similar designation in conjunction with the word "patents" or a substantially similar designation by practitioners who are attorneys registered to practice before the U.S. Patent and Trademark Office.

216 (Passed 1997 AR70-R103-17; **Retained 2007**)

Section favors, in principle, the view that representing others before the Patent and Trademark Office in patent matters involves the practice of law and calls for the special training and expertise of the legal profession and, therefore, Specifically, the Section favors limiting future admission to the register of persons authorized to represent others in patent matters before the PTO, to members of the bar, with reasonable provisions being made for the recognition of both student practitioners and activities of non-lawyer assistants who are acting under the supervision of a registered practitioner.

216 (Approved by Council Conference Call 11/96; AR122-R103-16; **Readopted 2007**)

Section opposes, in principle, the imposition of a fee on practitioners for continued registration to practice before the Patent and Trademark Office, when there is no assurance that such fees will be used to further the operations of the PTO regarding the administration of the registration system.

216 (Passed 2003-R103-3)

Section opposes in principle the outsourcing of the search function by the USPTO to the extent that it embodies an organizational separation of the search function from the examining function, unless and until pilot studies demonstrate that efficiency and/or quality will be improved by outsourcing.

216 (Passed 2003-R103-5(a))

Section favors in principle that inter partes reexamination be further expanded and Specifically, the Section favors expanded participation by the third party petitioner in the review process, including right to attend and participate in Examiner interviews and hearings at the Board of Patent Appeals and Interferences.

216 (Passed 2003-R103-5(c))

Section favors in principle that inter partes reexamination be further expanded and Specifically, the Section favors the requirement that the Examiner who issued the patent be barred from participation in a reexamination proceeding.

216 (Passed 2003-R103-9)

Section favors in principle the adoption of a reasonable time limit for requesting express abandonment of a patent application in order to obtain a refund of the search fee, the examination fee, and/or any excess claim fees; and Specifically, the Section favors amending H.R. 1561, 108th Cong., 1st Sess. (2003) (Smith-Berman, “United States Patent and Trademark Office Fee Modernization Act of 2003”) to expressly require that any request for refund of such a fee occur prior to the date of publication of the application.

216 (Passed 2003-R103-10)

Section favors, in principle, additional searching when the original search is not conducted by an Office examiner; and Specifically, the Section favors the implementation of a required supplemental search conducted by the examiner after an indication of allowable subject matter, if the original search was performed by a non-USPTO entity.

216 (Passed 2003-R103-11)

Section favors, in principle, lower search fees for small entities; and Specifically, the Section favors an amendment to H.R. 1561, 108th Cong., 1st Sess. (2003) (Smith-Berman, “United States Patent and Trademark Office Fee Modernization Act of 2003”) to provide for lower search fees for small entities.

216 (Passed 2004-R103-16)

Section favors, in principle, the limited expansion of the use of second examiner review (aka “second pair of eyes”) of patent applications during prosecution in the USPTO, in certain art areas where there is a demonstrated need, as in interim step in the overall improvement of the quality of examination of patents in such areas, and Specifically, the Section of Intellectual Property Law favors use of second examiner review only in those art areas which are now, and where training of examining personnel has been, insufficient, for so long as necessary to ensure

adequate examination quality and no longer, as utilization of examining resources in such manner is inherently inefficient and not in keeping with the need to reduce pendency in an environment of limited resources.

216 (Passed 2005-R103-4)

Section 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, 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.

216 (Passed 5/2005-Patent Law Reform Task Force TF-4)

Section supports, in principle, substituting for the common law "inequitable conduct" defense a new statutory unenforceability defense relating to misconduct in the prosecution of a patent providing that a patent could be held unenforceable only when fraud resulted in issuance of an invalid patent claim, and Specifically, the Section favors legislation that to implement the foregoing principle, as part of a codification of the law relating to misconduct in the prosecution of a patent that could be pled in an action in which a party thereto is seeking a judgment of invalidity and/or non-infringement of a patent, through enactment of the following provisions:

- (a) a patent could be held unenforceable only when it is proven by clear and convincing evidence that:
 - (1) a fraud was involved in the prosecution of the patent; and
 - (2) the fraud resulted in the issuance of one or more patent claims invalidated in the action;
- (b) the common law defense of "unenforceability" would be eliminated through statutory provisions preempting any investigation of and/or determination in the courts of underlying issues of misconduct before the PTO, except that this preemption would not apply to:
 - (1) criminal matters,
 - (2) attorney malpractice claims,
 - (3) attorney disciplinary proceedings,
 - (4) the new statutory unenforceability defense based upon a fraud, and
 - (5) any determinations made by the United States Patent and Trademark Office relating to issues of misconduct; and
- (c) if a non-preempted investigation into possible misconduct resulted in a final determination of actual misconduct, the adjudicated determination of misconduct could be used as a basis for liability of the patent owner under competition and other laws, including antitrust causes of action.

216 (Passed 8/2005-Patent Law Reform Task Force TF-4B)

Section opposes, in principle, providing that a patent may only be held unenforceable for misconduct in the prosecution of a patent if the fraud is attributable to the patent owner; and Specifically, in the context of codification of the law relating to misconduct in the prosecution of a patent providing that a patent can be held unenforceable only when a fraud was involved in the prosecution of the patent, the Section opposes limiting unenforceability to instances where the fraud is attributable to the patent owner.

216 (Passed 8/2005-Patent Law Reform Task Force TF-5B)

Section supports, in principle, in the context of substituting for the common law “inequitable conduct” defense a statutory unenforceability defense based upon a fraud in obtaining one or more invalid patent claims, codifying the authority of the Patent and Trademark Office to enforce the duty of candor and good faith in practice before it; and Specifically, the Section favors legislation that would:

- (1) afford the Patent and Trademark Office the statutory authority to promulgate regulations imposing a duty of candor and good faith, such as that in 37 C.F.R. § 1.56 (2005), in any proceedings before the Office that involve an application for a patent or a patent; and
- (2) permit the Office to enforce the duty of candor and good faith by action against registered patent attorneys and/or agents using existing mechanisms under 35 U.S.C. § 32; and, if probable cause exists to believe that an individual subject to the duty of candor and good faith may have violated 18 U.S.C. § 1001(a), to refer the matter to the Attorney General for appropriate action.

216 (Passed 8/2005-Patent Law Reform Task Force TF-5C)

Section supports, in principle, enforcement by the Patent and Trademark Office (“the Office”) of the duty of candor and good faith in practice before the Office through disciplinary proceedings, but opposes legislation that would afford the Office the statutory authority to impose civil monetary penalties against patent owners as a sanction for breach of the duty of candor and good faith; and Specifically, the Section opposes legislation that would require the Office to investigate possible violations of the duty of candor and good faith referred to the Office by the courts, hold contested evidentiary proceedings involving the patent owner and any person who was the owner of the patent or application at the time the alleged breach of the duty occurred, determine whether an intentional breach of the duty of candor and good faith occurred, and authorize the Office, if it found misconduct, to impose civil monetary penalties against the parties.

216 (Passed 5/2005-Patent Law Reform Task Force TF-6)

Section supports, in principle, in the context of the best practices for implementing in a coordinated manner a first-inventor-to-file system, legislation removing the provisions in the patent statute requiring an assessment of “deceptive intent” on the part of the inventor or others in order to undertake certain remedial actions or to seek certain types of relief; and Specifically, the Section favors legislation that—

- (1) assures that in all circumstances the correct inventor and/or joint inventors can be named in a patent or application for patent by repealing the limitations in 35 U.S.C. § 116 and 35 U.S.C. § 256 that prohibit the correction of inventorship in some circumstances where deceptive intent is found to exist;
- (2) assures that patents can be issued and issued patents can be enforced where, through error, a timely foreign filing license has not been obtained by repealing the limitations in 35 U.S.C. § 184 and 35 U.S.C. § 185, that prohibit obtaining retroactive foreign filing license or enforcing a patent where deceptive intent is found to exist;
- (3) assures that a reissue application can be filed in any circumstance where the inventor deems a patent is wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patent claims more or less (if the reissue is sought within two years from the patent issue date) than the inventor had a right to claim in the patent by repealing the requirement in 35 U.S.C. § 251 that limits the right to file reissue applications to circumstances where the inventor can show error without deceptive intent; and
- (4) assures that an invalid claim in a patent does not by itself render any other claim in the patent invalid or prevent the enforcement of the valid claims in the patent by repealing

the requirements in 35 U.S.C. § 253 and 35 U.S.C. § 288 eliminating the right to enforce any remaining valid claims in circumstances where deceptive intent is found to exist.

216 (Passed 5/2005-Patent Law Reform Task Force TF-8)

Section favors, in principle, the availability of a window after a patent has issued to challenge the validity of claims in the patent; and Specifically, the Section favors, in the context of adoption of a first-inventor-to-file system, the adoption of an inter partes, post-grant review proceeding that will provide the public with an appropriate means for challenging the validity of claims in issued patents at a reasonable cost, while providing patentees with adequate safeguards against harassment, including provisions to:

1. permit the filing of an opposition by any person, upon a suitable threshold showing, within a limited period of time not greater than 1 year after the date of the patent grant;
2. provide that the determination by the PTO that the threshold requirement has not been satisfied is not appealable and shall not be admissible in any litigation over the validity of the patent;
3. permit as grounds for opposition a broader scope of invalidity issues than is available in re-examination proceedings, including invalidity for double patenting and any of the requirements for patentability set forth in Sections §§ 101, 102 (except 102(c), and (g)), 103, 112 (except for the best mode requirement), and 251, fourth paragraph;
4. provide that all evidence other than patents and printed publications be presented through affidavit or declaration, and that affiants and declarants be subject to cross-examination;
5. provide that, except in exceptional circumstances, the evidence on which the opposer relies shall be submitted with its request for opposition, and the evidence on which the patent owner relies shall be submitted with its response to the opposition;
6. require that the opposition proceeding be instituted by the PTO within a specified period of time, preferably three months, after the period for filing oppositions closes, unless the PTO has determined that the required threshold showing has not been made;
7. provide that the identity of the real party in interest filing an opposition request shall be disclosed to the PTO, but shall not be disclosed to the patentee unless the opposer relies on declaration or affidavit evidence or the opposer becomes a party to an appeal taken to the Court of Appeals for the Federal Circuit;
8. provide that the file of any opposition proceeding shall be made available to the public;
9. permit a limited opportunity for amendment of the patent claims during the opposition, subject to appropriate intervening rights, and not permitting broadening amendments;
10. provide completely inter partes proceedings, including the right of any party thereto to appeal an adverse decision to the Court of Appeals for the Federal Circuit;
11. limit discovery to cross-examination of affiants, unless otherwise required in the interest of justice;
12. provide that a panel of three Administrative Patent Law Judges shall hear and decide all such post-grant review proceedings;
13. place the burden of proof on the opposer to show invalidity by a preponderance of the evidence;
14. require that the proceeding be completed within a specified period of time, preferably twelve months, which may be extended to eighteen months in exceptional cases;
15. provide that the opposer shall be estopped to raise in any subsequent litigation or other proceeding, only those issues of fact or law actually decided, and necessary to the determination, unless there is substantial additional evidence that could not reasonably have been discovered or presented by the opposer;

16. provide appropriate limits on re-examination proceedings concurrent with the opposition proceeding, and on re-examination requests filed by the opposer subsequent to the opposition;
17. provide that if the patent owner files litigation alleging infringement of a patent within a limited period after the patent is granted, any opposition filed against that patent shall be stayed until the suit is concluded, if the patent owner so requests; and
18. such other provisions as will provide the public with an appropriate means for challenging the validity of claims in issued patents at a reasonable cost and provide patentees with adequate safeguards against harassment.

216 (Passed 5/2005-Patent Law Reform Task Force TF-9)

Section favors in principle expanding the right of the public to submit prior art in pending patent applications; and Specifically, the Section favors legislation to codify the right of the public to submit to the U.S. Patent and Trademark Office prior art relevant to a pending application for patent, provided that such submission is made within a reasonable time after publication of the application, or entry of an international application into the national stage, and before the application has been allowed, and provided that the submission is accompanied by an explanation of the asserted relevance of the submitted art.

216 (Passed 5/2005-Patent Law Reform Task Force TF-10)

Section supports, in principle, amendments to the inter partes re-examination procedure to expand use of that procedure, and

Specifically, the Section supports legislation that would implement the following changes to the existing inter partes re-examination:

1. Limit the estoppel attaching to a third part requester in an inter partes re-examination to any ground that the third-party requester raised during the inter partes re-examination proceedings.
2. Expand the availability of inter partes re-examination proceedings to any patent that issues from an original application filed on any date

216 (Passed 5/2005-Patent Law Reform Task Force TF-12A)

Section favors, in principle, curtailing the unlimited ability of an inventor to file continuing applications for patent under section 120, provided every inventor is accorded a full and fair opportunity to protect any invention disclosed in an application for patent; and

Specifically, the Section supports legislation that would authorize the United States Patent and Trademark Office to promulgate regulations to limit the right to file continuing applications for patent consistent with this principle.

216 (Passed 5/2005-Patent Law Reform Task Force TF-12B)

Section opposes, in principle, eliminating the ability to file a broadening continuation application after publication or issuance of narrower claims in an application from which priority is claimed; and Specifically, the Section opposes amending 35 U.S.C. to include “§ 123. Limitation on enlargement of claim,” as proposed in Section 8 of the Committee Print or any similar legislation, that would render a claim unpatentable if it is broader in scope than the broadest claim that was previously published under § 122(b), issued under § 131 in an application or patent that shares a claim of priority under § 119 or § 120, or is made in an application within 12 months after the earliest filing date for which priority is sought for the pending application.

216 (Passed by Council Conference Call 12/2006-TF-B2)

Section opposes, in principle, legislation providing that a patent may not be held unenforceable based on misconduct in the U.S. Patent and Trademark Office by the patentee's counsel, agent or privy, even if such misconduct occurred without the patentee's actual or constructive knowledge, the patentee exercised due care in selecting and supervising such counsel, agent or privy, and the patentee reasonably relied on its counsel, agent or privy in obtaining the patent; and Section opposes the amendments to 35 U.S.C. §282 contained in Section 5.c. of S.3818, 109th Congress, 2d Sess. (2006) (Hatch-Leahy), or similar legislation, that would preclude a court from finding a patent to be unenforceable under such circumstances."

216 (Passed by Council Conference Call 12/2006-TF-B3)

Section opposes, in principle, legislation regarding the law of inequitable conduct that would establish a statutory standard for materiality for inequitable conduct in the U.S. Patent and Trademark Office that is broader than an objective "but for" standard; and Section opposes the amendment to 35 U.S.C. §282 that would be implemented by S.3818, 109th Congress, 2d Sess. (2006) (Hatch-Leahy), or similar legislation, insofar as the proposed statutory language, "the court has not determined 1 or more claims in the patent at issue in the action to be invalid", does not require that such claim or claims should not have issued but for the inequitable conduct.

216 (Passed by Council Conference Call 12/2006-TF-B4)

Section opposes in principle a statutory provision that would require a finding of infringement as a precondition to a pleading of unenforceability of a patent based on inequitable conduct or a court's determination of unenforceability of a patent based on inequitable conduct; and Section opposes the amendments to 35 U.S.C. §282 contained in S.3818, 109th Congress, 2d Sess. (2006) (Hatch-Leahy), or similar legislation, that would preclude such pleading or determination prior to a finding of infringement.

216 (Passed by Council Conference Call 12/2006-108-1)

Section favors, in principle, a uniform patent examination process regardless of subject matter, without any legislative, judicial or administrative action that

- (i.) restricts the scope of patentable subject matter under 35 U.S.C. §101 and the United States Constitution, art. I § 8, cl. 8, whether by imposition of a general utility requirement, commercialization requirement, or otherwise;
- (ii.) discriminates in patentability or availability of patent rights by class of patent examination; or
- (iii.) discriminates in patentability or availability of patent rights on account of subject matter, place of invention, field of technology, or import/export status; and,

Section opposes the initiative of the United States Patent and Trademark Office to provide one or more alternative patent products having differing scopes, patentability requirement or examination procedures.

216 (Passed by Council 02/2007; Patent Law Reform Task Force TF-4F)

Section favors, in principle, that a final determination by the trial court of invalidity of at least one patent claim that the patent challenger has contended should not have issued but for inequitable conduct in the U.S. Patent and Trademark Office ("PTO") shall be a condition precedent to a court's consideration or determination of unenforceability of the patent based on inequitable conduct in the PTO;

FURTHER RESOLVED, that the Section of Intellectual Property Law favors, in principle, that, in the absence of the consent of the patentee, neither discovery related solely to the issues of the unenforceability of a patent based on inequitable conduct in the U.S. Patent and Trademark

Office (“PTO”) nor trial or decision thereof shall take place prior to the date that a final determination has been made that at least one patent claim that the challenger has contended to have been obtained by inequitable conduct is invalid and should not have issued but for the contended inequitable conduct in the PTO; and

NOW THEREFORE, the Section favors the amendments to 35 U.S.C. § 282 contained in § 5(c) of S.3818, 109th Cong., 2d Sess. (2006) (Hatch-Leahy), or similar legislation, to the extent that they would preclude a trial or determination of unenforceability of a patent based on inequitable conduct in the U.S. Patent and Trademark Office (“PTO”) prior to a finding or conclusion of invalidity of a patent claim that should not have issued but for the asserted inequitable conduct in the PTO, provided that such legislation provides that inequitable conduct may be pled, and tried and decided by the trial court prior to a finding or conclusion of invalidity upon consent of the patentee.

216 (Passed 7/2007-R103-1)

Section opposes in principle any changes to 37 C.F.R. §§ 11.6 and/or 11.7 regarding qualification to practice before the U.S. Patent and Trademark Office that do not respect requirements for reciprocal recognition of rights for U.S. citizens to be admitted to practice before the patent office of an applicant’s country of citizenship or residency, and

NOW THEREFORE, the Section opposes changes thereto that, without respecting requirements for such reciprocal recognition, would permit the registration and continued qualification to practice before the USPTO of any attorney who;

- (1) merely demonstrates the necessary scientific, technical, character and language qualifications, and
- (2) passes the USPTO examination for registration without regard to the citizenship, country of residence, or immigration status of such person.

216 (Passed by Council 2/2008; Patent Law Reform Task Force TF-08-01)

Section opposes, in principle, legislative proposals that would establish a reissue or other Patent and Trademark Office proceeding to remove from an issued patent the unenforceability effect of inequitable conduct that occurred during prosecution of the issued patent; and

NOW THEREFORE, the Section opposes amendment of S. 1145, 110th Cong., 1st Sess., the “Patent Reform Act of 2007,” to authorize such removal.

216 (Passed by Council Conference Call 3/2008; Patent Law Reform Task Force TF-08-02)

Section supports in principle legislative proposals that would implement the 2004 recommendation of the National Academies of Science to eliminate litigation abuses arising from the “inequitable conduct” defense to the enforceability of a patent through amendments of the patent laws providing:

- (1) upon a finding by a court that it is more likely than not that intentionally deceptive conduct before the United States Patent and Trademark Office that materially affected a determination made by the Director has taken place in connection with a patent or efforts to obtain it, the court shall enter a judgment that the patent is unenforceable unless the patent owner promptly seeks a reissue of the patent and provides to the Office the information relating to the conduct at issue;
- (2) a patent shall not otherwise be held invalid or unenforceable based upon misconduct before the United States Patent and Trademark Office;
- (3) if a reissue of the patent in question is sought, the Office must reexamine the patent with respect to any substantial new questions of patentability presented;

(4) unless all the claims of the patent are confirmed to be patentable in the reissue, the patent must be surrendered, subject to the right to reissue claims determined to be patentable; and

(5) other sanctions for misconduct before the Office under criminal or antitrust laws or the Office's rules are expressly preserved; and

NOW THEREFORE, the Section supports the Hatch amendment (GRA08297, March 14, 2008) to S. 1145, the "Patent Reform Act of 2007," to the extent it embodies such reforms.

216 (Passed by Council Conference Call 1/13/2009; Patent Law Reform Task Force ICWG-1) Section favors, in principle, that the defense of unenforceability of a patent based on inequitable conduct in the United States Patent and Trademark Office ("PTO") be predicated on principles of common law fraud; and

NOW THEREFORE, the Section favors that any judgment of such unenforceability be entered only upon proof, by clear and convincing evidence,

(1) that a person having a duty of candor and good faith to the PTO in connection with the patent or an application therefor knowingly and willfully misrepresented a material fact or material information to the PTO or omitted a known material fact or known material information from the PTO;

(2) that, in the absence of such misrepresentation or omission, the PTO, acting reasonably, would not have granted or maintained in force at least one invalid patent claim; and

(3) that the misrepresentation or omission occurred with a specific intent to deceive the PTO, and that such intent cannot be established by the mere materiality of the misrepresentation or omission.

216 (Passed by Council Conference Call 1/13/2009; Patent Law Reform Task Force ICWG-2) Section favors, in principle, that, in considering whether to hold a United States patent unenforceable based on an applicant's alleged inequitable conduct in the United States Patent and Trademark Office, courts not find information to be material if it would not have been material under statutory and regulatory standards applicable during the prosecution of the application(s) for the patent or its reexamination.

216 (Passed by Council Conference Call 1/13/2009; Patent Law Reform Task Force ICWG-3) Section favors, in principle, that proof of the defense of unenforceability of a patent based on inequitable conduct in the United States Patent and Trademark Office ("PTO") is required to include proof by clear and convincing evidence of a specific intent to deceive the PTO by knowingly and willfully misrepresenting a material fact or material information to the PTO or omitting a known material fact or known material information from the PTO, and that such intent cannot be established by the mere materiality of the information that was misrepresented or omitted.

216 (Passed by Council Conference Call 1/13/2009; Patent Law Reform Task Force ICWG-4) Section opposes, in principle, that a defense of unenforceability of a patent on grounds of inequitable conduct in the United States Patent and Trademark Office can be based on any such conduct that did not substantially affect the validity, scope, or duration of one or more claims of the patent.

216 (Passed by Council Conference Call 1/13/2009; Patent Law Reform Task Force ICWG-5) Section opposes, in principle, legislation eliminating the defense of unenforceability of a patent based on inequitable conduct in the United States Patent and Trademark Office ("PTO") in favor of proceedings in the PTO; and NOW THEREFORE, the Section rescinds its approval of Resolution TF-08-02 that was adopted by Council in March, 2008.

216 (Passed 2009 ABA 2009A107A)

Association opposes the elimination of the defense of unenforceability of a patent based upon inequitable conduct arising from proceedings in the United States Patent and Trademark Office, without diminishing the authority of the United States Patent and Trademark Office to control the conduct of its own proceedings.

216 (Passed ABA 2009A107B)

Association urges that any judicially-administered defense of unenforceability of a patent based upon inequitable conduct arising from proceedings in the United States Patent and Trademark Office ("PTO") be predicated on principles of common law fraud, and that any judgment of such unenforceability be entered only upon proof by clear and convincing evidence that:

- (1) a person having a duty of candor and good faith to the PTO in connection with the patent or an application therefor knowingly and willfully misrepresented a material fact or material information to the PTO or failed to provide a known material fact or known material information to the PTO;
- (2) in the absence of such misrepresentation or omission, the PTO, acting reasonably, would not have granted or maintained in force at least one invalid patent claim; and
- (3) the misrepresentation or omission occurred with a specific intent to deceive the PTO, and that such intent cannot be established by only the materiality of the misrepresentation or omission.

216 (Passed ABA2009A107C)

Association urges that, in considering whether to hold a United States patent unenforceable based upon an applicant's alleged inequitable conduct arising from proceedings in the United States Patent and Trademark Office, information not be found to be material if it would not have been material under statutory and regulatory standards applicable during the prosecution of the application(s) for the patent or its reexamination.

216 (Passed ABA2009A107D)

Association urges that the defense of unenforceability of a patent based upon inequitable conduct arising from proceedings in the United States Patent and Trademark Office ("PTO") can be established only by proof by clear and convincing evidence of a specific intent to deceive the PTO by knowingly and willfully misrepresenting a material fact or material information to the PTO or by failing to provide a known material fact or known material information to the PTO, and that such intent cannot be established by only the materiality of the fact or information that was misrepresented or not provided.

218 (Passed 1966 SP 51-ABA 1967-R5; **Retained 1997; Retained 2007**)

Section favors in principle permitting the owner of an invention, whether or not he be the inventor, to file a patent application covering that invention provided that the inventor or inventors be named in the application.

218 (Passed 1983 SP 51-R108-2; **Retained 1998; Retained 2008**)

Section reaffirms in principle, its approval of revision of the patent laws to provide for filing of a patent application in the name of the assignee of the invention covered by the application and Specifically, the Section favors inclusion of a provision to that effect, as promptly as possible, in appropriate legislation submitted to Congress for modifying or supplementing the patent laws.

218 (Passed 1995 AR94-R102-3; **Readopted 2006 as Amended**)

Section favors expanded examination of patent applications, and Specifically favors passage by Congress, in a timely fashion, of legislation providing for amendments to the reexamination system to allow ~~both greater third party participation, and~~ expansion of the grounds for interpartes reexamining a patent to include the requirements of 35 U.S.C. §112 (1st and 2nd paragraphs), excluding the best mode requirement.

218 (Passed 1995 AR94-R102-6; **Readopted 2006**)

Section favors, in principle, the use by WIPO, the European Patent Office and the U.S. PTO of computerized documentation in the filing and prosecution of PCT applications; and Specifically, the Section favors a computerized documentation system for on-line filing of PCT applications at WIPO, the European Patent Office and the U.S. PTO.

218 (Passed 1995 AR113-R103-16; **Readopted 2006**)

Section favors, in principle, a revision of the Patent and Trademark Office practices and procedures relating to the examination and processing of patent applications after a final rejection, to simplify and make more efficient such examination and processing so as not to unnecessarily delay examination under a system where the term of a patent normally expires 20 years from the earliest effective filing date in the United States.

218 (Passed by Council Conference Call 11/96; AR111-R103-3; **Readopted 2007**)

Section favors, in principle, the view that a primary goal of the examination process is to conclude, as diligently as is reasonably possible, the process of determining whether the applied-for invention is patentable, and Specifically, the Section favors the examination process being structured to encourage investigation of the merits of applications that are under final rejection and opposes further restriction to entry of after-final responses.

218 (Passed 5/2005-Patent Law Reform Task Force TF-15)

Section supports, in principle, revision of the patent laws to permit the owner of an invention, whether or not the owner is the inventor, to file a patent application covering that invention; and Specifically, the Section favors revision of the patent laws to provide that any person to whom an inventor has assigned or agreed, in writing, to assign an invention, may make application for patent on behalf of and as agent for the inventor, and provide further that the Commissioner may grant a patent to such person upon such notice to the inventor as the Commissioner deems sufficient.

218 (Passed by Council 5/2006 – 103-1)

Section opposes arbitrary limitations on number of claims to be examined in an application; and Specifically opposes the U.S. Patent and Trademark Office's proposed rules regarding "Changes to Practice for the Examination of Claims in Patent Applications," as published in the Federal Register at Fed. Reg. 71(1): 61-69 (January 3, 2006).

218 (Passed by Council 5/2006 – 103-3)

Section favors in principle the full examination of each claim in an application prior to grant; and, Specifically, opposes the U.S. Patent and Trademark Office's proposed rule 37 C.F.R. §1.104, as set forth in "Changes to Practice for the Examination of Claims in Patent Applications," as published in the Federal Register at Fed. Reg. 71(1): 61-69 (January 3, 2006), whereby only designated claims are examined and non-designated claims will never be fully examined for compliance with all statutory requirements.

218 (Passed by Council 5/2006 – 103-4)

Section opposes implementation of rules that could unfairly restrict the opportunity of inventors to protect inventions disclosed in an application for patent, and Specifically opposes the U.S. Patent and Trademark Office's proposed rules regarding "Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims," as published in the Federal Register at Fed. Reg. 71(1):48-61 (January 3, 2006).

218 (Passed 2006 – 103-5)

Section favors, in principle, the sharing of examination and search results among the Trilateral patent offices, with the goal of reducing the backlog of pending applications in each of the offices and providing more efficient patent prosecution procedures; and Specifically, supports further review by the U.S. Patent and Trademark Office of the Patent Prosecution Highway, the Tri-Way Proposal, and The New Route as potential mechanisms to reduce patent backlog in the patent offices and improve the quality of issued patents.

218 (Passed 2006 – 108-3)

Section supports, in principle, clarifying revisions to the Interim Guidelines for the Examination of Patent Applications for Patent Subject Matter Eligibility, published by the U.S. Patent and Trademark Office on October 26, 2005, and Specifically, supports recommending that the U.S. Patent and Trademark Office make the following revisions to the Interim Guidelines:

- (1) in Annex IV and Annex V the U.S. Patent and Trademark Office should provide examples of claims and claim formats that meet subject matter eligibility requirements;
- (2) the paragraph beginning on page 4 that suggests that a complete disclosure should contain an indication of the practical application for the claimed invention should be removed;
- (3) on the last full paragraph on 15, the Guidelines should be amended to indicate that the decision in *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377 (Fed. Cir. 2005) only prohibits claims that cover both an apparatus and method of using the apparatus and does not suggest that that all claims that have limitations belonging to more than one category identified in 35 U.S.C. § 101 are invalid;
- (4) the flow charts of Annex 1 of the Interim Guidelines should be amended to eliminate the need to "identify" the utility or practical application of the claimed invention, and to simplify the overall process flow to determine if the claimed subject matter meets the requirements of 35 U.S.C. § 101.

218 (Passed 2007-Patent Law Reform Task Force TF-07-05)

Section favors in principle the adoption of rules requiring increased participation by the applicant during prosecution of a patent application, but only under an acceptable legislative reform for determining unenforceability of a patent for misconduct before the USPTO; and NOW THEREFORE, the Section favors: (a) the reforms set forth in the Specter-Hatch amendment on inequitable conduct, which was offered in the Senate Judiciary Committee on

July 19, 2007, or similar legislation, and (b) only in the context of such legislative reform, the Section supports legislation that would mandate adoption of regulatory rules that (1) require applicants to submit information and analysis relevant to patentability, (2) indicate that an application shall be regarded as abandoned if the applicant fails to submit the required information and analysis in the manner and within the time period prescribed by the rules, and (3) exclude micro entities from the requirement that information and analysis relevant to patentability be submitted to the USPTO; provided that the legislation mandates that the regulatory rules be implemented in a manner that appropriately balances the increased cost to applicants against the benefits of a better quality of patent examination.

218 (Passed 2007-Patent Law Reform Task Force TF-07-06)

Section opposes in principle placing additional disclosure requirements on patent applicants in the absence of an acceptable legislative reform for determining unenforceability of a patent for misconduct before the USPTO; and

NOW THEREFORE, in the absence of acceptable legislative reform such as the reforms set forth in the Specter-Hatch amendment on inequitable conduct, which was offered in the Senate Judiciary Committee on July 19, 2007, the Section opposes section 123 of the Amendment in the Nature of a Substitute to H.R. 1908 Offered by Mr. Berman of California, Mr. Smith of Texas, Mr. Conyers of Michigan, and Mr. Coble of North Carolina on July 16, 2007, which provides that the Director of the Patent Office shall promulgate regulations requiring that applicants submit to the Patent Office a search report and other information and analysis relevant to patentability.

218 (Passed 2007-R108-2A)

Section opposes, in principle, any legislative or administrative action that encourages or implements a system of deferred examination of U.S. patent applications.

218 (Passed 9/2007-R103-1)

Section favors in principle modifications of the United States Patent and Trademark Office Rules of Practice, to the extent that such modifications improve patent quality and reduce pendency within the Board of Patent Appeals and Interferences and which outweigh the added time and effort required to practice under them, and that the Section opposes in principle modifications of those rules to the extent that such modifications provide benefits that are outweighed by the added time and effort required to practice under them, and

NOW THEREFORE, the Section generally supports the proposed changes to the Rules of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals as proposed by the United States Patent and Trademark Office and published in the Federal Register of July 30, 2007 (72 Fed. Reg. 145), but specifically opposes certain of these changes relating to (1) responses to rejections under 35 U.S.C. §103, and (2) showing support in the specification and drawings for each claim limitation, as set forth in the attached letter to be sent to the Commissioner of Patents, since the burdens imposed by such changes outweigh the benefits.

218 (Passed 9/2007-Patent Law Reform Task Force TF-07-01)

Section opposes, in principle, any requirement that a patent applicant submit a search report to the U.S. Patent & Trademark Office in every application, and

NOW THEREFORE, the Section opposes section 11 of the Amendment in the Nature of a Substitute to H.R. 1908, as adopted by the House Committee on the Judiciary on July 18, 2007, and section 11 of S.1145, as approved by the Senate Committee on the Judiciary on July 19, 2007, or similar legislation, to the extent that it would authorize the Director to adopt regulations

requiring that applicants submit a search report in every case and that an application shall be regarded as abandoned if the applicant fails to submit the required search report.

218a (Passed 1993 AR100-R103-2; **Retain 2004**)

Section favors in principle simplifying the procedures under 37 C.F.R. §1.56, as amended effective March 16, 1992, by providing for the filing and consideration by the Examiner of Information Disclosure Statements, with an appropriate fee, at any time after notice of allowance up until one week before the scheduled issue date, as an alternative to having to file a petition with certification or petition to withdraw or refile the application in order to submit such a Statement and have it considered by the Examiner.

218a (Passed 1993 AR325-R407-1; **Retain 2004**)

Section favors in principle the development of a database of software related prior art, and Specifically, the Section favors the development of a database of software related prior art as suggested by the Report of the Secretary of Commerce's Advisory Commission on Patent Law Reform dated August 1992, recommendation XI-H (vi).

218a (Passed 2000 AR385 -R757-1; **Retained 2010**)

Section opposes, in principle, to any implementation of Patent Office rules that place a burden on applicants to locate or identify specific types of prior art, other than the art already required by 37 CFR 1.56, prior to or during the examination of a patent application.

218a (Passed 2003-R103-2)

Section favors in principle the adoption of an organized procedure by the USPTO for automatically adding all non-U.S.- patent prior art citations in proper IDS submissions and examiner-considered third party prior art submissions to the USPTO search files, where such prior art is not already present in retrievable form in the search files.

218a (Passed 2004-R103-3)

Section opposes any addition to 37 C.F.R. §1.105, which would require applicants to provide the Patent Office with information in the form of responses to interrogatories or requests for stipulations.

218a (Passed 2004-R103-14)

Section opposes, in principle, that USPTO regulations regarding Information Disclosure Statements be amended to provide that the USPTO may require applicants to submit statements of relevance regarding prior art references

218a (Passed by Council 5/2005-R102-7)

Section 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 to include all categories of patented subject matter, and Specifically, 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.

218a (Passed by Council 1/2005-R108-1)

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, 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.

218a (Passed 5/2005-Patent Law Reform Task Force TF-13A)

Section favors in principle should the United States adopt a first-to-file system, the recognition of prior user rights for all technologies; and

Specifically, the Section favors prior user rights, provided that as a minimum:

1. such rights shall be in the nature of a personal defense against a claim based on any patent alleged to cover an activity of the prior user;
2. the prior user activity began prior to the earliest filing date to which the patent is entitled and, at the time of said earliest filing date such activity had not been abandoned;
3. the prior user activity was not based on information obtained or derived from the patentee or those in privity with the patentee;
4. the prior user activity took place within the United States;
5. prior to said earliest filing date the prior user had demonstrated operability of the invention covered by the patent and had taken significant steps toward its commercialization; and
6. such rights shall be available only to the party performing the activity on which the defense is based and to those in privity with such party; and shall be nonassignable and nontransferable except with a transfer of that part of the business of the party to which the activity pertains

218a (Passed 5/2005-Patent Law Reform Task Force TF-13B)

Section 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 to include all categories of patented 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.

218b (Passed 2004-R1003-1 / 1004-1)

Section approves, in principle, the TC1600 Restriction Practice Plan of the United States Patent and Trademark Office and urges the Office to adhere to the Guidelines for Restriction Practice for inventions relating to genetic sequences, protein sequences, and Markush groups of chemical structures as the policy for patent examinations as outlined in Chapter 800 of the Manual for Patent Examining Procedure and in the Office’s guidelines set forth in Examination of Patent Applications Containing Nucleotide Sequences, 1192 O.G. 68 (November 19, 1996).

218c (Passed by Council 11/2006-TF-A3)

Section opposes, in principle, limiting the definition of joint inventorship to joint invention by collaborations of persons working towards the same end; and, Section opposes the definition appearing in Section 3(a) of S. 3818, 109th Congress, 2d Sess. (2006) (Hatch-Leahy), or similar legislation, that might limit or qualify the existing provisions of 35 U.S.C. §116, first paragraph, that now state that inventors may apply for a patent jointly even though (1) they did not

physically work together or at the same time, (2) each did not make the same type or amount of contribution, or(3) each did not make a contribution to the subject matter of every claim of the patent.

218d (Passed 1991 AR94-R108-7; **Retained 2002**)

Section favors, in principle, the issuance of a long pending continuation application or chain of continuing applications as promptly as possible following issuance of a patent on an earlier filed parent application; and Specifically, the Section favors review of each such long pending application by the Commissioner of Patents after expiration of a specified time following its effective filing date and expedition of its prosecution by adoption of procedures, such as prompt examinations and shortened periods for response, to promote issuance of the patent or patents as promptly as possible.

218d (Passed 1992 AR68-R102-1; **Retained 2003**)

Section favors in principle granting to an applicant for a U.S. utility patent the benefits of the Paris Convention for the Protection of Industrial Property based upon a prior application of that applicant filed in the United States.

218d (Passed by Council 11/2006-TF-A4)

Section opposes, in principle, treating the filing of a Paris Convention priority application any differently than the filing of a U.S. provisional application for patent when determining the effective filing date of a patent or a published application for patent as prior art under sections 102 and 103 of title 35, United States Code; and, Section opposes the introduction of any such discriminatory treatment in legislation creating a first-inventor-to-file system.

218e (Passed by Council 1/95 AR65-R103-7; **Readopted 2006 as Amended**)

Section favors, in principle, making the entirety of the prosecution history readily accessible to the public any time subsequent to the 18 month publication of patent applications, ~~particularly in view of the provisional rights which accrue upon publication of a patent application and the dissemination purpose of 18-month publication.~~

220 (Passed 1991 AR210-R401-4; **Retained 2002**)

Section favors in principle amending 35 U.S.C. §291 to specify that patent-patent interference disputes can be resolved either by civil action in federal court or by administrative action in the Patent and Trademark Office, and that when resolving disputes by administrative action in the Patent and Trademark Office through the filing of a reissue application, the owner of the interfering patent must comply with all the requirements of 35 U.S.C. §251, except that it need not allege that any claim in its patent is either wholly or partially inoperative or invalid.

220 (Passed 1994 AR103-R108-9; **Readopted 2006**)

Section opposes, in principle, changing United States patent law to impose any statutory time limit, following the effective or U.S. filing date of the application of a senior-party applicant, within which a junior-party applicant must have filed an application on an invention in order to contest priority of the invention with respect to the senior-party applicant.

220 (Passed 1995 AR165-R152-1; **Readopted 2006**)

Section of favors, in principle, speeding up the time for disposing of interferences in the Patent and Trademark Office, and in particular favors a summary judgment procedure for promptly considering dispositive unpatentability and no-interference-in-fact motions provided that on the record there is no genuine issue of material fact.

220 (Passed 2004-103-4)

Section opposes an absolute requirement of a “two-way test” to determine whether an interference can proceed; and

Specifically, the Section opposes proposed rule §41.203 Declaration, as set forth in Notice of Proposed Rulemaking Rules of Practice Before the Board of Patent Appeals and Interferences, 68 Fed. Reg. 66648 (November 26, 2003), which defines interfering subject matter using a “two-way test.”

220 (Passed by Council 6/2008-R104-1)

Section supports in principle expedited consideration of patent applications where a request for interference is filed; and

NOW THEREFORE, the Section supports reinstatement of the practice of permitting the filing of a Petition to Make Special on the basis that an interference is being requested.

222 (Passed 1992 AR420-RAH-1; **Retained 2003**)

Section favors, in principle, a "Mixed Approach" system providing that recordal of security interests in intellectual property governed by federal law in the relevant federal agency establishes priority with respect to bona fide purchasers for value, and providing that recordal of security interests in all intellectual property in the relevant state agency under Article 9 of the Uniform Commercial Code establishes priority as against all other persons; and Specifically, the Section favors amendment of the patent, trademark, copyright and mask work laws and rules to provide that recordal of security interests in the respective federal agencies with respect to registered and unregistered copyrights, registered and unregistered mask works, patents and applications for patents, and trademarks which are the subject of federal registrations or applications for federal registration establish priority with respect to subsequent bona fide purchasers for value, and to provide that recordal of security interests in such intellectual property under relevant state law under Article 9 of the Uniform Commercial Code establishes priority as against all other persons.

222 (Passed 1992 AR421-RAH-2; **Retained 2003**)

Section favors, in principle, the same form of notice filing in the federal agencies with respect to security interests as in state agencies under the Uniform Commercial Code; and Specifically, the Section favors amendment of the patent, trademark, copyright and mask work laws and rules to permit recordal in the respective federal agencies of notices of security interests with respect to debtors, without requiring specific identification of the properties securing the debt and without requiring recordal of the security interest agreement itself, in substantially the same form of notice filing as is currently employed under the Uniform Commercial Code.

222 (Passed 1992 AR422-RAH-3; **Retained 2003**)

Section favors, in principle, permitting the notice filing of security interests to apply to "after-acquired" intellectual property of debtors; and Specifically, the Section favors amendment of the patent, trademark, copyright and mask work laws and rules to permit recordal in the respective federal agencies of notices of security interests which shall be effective with respect to debtors' "after-acquired property."

222 (Passed 1992 AR422-RAH-4; **Retained 2003**)

Section favors, in principle, the prompt recordal by the Copyright Office of documents relating to title, license and security interests in copyrights and mask works.

222 (Passed 1992 AR422-RAH-5; **Retained 2003**)

Section favors, in principle, making the federal agency records concerning title to and security interests in intellectual property more useful by substantially reducing the grace periods for recordal of documents; and Specifically, the Section favors amendment of the patent, trademark, copyright and mask work laws and rules to establish grace periods of no more than ten days for recordal of documents concerning title to and security interests in intellectual property.

224 (Passed 1993 AR122-R108-16; **Retain 2004 – As Amended on May 11, 2004**)

~~If the U.S. changes the current patent laws, including 35 U.S.C. §122, to require publication of pending applications a fixed time after filing, the Section favors in principle, for published U.S. patent applications,~~ making available to the public an abandoned parent application upon expiration of said time whenever said application has been replaced by a continuation, substitute, continuation-in-part or divisional application.

224 (Passed 1994 AR108-R108-17; **Readopted 2006**)

Section favors, in principle, that Section 122, Title 35, United States Code, be amended to provide that in any case in which an applicant requests that his or her application for patent be opened to public inspection, the application shall be open to public inspection promptly within a time certain after the date of the applicant's request.

224 (Passed 1995 AR94-R102-2; **Readopted 2006**)

Section favors early publication of patent applications, and specifically, favors passage by Congress, in a timely fashion, of legislation providing for early publication of U.S. patent applications with provisional rights.

224 (Passed by Council 1/95 AR66-R103-12; **Readopted 2006**)

Section favors, in principle, that the Patent and Trademark Office, under an 18 month or other pre-grant publication requirement, preclude, where appropriate, or limit access, generally in accord with current European Patent Office practice, to biological deposits made in conjunction with the filing of a patent application between the date of pre-grant publication of a patent application and the date of grant of a patent.

224 (Passed 2004-R108-8)

Section favors, in principle, the publication of all patent applications within 18-months of filing as an appropriate balance between the interests of the applicant and the public; and; Specifically, the Section supports the elimination of special exceptions to and redactions from published U.S. patent applications as permitted under the American Inventors Protection Act and repeal of 35 U.S.C. §122(b)(2)(B)(i)-(v).

224 (Passed 2005-Patent Law Reform Task Force TF-7)

Section favors, in principle, the publication of all patent applications within 18-months of filing as appropriate balance between the interests of the applicant and the public; and; Specifically, the Section supports the elimination of special exceptions to and redactions from published U.S. patent applications as permitted under the American Inventors Protection Act and repeal of 35 U.S.C. § 122(b)(2)(B)(i)-(v).

230 (Passed 1988 SP 67-R101-3; **Retained 1999; Retained 2009**)

Section opposes in principle legislation prohibiting the United States Patent and Trademark Office from expending funds for the purposes of granting patents on genetically altered or modified animals.

230 (Passed 1989 SP71-RNB4; ABA 1990 in amended form; **Retained 2001**)

Section opposes in principle any significant weakening of the intellectual property rights enforcement measures currently provided by Sections 337 and 337(a) of the Tariff Act of 1930 (as amended) (19 U.S.C. Section 1337).

230 (Passed 1991 AR58-R102-1; **Retained 2002**)

Section favors in principle an amendment of the United States Patent Laws to provide that except in cases of derivation, the first-to-file a patent application among rival applicants for the same invention is the applicant entitled to a patent if, but only if, the foregoing be part of a patent harmonization treaty wherein other countries agree to changes in their systems sufficiently beneficial to United States applicants and their assignees.

230 (Passed 1991 AR58-R102-2; **Retained 2002**)

Section favors in principle: (a) an international grace period of 12 months from first publication; (b) broad subject matter availability for patent protection; (c) simplified filing and prompt disposition of patent applications; (d) a reasonable scope and term of patents; (e) a broad definition of rights conferred by patents and patent applicants; and (f) reasonable compensation for violation of those rights.

230 (Passed 1991 AR58-R102-5; **Retained 2002**)

Section opposes in principle, in any patent harmonization treaty involving the United States, any requirement for a change in United States patent law that would restrict the scope of patentable subject matter available under 35 U.S.C. §101.

230 (Passed 1991 AR58-R102-6; **Retained 2002**)

Section opposes in principle, in any patent harmonization treaty involving the United States, any requirement for a change in United States patent law that would discontinue the experimental use exception to 35 U.S.C. §102(b).

230 (Passed 1991 AR58-R102-7; **Retained 2002**)

Section opposes in principle, in any patent harmonization treaty involving the United States, any requirement for a change in United States patent law that would eliminate the patent defeating effect of non-public commercial activities prior to the grace period.

230 (Passed 1991 AR59-R102-8; **Retained 2002**)

Section opposes in principle, in any patent harmonization treaty involving the United States, any requirement for a change in United States patent law that would change 35 U.S.C. §102 to require consideration of non-patented and non-published foreign disclosures as prior art.

230 (Passed by Council Conference Call 1/05-R102-2)

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).

230 (Passed 2004 – 2005 Patent Law Reform Task Force TF-1; ABA 05M102)

Association supports enactment of legislation providing that the right to a patent shall belong to the inventor who first files an application for patent containing an adequate disclosure under 35 U.S.C. § 112 of the invention or, in the event of an assignment of rights, shall belong to the assignee thereof; FURTHER RESOLVED, that the ABA supports concomitant efforts to conclude international patent harmonization agreements that incorporate such principles.

230 (Passed 5/2005 – 2005 Patent Law Reform Task Force TF-2)

Section supports, in principle, in enacting first-inventor-to-file reforms, an objectively based definition of prior art and conditions for patentability, including provisions that continue to afford inventors a 1-year grace period in which to file an application for patent and that prevent certain prior-filed patent applications by the same or related persons from being used as patent-defeating prior art; and

Specifically, the Section favors legislation in this context that would—

(a) eliminate from U.S. patent law provisions relating to—

(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, United States Code, 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
- (b) provide a definition of prior art, to be used for both novelty and non-obviousness determinations, stating that a patent for a claimed invention may not be obtained if—
- (1) the claimed invention was patented, described in a printed publication, or otherwise publicly known—
 - (A) more than one year before the effective filing date of the claimed invention or
 - (B) before the effective filing date of the claimed invention other than through disclosures made by the inventor or a joint inventor or by others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor, or
 - (2) the claimed invention was described in an issued patent or in an application for patent published as provided in 35 U.S.C. § 122 or 35 U.S.C. § 374, in which the application or the patent names another inventor and was effectively filed before the effective filing date of the claimed invention; and
- (c) with respect to determining novelty and non-obviousness with respect to the prior art that state that—
- (1) subject matter that would otherwise qualify as prior art only because of the filing of a published patent application or patent shall not be prior art to a claimed invention if 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 that would otherwise qualify as prior art only because of the filing of a published patent application or patent shall not be prior art for purposes of determining non-obviousness of a claimed invention if—
 - (A) such claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the effective filing date of the claimed invention;
 - (B) such subject matter was developed and such claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

- (C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement; and
- (3) subject matter would be regarded as publicly known for the purposes qualifying as prior art 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
- (d) 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, provide that 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.

230 (Passed 9/2007-Patent Law Reform Task Force TF-07-02)

Section opposes, in principle, amendments to the United States patent laws that would substantially diminish incentives for innovation, investment in research and development, and full and timely disclosure of new inventions to the public; that would add unnecessarily to the complexity and expense of securing patent protection; or that would add complexity, expense, and uncertainty to patent litigation; and

NOW THEREFORE, the Section opposes enactment of either H.R. 1908, 110th Cong., 1st Sess. (2007), as passed by the House of Representatives on September 7, 2007, or S. 1145, 110th Cong., 1st Sess. (2007), as reported by the Senate Committee on the Judiciary on July 19, 2007.

232 (Passed 1993 AR375-R701-1; **Retain 2004**)

Section favors in principle relying on the statutory provisions and legislative history of 35 U.S.C. §101 in determining whether computer-related technology constitutes subject matter that is potentially eligible for patent protection; and Specifically, the Section opposes the use of special rules or tests not grounded in the statute with respect to questions of subject-matter patentability.

232 (Passed 1994 AR440-R1002-1; Approved by ABA BoG June 2001; **Retained 2009**)

Section favors in principle the patentability of (1) plants and seeds and (2) essentially biological processes for the production of the same plants or seeds under 35 U.S.C. §101 notwithstanding the protection of plants provided under the Plant Variety Protection Act of 1930 (7 U.S.C. §2321 *et seq.*).

232 (Passed 1995 AR78-R101-8; **Readopted 2006**)

Section opposes, in principle, excluding surgical and other medical procedures from the technologies that can be patented, and Specifically the Section opposes H.R. 1127, 104th Cong., 1st Sess., (Ganske-Wyden) (1995), entitled the "Medical Procedures Innovation and Affordability Act," and other acts of similar effect that may be proposed.

232 (Passed 2001 AR926-R757-1)

Section opposes, in principle, to any legislative, judicial, or administrative action that would result in discriminatory treatment of patent applications based on the field of invention, including different requirements for patentability, different criteria for publication, different opportunities

for third parties to challenge patentability, or different requirements to disclose the extent to which the applicant searched for prior art for business method-related inventions.

232 (Passed 2001 AR927-R757-2)

Section opposes, in principle, to any legislative, judicial, or administrative action that would result in discriminatory availability of patent rights based on the field of invention, including different presumptions of validity, different requirements for validity or different requirements for enforceability for business method-related inventions.

232 (Passed 2001 AR969-R757-3)

Section opposes, in principle, to any amendment or interpretation of title 35 of the United States Code that imposes different quality-related requirements based on the field of invention.

232 (Passed 2001 AR969-R1003-1)

Section opposes, in principle, the adoption of any patent law interpretation that allows a genetically engineered human being to be owned.

232 (Passed by Council 7/2007-R108-1)

Section reaffirms its opposition, in principle, to any legislative, judicial, or administrative action that would result in discriminatory availability of patent rights based on the field of invention; NOW THEREFORE, the Section opposes the enactment of (1) section 303 of S. 681, 110th Cong., (Levin/Coleman/Obama), the "Stop Tax Haven Abuse Act", and (2) H.R. 2365, 110th Congress, (Boucher/Goodlatte/Chabot).

232 (Passed by Council 8/7/08-R101-1)

Section opposes in principle the enactment of legislation that would create a subject matter specific bar to the patenting of DNA, polynucleotides or genetic-based inventions; and NOW THEREFORE, the Section opposes enactment of H.R. 977, 110th Congress, the "Genomic Research and Accessibility Act," and similar legislation.

234 (Passed 1988 SP 67-R101-2; **Retained 1999; Retained 2009**)

Section approves in principle the announcement by the United States Patent and Trademark Office that it would henceforth consider non-naturally occurring non-human multicellular organisms, including animals, to be patentable subject matter under 35 U.S.C. 101; and Specifically, the Section approves of Commissioner Quigg's announcement, "Animals-Patentability", 1077 Official Gazette 24 (April 21, 1987).

234 (Passed 1989 SP43-R110-1A; **Retained 2000**)

Section opposes in principle any Congressional legislation that would prohibit utility patents on non-human life forms higher than microorganisms and plants or that would place a moratorium on the granting of such patents by the Patent and Trademark Office.

234 (Passed 1990 SP91-R1003-2; **Retained 2001**)

Section opposes in principle legislation that would place a moratorium on the granting of utility patents on animals by the Patent and Trademark Office; and Specifically, the Section opposes enactment of H.R. 3247 (Cardin) 101st Cong., 1st Sess. (1989) and S. 2169 (Hatfield) 101st Cong, 2d Sess. (1990).

234 (Passed 1992 AR64-R101-3; **Retained 2003**)

Section opposes in principle any legislation that would place a moratorium on the granting of utility patents on invertebrate or vertebrate animals by the Patent and Trademark Office; and Specifically, opposes enactment of S. 1291, 102d Cong., 1st Sess. (1991) (Hatfield) or similar legislation.

234 (Passed 1992 AR124-R108-9; **Retained 2003**)

Section opposes, in principle, elimination of the best mode requirement of 35 U.S.C. §112.

234 (Passed 1993 AR399-R701-2; **Retained 2004**)

Section favors in principle advancement by the United States Government in international fora of the principle that a new, useful and non-obvious computer program-related invention shall be given no less protection under foreign patent law than any other invention under the same law; and Specifically, the Section favors that the United States Government oppose any foreign law or any revision in an international treaty (1) that would have the effect of declaring an invention to be, per se, unpatentable, if it is, or may be, implemented by programming a computer; or (2) that would grant immunity from liability for infringement to a person who makes or uses a patented invention during the term of the patent by programming a computer.

234 (Passed 2000 AR395 -R701-2/757-6)

Section is opposed, in principle, to any amendment or interpretation of section 101 of title 35 of the United States Code that excludes business methods from the class of statutory subject matter.

234 (Passed 2002 AR849-R1003-1)

Section opposes, in principle, the adoption of any patent law interpretation that would extend enforcement of rights under a patent covering a genetic engineering invention in such a way as to affect any person's control of his or her own body because it includes or incorporates such an invention or to limit the civil or human rights of any person in whom such invention is incorporated.

234 (Passed 2004-R102-6)

Section favors, in principle, patent protection in the European Union for computer-implemented inventions on the same basis as other inventions, in order to implement the basic intellectual property interests of inventors, competitors and the public, and Specifically, the Section disapproves the restrictive September 2003 amendments adopted by the European Parliament in Articles 2 through 5 and 6(a) of the European Union proposed Directive on The Patentability of Computer-Implemented Inventions, and urges the European Commission and Council to reject such amendments.

234 (Passed 2004-RSC-1; ABA 04M104)

ABA supports the role of U.S. patent law in encouraging and rewarding scientific and technical research and innovation; and Further resolved that the Association opposes any restriction or limitation on the use of funds otherwise lawfully appropriated by Congress if that restriction or limitation has or may have the effect of imposing any subject matter limitation on the patents which the Patent and Trademark Office may issue, in addition to the statutory limitations on the scope of patentable subject matter set forth in 35 U.S.C. § 101.

234 (Passed 2004-RSC-2)

Section opposes in principle any restriction or limitation on the scope of patentable subject matter imposed for the purpose of discouraging or prohibiting any activity that may be regarded as objectionable – because a patent (a) merely gives the patent owner the right to exclude others

from practicing the patented invention, see 35 U.S.C. § 154(a)(1), and (b) does not give the patent owner (or anyone else) any right to practice the patented invention; and Specifically, the Section opposes the enactment of section 634 of Division B of the Conference Report on H.R. 2673, Consolidated Appropriations Act, 2004 (the "Weldon Amendment") or any similar legislation.

234 (Passed by Council 3/2005-409-1)

Section 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, 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.

234 (Passed by Council 3/2005-409-2)

Section 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, 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.

234 (Passed 2005-Patent Law Reform Task Force TF-3)

Section supports, in principle, in the context of enacting first-inventor-to-file reforms, elimination of the requirement to disclose the "best mode" of the claimed invention; and Specifically, the Section favors, in that context, legislation to eliminate the requirement to disclose the "best mode" as set forth in 35 U.S.C. § 112, first paragraph.

234 (Passed 2006 – 160-2)

Section supports, in principle, that an invention claimed as a new and useful process is not patent ineligible subject matter solely because it is based upon one or more scientific principles or natural phenomena.

234 (Passed by Council 2/2008; Patent Law Reform Task Force BMP-08-03)

Section favors that the full scope of protection for which a patent is sought must be non-obvious, but with non-obviousness assessed only with reference to the subject matter as a whole of the claim made to the invention;

NOW THEREFORE, the Section favors repudiation of the holding in *In re Comiskey*, App. No. 2006-1286 (Fed. Cir. 2007), if and to the extent that, it holds that a process that would represent a patent-ineligible mental process unless claimed in combination with the use of a machine may be analyzed for non-obviousness without considering the subject matter as a whole of the claim, including specific limitations of the claim that, in the absence of the use made of the machine, would be patent-ineligible subject matter.

234 (Passed by Council Conference Call 6/2009-Patent Law Reform Task Force BMP-1)
Section supports, in principle, application of the common-law tradition of incremental development of jurisprudential doctrine in determining patent eligibility under 35 U.S.C. § 101 and

And, Section favors formulations by courts of tests to define patent-eligible subject matter under 35 U.S.C. § 101 in a manner that avoids articulation of fixed and specific requirements that adversely affect yet-to-be conceived but deserving inventions in emerging or unknown technologies;

NOW THEREFORE, the Section believes that the prudent and proper approach for determining patent eligibility under 35 U.S.C. § 101 is for courts to incrementally determine, over time, what should *not* be patent-eligible subject matter, rather than attempting to affirmatively delineate the scope of patent-eligible subject matter, thereby risking the exclusion of whole classes of inventions, including prospective exclusion of deserving but yet-to-be discovered technology.

234 (Passed by Council Conference Call 6/2009-Patent Law Reform Task Force BMP-2)

Section opposes, in principle, that a process must be explicitly tied to a particular machine or apparatus, or transform a particular article into a different state or thing (*i.e.*, the "machine-or-transformation" test), in order to be eligible for patenting under 35 U.S.C. § 101, but favors, in principle, an evenly applied and more generalized subject-matter bar on claims that would preempt the use of an abstract idea, thereby better effectuating the broad statutory grant of patent eligibility under 35 U.S.C. § 101 and the Supreme Court's precedent declining to limit that grant, while ensuring the unfettered use of abstract ideas.

234 (Passed by Council Conference Call 6/2009-Patent Law Reform Task Force BMP-3)

Section supports, in principle, that phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work;

NOW THEREFORE, the Section supports the exclusion from patent eligibility under 35 U.S.C. § 101 of process claims in which the exercise of human intellect or judgment is central, rather than incidental or ancillary, to achieving the result of the claimed process.

234 (Passed ABA2009A302)

Association supports the existing principle that laws of nature, physical phenomena, and abstract ideas are not patentable, even if they are new and non-obvious.

and, Association supports application by the Supreme Court of the United States of the common-law tradition of incremental development of jurisprudential doctrine for determining patent-eligible subject matter under 35 U.S.C. § 101;

and, Association opposes formulations by courts of tests to determine patent-eligible subject matter under 35 U.S.C. § 101 in a manner that articulates fixed and specific requirements that adversely affect yet-to-be conceived but deserving inventions in emerging or unknown technologies;

and, Association opposes a requirement that a process be explicitly tied to a particular machine or apparatus, or transform a particular article into a different state or thing (*i.e.*, the "machine-or-transformation" test), in order to be eligible for patenting under 35 U.S.C. § 101, but favors, in principle, an evenly applied and more generalized subject-matter bar on claims that would preempt the use of an abstract idea, thereby better effectuating the broad statutory grant of patent eligibility under 35 U.S.C. § 101 and Supreme Court precedent declining to limit that grant, while ensuring the unfettered use of abstract ideas.

235 (Passed 1986 SP 80-R401-3; **Retained 1999; Retained 2009**)

Section approves in principle the proposition that obviousness vel non under 35 U.S.C. Section 103 is a question of law (albeit based upon factual inquiries).

235 (Passed 1992 AR125-R108-10A; **Retained 2003**)

Section favors, in principle, permitting a named inventor of a reference patent to prove, as prior art for obviousness purposes under 35 U.S.C. 102(g), invention dates for unclaimed subject matter in his or her patent specification, to the same extent as a 35 U.S.C. 102(g) prior inventor who has not filed a patent application.

235 (Passed 1993 AR128-R108-32; **Retained 2004**)

Section favors in principle amending 35 U.S.C §102(e) to permit a U.S. patent to be effective as a reference as of its earlier foreign filing date provided priority is claimed under 35 U.S.C. §119.

235 (Passed 1994 AR448-R-TF-1; **Readopted 2006**)

Section favors in principle maintaining the obviousness standard as set forth in 35 U.S.C. §103 and, furthermore, opposes in principle any legislative modification of the obviousness standard of 35 U.S.C. §103.

235 (Passed 1994 AR448-R-TF-2; **Readopted 2006**)

Section favors, in principle, relying on case law precedent for interpreting the obviousness standard of 35 U.S.C. §103, and, furthermore, opposes in principle, any legislative modification of any judicial interpretation of the obviousness standard of 35 U.S.C. §103.

235 (Passed 1994 AR448-R-TF-3; **Readopted 2006**)

Section opposes, in principle, raising the nonobviousness standard because, there is not substantial evidence that such a change would promote industrial and technological progress in the United States and, thereby, improve and strengthen the domestic economy.

235 (Passed 1994 AR448-R-TF-4; **Readopted 2006**)

Section opposes, in principle, raising the nonobviousness standard because, on the basis of information and belief, such a change would adversely impact the ability of the United States industry to compete in the International market.

235 (Passed 1994 AR448-R-TF-5; **Readopted 2006**)

Section favors, in principle, maintaining a "teaching", "reason," "suggestion," or "motivation" inquiry with respect to combining elements or features in the prior art in determining obviousness of an invention under 35 U.S.C. §103.

235 (Passed 1994 AR448-R-TF-6; **Readopted 2006**)

Section opposes, in principle, any action by the Patent and Trademark Office to set or apply standards of obviousness or nonobviousness, by rule making or otherwise, which are inconsistent with the case law.

235 (Passed 1994 AR448-R-TF-7; **Readopted 2006**)

Section favors, in principle, that the obviousness standard, as presently set forth in 35 U.S.C. §103 and as may be interpreted by the courts, continue to be applied to all areas of technology, and, furthermore, opposes the establishment of different standards of obviousness in different areas of technology.

235 (Passed 1994 AR448-R-TF-8; **Readopted 2006**)

Section opposes, in principle, any legislative modification of the *de novo* standard of review of obviousness decisions by the Patent and Trademark Office on Appeal to the Court of Appeals for the Federal Circuit.

235 (Passed 1994 AR449-R-TF-9; **Readopted 2006 as Amended**)

Section favors, in principle, an increase in the uniformity and consistency with which patent applications are examined and with which the standard of obviousness in 35 U.S.C. §103 is applied by different patent examiners, and Specifically, the Section reconfirms its support for ~~the program to~~ expanding the automated search capabilities of the Patent and Trademark Office, and further supports expanding and updating, consistent with case law precedent, the existing guidelines on the application of §103 in the Manual of Patent Examining Procedure, increasing the training of patent examiners on the application of §103 in accordance with the case law, and reviewing on a continuing basis and adjusting, as necessary, the administrative procedures and goals under which patent examiners conduct the examination of patent applications.

235 (Passed 1994 AR449-R-TF-10; **Readopted 2006**)

Section opposes, in principle, any legislative modification of the burden of proof for examiners to establish a *prima facie* case of obviousness and the burden of going forward on applicants for rebutting a *prima facie* case of obviousness.

235 (Passed 1997 AR32-R101-5; **Retained 2007**)

Section favors, in principle, amendment of 35 U.S.C. § 103 to eliminate provisions providing for special treatment with respect to the non-obviousness of patents claiming “biotechnological processes,” and, Specifically, the Section supports the repeal of P.L. 104-41, enacted November 1, 1995.

235 (Passed 2002 AR110-R101-12)

Section opposes any attempt to change the definition of prior art under Section 103 based on the existence of "collaborations" when there is no obligation to assign.

235 (Passed 2004-R101-4)

Section favors, in principle, legislation that would make 35 U.S.C. 103(c) applicable to inventions made within the scope of a joint research agreement involving two or more entities if the claimed invention and subject matter that would be exempted by §103 (c) (as it would be amended) was developed by or for a party to the joint research agreement and if such inventions and subject matter are not subject to a requirement of common ownership or an obligation of common assignment, provided that:

- (i) the identity of the parties to the joint research agreement claiming the benefit of the provision are disclosed in the patent application or are similarly disclosed to the public;
- (ii) the claimed invention and the exempted subject matter were made by or on behalf of the parties to the joint research agreement during the period of and within the scope of the joint research agreement; and
- (iii) if two patents result from application of the amended standard, the patents can be enforced only to the same degree and in the same manner and for the same term.

235 (Passed 2004-R103-13)

Section opposes, in principle, the standard that, for a determination of non-patentability under 35 U.S.C. §103, a combination of references is proper if consistent with the creativity and problem-

solving skills characteristic of those having ordinary skill in the art; and Specifically, the Section favors that Federal Circuit precedent be followed and that a showing must be made of why the references would have been combined by a person skilled in the art based upon the teachings of the pertinent references or the knowledge of one of ordinary skill in the art, as supported by evidence, without the use of improper hindsight.

235 (Passed 2004-R601-1)

Section opposes, in principle, change to the legal standards by which the courts currently evaluate commercial success evidence as an objective indicia of non-obviousness; and Specifically, the Section considers that (1) the current case law does require that commercial success be evaluated on a case-by-case basis to determine whether commercial success is a valid indicator that the claimed invention is not obvious; (2) the current case law does place the burden on the patent holder to prove that the claimed invention caused the commercial success; and (3) thus, Recommendation No 3(a) of the Federal Trade Commission Report, “To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy” (October 2003) is moot.

235 (Passed 8/2005-Patent Law Reform Task Force TF-2B)

Section re-affirms its opposition, in principle, in the context of a first-inventor-to-file system, to permitting the inventor to rely upon proof of date of invention in order to eliminate as prior art subject matter that would otherwise represent prior art relative to the effective filing date for the invention; and Specifically, the Section opposes legislation, in the context of a first-inventor-to-file system, providing that a patent for a claimed invention is not precluded by the claimed invention having been patented, described in a printed publication, or otherwise publicly known no more than one year before the effective filing date, but after the invention thereof by the applicant.

235 (Passed 8/2005-Patent Law Reform Task Force TF-2C-1)

Section supports, in principle, in the context of a first inventor to file system, that a one year grace period for filing an application after an inventor’s direct or indirect public disclosure of the invention contain an exclusion as prior art for any intervening public disclosures made by and/or intervening applications for patent filed by others, including disclosures or filings based upon derivation from the inventor, and Specifically, the Section supports amending § 102(b), as proposed in HR 2795 (June 6, 2005) to provide for the following exemptions from prior art:

(1) Prior Inventor Public Disclosure Exception.—Subject matter that would otherwise qualify as prior art based upon its public disclosure not more than one year prior to the effective filing date for a claimed invention shall not be prior art to the claimed invention under such circumstances if such subject matter had previously been made publicly known by the inventor or a joint inventor or others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

(2) Prior Filing Exceptions.—Subject matter that would otherwise qualify as prior art as of the filing date of a patent or published application for patent only by virtue of its disclosure in such patent or published application shall not be prior art to a claimed invention if the subject matter had previously been made publicly known by the inventor or a joint inventor or others who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

235 (Passed 8/2005-Patent Law Reform Task Force TF-2C-2)

Section supports, in principle, in the context of a first inventor to file system, the doctrine of *In re Facius*, 408 F.2d 1396 (C.C.P.A. 1969), and Specifically, the Section supports amending § 102(b), as proposed in HR 2795 (June 6, 2005) to provide that subject matter that would otherwise qualify as prior art as of the filing date of a patent or published application for patent only by virtue of its disclosure in such patent or published application shall not be prior art to a claimed invention if the subject matter was obtained directly or indirectly from the inventor or a joint inventor

235 (Passed by Council 6/2006 – 108-6; ABA 06A306)

Association supports maintaining a “teaching, suggestion, or motivation” inquiry with respect to combining elements or features in the prior art in determining obviousness of an invention under 235 U.S.C. §103, as a means of guarding against the use of hindsight, wherein a showing must be made as to why the teachings of the references would have been combined by a person skilled in the art based upon, but not limited to, the explicit or implicit teachings of the pertinent references, the knowledge of one of ordinary skill in the art, and/or the nature of the problem as supported by evidence.

235 (Passed by Council 6/2008-R108-2)

Section favors in principle third party submissions of prior art to patent applications during the examination process,
NOW THEREFORE, the Section favors that the United States Patent and Trademark Office establish a substantially similar program to the Peer to Peer (P2P) Pilot Program, and to make that program available to all applicants and to all technologies.

237 (Passed 1967 S.SP 71, 73-ABA 1967; **Retained 1997; Retained 2007 as amended by Council on April 14, 2007**)

Section is opposed in principle to: (a) Elimination of the grace period within which applications may be made for a patent after the public use or sale of the invention or the patenting or publication of the invention, and ~~(b) Any change in the law which would have the effect of awarding the patent only to the applicant who is the first to file his application, and is opposed therefore to Sections 102(a) and 102(b) of S.1042 and H.R. 5924, 90th Congress.~~

237 (Passed 1984 SP 36-R101-8; **Retained 1999; Retained 2009**)

Section favors in principle legislation permitting inventors to join in applying for a patent even though each of them may not have made an inventive contribution to every claim of their application; and Specifically favors legislation of the nature proposed in S. 1535, Section 6 (Mathias, 98th Congress, 1st Session) and H.R. 4527 (Kastenmeier).

237 (Passed 2002 AR104-R101-11)

Section favors, in principle, amending the on-sale bar of 35 U.S.C. § 102(b) to provide an exception for sales or offers for sale of a product embodying an invention to a patentee of the invention.

237 (Passed 2002 AR243-R157-4)

Section supports, in principle, enactment of legislation providing that the right to a patent shall belong to the inventor who first files an application for patent containing an adequate disclosure (35 U.S.C. §112) of the invention or, in the event of an assignment of rights, shall belong to the assignee thereof, and FURTHER, the Section of Intellectual Property Law approves in principle

and recommends to the House of Delegates the rescission of the following resolution that was adopted by the American Bar Association in 1967:

“RESOLVED, that the American Bar Association is opposed in principle to: Any change in the law which would have the effect of awarding the patent only to the applicant who is the first to file his application.”

237 (Passed 2004-R101-5)

Section reaffirms its support in principle for enactment of legislation providing that the right to a patent shall belong to the inventor who first files an application for patent containing an adequate disclosure (35 U.S.C. §112) of the invention or, in the event of an assignment of rights, shall belong to the assignee thereof, and

Further, the Section supports concomitant efforts to conclude international patent harmonization agreements that incorporate such principle, and In addition, the Section rescinds the following past actions as potentially inconsistent with the foregoing: *1992 AR73-R102-8; Defeated by ABA 1993, 1991 AR58-R102-1, 1987 SP 57-R102-1, and 1967 S.SP 71.*

237 (Passed 2004-R101-6)

Section reaffirms its support for the rescission of the following resolution that was adopted by the American Bar Association in 1967, and so recommends to the House of Delegates:

“RESOLVED, that the American Bar Association is opposed in principle to: ... Any change in the law which would have the effect of awarding the patent only to the applicant who is the first to file his application.”

237 (Passed by Council 11/2006-TF-A2)

Section opposes, in principle, in any contested proceeding before the United State Patent and Trademark Office in which derivation of a claimed invention could be raised, barring an applicant for patent from raising the issue of derivation in such a proceeding against a rival applicant or patent owner on the grounds that the effective filing date of the rival applicant or patent owner is more than a specified time earlier than the filing date of the applicant raising the issue; and, Section opposes the requirement in Section 3(i) of S.3818, 109th Congress, 2d Sess. (2006) (Hatch-Leahy), or similar legislation, that would impose such a bar if the effective filing date of the rival applicant or patent owner was more than 18 months earlier than the filing date of the applicant raising the issue of derivation.

237 (Passed 2007-Patent Law Reform Task Force TF-07-01)

Section opposes in principle making the transition in the U.S. patent law to a first-inventor-to-file system contingent on treaty negotiations between the United States and other parties or on actions to be taken by foreign governments or international agencies; and

NOW THEREFORE, the Section opposes the relevant transition provisions of H.R. 1908, 110th Congress, as reported on July 18, 2007 by the House Committee on the Judiciary, or similar legislation, providing that a first-inventor-to-file system should only take effect in the United States 90 days after the date on which the President transmits to the Congress a finding that major patenting authorities have adopted a grace period having substantially the same effect as contained in H.R. 1908.

237 (Passed 2007-Patent Law Reform Task Force TF-07-02)

Section supports in principle a transition in the U.S. patent law to a first-inventor-to-file system under which only those patents having at least one claimed invention with an effective filing date

one year or more after the date of enactment of implementing legislation would be subject to the first-inventor-to-file provisions of such legislation; and
NOW THEREFORE, the Section opposes the transition provisions of S. 1145, 110th Congress, as reported on July 19, 2007 by the Senate Committee on the Judiciary, or similar legislation, providing a transition to a first-inventor-to-file system for all patents issued one year after the date of enactment of such legislation.

238 (Passed 1986 SP 75-R406-3; **Retained 1999**)

Section favors in principle treating a patent claim directed to subject matter implemented at least in part with software the same as other inventions, whether or not the novelty of the claimed subject matter resides wholly in the software, as long as the claim as a whole defines patentable subject matter as defined by 35 U.S.C. 101.

238 (Passed by Council 6/2009-R108-2-OTF)

Section opposes in principle application of the “claim vitiation doctrine” as a matter of law in a manner that would limit the doctrine of equivalents by emphasizing the literal construction of a claimed element or limitation, regardless of the insubstantiality of the difference between the claimed element or limitation and the corresponding structure or act in the accused infringing subject matter.

245 (Passed 1993 AR85-R101-13; **Retained 2004 – As Amended by Council on May 11, 2004**)

Section favors in principle legislative extensions of the term of a patent if there are extraordinary circumstances that have substantially adversely affected the patent owner's enjoyment of the benefits of the patent; ~~and Specifically, the Section disapproves H.R. 5475 (Hughes) and S. 1506 (Glenn), 102d Cong., 2d Sess. (1992), or similar legislation, (without taking any position on the specific patent term extensions provided therein), to the extent that the standards thereof that should be met before a patent term extension bill is approved by the Congress require circumstances that are (a) controlled by the Federal Government, and (b) more than extraordinary.~~

245 (Passed by Council 1/94 AR29-R-AH-1; **Readopted 2006**)

Section opposes in principle denial of the right to a U.S. patent or forfeiture of any part of the patent term because of the price charged for a patented product or a product made by a patented process.

245 (Passed by Council 1/94 AR29-R-AH-2; **Readopted 2006**)

Section opposes in principle imposition upon a patent owner of a legal requirement to disclose the manufacturing or production costs of a product or process using the invention of the patent to any government controlled or appointed administrative entity for the purpose of determining whether to restrict the enforcement or term of a patent.

245 (Passed 1997 AR48-R101-13; **Retained 2007**)

Section favors, in principle, amending 35 U.S.C. § 156 to provide that all patents of the holder of a regulatory approval that are related to the approved product subject to a regulatory review period should be eligible for extension for the period of patent term lost, and SPECIFICALLY, the Section favors eliminating from 35 U.S.C. § 156 the following provisions that are inconsistent with full patent term restoration: (1) the deduction from the calculation of the regulatory review period of one-half of the portion of the regulatory review period before the filing of the application for regulatory approval, (2) the two-year or five-year limitation on the duration of extension from the original expiration date of the patent, (3) the 14-year limitation on

the extended expiration date of the patent from the date of approval of the application for regulatory approval, (4) the limitation that only one patent covering the approval product may be extended based on the regulatory approval for a “new chemical entity” product, (5) the limitation that a patent may only be extended once, and (6) the deduction from the regulatory review period based on the absence of “due diligence.”

245 (Passed 2004-R103-1)

Section favors in principle that the period of adjustment of the term of a patent under §§1.703(a)-(e) not be automatically reduced by the filing of a §1.312 amendment or other paper after a notice of allowance has been issued if the purpose of the amendment or other paper was to correct a Patent Office error; and Specifically, the Section proposes that 37 C.F.R. §1.704 Reduction of period of Adjustment of Patent Term, be amended to include a provision that the reduction in term set forth in (c)(10) will not result if the §1.312 amendment or other paper is filed to correct a Patent Office error.

245 (Passed 2004-R103-2)

Section favors in principle that a request for reconsideration regarding patent term adjustment be allowed to be filed within thirty days of the issue date of the patent in the event that the patent indicates a revised patent term adjustment; and Specifically, the Section approves the proposed amendment to 37 C.F.R. §1.705 Patent Term Adjustment, as set forth in 68 Fed. Reg. 53816 (September 12, 2003), which would allow a request for reconsideration regarding patent term adjustment to be filed within thirty days of the issue date of the patent in the event that the patent indicates a revised patent term adjustment.

245 (Passed by Council 11/2006-TF-A1)

Section supports the principle that any legislation repealing 35 U.S.C. §102(f) (barring a patent to a person who “did not himself invent the subject matter sought to be patented”) contain an explicit provision that the right to apply for and obtain a patent is the right of the inventor or, in the case of a joint invention, the right of the joint inventors; and, Section supports adding to S.3818, 109th Congress, 2d Sess. (2006) (Hatch-Leahy), or similar legislation, a provision, in substance, that the inventor, or the joint inventors, as the case may be, of any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, have the right to apply for and to obtain a patent therefore, subject to the conditions and requirements of title 35.

246 (Passed 1967 S.SP 90-ABA 67M___; **Retained 1997; Retained 2007**)

ABA opposes any provision prohibiting reissued patents with one or more claims broader than those in the original patent, and Further, ABA is opposed to Section 251(c) of S.1042.

246 (Passed 1989 SP41-R103-9; **Retained 2000; Retained 2010**)

Section reaffirms its approval in principle of patent reexamination as a cost effective method for obtaining determinations of patent validity prior to or during litigation; and Specifically, the Section favors in principle the consideration by the Patent and Trademark Office of a directive wherein the patent examiner selected to conduct the reexamination procedure is a patent examiner other than the one who examined the application resulting in the patent being reexamined.

246 (Passed 1992 AR132-R151-1; **Retained 2003**)

Section is opposed in principle to the repeal of 35 U.S.C. §§301-307.

246 (Passed 1993 AR102-R104-1; **Retained 2004**)

Section favors in principle the general rule that an assignor of a patent right who has been found by a court to be estopped from attacking the validity of a patent because of assignor estoppel is also estopped from challenging the validity of that patent in reexamination.

246 (Passed 1993 AR118-R108-6; **Retained 2004**)

Section favors in principle a requirement that the U.S. Patent and Trademark Office in conducting reexamination of a patent shall do so under conditions providing that the basis for and scope of reexamination should include compliance with all aspects of 35 U.S.C. §112 except for best mode.

246 (Passed 1993 AR118-R108-7; **Retained 2004**)

Section favors in principle a requirement that the U.S. Patent and Trademark Office in conducting reexamination of a patent shall do so under conditions providing that the order for reexamination and the first office action should be consolidated and any third party requester should be permitted, within strict time deadlines, to submit written comments on the patent owner's response to the first office action; and further providing that the third party's comments should be limited to issues covered by the examiner's office action and the patent owner's response.

246 (Passed 1993 AR119-R108-8; **Retained 2004**)

Section favors in principle a requirement that the U.S. Patent and Trademark Office in conducting reexamination of a patent shall do so under conditions providing that a third party requester should have the right to participate in any examiner interview initiated by the patent owner or by the examiner; and further providing that such an interview should be conducted under controlled conditions before the examiner and a senior USPTO representative and the third party should not be permitted to initiate interviews.

246 (Passed 1993 AR120-R108-10; **Retained 2004**)

Section favors in principle a requirement that the U.S. Patent and Trademark Office in conducting reexamination of a patent shall do so under conditions providing that a reexamination should not be initiated or continued on any patent claim held valid in an entered judgment, or its equivalent, of a district court in an action in which the requesting party or its privies raised or could have raised the same issues.

246 (Passed 1993 AR121-R108-13; **Retained 2004**)

Section favors in principle amendment of 35 U.S.C. §251 to eliminate the requirement that "error" must have occurred in the grant of an original patent as a prerequisite for filing an application for reissue of that patent.

246 (Passed 1993 AR121-R108-14; **Retained 2004**)

Section favors in principle, if current law is changed to permit assignee filing of an application, amendment of 35 U.S.C. §251 to permit the assignee of an original patent to file for reissue of that patent irrespective of whether one or more of the claims being sought in the reissue application is broader than the claims of the original patent provided that all duties and responsibilities imposed upon the inventor(s) and the assignee in the filing of an application for the original patent are maintained as to any reissue application containing broadened claims.

246 (Passed 1993 AR122-R108-15; **Retained 2004**)

Section opposes in principle amendment of 35 U.S.C. §251 to reduce the time limit for filing a reissue application enlarging the scope of one or more claims of an original patent from the current two year period to one year.

246 (Passed 1994 AR82-R104-1; **Readopted 2006**)

Section favors in principle the general rule that any person other than the patent owner seeking reexamination of a patent shall aver by oath or declaration that no court has estopped that person from attacking the validity of that patent because of assignor estoppel.

246 (Passed 1994 AR449-R-TF-11; **Readopted 2006**)

Section reaffirms, in principle, its support in its prior Resolutions, 1985 SP 44-R108-2, 1989 SP 41-R103-9, and 1993 AR 118-R108-7, for an improved reexamination procedure as a means for members of the public to correct, in certain circumstances, improperly issued patents.

246 (Passed 1995 AR115-R103-13; **Readopted 2006 as Amended**)

Section favors, in principle, the right of a third party requester in a an inter partes reexamination proceeding before the Patent and Trademark Office to appeal a decision adverse to the third party requester to the Board of Patent Appeals and Interferences and to the Court of Appeals for the Federal Circuit and the right of a third party requester to participate in any appeal taken by a patent owner, providing that an appeal, or participation in an appeal, by a third party requester constitutes a waiver by that third party requester of the right to raise any issue that was raised in the reexamination proceeding in any other forum.

246 (Passed by Council Conference Call 11/96; AR110-R103-1; **Readopted 2007**)

Section favors, in principle, the imposition of a requirement that all substantive amendments to the claims in a reissue or reexamination proceeding be accompanied by a statement explaining where such amendments find support in the specification.

246 (Passed 1999 AR31-R103-3; **Retained 2009**)

Section favors, in principle, the practice of holding examining group conferences in regard to appealed cases.

246 (Passed 2002 AR40-R101-1)

Section favors, in principle, amending the inter partes and Director-ordered reexamination authority under 35 U.S.C. to:

- clarify the estoppel effect of an inter partes reexamination proceeding on parties involved in subsequent litigation involving the patent, to ensure that such estoppel applies only after a complete determination of the issues giving rise to the estoppel;
- permit appeals to the Federal Circuit by any party to an inter partes reexamination proceeding, including the third party requester; and
- overrule the holding of *In re Portola Packaging*, 110 F.3d 786 (Fed. Cir. 1997).

246 (Passed 2002 AR40-R101-2)

Section, in the event of enactment of a legislative authority to permit reexamination on the basis of evidence, other than in the form of a patent or a printed publication, on the basis of a substantial new question of patentability in view of sections 102(a), (b), (e), 103, or 112, first or second paragraph (other than best mode), favors implementation of rules to ensure that such evidence can be reviewed accurately, efficiently and fairly by the PTO, and raises only those issues within the traditional competence of the PTO to adjudicate.

246 (Passed 2002 AR73-R101-5)

Section favors, in principle, amending the inter partes and Director-ordered ex parte reexamination authority under Title 35, United States Code, to permit reexamination on the basis of a substantial new question of patentability relating to compliance with the requirements of the first and second paragraphs of § 112, other than best mode, provided that any such reexamination is commenced within a limited period of time following the grant of the patent.

246 (Passed 2004-R103-18a)

Section favors, in principle, the availability of appropriate simplified procedures to challenge the validity of claims in issued patents; and Specifically, the Section favors the adoption of an *inter partes* post-grant review proceeding, commenced only upon a suitable threshold showing, such proceeding to provide the public with an appropriate means for challenging the validity of claims in issued patents at a reasonable cost and to provide patentees with adequate safeguards against harassment.

246 (Passed 2004-R103-18b)

Section favors, in principle, the inclusion in any legislative proposal to create an *inter partes*, post-grant review proceeding of provisions that will provide the public with an appropriate means for challenging the validity of claims in issued patents at a reasonable cost, while providing patentees with adequate safeguards against harassment including provisions to:

- [1] permit the filing of an opposition by any person upon a suitable threshold showing within a limited period of time not greater than 1 year after the date of the patent grant;
- [2] permit as grounds for opposition a broader scope of invalidity issues under 35 U.S.C. §§ 102 (except 102 (c), (f) and (g)), 103 and 112 (except for the best mode requirement), than is available in reexamination proceedings;
- [3] permit a limited opportunity for amendment of the patent claims during the opposition;
- [4] provide completely *inter partes* proceedings, including the right of any party thereto to appeal an adverse decision to the Court of Appeals for the Federal Circuit;
- [5] provide that all evidence other than patents and printed publications be presented through affidavit or declaration, and that affiants and declarants be subject to cross-examination;
- [6] limit discovery to cross examination of affiants, unless otherwise required in the interest of justice;
- [7] provide authority to the Board of Patent Appeals and Interferences to hear and decide all such post-grant review proceedings;
- [8] put the burden of proof on the Opposer to show invalidity by a preponderance of the evidence; and
- [9] require that the proceeding be completed within a specified period of time.

246 (Passed by Council 11/2006-TF-H2)

Section supports, in principle, limiting the estoppel effects in inter partes reexamination proceedings; and, Section supports the enactment of Section 9(f)(4) of S. 3818, 109th Congress, 2d Sess. (2006) (Hatch-Leahy), or similar legislation, to delete the estoppel language in the present statutory note appended to 35 U.S.C. § 315 by §1000(a)(9) of Pub. L. 106-113 that provides that any party who requests an inter partes reexamination under Section 311 is estopped from challenging at a later time, in any civil action, any fact determined during the process of such reexamination, except with respect to a fact determination later proved to be erroneous based on information unavailable at the time of the inter partes reexamination decision.

246 (Passed by Council Conference Call 12/2006-TF-E1)

Section opposes, in principle, a requirement that the Under Secretary of Commerce for Intellectual Property and Director of the PTO must consider the effect on the economy when prescribing regulations relating to the conduct of post-grant review proceedings; and Section opposes the provision in 35 U.S.C. §315(c), as proposed in Section 6 of S. 3818, 109th Congress, 2d Sess. (2006) (Hatch-Leahy), or similar legislation, that would require the Director to “take into consideration the effect on the economy” in prescribing such regulations.

246 (Passed by Council 4/2007; Patent Law Reform Task Force TF-8B)

Except through an enhanced reexamination proceeding, Section opposes, in principle, the adoption of a so-called “second window” in which an administrative validity challenge by a party adverse to a patent could be sought after an initial post grant opposition window of no longer than 12 months after the patent has issued, and

NOW THEREFORE, the Section specifically opposes the creation of any such “second windows” except through enhancement of the currently available administrative procedures for making challenges to a patent’s validity by appropriate legislative changes to reduce the estoppel provisions applicable to inter partes reexaminations, and to expand the availability of inter partes reexamination to any patent regardless of its filing date, and by administrative improvements to inter partes reexamination through the use of senior examiners other than those who examined the application before its issuance.

246 (Passed 2007-Patent Law Reform Task Force TF-07-03)

Section favors in principle the disclosure of material information to the USPTO to improve the quality of issued patents; and

NOW THEREFORE, the Section favors appropriate legislation that establishes that, in an *ex parte* or *inter partes* reexamination pursuant to sections 304, 313 or 314 of Title 35, any person at any time may cite to the PTO in writing prior art (patents or printed publications) or written statements of the patent owner filed in a proceeding before a Federal court or the PTO in which the patent owner takes a position on the scope of one or more patent claims, but that such written statements shall not be considered for any purpose other than to determine the broadest reasonable construction of the claims, consistent with the written description, that are the subject of a request for reexamination.

246 (Passed 2007-Patent Law Reform Task Force TF-07-04A)

Section supports, in principle, enhancements to reexamination that improve patent quality, without creating unreasonable costs and delays; and

NOW THEREFORE, the Section favors the enhancements to reexamination as provided in H.R. 1908, 110th Congress, as reported on July 18, 2007 by the House Committee on the Judiciary, or similar legislation.

246 (Passed 2007-Patent Law Reform Task Force TF-07-04B)

Section supports, in principle, enhancements to reexamination that improve patent quality, without creating unreasonable costs and delays; and

NOW THEREFORE, the Section reaffirms its support of the enhancements to reexamination as provided in H.R. 1908, 110th Congress, as reported on July 18, 2007 by the House Committee on the Judiciary, or similar legislation, and recommends the following corrections:

(a) in the proposed amendments to Section 303(a):

(i) delete “ the owner of a patent files” in line one, and

(ii) delete “or is cited by any person other than the owner of the patent under section 302 or section 311” at the end of the first sentence; and

(b) in the proposed amendments to Section 314(b)(2):

- (i) delete the language which would permit a third party requester to file comments on an Office Action by the PTO in addition to comments on the applicant's response to the Office Action, and
- (ii) delete the provision that would extend the time for Requester comments from the 30 day period of the present rules to 60 days.

246 (Passed 11/2007-Special Committee on Patent Law Reform Legislation-SC-07-01)

Section opposes, in principle, basing venue in patent infringement actions on the activities, conduct and circumstances of plaintiffs;

NOW THEREFORE, the Section opposes determining venue based on a patentee's manufacturing, research, development or other activities.

246 (Passed by Council 4/2009-Patent Law Reform Task Force TF-2A)

Section opposes in principle broadening the scope of reexamination to include references other than patents and publications, because reexamination does not allow for discovery or cross-examination;

NOW THEREFORE, the Section opposes Section 6 of H.R. 1260, 111th Congress, to the extent that it would require patent examiners to consider evidence that the claimed invention was in public use or on sale more than one year prior to the date of the application.

246 (Passed by Council 4/2009-Patent Law Reform Task Force TF-2B)

Section supports in principle broadening the scope of inter partes reexamination to include consideration of documentary evidence that a claimed invention was in public use or on sale, regardless of whether the use or sale activity was substantial, before the effective filing date of the patent in which the invention is claimed so long as the reexamination is before an administrative patent judge who has the authority to allow discovery with regard to authentication or explanation of the documentary evidence including depositions of the signatories of any affidavits or declarations given to authenticate or explain such documentary evidence;

NOW THEREFORE, the Section urges that language be added to Section 6 of H.R.1260, 111th Congress, to provide that "documentary evidence" that a claimed invention was in public use or on sale before the effective filing date of the patent in which the invention is claimed may be cited and placed in the file of the patent in accordance with Section 301 but may only be considered in an *inter partes* reexamination heard by an administrative patent judge and to provide that the procedures before such administrative patent judge shall include the opportunity to seek discovery as to any authentication or explanation of the documentary evidence submitted by the proponent of the documentary evidence including the opportunity to cross examine any person giving a declaration or affidavit in support of such authentication or explanation.

248 (Passed 1986 SP 72-R403-1; **Retained 1999; Retained 2010**)

Section favors in principle amendment of the patent laws to provide that parties to a patent license agreement may agree that either or both of them can terminate the license if the licensee challenges validity, and, if the licensee has the right to terminate, the agreement may further provide that the licensee's royalty obligation shall continue until a final determination of invalidity is reached or until such right to terminate is exercised; and Specifically, the Section favors enactment of title III (LICENSEE CHALLENGES TO PATENT VALIDITY) of the "Intellectual Property Rights Protection and Enforcement Act of 1985," Moorhead H.R. 3776 (99th Congress).

248 (Passed 5/2006 by Council-R-112-2; ABA BOG June 2006)

Section supports, in principle, the rule, recently reaffirmed by the Federal Circuit in *Medimmune, Inc. v. Genentech, Inc.*, 427 F.3d 958 (Fed. Cir. 2005), requiring that a patent licensee commit a material breach of the license agreement (such as refusing to pay royalties) as a condition of bringing an action seeking a declaration of patent invalidity, unenforceability, or noninfringement. SPECIFICALLY, the Section supports filing an amicus brief on the side of Respondents defending the rule in the Supreme Court, which has granted a petition for review of the Federal Circuit's decision. (*Medimmune, Inc. v. Genentech, Inc.*, No. 05-608.)

248 (Passed by Council 7/2007-R101-8/160-3)

Section opposes in principle, statutory provisions prohibiting the holder of a new drug application (NDA) approved under subsection (c) of the Food, Drug and Cosmetic Act, to commence directly or to enter intellectual property licensing or joint venture activity associated with marketing, selling, or distributing, directly or indirectly, the NDA holder's approved drug after receipt of an ANDA notice; and

NOW THEREFORE, the Section opposes the enactment of the "Fair Prescription Drug Competition Act" S.438, 110th Congress as introduced on January 30, 2007 or similar legislation prohibiting the NDA holder from commencing marketing, selling, or distributing, directly or indirectly, the NDA holder's approved drug.

249 (Passed 2002 AR87-R101-7)

Section reaffirms its opposition, in principle, to statutory provisions permitting compulsory licensing of patents and, Specifically, the Section opposes enactment of the "Affordable Prescription Drugs and Medical Inventions Act" H.R. 1708, 107th Congress, as introduced on May 5, 2001 and thereafter referred to the House Committee on the Judiciary and House Committee on Energy and Commerce, or similar legislation.

249 (Passed 2006 – 108-1 and 413-1)

Section reaffirms its opposition, in principle, to statutory provisions permitting compulsory licensing of patents, and Specifically, in furtherance of such principle, the Section opposes any state, local or territorial legislation that provides for compulsory licensing of a patented product or process.

260 (Passed 1997 AR430-R655-1; **Retained 2008**)

Section favors in principle an interpretation of Fed.R.Civ.P. 26(a)(2) and 26(b)(3) that preserves work-product protection for mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning a litigation (hereinafter "core attorney work product"), notwithstanding the fact that such core attorney work product has been disclosed to an expert whose opinions may be presented at trial and who may be deposed by an opponent pursuant to subdivision 26(b)(4)(A), and specifically the Section favors the interpretation of subdivisions 26(b)(3) and (b)(4) of Fed.R.Civ.P. set forth in *Bogosian v. Gulf Oil Corp.*, 738 F.2d 587 (3d Cir. 1984) and *Haworth v. Herman Miller, Inc.*, 162 F.R.D. 289 (W.D.Mich. 1995).

261 (Passed 1971 SP 101-R44A-ABA 74M___; **Retained 1997; Retained 2007**)

ABA expresses its support for legislation providing for voluntary arbitration of patent disputes including questions of infringement and validity of patents.

264 (Passed 1983 SP 51-R108-3; **Retained 1998; Retained 2008**)

Section reaffirms, in principle, its support for appointment of lawyers to the Federal judiciary having experience and training in patent law, and Specifically, favors the appointment of lawyers

having experience in patent matters to the Court of Appeals for the Federal Circuit, and further favors such appointments to the CAFC in sufficient numbers to promote uniformity in that Court's interpretation of the patent laws taking into account the number and complexity of the patent cases before that Court and the workloads of the judges.

264 (Passed 1983 SP 73-R401-5; **Retained 1998; Retained as Amended 2008**)

Section favors in principle enactment of an amendment to 28 USC 1292 which would give the Court of Appeals for the Federal Circuit discretionary authority to permit appeals to be taken from interlocutory orders of the Trademark Trial and Appeal Board and the Board of Patent Appeals and Interferences in cases in which the particular Board has certified that the interlocutory order appealed from involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal from the order may materially advance the ultimate termination of the proceeding.

264 (Passed 1984 SP 44-R201-1; **Retained 2000**)

Section opposes in principle federal legislation which would establish exclusive jurisdiction in the Court of Appeals for the Federal Circuit for appeals from the United States District Courts in trademark cases; and Specifically, the Section disapproves Section 3 of H.R. 4460 (Kastenmeier) 98th Congress, or similar legislation.

264 (Passed 1986 SP 71-R401-2; **Retained 2000; Retained 2010**)

Section favors in principle enactment of an amendment to 28 U.S.C. which would give the United States Court of Appeals for the Federal Circuit jurisdiction over interlocutory appeals-by-permission from the Board of Patent Appeals and Interferences and the Trademark Trial and Appeal Board in accordance with 28 U.S.C. Section 1292 (b) in cases in which the Federal Circuit has jurisdiction over an appeal in accordance with 28 U.S.C. Section 1295.

264 (Passed 1989 SP61-R551-2; ABA 91____; **Retained 2001**)

ABA favors in principle the creation of a national commission to consider and recommend to the President candidates for nomination to the Court of Appeals for the Federal Circuit; and Specifically, the Section approves the following or similar guidelines for the Commission. The Commission will consist of twelve members, appointed by the President, who will be selected in such a manner as to be representative of the various needs and concerns which may be substantially affected by the jurisdiction of the Court of Appeals for the Federal Circuit.

264 (Passed 1990 SP90-R401-8; **Retained 2001**)

Section reaffirms its opposition in principle to the enactment of any legislation which would remove exclusive jurisdiction for the trial of patent cases from the federal district courts, and Specifically, the Section opposes in principle the creation of any new Article III specialty trial court(s) which would have jurisdiction of patent disputes.

264 (Passed 1990 SP91-R408-3; **Retained 2001**)

Section reaffirms in principle support for legislation confirming the intent of Congress that states and state agencies are subject in Federal Court to all remedies available in infringement actions under the patent laws of the United States; and Specifically, the Section favors enactment of H.R. 3886, 101st Cong., 2nd Sess. (1990) (Kastenmeier), or similar legislation, abrogating state immunity from liability for patent infringement.

264 (Passed 1992 AR264-R401-9; ABA 92A303 as amended; **Retained 2003**)

ABA favors, in principle, the proposition that a court of appeals, like a trial court, is not deprived of jurisdiction to determine the validity of a patent merely because the court of appeals determines that the patent was not infringed. Further resolved the ABA favors, in principle, the proposition that a court of appeals should not refuse to consider a claim or counterclaim for a declaratory judgment regarding the validity of a patent merely because the court of appeals determines that the patent was not infringed.

264 (Passed 1992 AR264-R401-10; ABA 92A303 as Amended; **Retained 2003**)

ABA favors, in principle, the proposition that a court of appeals, like a trial court, is not deprived of jurisdiction to determine the validity of a patent merely because the court of appeals determines that the patent was not infringed. Further resolved, that the ABA favors, in principle, the proposition that a court of appeals should not refuse to consider a claim or counterclaim for a declaratory judgment regarding the validity of a patent merely because the court of appeals determines that the patent was not infringed.

264 (Passed by Council 9/92; mail vote;R411-1; **Retained 2003**)

Section supports in principle increasing the funding for the Court of Appeals for the Federal Circuit to support an increase in staff commensurate with the workload of the Court and within the guidelines of the Judicial Conference of the United States.

264 (Passed 2002-R409-1)

Section supports, in principle, jurisdiction of the Court of Appeals for the Federal Circuit over all issues in cases in which it has exclusive appellate jurisdiction pursuant to 28 U.S.C. §1295(a)(1).

264 (Passed 2002-R409-2)

Section supports, in principle, the Court of Appeals for the Federal Circuit applying regional circuit law to antitrust issues not specific to patent law, and specifically, supports the Federal Circuit's holding in Nobelpharma that the court will continue to apply the law of the appropriate regional circuit to issues involving elements of antitrust law such as relevant market, market power, and damages.

264 (Passed 2003-R108-6)

Section supports in principle the uniformity, predictability and consistency in the administration of the patent law fostered by having the Federal Circuit Court of Appeals decide appeals of all cases involving a claim which “arises under” the patent laws; and Specifically the Section supports the proposition that a claim stated in the Complaint or Counterclaim can be relied upon to determine whether a civil action “arises under” federal patent law.

264 (Passed 2006-R601-8)

Section supports, in principle, the implementation of a pilot program to determine whether the consolidation of patent cases among designated judges in whose districts such cases are filed improves the litigation of patent cases; and, Specifically supports, in principle, a pilot program of the type contemplated by H.R. 5418 (109th Congress, 1st Sess.) (2005) (Issa) (“To establish a pilot program...to encourage enhancement of expertise in patent cases among patent judges”), or similar legislation.

264 (Passed 2006-R603-1)

Section favors, in principle, the appointment of a fifth Administrative Law Judge and the provision of a third courtroom at the International Trade Commission (ITC) to accommodate the

continually increasing number of ITC cases under Section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337.

264 (Passed by Council Conference Call 3/2007; R101-1)

Section supports, in principle, the implementation of a pilot program to determine whether the consolidation of patent cases among designated judges in whose districts such cases are filed improves the litigation of patent cases; and

NOW THEREFORE, the Section supports a pilot program of the type contemplated by H.R. 34 (110th Congress, 1st Sess.) (2007) (Issa) (“To establish a pilot program . . . to encourage enhancement of expertise in patent cases among patent judges”), or similar legislation.

264 (Passed by Council Conference Call 12/2007; Executive Committee EX-1)

Section favors in principle the ability of the U.S. International Trade Commission (ITC) to properly manage its case load through implementation of procedures for the appointment and retention of hearing officers that are supplemental to the existing procedures for the appointment of Administrative Law Judges; and

NOW THEREFORE, the Section favors the enactment of legislation authorizing the ITC to appoint hearing officers, other than administrative law judges, to preside at the taking of evidence at hearings before it and to make initial and recommended decisions in investigations before it; that such legislation specify qualifications for appointment that may include technical expertise and experience in patent, trademark, copyright and unfair competition law; and that, except as specifically provided in the legislation, all laws, rules and regulations applicable to administrative law judges and to positions in the competitive service apply to ITC appointed hearing officers.

264 (Passed by Council 4/2009-Patent Law Reform Task Force TF-I-1)

Section supports, in principle, the implementation of a pilot program in a small number of U.S. district courts to determine if the litigation of patent cases is improved by the consolidation of patent cases among participating judges and the provision of additional resources to participating district courts,

and, Section supports that under any such pilot program reassignment of a patent case could occur only after random assignment of all cases among all the judges of the district, a request by the assigned judge for its reassignment, and the availability of a judge who has requested such reassignments.

NOW THEREFORE, the Section favors the enactment of H.R. 638, 111th Congress, (Issa) and similar provisions in S. 515, 111th Congress, (Specter), bills to establish such pilot program, or similar legislation.

266 (Passed 1989 SP51-R405-1B; **Retained 2000; Retained 2010**)

Section favors in principle the adoption by the U.S. International Trade Commission of rules providing for sanctions for abuse of discovery and abuse of process to the extent authorized by Rule 11 and Rule 37 of the Federal Rules of Civil Procedure.

266 (Passed 1989 SP60-R551-1A(3) ; **Retained 2000**)

Section favors in principle the promulgation of a new rule and/or modification of existing rules by the Court of Appeals for the Federal Circuit specifically addressing the subject of cross appeals, to include the provision requiring in connection with the preparation of the appendix that both the appellant and cross appellant comply with F.R.A.P. 30 (b) with regard to the enumeration of issues presented on appeal and the designation of the appendix.

266 (Passed 1990 SP89-R401-2; **Retained 2001**)

Section favors in principle that the Federal Rules be amended to provide that United States District Courts treat discovery taken in a parallel International Trade Commission proceeding, respecting common claims or issues between the same parties, as though the discovery was taken in the United States District Court action; and that the Rules of the International Trade Commission treat discovery taken in a parallel District Court action, respecting common claims or issues between the same parties, as though the discovery was taken in the International Trade Commission proceeding.

266 (Passed 1990 SP83-R401-4; **Retained 2001**)

Section favors, in principle, the general concept of an expedited, low-cost small claims procedure within the federal judiciary for the resolution of patent and civil copyright disputes subject to exclusive federal jurisdiction, having an amount in controversy less than an appropriate stated sum.

266 (Passed 1990 SP86-R401-6; **Retained 2001**)

Section favors in principle a change in Local Rule 33 of the Federal Circuit which would permit the appellant to file a statement of compliance under circumstances where a timely joint statement cannot be filed.

266 (Passed 1992 AR260-R401-5; **Retained 2003**)

Section opposes, in principle, a procedure that would allow a court to require that the direct examination of a witness in a non-jury trial be presented through the adoption by the witness of an affidavit, written statement, report or deposition, and Specifically, the Section of Patent, Trademark and Copyright Law opposes amendments to Rule 43 of the Federal Rules of Civil Procedure establishing such a procedure.

266 (Passed 1992 AR262-R401-7; **Retained 2003**)

Section favors, in principle, amendment of 19 C.F.R. § 210.30(b) to add a new sentence, as follows:

The Commission and administrative law judge shall treat discovery taken in a parallel district court civil action, respecting common claims or issues between the same parties, as though the discovery was taken in proceedings under Section 337 of the Tariff Act.

266 (Passed 1993 AR288-R401-5; **Retained 2004**)

Section favors in principle the elimination of contingent fee arrangements for compensation of expert witnesses.

266 (Passed 1993 AR292-R401-6; **Retained 2004**)

Section opposes in principle the practice by the Court of Appeals for the Federal Circuit of issuing unprecedential opinions in which the judgment of the district court on patent validity, infringement, or enforceability is reversed.

266 (Passed 1994 AR308-R401-6/458-1; **Readopted 2006**)

Section supports in principle the proposition that an accused patent infringer should not be required to disclose its attorneys' opinions to a jury or offer other evidence before a jury in defense to a charge of willfulness before it has been found liable for infringement nor shall such attorneys' opinions be admissible into evidence upon motion of the patentee before the conclusion of the liability trial.

266 (Passed 1998 AR402-R655-1; **Retained 2008**)

Section favors in principle an interpretation of Fed.R.Civ.P. 26(a)(2) and 26(b)(3) that preserves work-product protection for mental impressions, conclusions, opinions, or legal theories of an attorney or other representative of a party concerning a litigation (hereinafter "core attorney work product"), notwithstanding the fact that such core attorney work product has been disclosed to an expert whose opinions may be presented at trial and who may be deposed by an opponent pursuant to subdivision 26(b)(4)(A), and specifically the Section favors the preservation of protection for such core attorney work product notwithstanding the introductory clause "Subject to the provisions of subdivision (b) (4) of this rule," appearing at the beginning of subdivision (b)(3) of Fed.R.Civ.P. 26.

266 (Passed 2001 AR149-R108-8)

Section favors, in principle, that the attorney-client privilege protecting communications between a client accused of patent infringement and that client's litigation counsel is not waived with respect to litigation counsel where the client has asserted the defense of reliance on advice of counsel in response to an allegation of willful infringement and where (1) the litigation counsel was at no time involved in rendering the advice upon which the client has asserted reliance; and (2) the opinion relied upon was rendered prior to the service of any summons and complaint alleging infringement.

266 (Passed 2001 AR614-R601-1)

Section favors, in principle, the adoption of procedural guidelines that, without unduly infringing upon the case management discretion of trial courts, promote uniformity and consistency in the trial courts' (1) resolution of the issue of claim construction and (2) use of materials or advisors to understand the relevant art.

266 (Passed 2001 AR666-R651-3)

Section favors, in principle, that the attorney-client privilege protecting communications between a client accused of patent infringement and that client's litigation counsel is not waived with respect to litigation counsel where the client has asserted the defense of reliance on advice of counsel in response to an allegation of willful infringement and where 1) the litigation counsel was at no time involved in rendering the advice upon which the client has asserted reliance; and 2) the opinion relied upon was rendered prior to the service of any summons and complaint alleging infringement.

266 (Passed 2003-R604-1)

Section opposes, in principle, any court's reliance on dictionaries, encyclopedias or treatises, in construing or interpreting any disputed portion of a patent claim unless (a) that material has been made part of the record and (b) the parties have had a full and fair opportunity to address, challenge, or rebut that material.

266 (Passed 2003-R655-1)

While not endorsing a court appointed expert, if a court appointed expert is used, the Section opposes in principle the appointment and use, under a district courts' inherent powers, of court-appointed technical advisors unless procedural safeguards are put in place to protect the litigants' interests.

266 (Passed 2003-R655-2)

While not endorsing a court appointed expert, if a court appointed expert is used, the Section opposes in principle the appointment and use, under a district courts' inherent powers, of court-

appointed technical advisors in a case, unless an appropriate Federal Rule or Rules are adopted to govern the use and appointment of court-appointed technical advisors.

266 (Passed 2003-R655-3)

Section favors in principle the adoption of an appropriate Federal Rule or Rules to govern the appointment and use, under a district courts' inherent powers, of court-appointed technical advisors ("CATA") in cases; and Specifically, the Section favors a Federal Rule or Rules which would, at a minimum, (1) require district court judges to inform parties of his or her intention to appoint a CATA, (2) allow the parties an opportunity to raise objections concerning the competency and/or independence of any CATA selected by the court, (3) require district court judges to inform the parties of the intended role of the CATA, (4) require district court judges to create a record of the CATA's actual role, and (5) require that the parties be provided copies of any written reports prepared by the CATA for the district court judge.

266 (Passed by Council 8/2004; ABA 04A302)

RESOLVED, that the American Bar Association recommends that courts apply the following principles in interpreting claim terms in a patent—

--In construing a patent claim term, the ordinary meaning of the claim term to one of ordinary skill in the art as used in the context of the patent shall apply, unless (a) the patentee has acted as his or her own lexicographer, in which case the patentee's definition should control; or (b) there has been a clear disavowal of claim scope, in which case the patentee should be bound by such action. In determining the ordinary meaning of the claim term to one of ordinary skill in the art as used in the context of the patent, the court shall look to dictionaries and similar sources, the specification and the prosecution history;

--While technical dictionaries should be given more weight than general purpose dictionaries, all types of dictionaries and similar sources should be considered;

--In construing or interpreting any disputed portion of a patent claim, courts should not rely on dictionaries and similar sources unless (a) that material has been made part of the record and (b) the parties have had a full and fair opportunity to address, challenge, or rebut that material;

--Courts should not apply a rule of claim construction whereby the specification is the primary source for claim construction such that the range of ordinary meaning of claim language is limited to the scope of the invention disclosed in the specification;

--Courts should not apply a rule of claim construction whereby the claim construction methodologies in the majority and dissent in the now-vacated panel opinion in *Phillips v. AWH Corp.*, 363 F.3d 1207 (Fed. Cir. 2004), are treated as complementary methodologies such that there is a dual restriction on claim scope, and a patentee must satisfy both limiting methodologies in order to establish the claim coverage it seeks;

--Courts should not consider invalidity under, e.g. 35 U.S.C. 102, 103, and 112, when construing claim terms in a patent;

--Courts should apply a rule of claim construction in which the prosecution history is given the same weight as the specification and both are considered in every case when evaluating the meaning of a claim term;

--Trial courts should receive expert testimony at the court's discretion to educate the court on the technology, but expert testimony may not be used to contradict the claim meaning discernable from the dictionaries and similar sources, specification, and prosecution history;

--While the ultimate issue of claim construction should be reviewed de novo, an appellate court should review only by the clearly erroneous standard any underlying findings of fact made by a trial court in connection with construing a claim term.

266 (Passed 2004-R101-1)

Section opposes, in principle, legislation that would alter the law governing the discretion of district courts to grant or refuse preliminary injunctions restraining alleged patent infringement.

266 (Passed by Council 1/2005-R601-8)

Section 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.

266 (Passed by Council 1/2005-R601-9)

Section 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.

266 (Passed by Council 1/2005-R604-1)

Section 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, 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.

266 (Passed by Council 1/2005-R604-2)

Section 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, 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.

266 (Passed by Council 1/2005-R604-3)

Section favors, in principle, encouraging the Federal Circuit judges to sit by designation on other federal courts and vice-versa, and Specifically, 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.

266 (Passed 6/2005-Patent Law Reform Task Force TF-19)

Section favors, in principle, the just, speedy and inexpensive determination of federal litigation, including patent infringement litigation; and Specifically, the Section opposes, in principle, granting patent litigants an interlocutory appeal as a matter of right from a district court's claim construction ruling.

266 (Passed 2007 ABA 07M302)

RESOLVED, That the American Bar Association supports the principle that a party's assertion of the advice-of-counsel defense to a charge of willful patent infringement does not waive the attorney-client privilege with respect to communications with that party's trial counsel, so long as such trial counsel is not the same counsel who provided the opinion upon which the accused infringer relies;

FURTHER RESOLVED, That the American Bar Association supports the principle that a party's assertion of the advice-of-counsel defense to a charge of willful patent infringement does not waive the work product privilege of that party's trial counsel, so long as such trial counsel is not the same counsel who provided the opinion upon which the accused infringer relies;

FURTHER RESOLVED, That the American Bar Association supports the principle that a legally consistent standard for a patent infringer to be liable for enhanced, or punitive, damages under 35 U.S.C. § 284 is "reprehensible conduct" in accord with general Supreme Court standards for punitive damages; and

FURTHER RESOLVED, That the American Bar Association supports replacement of the affirmative duty of due care standard set forth in *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380 (Fed. Cir. 1983), with the foregoing reprehensible conduct standard.

266 (Passed by Council 2/2007; Seagate Task Force Resolution Seagate 1)

Section favors in principle that a party's assertion of the advice-of-counsel defense to a charge of willful patent infringement does not waive the attorney-client privilege with respect to communications with that party's trial counsel so long as such trial counsel is not the same counsel who provided the opinion upon which the accused infringer relies;

NOW THEREFORE, the Section favors that the United States Court of Appeals for the Federal Circuit answer "NO" to question number 1 posed in its en banc Order dated January 26, 2007 in *In Re Seagate Technology, LLC* (Misc. Docket No. 830).

266 (Passed by Council 2/2007; Seagate Task Force Resolution Seagate 2)

Section favors, in principle, that a party's assertion of the advice-of-counsel defense to a charge of willful patent infringement does not waive the work product privilege of that party's trial counsel so long as such trial counsel is not the same counsel who provided the opinion upon which the accused infringer relies;

NOW THEREFORE, the Section favors that the United States Court of Appeals for the Federal Circuit answer "NO" to question number 2 posed in its en banc Order dated January 26, 2007 in *In Re Seagate Technology, LLC* (Misc. Docket No. 830).

266 (Passed by Council 2/2007; Seagate Task Force Resolution Seagate 3)

Section favors, in principle, that the correct standard for an infringer to be liable for enhanced damages under 35 U.S.C. § 284 is "reprehensible conduct" and that this standard replace the affirmative duty of due care standard set forth in *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380 (Fed. Cir. 1983), and;

NOW THEREFORE, the Section favors that:

1. the duty of due care standard set forth in *Underwater Devices, Inc. v. Morrison-Knudsen Co.*, 717 F.2d 1380 (Fed. Cir. 1983) be reconsidered; and
2. question number 3 posed in the en banc Order of the United States Court of Appeals for the Federal Circuit in *In re Seagate Technology, LLC* (Misc. Docket No. 830) dated January 26, 2007 be answered "YES"; and
3. instead a standard of "reprehensible conduct" be adopted in order for an infringer to be liable for enhanced damages under 35 U.S.C. § 284.

266 (Passed by Council 2/2007; Patent Law Reform Task Force TF-G-2)

Section favors, in principle, amending the patent statute to provide that the construction of a claim is to be determined by the court based upon underlying factual issues also determined by the court; and

NOW THEREFORE, the Section supports enactment of legislation that would implement this principle through amendments further providing that:

1. in determining the meaning of any patent claim, the trial court shall state separately its findings of fact and conclusions of law thereon; and
2. the findings of fact shall not be set aside unless clearly erroneous.

266 (Passed by Council 4/2009-R706-1)

Section supports in principle the protection of attorney work product, opinions and advice to foster full and frank discussions between attorneys and clients; and

NOW THEREFORE, the Section disapproves of the holding in *Broadcom Corp. v. Qualcomm Inc.*, 2008 WL 4330323, *13 (Fed. Cir. 2008), that the absence of advice of counsel, or the decision of the infringer not to present evidence of advice of counsel, may be considered by the finder of fact in determining the existence of inducement of infringement.

268 (Passed 1993 AR130-R108-34; **Retained 2004**)

Section favors, in principle, that no patent shall be held invalid or unenforceable for an applicant's misstating information during prosecution of the application which matured into such patent, or for failure to disclose known prior art unless it is established by clear and convincing evidence both that such misstating or failure to disclose resulted from an intent to deceive and that such prior art, when considered alone or in combination with cited prior art, or that such misstating, caused issuance of one or more invalid claims of the patent; and Specifically, the Section favors adoption, either by the courts or by legislation, of a "but for" standard of materiality for resolving issues of inequitable conduct raised during litigation of an issued patent.

268 (Passed 2001 AR142-R108-3)

Section opposes, in principle, a rule that any amendment to a patent application claim made for reasons related to a statutory requirement for a patent creates prosecution history estoppel and favors instead that, for an amendment to create a prosecution history estoppel, it must be for a *substantial* reason related to patentability; and Specifically, the Section favors reversal of the holding in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed Cir. 2000) that "'a substantial reason related to patentability' . . . includes *any* reason which relates to the statutory requirements for a patent [emphasis in original]."

268 (Passed 2001 AR142-R108-4)

Section favors, in principle, a flexible rule for determining the scope of prosecution history estoppel applicable to a patent claim limitation or element that is subject to prosecution history estoppel as a result of an amendment, the reason for which is explained in the prosecution history, and which was made for a substantial reason related to patentability; and Specifically, the Section favors reversal of the holding in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558 (Fed Cir. 2000) that "when a claim amendment creates prosecution history estoppel with regard to a claim element, there is no range of equivalents available for the amended claim element."

268 (Passed 2001 AR143-R108-5)

Section favors, in principle, that, with respect to patents issuing on applications filed before the decision of the Court of Appeals for the Federal Circuit in *Festo Corp. v. Shoketsu Kinzoku*

Kogyo Kabushiki Co., Ltd., 234 F.3d 558 (Fed Cir. 2000), the rules and principles for determining the existence and scope of prosecution history estoppel in effect immediately prior to such decision shall apply; and Specifically, the Section opposes retroactive application of the rules announced in *Festo* claims amended before the decision in such case.

268 (Passed 2005-Patent Law Reform Task Force TF-17)

Section opposes, in principle, enactment of legislation to amend the burden of proof for attacking the validity of an issued patent to a preponderance of the evidence standard.

268 (Passed by Council 2/2006 – R112-1, ABA06M303)

Association supports the granting of a permanent injunction enjoining a patent infringer from future infringement of a patent that has been adjudicated to be valid, enforceable and infringed, in accordance with the principles of equity on such terms as the court deems reasonable; Further Resolved, that the Association opposes consideration of the extent to which the patent owner has practiced the patented invention or has licensed others to do so, except when determining whether grant of a permanent injunction would adversely affect public safety, public welfare, the national security, or the like.

270 (Passed 1983 SP 76-R403-3; **Retained 1998; Retained 2008**)

Section favors in principle consideration of amendment of the patent and copyright laws to provide that relief for infringement shall not be denied because of any doctrine of misuse which involves a theory of suppression of competition, unless the conduct on which misuse is based, in view of the circumstances in which it is employed, constitutes a violation of the antitrust laws.

270 (Passed 1985 SP 34-R101-2; **Retained 1999; Retained 2009**)

Section opposes in principle the exclusion of any class of products from the scope of legislation that would make it an infringement to use or sell within, or import into, the United States during the term of a United States process patent a product produced by the patented process.

270 (Passed 1986 SP 34-R105-1; ABA, in amended form, 88M___; **Retained 1999; Retained 2009**)

ABA opposes in principle state exemption from liability for damages and/or equitable relief in private infringement actions brought under United States patent, trademark and copyright law.

270 (Passed 1988 SP 69-R101-4; **Retained 1999; Retained 2009**)

Section favors in principle an exemption from infringement for activities conducted solely for experimental or research purposes whether or not such activities are conducted by a commercial organization.

270 (Passed 1989 SP71-RNB4; ABA 1990 in amended form; **Retained 2001**)

Section opposes in principle any significant weakening of the intellectual property rights enforcement measures currently provided by Sections 337 and 337(a) of the Tariff Act of 1930 (as amended) (19 U.S.C. Section 1337).

270 (Passed 1990 SP57-R108-2A; **Retained 2001**; Approved by ABA 01A116D)

ABA opposes a blanket rule under which the failure of a defendant in an action for patent infringement to introduce an opinion of counsel at trial will permit an inference to be drawn that either no opinion was obtained or, if an opinion was obtained, it was contrary to the accused infringer's desire to initiate or continue its use of the patentee's invention.

270 (Passed 1990 SP90-R405-3; **Retained 2001**)

Section favors in principle increased access by in-house counsel to certain information presently designated confidential in unfair importation proceedings before the International Trade Commission under 19 U.S.C. §1337; and Specifically, the Section favors in principle close judicial scrutiny of requests to designate information as confidential in §337 proceedings so as not to unnecessarily exclude in-house counsel from participation in §337 proceedings.

270 (Passed 1990 SP91-R1003-1; **Retained 2001**)

Section opposes in principle legislation that would provide an exemption from liability for patent infringement based on an accused infringer's occupation; and Specifically, the Section opposes enactment of Section 2 of H.R. 1556 (Kastenmeier), 101st Cong., 1st Sess. (1989).

270 (Passed 1991 AR52-R101-3; **Retained 2002**)

Section favors in principle legislation that would give the holder of a U.S. utility patent claiming a machine, manufacture or composition of matter the right to prevent unauthorized importation into the United States of a product made outside the United States by use of the patented machine, manufacture or composition of matter, if such use would be an infringement of one or more claims of the patent if it were done in the United States.

270 (Passed 1992 AR288-R405-4; **Retained 2003**)

Section opposes, in principle, allowing a party that could be named a respondent in a Section 337 proceeding to file a petition to initiate a declaratory action before the U.S. International Trade Commission.

270 (Passed by Council 2/94 R-AH-1; mail vote; **Readopted 2006**)

Section favors in principle that construing a patent claim to define the scope of the patent right is a question of law that is treated, by both the trial and appellate courts, identical to statutory construction.

270 (Passed 1996 AR421-R-601-5; **Readopted 2007**)

Section favors in principle the bifurcation of discovery regarding the issue of willful patent infringement based on a privileged opinion of counsel and, specifically, favors the bifurcation of discovery directly related to such an opinion or related opinions until after a finding of liability, allowing a brief hiatus after such finding (e.g., 30-60 days) to conduct expedited discovery concerning any such opinion or related opinions.

270 (Passed 2001 AR656-R605-2)

Section favors, in principle, that the equitable defense of laches resulting from a patentee's unreasonable and unjustified delay in the prosecution and issuance of a patent be available under appropriate circumstances to a person charged with infringement of such patent who can show injury as a result of the delay; and Specifically, the Section favors reversal of the decision of the United States District Court for the District of Nevada in the case of Symbol Technologies, Inc. v. Lemelson Medical, Education and Research Fdn., L. P., CV-N-99-0397/0533 PMP (PHA) (D. Nev. 2000) dismissing the complaint of plaintiffs, Symbol Technologies, Inc. and Cognex Corporation, pursuant to Fed. R. Civ. P. 12(b)(6) for failure to state a claim upon which relief can be granted. . (Passed by Council E-mail, October, 2000)

270 (Passed 2001 AR657-R605-3, ABA 01M301)

ABA opposes, in principle, an absolute bar to the application of the doctrine of equivalents with respect to unclaimed subject matter that is disclosed in the specification of a patent.

270 (Passed 2001 AR994-R757-6)

Section opposes, in principle, the passage of federal legislation intended to eliminate liability or provide a common-carrier exception specifically for online service providers or other Internet enabling entities for patent infringement

270 (Passed 2002-R108-5)

Section opposes in principle that any defendant to a patent infringement claim should have a defense based on a bona fide purchaser theory, where the purchased right is a patent license.

270 (Passed 2004-R601-2)

Section opposes, in principle, enactment of legislation to amend the burden of proof for attacking the validity of an issued patent to a preponderance of the evidence standard.

270 (Passed 2005-R701-1)

Section favors, in principle, that a computer program falls within the scope of the term "component" in 35 USC § 271(f).

270 (Passed 5/2005-Patent Law Reform Task Force TF-11)

Section supports, in principle, the desirability of reducing litigation cost and increasing predictability of patent infringement litigation outcomes in cases involving willful infringement allegations; and

Specifically, the Section supports legislation that would implement the following changes to the existing law of willful patent infringement --

- (1) A court that has determined that the infringer has willfully infringed a patent or patents in suit may increase the damages up to three times the amount found or assessed, provided, however, that increased damages under this section shall not apply to provisional rights under section 154(d) of this title.
- (2) A court may find that an infringer has willfully infringed a patent only if the patent owner presents clear and convincing evidence that:
 - (A) after receiving written notice from the patentee (i) alleging acts of infringement in a manner sufficient to give the infringer an objectively reasonable apprehension of suit on such patent, and (ii) identifying with particularity each claim of the patent, each product or process that the patent owner alleges infringes the patent, and the relationship of such product or process to such claim, the infringer, after a reasonable opportunity to investigate, thereafter performed one or more of the alleged acts of infringement; or
 - (B) the infringer intentionally copied the patented invention with knowledge that it was patented; or
 - (C) after having been found by a court to have infringed the patent, the infringer engaged in conduct that was not colorably different from the conduct previously found to have infringed the patent, and which resulted in a separate finding of infringement of the same patent.
- (3) A court shall not find that an infringer has willfully infringed a patent under paragraph (2) for any period of time during which the infringer had a good faith belief that the patent was invalid, unenforceable or would not be infringed by the conduct later shown to constitute infringement of the patent. Reasonable reliance on advice of counsel shall establish an informed good faith belief within the meaning of this section. The absence of the advice of counsel, or the decision of the infringer to not present evidence of such

advice of counsel, however, shall have no relevance to determining the existence of willful infringement.

- (4) A court may not determine that an infringer has willfully infringed a patent prior to the date that a final determination has been made that the patent in suit is not invalid, or unenforceable and has been infringed by the infringer.
- (5) An appeal to the Court of Appeals for the Federal Circuit may be taken from a judgment of a district court in patent cases which is final except for an accounting or a determination of willful infringement.

270 (Passed 5/2005-Patent Law Reform Task Force TF-18)

Section opposes, in principle, amendment of Section 271(f) of title 35, United States Code, to limit its application to tangible items that are combined physically with other components to create the combination that is alleged to infringe.

270 (Passed 8/2005-Patent Law Reform Task Force TF-18A)

Section supports, in principle, that a person who supplies all or substantially all of the components of a patented invention, or supplies a nonstaple component of a patented invention, is liable as an infringer if the components were supplied with the intent that they be assembled outside of the United States in a manner that would infringe a U.S. patent if done in the United States.; and Specifically, the Section opposes repeal of 35 U.S.C. § 271(f).

270 (Passed 8/2005-Patent Law Reform Task Force TF-20)

Section opposes, in principle, modification of the current venue statutes for patent infringement actions, because no need now exists to change such provisions; and Specifically, the Section opposes proposed amendments to the federal venue laws being considered by Congress in the first Session of the 109th Congress.

270 (**Defeated** 2006 - 701-2)

Section favors, in principle, that a distributed system involving a computer program does not infringe a system claim of a United States Patent under 35 USC § 271(a) unless all elements of the claim are satisfied within the United States.

270 (Passed by Council, as amended, 2/2006-R108-4)

Section favors, in principle, the amendment of 35 U.S.C. § 271(f) to limit the reach of “supplying” under the statute to activities that actually occur within the territory of the United States, and SPECIFICALLY, the Section favors an amendment to § 271(f) to limit liability thereunder to patented combinations assembled from the components supplied or caused to be supplied as described under section 271(f), and to exclude liability therefore when all components of the combination are made outside the United States and not imported into the United States.

270 (Passed by Council 11/2006-TF-C1)

Section supports, in principle, reducing litigation cost and increasing predictability of patent infringement litigation outcomes in cases involving willful infringement allegations; and, Section supports amending 35 U.S.C. §284 to implement the following changes relating to the law of willful patent infringement –

- (1)A court that has determined that the infringer has willfully infringed a patent or patents in suit may increase the damages up to three times the amount found or assessed, provided, however, that increased damages under this section shall not apply to provisional rights under section 154(d) of this title

(2) A court may find that an infringer has willfully infringed a patent only if the patent owner presents clear and convincing evidence that:

(A) after receiving written notice from the patentee (i) alleging acts of infringement in a manner sufficient to give the infringer an objectively reasonable apprehension of suit on such patent, and (ii) identifying with particularity each claim of the patent, each product or process that the patent owner alleges infringes the patent, and the relationship of such product or process to such claim, the infringer, after reasonable opportunity to investigate, thereafter performed one or more of the alleged acts of infringement; or

(B) the infringer intentionally copied the patented invention with knowledge that it was patented; or

(C) after having been found by a court to have infringed the patent, the infringer engaged in conduct that was not colorably different from the conduct previously found to have infringed the patent, and which resulted in a separate finding of infringement of the same patent.

(3) A court shall not find that an infringer has willfully infringed a patent under paragraph (2) for any period of time during which the infringer had a good faith belief that the patent was invalid, unenforceable or would not be infringed by the conduct later shown to constitute infringement of the patent. Reasonable reliance on advice of counsel shall establish an informed good faith belief within the meaning of this section. The absence of the advice of counsel, or the decision of the infringer to not present evidence of such advice of council, however, shall have no relevance to determining the existence of willful infringement.

(4) Discovery related solely to willful infringement issues and trial thereof shall not take place, prior to the date that a final determination has been made that the patent in suit is not invalid, or unenforceable and has been infringed by the infringer.

(5) An appeal to the Court of Appeals for the Federal Circuit may be taken from a judgment of a district court in patent cases which is final except for an accounting or determination of willful infringement.

270 (Passed 2007-R102-5)

Section opposes, in principle, statutory provisions adopting a rule that any sale of an item outside of the United States exhausts United States patent rights; and

NOW THEREFORE, the Section opposes the enactment of provisions of S. 242 (H.R. 380), 110th Congress, the "Pharmaceutical Market Access and Drug Safety Act of 2007" and other similar legislation, that adopt such a rule.

270 (Passed by Council 7/2007-R101-5/102-5)

Section opposes, in principle, statutory provisions adopting a rule that any sale of an item outside of the United States exhausts United States patent rights; and

NOW THEREFORE, the Section opposes the enactment of provisions of S.242 (H.R. 380), 110th Congress, the "Pharmaceutical Market Access and Drug Safety Act of 2007" and other similar legislation, that adopt such a rule.

270 (Passed by Council 4/2009-R108-1A)

Section opposes in principle any interpretation of Section 271(f) of title 35, United States Code, that prohibits the exportation from the United States of products that are specifically adapted to be used in the practice of a process patented in the United States, and that are intended to be used in the practice of the domestically patented process in a foreign country.

270 (Passed by Council 4/2009-Patent Law Reform Task Force TF-1)

Section supports in principle legislation that a finding of willful patent infringement requires a finding by the court that the infringer acted with “objective recklessness,” and NOW THEREFORE, the Section supports the amendment of 35 U.S.C. § 284 by including subsections (c)(2) and (c)(3), as set forth in Section 4 of S.515, 111th Congress, and subsection (e)(2), as set forth in Section 5 of H.R.1260, 111th Congress.

272 (Passed 1967 S.SP 101-ABA 67____; **Retained 1997; Retained 2007**)

ABA approves legislation by which (a) the licensable nature of patent rights would be clarified by specifically stating in the patent statute that applications for patents, patents, or any interests therein may be licensed in the whole, or in any specified part, of the field of use to which the subject matter of the claims of the patent are directly applicable, (b) a patent owner shall not be deemed guilty of a patent misuse merely because he agreed to a contractual provision or imposed a condition on a licensee, which has (1) a direct relation to the disclosure and claims of the patent, and (2) the performance of which is reasonable under the circumstances to secure to the patent owner the full benefit of his invention and patent grant; (c) it is made clear that the "rule of reason" shall constitute the guideline for determining patent misuse. Be it Further Resolved, that the Section is authorized to communicate this action to members and committees of Congress and to others concerned with enactment of legislation to which the subject matter of this resolution is enacted.

272 (Passed 1989 SP50-R403-6; ABA 90M___ in amended form; **Retained 2001**)

ABA favors, in principle, legislation such as H.R.469, 101st Congress, 1st session (1989) (Fish) and S. 270, 101st Congress, 1st session (1989) (Leahy) which provides that intellectual property rights shall not be presumed to define a market or to establish market power in actions under the antitrust laws; Resolved the ABA recommends such legislation cover specifically the licensing of or refusal to license such rights.

272 (Passed 1991 AR80-R104-1; **Retained 2002**)

Section favors in principle enactment of legislation eliminating for the purpose of antitrust law enforcement any presumption of market power, including economic power, or monopoly power by virtue of mere ownership of a United States patent, copyright, or mask work, or of a trademark.

272 (Passed 2004-R108-7)

Section opposes in principle the proposition that the courts and the PTO should “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 monopolies.

272 (Passed 2004-R409-1)

Section opposes in principle the proposition that the courts and the PTO should “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 monopolies.

272 (Passed 2004-R409-2)

Section 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.

272 (Passed by Council 7/2007-R101-6/160-1)

Section opposes in principle, statutory provisions making it per se illegal for any person, in connection with the sale of a drug product, to directly or indirectly be a party to any agreement resolving or settling a patent infringement claim when an abbreviated new drug application (ANDA) filer receives anything of value in exchange for the ANDA filer's agreement not to research, develop, manufacture, market, or sell the ANDA product for any period of time; and NOW THEREFORE, the Section opposes the enactment of the "Preserve Access to Affordable Generics Act" S.316, 110th Congress as introduced on January 17, 2007.

274 (Passed 1993 AR127-R108-30; **Retained 2004**)

Section opposes in principle diminution of the 35 U.S.C. §284 requirement for an award of "damages adequate to compensate for the infringement but in no event less than a reasonable royalty", together with interest and costs.

274 (Passed 5/94 R-AH-1; mail vote; **Readopted 2006**)

Section favors, in principle, that a patentee should not be precluded as a matter of law from recovering lost profits damages under 35 U.S.C. §284 because the patentee is not selling products covered by the patent it is enforcing.

274 (Passed by Council 5/97; AR38-R101-7; **Retained 2007**)

Section favors, in principle, amendment of 35 U.S.C. § 284 to eliminate provisions providing for discriminatory treatment with respect to the enforcement of patents claiming "medical activities," and, Specifically, the Section supports the repeal of the patent amendments in Section 616 of the Omnibus Appropriations Act of 1996 (H.R. 3610, 104th Congress).

274 (Passed 2000 AR83 -R108-7)

Section approves, in principle, amendment of the marking provision of the patent statute, 35 U.S.C. §287(a), to provide that constructive notice is given when a patent owner marks the patented product with information sufficient to allow the public to readily obtain a list of the patents that pertain to that product.

274 (Passed 2004-R101-2)

Section opposes, in principle, legislation that would require a patent owner to provide a particular form of notice to an infringer as a condition precedent to recovery of enhanced damages based on a finding of willful infringement.

274 (Passed 5/2005-Patent Law Reform Task Force TF-14B)

Section opposes, in principle, legislation to limit the award of damages for patent infringement to exclude value attributable to elements known in the prior art; and Specifically, the Section opposes amendment of 35 U.S.C. § 284 to provide that if an invention is incorporated into, or is made part of, a method or apparatus otherwise known in the art, or is an approved method or apparatus including within it elements otherwise known in the art, then any award of a reasonable royalty or other damages shall be based only upon such portion of the total value of the method or apparatus as is attributable to the invention alone and shall not include value attributable to the method, apparatus, or elements otherwise known in the art or contributed by the infringer or its licensors.

274 (Passed 8/2005-Patent Law Reform Task Force TF-14C)

Section opposes, in principle, determination of which elements of a claim were the inventive contribution, in determining damages, and Specifically, the Section opposes legislation providing that a determination of a reasonable royalty in the case of a combination invention shall consider, where relevant and among other factors, the portion of the realizable profit that should be credited to the inventive contribution as distinguished from other claimed features of the combination; and Past Resolution TF-14A is hereby rescinded.

274 (Passed 2005-Patent Law Reform Task Force TF-16A)

Section opposes, in principle, awarding monetary damages in lieu of an injunction upon a finding of infringement of a valid patent; and Specifically, the Section opposes amending 35 U.S.C. § 283 to change the presumption and burden of proof for grant of a permanent injunction, whereby a permanent injunction would be granted only if a court finds that “the patentee is likely to suffer irreparable harm that cannot be remedied by the payment of money damages” and further where “the extent to which the patentee makes use of the invention” is a factor to be considered against grant of an injunction.

274 (Passed 2005-Patent Law Reform Task Force TF-16B)

Section favors, in principle, granting of permanent injunctions in patent infringement actions under the principles of equity as expressed in 35 U.S.C. Section 283, and Specifically, the Section opposes legislation providing that, in determining equity for purposes of granting a permanent injunction for patent infringement, the court shall consider the fairness of the remedy in light of all the facts and the relevant interests of the parties associated with the invention, and further opposes such provisions in H.R. 2795 or other similar legislation.

274 (Passed 2005-Patent Law Reform Task Force TF-16C)

Section opposes, in principle, proposed statutory provisions to mandate a stay of a permanent injunction pending appeal in a patent infringement action merely on an affirmative showing that the stay would not result in irreparable harm to the owner of the patent and that the balance of hardships from the stay does not favor the owner of the patent; and Specifically, the Section opposes enactment of such provisions in H.R. 2795, “The Patent Act of 2005” or similar legislation.

274 (Passed by Council 11/2006-TF-C2)

Section opposes, in principle, changing the law regarding awarding attorney fees in patent cases, to create a presumption in favor of an award of fees to the prevailing party; and, Section opposes amending 35 U.S.C §285 along the lines proposed in S.3818 , 109th Congress, 2d Sess. (2006) (Hatch-Leahy), or similar legislation, to mandate such an award together with other expenses incurred by that party in connection with that proceeding, unless the court finds that the position

of the non-prevailing party or parties was substantially justified or that special circumstances make an award unjust.

274 (Passed by Council Conference Call 12/2006-TF-B1)

Section opposes, in principle, a statutory provision requiring that, in determining reasonable-royalty damages for patent infringement, a court must consider the economic value attributable to novel and non-obvious features of the claimed invention as distinguished from the economic value attributable to other features, improvements added by the infringer, and the business risks the infringer undertook in commercialization; and Section opposes the amendments to 35 U.S.C. §284 that would be implemented by Section 5(a) of S.3818, 109th Congress, 2d Sess. (2006) (Hatch-Leahy), or similar legislation.

274 (Passed by Council 4/2007; Patent Law Reform Task Force TF-1)

Section favors, in principle, that, in appropriate circumstances, when determining damages based on a reasonable royalty for patent infringement, an apportionment be made of the value of the use of the invention by the infringer when such apportionment is necessary to assure that the royalty does not exceed the value properly attributable to the use made of the invention;

NOW THEREFORE, the Section favors an apportionment that excludes from the reasonable royalty determination the value attributable to the infringer's incorporation into the infringing product or process of features or improvements, whether or not themselves patented, that contribute value to the infringing product or process that is separate from the value properly attributable to the use made of the invention; with the following conditions:

- (a) the court should identify all factors relevant to the determination of a reasonable royalty for patent infringement and the court or the jury, as the case may be, should consider such factors in making the determination;
- (b) the burden of proof should be on the infringer to establish the need for such an apportionment and any exclusion to be made from the royalty determination as a result of the apportionment; and
- (c) where the use made of the invention is the basis for market demand for an infringing product or process, the royalty may be based upon the entire market value of the products or processes provided to satisfy that demand.

274 (Passed by Council 4/2009-Patent Law Reform Task Force TF-3)

Section supports in principle legislation to make clear that a patentee is not required to seek a preliminary injunction to be entitled to recover enhanced damages for infringement which occurs after the filing of the complaint for infringement of the patent in suit;

NOW THEREFORE, the Section proposes that language be added to Section 4 of S.515 and Section 5 of H.R.1260, 111th Congress to specify that a patent owner shall not be denied the opportunity to seek enhanced damages due to willful infringement for activities of the infringer occurring after suit has been brought merely because the patent owner has not sought a preliminary injunction against such activities.

274 (Passed by Council 4/2009-Patent Law Reform Task Force TF-4)

Section favors, in principle, that when determining damages for patent infringement, the court should identify those factors relevant to the determination of damages for patent infringement and only those factors should be considered in making the determination of damages;

NOW THEREFORE, the Section of Intellectual Property Law favors the adoption of a procedure, in appropriate cases, by which the court should be required to identify the methodologies and factors relevant to the determination of damages in the particular case, and the court or jury, as the case may be, should be required to employ only those methodologies and factors in making the determination of damages, under the following conditions:

(a) upon motion or submission of either party, the court should determine whether one or more of the methodologies and factors submitted by a party lacks a legally sufficient evidentiary basis, considering the evidence adduced or expected to be adduced at trial.

(b) after providing the parties the opportunity to be heard, and after any further submission of evidence, briefing, or argument on legal sufficiency that the court deems appropriate, the court should identify on the record the legal standards and factual contentions relevant to the determination of damages under the facts of the case, together with the court's rationale for submitting any challenged standards to the jury or the court for consideration.

276 (Passed 1983 SP 73-R401-4; **Retained 1998; Retained as Amended 2008**)

Section favors in principle enactment of amendments to 15 USC 1071(a) and 35 USC 141 which would give the Trademark Trial and Appeal Board and the Board of Patent Appeals and Interferences, respectively, authority to certify that an interlocutory order involves a controlling question of law as to which there is substantial ground for difference of opinion and that an immediate appeal to the Court of Appeals for the Federal Circuit from the order may materially advance the ultimate termination of the proceeding.

276 (Passed by Council Conference Call 11/96; AR114-R103-7; **Readopted 2007**)

Section favors, in principle, providing patent applicants on appeal as a matter of right with the opportunity to file a reply brief replying to positions expressed in the examiner's answers.

278 (Passed 1996 AR75-R101-9; **Readopted 2007**)

Section favors in principle amending Section 1498(a) of Title 28, United States Code (28 U.S.C. §1498(a)) to provide that in actions against the United States for compensation for the use of an invention, patent owners may recover costs, including reasonable attorney fees and expert witness fees, against the United States government irrespective of their status as independent inventors, non-profit organizations or entities with less than 500 employees, and Specifically, the Section supports amendments to S. 880, 104th Cong., 1st Sess. (1995)(Hutchison) and H.R. 632, 104th Cong., 1st Sess. (1995) (Frost) to eliminate the provision limiting the award of costs to patent owners that are "an independent inventor, a non-profit organization, or an entity that had no more than 500 employees at any time during the 5-year period preceding the use or manufacture of the patented invention by or for the United States."

280 (Passed 1989 SP43-R105-1; **Retained 2000; Retained 2010**)

Section favors in principle the undertaking of a study by the Department of Commerce Office of Technology Policy of ways in which United States Government patent policy can be changed or more effectively used to better promote commercial utilization of technology resulting from government funded research or development efforts.

280 (Passed 1992 AR63-R101-1; **Retained 2003**)

Section supports in principle legislation confirming the intent of Congress that states and state agencies are subject in Federal Court to all remedies available in infringement actions under the patent laws of the United States; and Specifically, the Section favors enactment of S. 758, 102d Cong., 1st Sess. (1991) (DeConcini), or similar legislation, abrogating state immunity from liability for patent infringement.

280 (Passed 1992 AR64-R101-2; **Retained 2003**)

Section supports in principle legislation confirming the intent of Congress that states and state agencies are subject in Federal Court to all remedies available in infringement actions under the plant variety protection laws of the United States; and Specifically, the Section favors enactment

of S. 758, 102d Cong., 1st Sess. (1991) (DeConcini), or similar legislation, abrogating state immunity from liability for infringement of the plant variety protection laws of the United States.

284 (Passed 1976 SP 81-R5; ABA 77A___; **Retained 1997; Retained 2007**)

ABA opposes in principle the adoption of any agency regulations or the enactment of legislation which automatically vests in or transfers to the government title to inventions conceived or first reduced to practice by the contractor under a government research and development contract, or which would require a waiver by such contractor of such title as a prerequisite to award of the contract.

284 (Passed 1976 SP 81-R6; ABA 77A___; **Retained 1997; Retained 2007**)

ABA opposes in principle the adoption of agency regulations or the enactment of legislation which would require access to, or mandatory licensing of, a contractor's background patents as a prerequisite to approval of a government research and development contract.

284 (Passed 1984 SP 63-R406-4; **Retained 1999; Retained 2009**)

Section favors in principle that title to data developed under a Government contract should remain with the contractor with a non-exclusive royalty free license to the Government to use for government purposes.

284 (Passed 1985 SP 40-R107-1; **Retained 1999**)

Section favors in principle the presumption that confidential technical data and computer software disclosed to agencies of the United States Government under contracts with the Government remain the property of the contractor unless the agency can demonstrate that unlimited rights in the agency are necessary to accomplish the objective of the contract under which the data was obtained.

284 (Passed 1992 AR117-R107-1; **Retained 2003**)

Section favors, in principle, the establishment of federal acquisition regulations which provide standard clauses having differing rights in technical data terms applicable to basic research contracts, to hardware development contracts, to hardware production contracts, and to supply contracts.

284 (Passed 1992 AR117-R107-2; **Retained 2003**)

Section favors, in principle, the establishment of federal acquisition regulations which would permit the negotiation of rights in technical data as an alternative to the use of standard clauses defining rights in technical data.

284 (Passed 1992 AR117-R107-3; **Retained 2003**)

Section favors, in principle, the establishment of federal acquisition regulations under which rights in computer software and computer software documentation are addressed in a clause separate and apart from that applicable to rights in technical data.

284 (Passed 1992 AR118-R107-5; **Retained 2003**)

Section favors, in principle, the establishment of federal acquisition regulations under which the rights of a contractor or subcontractor in proprietary technical data are established independently of the Government's competitive procurement needs.

284 (Passed 1992 AR118-R107-6; **Retained 2003**)

Section favors, in principle, the establishment of federal acquisition regulations which permit contractors and subcontractors under Government contracts to propose alternative methods of meeting Government competitive procurement needs, in lieu of the delivery of technical data and the grant of rights in technical data to the Government.

284 (Passed 1992 AR118-R107-7; **Retained 2003**)

Section favors, in principle, the establishment of federal acquisition regulations which require the Government to pay royalties for the procurement use of technical data packages provided by contractors or subcontractors under Government Contracts.

284 (Passed 1995 AR133-R107-1; **Readopted 2006**)

Section favors, in principle, protection of U.S. contractors from unfair dissemination of their technical data and computer software by the United States government, and Specifically, favors the adoption in the Defense Federal Acquisition Regulations of a provision specifying that in the event the government enters an international cooperative development program utilizing U.S. contractor technical data, the government shall protect against the undue dissemination of such data by specifying that its international partners can use the data only for project purposes.

284 (Passed by Council 2/2007; R158-1)

Section opposes, in principle, any policy to the extent that it would prohibit or otherwise discourage the filing or the enforcement of patents on inventions relating to genotype-phenotype datasets obtained from Genome-Wide Association Studies (“GWAS”) and placed into a centralized NIH GWAS data repository; and

NOW THEREFORE, the Section opposes Section IV of the Proposed Policy of the National Institute of Health (NIH) for Sharing of Data Obtained in NIH Supported or Conducted Genome-Wide Association Studies (GWAS) (Request for Information No. NOT-OD-06-094) to the extent that it could be interpreted to be inconsistent with this principle.

288 (Passed 1941 SP 20-ABA 1941; **Retained 1997; Retained 2007**)

It is the sense of the Section that the encouragement of invention and technological improvements is essential to our national defense and our economic well being; that laws which have the effect of decreasing the reward to inventors and those who finance new developments, at a time when the increased complexity of science and industry has made the development of inventions vastly more costly and more hazardous, are to be deprecated; and that our national tax policy should be based upon the principle that the progress of science and the useful arts can be promoted only by a minimizing of the difficulties of new enterprise.

288 (Passed 1991 AR296-R651-4; **Retained 2002**)

Section favors in principle that, should any reduced patent fees for small entities be eliminated, small entities be entitled to a tax credit for one-half of the fees paid to the Patent and Trademark Office in connection with the filing and prosecution of patent applications and the maintenance of issued patents.

288 (Passed 2002-R406-1)

Section supports making the federal research tax credit (Internal Revenue Code §41) permanent (without expiration).

300 (Passed 1983 SP 65-R305-5; **Retained 1998; Retained 2008**)

Section favors in principle legislation providing for the protection of ornamental designs of useful articles that does not extend or limit the term of available protection under copyright law for works incorporated in a useful article.

300 (Passed 1993 AR259-R305-1; **Retained 2004**)

Section opposes in principle any requirement that an applicant for a design patent include a description in the specification of the nature and intended use of the design sought to be patented, unless it is made clear in the requirement that such description is not limiting of the scope of the claimed design, but is merely required as an aid in classifying the application.

300 (Passed 1993 AR259-R305-2; **Retained 2004**)

Section favors in principle that applicants for design patents be permitted to use color photographs in design patent applications.

300 (Passed 1993 AR259-R305-3; **Retained 2004**)

Section favors in principle that applicants for design patents be permitted to use photographs and line drawings in the same design patent application.

300 (Passed 1993 AR286-R351-1; **Retained 2004**)

Section favors in principle the convenience, simplicity and economy for a design owner to be able to file in the owner's national office the International Design Registration (IDR) Application under the Hague Agreement concerning the International Deposit of Industrial Designs; and Specifically, the Section favors the option to file an application at the U.S. Patent and Trademark Office (PTO) to obtain that date as the international filing date and to complete national security review, with the PTO promptly forwarding the reviewed application to the World Intellectual Property Organization (WIPO) to initiate processing of the IDR application.

300 (Passed 1998 AR247-R351-1; **Retained 2008**)

Section favors in principle revision of the Hague Agreement Concerning the International Deposit of Industrial Designs, to the extent it is compatible with U.S. design patent law, and it is in agreement with U.S. State Department policy on membership of Intergovernmental Organizations, to provide centralized filing of design patent applications with provisions accommodating novelty examination countries, and specifically favors U.S. adherence to a treaty embodying the Draft New Act of the Hague Agreement Concerning the International Registration of Industrial Designs, WIPO Document H/CE/VII/2 (Sept. 3, 1997).

300 (Passed 2000 AR255 -R412-1)

Section favors, in principle, United States ratification of the Geneva Act of the Hague Agreement Concerning the International Registration of the International Registration of Industrial Designs; and Specifically, the Section supports the filing of International Registration applications in the U. S. Patent and Trademark Office, as provided in article 4(1)(b), and that the United States does not not permit an International Registration deferment of publication, an option given under article 11.

300 (Passed 2005-R412-1)

Section favors, in principle, the coordination of domestic and foreign protection of industrial designs; and Specifically, favors ratification by the United States of the Geneva Act of the Hague Agreement Concerning the International Registration of Industrial Designs.

300 (Passed at Section Business Session 8/2008; Council Resolution R-1A)

The Section, believing that there is sufficient need for greater intellectual property protection than is now available for fashion designs, supports, in principle, enactment of federal legislation to provide a new limited copyright-like protection for such designs.

310 (Passed 1984 SP 43-R110-1; **Retained 2000**)

Section reaffirms past action resolution 1976 SP 95 - R24 and favors the principle that the patent grant shall be made clearly applicable to all parts of patented plants, such as cut flowers; and Specifically, the Section favors amendment of 35 U.S.C. §163 by deleting from line 3 the word "asexually" and after "reproduced" in line 3 adding the words "or any part thereof".

310 (Passed 1990 SP91-R1002-1; **Retained 2001**)

Section opposes in principle legislation that would prohibit patents on plant varieties under 35 U.S.C. §101 or make the grant of such patents subject to compulsory licensing.

310 (Passed 1990 SP91-R1002-2; **Retained 2001**)

Section reaffirms in principle its support for broadening of the scope of the Plant Patent Act; and Specifically, the Section reaffirms resolutions 1976 SP94-R22(b) to delete language in 35 U.S.C. §161 which has denied patentability to tuber-prorogated plants; and 1984 SP 43-R110-1 to amend 35 U.S.C. §163 by deleting from line 3 the word "asexually" and after "reproduced" in line 3, by adding the words "or any part thereof".

310 (Passed 1990 SP91-R1002-4; **Retained 2001**)

Section favors in principle revising the UPOV Convention to prohibit member states from excluding some plant species from protection; and Specifically, the Section favors provision of varietal protection for all plant species without limitation.

310 (Passed 1990 SP91-R1002-5; **Retained 2001**)

Section favors in principle revising the UPOV Convention to provide for universal acceptance of examination of plant breeder's rights applications by member states; and Specifically, the Section favors elimination of the need for duplicative or multiple substantive examinations by different member states.

310 (Passed 1990 SP91-R1002-7; **Retained 2001**)

Section opposes in principle any revisions of the UPOV Convention which would establish a compulsory licensing system; and Specifically, the Section opposes revisions mandating that the owners of a plant breeder's right granted under the UPOV Convention shall have the right to obtain a compulsory license to use the industrial property of a third party relating to such variety.

310 (Passed 1991 AR374 -R1002-2; **Retained 2002**)

Section approves in principle Congressional legislation that would amend the Plant Variety Protection Act, 7 U.S.C. 2541 to eliminate state immunity from infringement of Plant Variety Protection Certificates.

310 (Passed by Council 1/92; AR31; **Retained 2003**)

Section approves in principle the interpretation of the "Right to Save Seed" provision of the Plant Variety Protection Act, 7 U.S.C. §2543, limiting the amount of seed of a protected variety which a farmer can save under that provision to that amount which the farmer reasonably expects to plant in the subsequent crop year.

310 (Passed 1992 AR64 -R101-2; **Retained 2003**)

Section supports in principle legislation confirming the intent of Congress that states and state agencies are subject in Federal Court to all remedies available in infringement actions under the plant variety protection laws of the United States; and Specifically, the Section favors enactment of S. 758, 102d Cong., 1st Sess. (1991) (DeConcini), or similar legislation, abrogating state immunity from liability for infringement of the plant variety protection laws of the United States.

310 (Passed 1992 AR413-R1002-1; **Retained 2003**)

Section favors in principle congressional legislation which would amend the Plant Variety Protection Act (7 U.S.C. 221 et seq.) to conform the Act to the provisions of the International Convention for the Protection of New Varieties of Plants (UPOV) as revised at Geneva on March 19, 1991; and Specifically, the Section favors amending the Act by (1) extending the term of protection from 18 to 20 years for all species of plant other than trees and vines, and in the case of trees and vines by extending the term from 18 to 25 years; (2) extending the scope of protection to include harvested material of protected plants such as flowers and fruit; (3) limiting the crop exemption by prohibiting the farmer's right to sell "saved seed" to other farmers; (4) expanding the definition of infringement to include a) reproduction of the protected variety and b) the sale of a variety derived from a protected variety if such contains expression of the essential characteristics of the protected variety.

310 (Passed 1993 AR417-R1002-1; **Retained 2004**)

Section supports in principle congressional legislation which would overrule the decision of the Court of Appeals for the Federal Circuit in Asgrow Seed Co. v. Winterboer, 982 F. 2d 486 (Fed. Cir. 1992), rehearing denied, 989 F. 2d 478 (Fed. Cir. 1993), by eliminating the exemption from plant variety protection infringement for farmers who sell seed of a protected variety, or limits that exemption consistent with the decision of the District Court in that case.

310 (Passed 1993 AR418-R1002-2; **Retained 2004**)

Section recommends that any congressional legislation which would amend the Plant Variety Protection Act (17 U.S.C. §2321 et seq.) to conform with the provisions of the International Convention for the Protection of New Varieties of Plants (UPOV) as revised at Geneva on March 19, 1991, be drafted consistent with the guidelines published by the UPOV Council.

310 (Passed 1999 AR400-R1002-1; **Retained 2009**)

Section favors in principle federal legislation that would broaden the scope of the Plant Patent Act; and Specifically the Section favors enactment of legislation amending 35 U.S.C. §161 to delete language which denies patentability to tuber propagated plants.

310 (Passed 2004-R1002-1)

Section opposes, in principle, any legislation specifically limiting the patentability of plant related inventions and enforcement of patents on such inventions; and Specifically, the Section opposes Section 3 of the International Seed Federation position paper on intellectual property.

310 (Passed 2004-R1002-2)

Section opposes, in principle, any breeders exemption for plants and seeds under 35 U.S.C. §101.

310 (Passed 2005-R1002-1)

Section opposes, in principle, any saved seed exemption for plants and seeds patented under 35 U.S.C. §101 et seq.

310 (Passed 2005-R1002-2)

Section 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, 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.

410 (Passed 1983 SP 57-R203-3; **Retained 1998; Retained as Amended 2008**)

Section favors in principle at least annual publication of revisions **being** made to the Trademark Manual of Examining Procedure so that it reflects current case law and office procedures.

410 (Passed 1986 SP 51-R203-2; **Retained 2000; Retained 2010**)

Section favors in principle continued public access without charge to and favors using appropriate funds to pay for the information in the U.S. Patent and Trademark Office Trademark Examining Operation which has historically been and currently is available to the public without charge.

410 (Passed 1986 SP 51-R203-5; ABA 87M___; **Retained 1999**)

ABA favors in principle the continued administration of all trademark matters within the United States Patent and Trademark Office by an Assistant Commissioner for Trademarks.

410 (Passed 1987 SP 70-R203-2; **Retained 2000; Retained 2010**)

Section favors in principle the Patent and Trademark Office publishing quarterly financial reports showing, in understandable form, how the trademark user fees are being accounted for and used to support the operations of the Office, and in particular, the automation process.

410 (Passed 1987 SP 70-R203-6; **Retained 2000**)

Section favors in principle permanent retention of records of at least all Trademark Trial and Appeal Board inter partes proceedings and published ex parte proceedings.

410 (Passed 2001 by Council E-mail vote AR25)

Section favors, in principle, that all revenue generated by fees paid by patent and trademark applicants and owners to the United States Patent and Trademark Office for application processing and other services be made promptly available to the USPTO without limitation to provide such services, and Specifically, the Section opposes the withholding or diversion of any such revenue to fund any unrelated programs.

420 (Passed 1997 AR106-R201-1; **Retained 2007**)

Section supports in principle amendments to sections 14(3) and 33(b) of the Lanham Act, 15 U.S.C. §§ 1064(3) & 1115(b) (1994), to ensure that "functionality" is recognized as a valid ground for the cancellation "at any time" of a federal trademark registration and that functionality remains a defense against the "conclusive" evidentiary presumptions attaching to a federally registered mark, the right to use which has become "incontestable" under section 15 of the Act, 15 U.S.C. § 1065 (1994).

420 (Passed 3/2006 by Council – R203-4)

Section favors, in principle, the adoption of the proposed Trademark Trial and Appeal Board (TTAB) rule change that would require the mandatory automatic initial disclosure in inter partes proceeding that are consistent with the documents and information required under Rule 26(a)(1) of the Federal Rules of Civil Procedure.

420 (Passed 3/2006 by Council – R203-5)

Section opposes, in principle, adoption of the list of mandatory automatic initial disclosures in inter partes proceeding proposed Trademark Trial and Appeal Board (TTAB) rule change listed in Federal Register Vol. 71, No. 10 as too overly broad.

420 (Passed 5/2006 by Council – R203-8)

Section opposes, in principle, the adoption in the Trademark Rules of Practice of a mandatory protective order upon the institution of all *inter partes* proceedings before the Trademark Trial and Appeal Board (TTAB) without sufficient safeguards for the parties' trade secrets and confidential information; and Specifically, the Section opposes the adoption of the Trademark Trial and Appeal Board (TTAB) rule change listed in Federal Register Vol. 71, No. 10, that requires the adoption of the Board's standard protective order unless this rule change also provides (1) that before adoption of the mandatory protective order, the parties will agree to reasonable limitations on the disclosure of such information, (2) that the order would survive the *inter partes* action, and (3) that there would be a mechanism to enforce the terms of the agreement on parties during or after the proceedings.

420 (Passed 5/2006 by Council – R203-9)

Section opposes, in principle, the amendment of the Trademark Rules of Practice to require the identification of expert witnesses in *inter partes* proceedings before the Trademark Trial and Appeal Board (TTAB) in a manner that would unreasonably increase the cost of *inter partes* proceedings and create uncertainty as to the nature and timing of those identifications; and Specifically, the Section opposes the adoption of the Trademark Trial and Appeal Board (TTAB) rule change listed in Federal Register Vol. 71, No. 10, that requires the identification of expert witnesses no later than ninety days prior to the close of the discovery period or promptly upon retention of the expert where this requirement (1) potentially would require parties to retain experts and develop their testimony before factual discovery is completed thereby unnecessarily driving up costs early in the proceeding, (2) does not differentiate between testifying and non-testifying experts thereby subjecting parties to disclosure of material commonly immune from disclosure on work product grounds, and (3) would allow the parties to retain experts after the disclosure deadline without guidance as to whether and how those witnesses may testify at trial.

425 (Passed 1996 AR199-R-204-1; **Retained 2007**)

Section favors the adoption by each of the states of the following model statute: Neither the reservation of any proposed corporate name, nor the acceptance of the filing of any articles of incorporation, nor the registration of any foreign corporation's name, nor the registration of an assumed name, shall authorize the use of such corporate or assumed name in violation of any rights of another arising under the trademark laws of the United States, this State, or the common law, or provide a defense to an action for violation of any such rights. Upon reserving any proposed corporate name, or upon accepting the filing of any articles of incorporation, or upon registering any foreign corporation's name, or upon registering any assumed name, The Secretary of State or appropriate governmental agency shall issue the following notice to the registrant (selecting the appropriate phrase from each bracket):

The Secretary of the State of _____ has [reserved your proposed corporate name; accepted the filing of your articles of incorporation; registered your corporate name; recorded your assumed name]. However, this does not necessarily give you the right to use your [proposed corporate name; corporate name; assumed name] in this State, if such use violates someone else's trade name, trademark, or service mark rights under the trademark laws of the United States, this State, or the common law. Prior to your use of the name, you are encouraged to research the names and marks of other parties used or registered in this State, or registered in the United States Patent and Trademark Office, and/or consult an attorney, to determine the existence of any such conflicting rights."

425 (Passed by Council Mail Poll 12/95; AR185-R201-1; **Readopted 2006**)

Section opposes in principle the passage of federal legislation restricting access to trademark protection to relocating sports clubs and franchises, or otherwise using trademark law principles to discourage the relocation of sports clubs and franchises.

425 (Passed 2001 AR202-R201-4)

Section favors, in principle, the proposition that a federally registered mark, registration of which has become incontestable under Section 15 of the Trademark Act, 15 U.S.C. § 1065, should not be presumed because of that incontestable status to be a strong mark for purposes of determining whether confusion is likely with another mark in an infringement action or otherwise.

425 (Passed 2009-R201-1)

Section favors in principle that willfulness is not required for an accounting of a defendant's profits under the Lanham Act, 15 USC §§ 1051 et seq.

425 (Passed 2009-R203-1)

Section recommends amendment of the Lanham Act precluding the United States Patent & Trademark Office from requiring a trademark applicant to disclaim a component of a mark sought to be registered

430 (Passed 1986 SP 52-R205-1; **Retained 2000**)

Section endorses the principle that titles of single literary works, motion pictures, theatrical plays, sound recordings and the like, which identify the source of products and satisfy the normal statutory tests for registrability, should not be barred from federal registration as trademarks on the sole ground that they have been used only on a single work.

430 (Passed 1988 SP 65-R205-1; **Retained 2000**)

Section favors in principle amendment of Sections 34, 35 and 36 of the Lanham Act to have their provisions applicable to all civil actions involving rights protected under the Lanham Act.

430 (Passed 1992 AR136-R201-1; **Retained 2003**)

Section favors in principle that the owner of a famous mark registered with the Patent and Trademark Office under the Trademark Acts of 1881 or 1905 or on the Principal Register of the Act of 1946, as amended, be entitled, subject to the principles of equity, to an injunction against another's use of a mark, beginning after the registrant's mark becomes famous, that causes dilution of the distinctive quality of the registrant's mark, regardless of the presence or absence of (a) competition between the parties, or (b) likelihood of confusion, mistake, or deception.

430 (Passed 1993 AR163-R201-3; **Retained 2004**)

Section favors in principle federal legislation which would permit a trademark licensee whose license is rejected pursuant to Section 365 of the Bankruptcy Code, either to treat the license as terminated by the rejection or to retain the rights to the licensed trademark.

430 (Passed 1997 AR111-R202-1; **Retained 2007**)

Section favors in principle the protection of well-known marks in a country based on the mark's reputation in that country without requiring use or registration of the mark in the particular country as a condition for protection.

430 (Passed by Council Conference Call 2/98; AR67-R201-2; **Retained 2008**)

Section favors in principle the passage of federal legislation confirming the registrability of nonfunctional and distinctive trade dress.

430 (Passed by Council Conference Call 2/98; AR67-R201-3; **Retained 2008**)

Section opposes in principle the passage of federal trademark legislation to codify a single and authoritative definition of "inherent distinctiveness" (or "inherently distinctive") as applied to trade dress.

430 (Passed by Council Conference Call 2/98; AR67-R201-4; **Retained 2008**)

Section opposes in principle the passage of federal legislation to codify a single and authoritative definition of "functionality" as applied to trade dress.

430 (Passed 2001 AR178-R201-1)

Section favors, in principle, the passage of federal legislation protecting the Right of Publicity of an individual to the extent the individual's identity is used for a commercial purpose in "commerce", as this term is defined in Section 45 of the Lanham Act, 15 U.S.C. § 1127, and to the extent that this federal legislation preempts state laws as of the date of its passage that are equivalent to or that exceed the provisions of this federal legislation.

430 (Passed 2001 AR202-R201-4)

Section favors, in principle, the proposition that a federally registered mark, registration of which has become incontestable under Section 15 of the Trademark Act, 15 U.S.C. § 1065, should not be presumed because of that incontestable status to be a strong mark for purposes of determining whether confusion is likely with another mark in an infringement action or otherwise.

430 (Passed 2001 AR553-R412-1)

Section favors, in principle, revision of the Lanham Act, 15 U.S.C. §§ 1051 - 1127, to state that there can be inherent distinctiveness of a non-functional product configuration when the general requirements for inherent distinctiveness applied to trade dress are met.

430 (Passed 2002-R201-1; ABA Board of Governors June 2002)

ABA supports interpretation and amendment of the federal Lanham Act to insure that questions of trademark dilution under that Act are uniformly resolved under the standard of whether the junior user's mark is likely to cause dilution of the senior user's mark, rather than a standard of actual dilution.

430 (Passed 2002-R201-2)

Section favors the passage of the following amendments to the federal Lanham Act:
Marks Registrable on the Principal Register

Section 2 (15 U.S.C.A. §1052)

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it –
* * *

(g) ~~A mark which~~ when used would likely cause dilution under section 43(c). However, a mark may be refused registration under this section only pursuant to a proceeding brought under section 13. A registration for a mark which when used would likely cause dilution under section 43(c) may be canceled pursuant to a proceeding brought under either section 14 or section 24.

Filing an Opposition

Section 13 (15 U.S.C.A. §1063)

(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register, including as a result of the likelihood of dilution under section 43(c), may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Director.

* * *

Cancellation

Section 14 (15 U.S.C.A. §1064)

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of the likelihood of dilution under section 43(c), by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905:

* * *

Registration on Supplemental Register

Section 23 (15 U.S.C.A. §1091)

(a) In addition to the principal register, the Director shall keep a continuation of the register provided in paragraph (b) of section 1 of the Act of March 19, 1920, entitled “An Act to give effect to certain provisions of the convention for the protection of trademarks and commercial names, made and signed in the city of Buenos Aires, in the Argentine Republic, August 20, 1910, and for other purposes,” to be called the supplemental register. All marks capable of distinguishing applicant’s goods or services and not registrable on the principal register herein provided, except those declared to be unregistrable under subsections (a), (b), (c), (d) ~~and~~, (e)(3) and (g) of section 2 of this Act, which are in lawful use in commerce by the owner thereof, on or in connection with any goods or services may be registered on the supplemental register upon the payment of the prescribed fee and compliance with the provisions of subsections (a) and (e) of section 1 so far as they are applicable. Nothing in this section shall prevent the registration on the supplemental register of a mark, capable of distinguishing the applicant’s goods or services and not registrable on the principal register under this Act, that is declared to be unregistrable under section 2(e)(3), if such mark has been in lawful use in commerce by the owner thereof, on or in connection with any goods or services, since before the date of the enactment of the North American Free Trade Agreement Implementation Act.

* * *

Publication; Not Subject to Opposition; Cancellation
Section 24 (15 U.S.C.A. §1092)

Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by registration of a mark on this register, including as a result of the likelihood of dilution under section 43(c), he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration.

* * *

Unregistered Marks; False or Misleading Descriptions and Representations
Section 43 (15 U.S.C.A. §1125)

* * *

Dilution of Famous Marks Forbidden

(c) (1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and ~~causes~~ is likely to cause dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to-

- (A) the degree of inherent or acquired distinctiveness of the mark;
- (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
- (C) the duration and extent of advertising and publicity of the mark;
- (D) the geographical extent of the trading area in which the mark is used;
- (E) the channels of trade for the goods or services with which the mark is used;
- (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;
- (G) the nature and extent of use of the same or similar marks by third parties; and
- (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

* * *

430 (Passed 2002-R201-4)

Section favors the principle that the degree to which protection would hinder competition shall be considered in determining the functionality of a product feature for which trade dress protection is sought.

430 (Passed 2003-R205-1)

Section rescinds its resolution of February, 1998, AR67-R201-3, which stated, "Section opposes in principle the passage of federal trademark legislation to codify a single and authoritative definition of "inherent distinctiveness" (or "inherently distinctive") as applied to trade dress.

430 (Passed 2003-R205-2)

Section opposes in principle the rule set forth in the decision *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000), that the design of a product can never be inherently distinctive as a matter of law.

430 (Passed 2003-R205-3)

Section favors in principle a rule that the design of a product may be inherently distinctive according to a standard derived from the standards in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342 (C.C.P.A. 1977), and *-Duraco Prods., Inc. v. Joy Plastic Enters., Ltd.*, 40 F.3d 1431, 1449, 32 U.S.P.Q.2d 1724, 1738 (3d Circ. 1994); and Specifically, the Section favors a rule that the design of a product may be inherently distinctive according to a combined *Seabrook-Duraco* standard considering the following five elements: 1) the trade dress is unusual and memorable, 2) it is conceptually separable from the product, 3) it is likely to serve primarily as a designator of origin of the product, 4) it is not a mere refinement of a commonly adopted and well-known form of configuration for a particular class of goods, and 5) it is capable of creating a commercial impression distinct from any accompanying words on the trade dress.

430 (Passed 2004-R201-2)

Section favors in principle that the Federal Trademark Dilution Act of 1995 (the “FTDA”), 15 U.S.C. §§ 1125(c), 1127, should be amended to state specifically that questions of trademark dilution can be supported by the theory of “tarnishment” as well as by the theory of “blurring”

430 (Passed 2004-R201-3)

Section favors, in principle, that the Federal Trademark Dilution Act of 1995 (the “FTDA”), 15 U.S.C. §§ 1125(c), 1127, should be amended to state that marks which have acquired distinctiveness from use in the marketplace are equally eligible for dilution protection under the Trademark Act to the same extent as marks that are inherently distinctive.

430 (Passed 2004-R201-4)

Section favors in principle that the Federal Trademark Dilution Act of 1995 (the “FTDA”), 15 U.S.C. §§ 1125(c), 1127, should not be amended at this time to state either that marks which are famous within limited geographic areas or commercial market segments are eligible for dilution protection under the Trademark Act to the same extent as marks that are famous on a nationwide basis, or to state that such marks are ineligible for dilution protection under the Act.

430 (Passed by Council 2/2005-R201-1)

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, 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.

430 (Passed by Council 2/2005-R201-2)

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, 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.”

430 (Passed by Council 2/2005-R201-3)

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.

430 (Passed by Council 2/2005-R201-4)

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.

430 (Passed by Council 2/2005-R201-5)

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.

430 (Passed by Council 2/2005-R201-6)

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.”

430 (Passed by Council 2/2005-R201-7)

Section favors, in principle, legislation prohibiting the trafficking in 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; and Specifically, favors the Stop Counterfeiting in Manufactured Goods Act, H.R. 32, 109th Congress, 1st Sess. (2005) (Knollenberg).

430 (Passed 2006-R205-1)

Section opposes, in principle, the complete exclusion of all famous marks in the form of trade dress, including product configuration, from potential protection under the federal trademark dilution law.

450 (Passed 1989 SP44-R204-1; **Retained 2000**)

Section favors in principle the adoption by each of the States of a uniform state trademark application form and the promulgation by each State of rules (or the enactment of laws) accepting typewritten state trademark applications, the models for which could be supplied by the Section upon request of the Secretaries of State.

450 (Passed 1991 AR128-R204-2; **Retained 2002**)

Section opposes in principle any state legislation which purports to create any substantive trademark rights based upon an intention to use a mark in the future.

450 (Passed 1992 AR160-R204-1; **Retained 2003**)

Section favors in principle the adoption by each of the states of an appropriate uniform statute clarifying, and requiring notice to interested parties, that the approval of corporate and assumed names by the applicable state agency does not authorize use of such names in violation of any preexisting trademark or trade name rights.

455 (Passed 1990 SP91-R-AH2; **Retained 2001**)

Section opposes in principle the inclusion in any international intellectual property agreement of mandatory protection for appellations of origin unless such protection is currently within the ambit of the Lanham Act (Title 15 U.S.C. Chapter 22) or other United States law.

455 (Passed 1990 SP80-R-AH4; **Retained 2001**)

Section opposes in principle the inclusion in any international trade related agreement to which the United States adheres, such as the GATT, of a prohibition on a requirement of use prior to the registration of a trademark or service mark.

455 (Passed 1991 AR114-Jt. Res. 202-1/203-1/255-1; Amended & Approved by ABA 01A116C; **Retained 2002**)

ABA urges the United States to adhere to the Protocol to the Madrid Agreement for the International Registration of Trademarks, adopted in Madrid, Spain on June 27, 1989, and the amendment of the Lanham Act, 15 U.S.C. § 1051 et. seq. (1994 & Supp. II 1996), to the minimum extent required for United States adherence.

455 (Passed 1996 AR293-R-255-1; **Retained 2007**)

Section favors in principle the adherence by the United States to the Trademark Law Treaty, adopted in Geneva, Switzerland, on October 27, 1994, and amendment of the Trademark Act of 1946 as amended by the Trademark Law Revision Act of 1988 ("the Lanham Act") to the minimum extent required for adherence to the said Treaty.

455 (Passed 2000 AR114 -R202-1)

Section favors, in principle, enhanced international protection for well-known marks; and, Specifically, the Section supports (1) the timely adoption into the laws of other countries of the provisions contained in the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks adopted in September, 1999 by a joint session of the Assembly of the Paris Union and the General Assembly of WIPO, (2) United States action to persuade other countries to modify their laws to provide greater protection for well-known marks, (3) United States support for an international treaty that reflects the provisions contained in the Joint Recommendation Concerning Provisions on the Protection of Well-Known Marks.

455 (Passed 2002-R202-1)

Section opposes in principle the reopening of negotiations by the Trade-Related Aspects of Intellectual Property Rights (TRIPs) Council with respect to the issue of geographical indications.

455 (Passed 2002-R202-2)

Section opposes in principle the expansion of protection of geographical indications under the Trade-Related Aspects of Intellectual Property Rights (TRIPs) Agreement to products other than wines and spirits.

455 (Passed 2002-R202-3)

Section favors the principle that geographic indications (appellations of origin) should not be accorded legal precedence over trademark rights; and Further Resolved, that the Section opposes in principle the creation of a mandatory multinational system of notification and registration of geographic indications for wines and spirits, or any other products; and Specifically, the Section favors that, in any individual country that may adopt a national system of protection of geographic indications (appellations of origin); that (a) such system

be implemented only by global notification thereof, and (b) any such geographic indications (appellations of origin) neither be accorded legal precedence over trademark rights, nor impose any enforcement obligations on other countries, nor provide a defense to a charge of infringement of prior trademark rights.

460 (Passed 1996 AR192-R-201-4; **Retained 2007**)

Section favors in principle an amendment to Section 526 of the Tariff Act of 1930 eliminating the requirement in that statute that gray market merchandise must be of "foreign manufacture" in order to be barred from importation.

460 (Passed 1997 AR155-R205-1; **Retained 2007**)

Section opposes, in principle, any federal statutory requirement that the owner of a federal registration use a trademark registration notice or give actual notice of a registration as a prerequisite to obtaining monetary recoveries under the Lanham Act and, therefore, Specifically favors the repeal of that part of Section 29 of the Lanham Act, 15 U.S.C. §1111 which is inconsistent therewith, namely that part following the initial occurrence of "®".

460 (Passed 2001 AR199-R201-3)

Section opposes, in principle, Senate Bill S.2359 that would seek to allow entry into the United States of what would otherwise be "restricted gray market articles," if (1) such articles bear multiple trademarks or trade names, and (2) any one of the trademarks or trade names is owned in the United States by a company affiliated with a foreign owner of any other mark appearing on the product.

460 (Passed 2001 AR652-R605-1)

Section opposes, in principle, any *per se* rule that bars trade dress protection solely because of the existence of a utility patent.

460 (Passed by Council 3/2006 – R203-2)

Section favors, in principle, adoption of the proposed Trademark Trial and Appeal Board (TTAB) rule change that would require an opposer or petitioner filing a complaint with the Board to concurrently serve a copy of its complaint (notice of opposition or petition for cancellation), including any exhibits, on the owner of record, or the domestic representative therefor, of the defending application or registration, or the attorney of record of a pending application.

460 (Passed by Council 3/2006 – R203-3)

Section opposes the adoption of the proposed Trademark Trial and Appeal Board (TTAB) rule change that would permit an opposer or petitioner filing a complaint with the Board to concurrently serve a copy of its complaint (notice of opposition or petition for cancellation), including any exhibits, on the attorney of record of a registered mark unless the attorney has agreed to accept such service on behalf of the defendant.

460 (Passed by Council 3/2006 – R203-6)

Section opposes, in principle, the adoption of the proposed Trademark Trial and Appeal Board (TTAB) rule change that would limit the number of interrogatories that a party can propound upon other parties to 25 including subparts as too limiting.

460 (Passed by Council 3/2006 – R203-7)

Section favors, in principle, the proposed Trademark Trial and Appeal Board (TTAB) rule change that would remove from the Trademark Rule 2.126, 37 CFR 2.126 the option to file submissions in CD-ROM format.

460 (Passed by Council 6/2009-R201-2)

Section favors in principle amending Section 35 of the Trademark Act of 1946 (15 U.S.C. §1117) to insure that reasonable attorney's fees are available under 15 U.S.C. §1117(b) to plaintiffs electing to pursue statutory damages under either 15 U.S.C. §1117(c) or 15 U.S.C. §1117(d).

465 (Passed 1995 AR189-R202-1; **Readopted 2006**)

Section favors, in principle, equal treatment to domestic and foreign nationals who own domestic registered trademarks which are properly recorded at U.S. Customs and, specifically, favors amendment of §526 of the Tariff Act of 1930, as amended, (19 U.S.C. §1526) and §133.21 et seq. of the Customs Regulations (19 C.F.R. §133.21) to so provide.

525 (Passed 1989 SP72-R308-2; **Retained 2000**)

Section is opposed in principle to copyrights in numbers or names per se by which state statutes are identified.

525 (Passed 1991 AR346-R702-1; **Retained 2002**)

Section favors in principle equal treatment of and protection for published and unpublished automated databases registered under the group update provisions contained in 37 C.F.R. §202.3(b)(4); and Specifically, the Section favors amendment of 17 U.S.C. §410(d) and existing Copyright Office practices to permit the effective date of registration under 37 C.F.R. §202.3(b)(4) for a group update to a published or unpublished automated database to be the earliest publication or creation date, whichever is applicable, for the group update period covered by the application, provided that the Copyright Office receives a complete application within three months of the final date in that period.

525 (Passed 1999 AR190-R301-1)

Section reaffirms its opposition in principle to exemptions in copyright law enforcement permitting the unremunerated use of musical works in business establishments; and Specifically, favors legislation to repeal the expanded exemptions enacted in amendments 17 U.S.C. " 110(5), by Title II of P.L. 105-298, regarding non-dramatic public performances of copyrighted musical compositions, and to repeal the provisions permitting proceedings to be filed in Federal District Courts in eleven locations, in order to contest the "reasonableness" of license fees paid to performing rights organizations.

530 (Passed 1989 SP64-R701-1; **Retained 2000**)

Section opposes in principle any exclusion of software expression from copyright protection merely because the software implements, or is part of, a patented process, and opposes in principle any exclusion of software from patent protection merely because the software expression is protected by copyright.

530 (Passed 1992 AR244-R306-1/703-1; **Retained 2003**)

Section favors in principle providing appropriate compensation to copyright owners through legislation requiring importers and manufacturers of digital audio recording devices and media to pay a statutory royalty thereon, and requiring manufacturers of such devices to incorporate in

such devices a Serial Copy Management System limiting the number of copies that can be made from initial copies of original digital audio source material; and Specifically, the Section approves S. 1623, 102d Cong., 1st Sess. (1991) (DeConcini), H.R. 3204, 102d Cong., 1st Sess. (1991) (Brooks and Hughes), and H.R. 4567, 102d Cong., 2nd Sess. (1992) (Collins), or similar legislation, relating to audio home recording.

530 (Passed 1995 AR274-R301-1; **Readopted 2006**)

Section opposes, in principle, the broadening of the existing exemptions in 17 U.S.C. §110(5) regarding nondramatic public performances of copyrighted musical compositions or the interference in existing marketplace relations between interested parties by requiring mandatory arbitration of license fees, reduction of available remedies for infringement, and imposition of standard forms of licenses and license terms; and Specifically, opposes H.R. 789, 104th Cong., 1st Sess. (Sensenbrenner).

530 (Passed 1997 AR487-R753-1; **Retained 2007**)

Section favors, in principle, that the educational community be provided a set of reasonable standards for use of copyrighted works in noncommercial educational activities; and Specifically, the Section endorses the Fair Use Guidelines For Educational Multimedia, prepared by the Educational Multimedia Fair Use Guidelines Development Committee, dated July 17, 1996, which represent an interpretation of the fair use provisions of the Copyright Act agreed upon by the overwhelming majority of educational institutions and copyright organizations concerned with educational multimedia.

530 (Passed 2001 AR22-R301-1)

Section favors, in principle, amendments to the copyright law to exempt certain reasonable and limited uses of copyrighted materials as part of systematic mediated instructional activities in distance education by non-profit educational institutions utilizing advancements in digital technologies, while providing adequate protection against infringement of those materials; and, Specifically, the Section favors enactment of S. 487, 107th Congress, 1st Sess. (2001) (Leahy and Hatch, “Technology Education and Copyright Harmonization Act of 2001”), as passed by the Senate on June 7, 2001, or similar legislation.

530 (Passed 2001 AR795-R755-2)

Section opposes, in principle, any measure that would grant blanket immunity for performances of musical works to owners of embodiments of musical works or to third party custodians of centralized repositories of on-line accessible copies of those musical works.

530 (passed by Council Conference Call 10/2008; Copyright Law Reform Task Force CRTF-3)

Section supports in principle legislation to limit the remedies available in copyright infringement suits against users of orphan works who make a good faith, reasonably diligent effort to identify and locate the copyright owners of such works without success, provided that the legislation preserves the ability of copyright owners to obtain meaningful relief, including meaningful compensation for use of orphan works, regardless of the category of work or the nature of the user.

530 (Passed by Council 4/2009-Copyright Law Reform Task Force CRTF-5)

Section supports the principle that a party reproduces copyrighted video programs within the meaning of 17 U.S.C. section 106(1) when it designs, houses, and maintains a system whereby unauthorized copies of the copyrighted video programs supplied by that party are made and stored on that party’s data storage device and controlled by that party for later transmission to

and viewing by others, and that party may not avoid direct infringement liability for unauthorized reproduction of those copyrighted programs by utilizing a centralized, automated electronic means and reducing or eliminating the utilization of human agents in the production of such individual copies; and

NOW THEREFORE, the Section disapproves of the holding in *The Cartoon Network LP et al. v. CSC Holdings, Inc. et al.*, 536 F.3d 121 (2d Cir. 2008), *petition for cert. filed sub nom. Cable News Network, Inc. v. CSC Holdings*, that a cable company that knowingly and systematically solicits customer requests for unauthorized copies of video programs that are supplied by the cable company is not liable for direct infringement when the individual copies are made in response to customers' requests to the centralized electronic copying system designed and employed by the company for that purpose rather than through the direct involvement of a human agent.

530 (Passed by Council 4/2009-Copyright Law Reform Task Force CRTF-6)

Section supports the principle that the transmission or other communication of a copyrighted work to the public by means of any device or process is a public performance, regardless of whether members of the public capable of receiving the performance receive it in the same place or in separate places and at the same time or at different times, and a party may not avoid direct liability for unauthorized public performances by using as the source thereof separate copies of the work that members of the public may have requested for such transmission; and

NOW THEREFORE, the Section disapproves of the holding in *The Cartoon Network LP et al. v. CSC Holdings, Inc. et al.*, 536 F.3d 121 (2d Cir. 2008), *application for cert. filed sub nom. Cable News Network, Inc. v. CSC Holdings*, that a cable company that knowingly and systematically solicits customer requests for the making of unauthorized copies of video programs, and for the unauthorized transmission thereof to customers upon their later request, can avoid direct liability for unauthorized public performance of the programs because it makes each such transmission from a separate copy of the program made at the customer's request.

530 (Passed by Council 4/2009-Copyright Law Reform Task Force CRTF-7)

Section supports the principle that the statutory license provided to cable operators in section 111 of the Copyright Act allows nonsimultaneous secondary transmissions of copyrighted programs only under carefully circumscribed conditions that require, inter alia, that any such program is transmitted no more than one time to the cable system's subscribers, that it is transmitted without deletion or editing, and that the cable company prevents the unauthorized duplication of the copy it makes to facilitate a permissible nonsimultaneous secondary transmission; and

NOW THEREFORE, the Section supports the interpretation of section 111 that a cable company exceeds the scope of the statutory license thereunder when it knowingly and systematically solicits customer requests for unauthorized copies of video programs that it transmits, produces such copies, and then transmits the programs to customers upon request at a later time.

535 (Passed 1939 SP 10, 28-ABA 1940; **Retained 1997**; **Retained 2007**)

Section disapproves private Congressional bills to extend the lives of particular patents or copyrights.

535 (Passed 2002-R301-1)

Section supports the principle that Congress has the power under the Copyright Clause (Article I, section 8, clause 8) of the United States Constitution to extend the term of existing copyrights; and Specifically, the Section favors the position that the Copyright Term Extension Act (Title I, P.L. 105-298) does not violate, and is fully in accordance with, the Copyright Clause and the First Amendment of the United States Constitution.

540 (Passed 1992 AR381-R702-1; **Retained 2003**)

Section favors in principle the establishment in the EC of minimum standards for adequate and effective copyright protection for databases; and Specifically, the Section approves the proposed EC Directive of Legal Protection of Databases, dated January 29, 1992, but only if such modifications are made as may be necessary to assure that the entire Directive conforms to international norms of copyright protection under the Berne Convention and the GATT/TRIPS Agreement, and the Directive is made clear and unambiguous.

540 (Passed 1992 AR382-R702-2; **Retained 2003**)

Section favors in principle international copyright protection of databases and other compilations whose contents are data or materials, whether or not individually copyrightable per se, rather than protection for any non-copyrightable contents under a sui generis approach diluting worldwide standards of intellectual property protection; and Specifically, the Section disapproves Articles 2(5), 8, 9(3), 9(4) and 11 of the proposed EC Directive on the Legal Protection of Databases, dated January 29, 1992.

540 (Passed 1997 AR219-R302-3; **Retained 2007**)

Section favors in principle an ambitious program of copyright training for developing countries, and specifically, the Section supports the copyright training programs of the World Intellectual Property Organization and the United Nations Educational, Scientific, and Cultural Organization (UNESCO) and urges the United States government and the U.S. private sector to undertake such programs.

550 (Passed 1991 AR212-R401-6; **Retained 2002**)

Section opposes in principle any special venue provisions for copyright infringement actions; and, Specifically, the Section favors the repeal of 28 U.S.C. §1400(a), leaving venue in copyright infringement actions to determination under the general venue statute, 28 U.S.C. §1391.

550 (Passed by Council 6/2009-R310-1)

Section favors in principle that, when the deposit, application and fee for registration of a claim of copyright in a United States work have been delivered to the Copyright Office in proper form, an action for infringement of the copyright in the work may be instituted in an appropriate federal court.

570 (Passed 1955 SP 36-ABA 1956; **Retained 1997; Retained 2007**)

Section approves the principle that the government and agencies should be liable for copyright infringement, and that copyright proprietors should have appropriate remedies against the government and its agencies for such infringement on a basis comparable to those available in actions against private citizens. Specifically, Section approves H.R. 6716 insofar as it embodies this principle.

570 (Passed 1985 SP 52-R308-1; ABA, in amended form, 88M___; **Retained 1999; Retained 2010**)

ABA opposes in principle state exemption from liability for damages and/or equitable relief in private actions brought under the United States patent, trademark and copyright laws.

570 (Passed 1987 SP 71-R308-1; **Retained 1999; Retained 2010**)

Section favors in principle having states, and state departments, state universities, and state administrative agencies, be liable for copyright infringement and favors the holding in Mills Music, Inc. v. Arizona, 591 F.2d 1278 (9th Cir. 1979).

570 (Passed 1988 SP 67-R308-1; **Retained 1999**)

Section favors in principle an amendment by Congress to the United States Copyright Act to make it explicit that Congress intended to abrogate state immunity from liability for infringement.

570 (Passed 1989 SP44-R308-1; **Retained 2000**)

Section opposes in principle the exertion of control in the nature of copyright, quasi-copyright, license, or unreasonable financial or media restrictions, by government agencies on the availability or distribution of inherently governmental works, such as judicial decisions, statutes, legislative records, attorney general opinions, and the rules or decisions of administrative or regulatory agencies, or public information contained in government maintained records such as corporate records or UCC files, unless such works or information properly fall under existing exceptions to public disclosure such as those relative to security, law enforcement or personal information.

570 (Passed 1992 AR117-R107-3; **Retained 2003**)

Section favors, in principle, the establishment of federal acquisition regulations under which rights in computer software and computer software documentation are addressed in a clause separate and apart from that applicable to rights in technical data.

600 (Passed 1988 SP 67-R404-1; **Retained 1999**)

Section approves in principle efforts to influence and promote legislation in foreign countries which would afford protection against, and penalties for, unauthorized use or disclosure of trade secrets.

700 (Passed 1987 SP 70-R206-1; **Retained 1999**)

Section favors in principle continued insistence by the U.S. Government during governmental bilateral and multilateral trade talks on the inclusion of strong provisions for the protection and enforcement of intellectual property rights, including those relating to trade secrets, in all multilateral and bilateral agreements.

700 (Passed 1992 AR408-R1001-1; **Retained 2003**)

Section opposes in principle in any treaty relating to the protection of biological diversity any provision which would have as its purpose or effect, the elimination or dilution of the protection of intellectual property.

700 (Passed 1992 AR408-R1001-2; **Retained 2003**)

Section opposes in principle in any treaty relating to the protection of biological diversity a provision which would require or permit national legislation to compel the transfer of technology, whether through compulsory licenses or any other means, except in the following circumstances: (1) to address, only during its existence, a declared national emergency; (2) to remedy an adjudicated violation of a country's antitrust laws; or (3) to permit the use of technology which is subject to intellectual property protection on a non-exclusive basis by a government and only for governmental purposes.

700 (Passed by Council 1/93 AR27-R456-3; **Retained 2004**)

Section favors in principle ratification of an appropriate agreement among the United States, Canada and Mexico which includes strong provisions for the protection and enforcement of intellectual property rights in the three countries; and Specifically, the Section approves in

general the intellectual property provisions of the North American Free Trade Agreement (NAFTA).

700 (Passed 1993 AR93-R102-2; **Retained 2004**)

Section maintaining as open and public, those portions of trade treaty negotiations which relate to patents, and Specifically, the Section favors prompt public announcement of, and free public access to, positions under consideration by the United States, regarding such portions of trade treaty negotiations.

700 (Passed by Council 1/94 AR30-R456-1; **Readopted 2006**)

Section favors in principle the inclusion in a multilateral trade agreement of strong provisions for the adequate and effective protection and enforcement of intellectual property rights in countries party to the agreement; and Specifically, the Section approves in general the Agreement on Trade-Related Aspects of Intellectual Property Rights including Trade In Counterfeit Goods (TRIPS) included in the Final Act embodying the Results of the Uruguay Round of Multilateral Trade Negotiations dated December 15, 1993.

700 (Passed by Council 5/94 AR36-R456-1; **Readopted, as Amended, 2006**)

Section favors in principle efforts by the United States government to ~~accelerate~~ secure compliance with the TRIPs agreement by the members of the World Trade Organization, and further, the Section favors in principle legislation conditioning entitlement to the benefits of the Generalized System of Preferences on ~~accelerating~~ compliance with the requirements of TRIPs relating to standards and enforcement of intellectual property rights, and Specifically, the Section supports S. 2041, 103rd Congress, 2nd Session (1994) (Lautenberg) or any similar legislation.

700 (Passed 1995 AR94-R102-9/302-1; **Readopted, as Amended, 2006**)

Section favors, in principle, the strengthening of intellectual property rights throughout the world and the adequate and effective enforcement of those rights; and Specifically, favors, and commends the continuing efforts of the United States Government to secure, adequate and effective enforcement of intellectual property rights in the People's Republic of China, as evidenced by the agreement that the United States obtained from the People's Republic of China on February 26, 1995, and subsequent agreements with the United States.

700 (Passed 1996 AR335-R-351-1; **Retained 2007**)

Section favors in principle an inter-governmental review of national procedures and laws that would interface under the Hague Agreement for the International Deposit of Industrial Designs, to consider the operation and benefits of the national systems and possible improvements; and Specifically, the Section recommends that the U.S. Patent and Trademark Office (PTO) convene a tri-lateral meeting of the PTO, Japanese Patent Office and European Union representatives to discuss these subjects.

700 (Passed by Council via mail poll 6/97; AR67-R102-9; **Retained 2007**)

Section favors, in principle, that the use of color in the drawings of international applications be permitted where necessary to show technical features, and specifically, the Section favors a change in the PCT Regulations which would allow applicants to file drawings which show technical features in color provided that the drawings of such do not have to be published in color.

700 (Passed 2000 AR387-R757-4; **Retained 2010**)

Section favors, in principle, an amendment of European Patent Convention to ensure that that software and business method inventions, as well as other inventions related to electronic commerce, are considered patentable subject matter under the Convention and to harmonize European practice with that in the United States and Japan.

700 (Passed 2001 AR628-R601-2)

Section favors, in principle, the United States Government's continuing to negotiate the Hague Convention On Jurisdiction and Foreign Judgments In Civil and Commercial Matters, but proposes that the United States Government reject the Draft of said Hague Convention that was operative as of October, 2000.

700 (Passed 2004-R102-5)

Section favors, in principle, that the Community Patent should be a cost-effective alternative to the current European Patent System; and
Specifically the Section favors that the claims of a Community Patent only be required to be translated into the official EPO languages of English, French and German, in order to avoid additional costs and administrative complexity and opposes translating the issued claims into all European Community languages.

700 (Passed by Council 7/2007-R101-3/102-3)

Section reaffirms its support, in general, to the Patent Law Treaty as completed in Geneva on June 1, 2000, without reservation; and
NOW THEREFORE, the Section favors ratification of the Patent Law Treaty by the United States Senate but opposes the reservation under Article 23 of the PLT as requested by the President in the Congressional Record on September 5, 2006 pages S8977-8978, which reservation would prevent the unity of invention standard as set forth in the Patent Cooperation Treaty to be applicable to national applications filed in the USPTO.

700 (Passed by Council 7/2007-R101-4/102-4)

Section reaffirms its support, in general, to the Patent Law Treaty as completed in Geneva on June 1, 2000; and
NOW THEREFORE, the Section supports patent legislation consistent with the PLT for restoring the right of priority for a period not to exceed two months when the failure to file a claim of priority during the priority period was due to unintentional delay.

700 (Passed by Council 6/2009-R102-X)

Section favors, in principle, that the United States take such steps as are necessary for full implementation of the Patent Law Treaty ("PLT") that was signed on behalf of the United States on June 2, 2000 and that was ratified by the Senate on December 7, 2007; and
NOW THEREFORE, the Section favors the prompt introduction and passage into law of implementing legislation in substantially the form proposed by the United States Patent and Trademark Office and transmitted to the Senate and House of Representatives on July 16, 2007, and urges the Congress and the administration to take such other steps as are necessary or desirable to insure that the PLT enters into force in the United States as soon as practicable.

701 (Passed 1963 SP 45-ABA 1963; **Retained 1997**; **Retained 2007**)

Section is of the view that, where some of the contracting parties of the Paris Convention relating to industrial property may establish international patent rights effective in their respective territories, the principle of national treatment embodied in Article 2 of the Convention applies to

said international patent rights and operates for the benefit of nationals of all contracting parties of the Paris Convention with respect to participation in said rights.

701 (Passed 1975 SP 79-ABA 76M___ -R4; **Retained 1997; Retained 2007**)

ABA strongly opposes any modification of the principles of national treatment and the right of priority presently contained in the Paris Convention for the Protection of Industrial Property.

701 (Passed 1976 SP 113-R51 - ABA 78M___; **Retained 1997; Retained 2007**)

ABA opposes any revision of the Paris Convention for the Protection of Industrial Property which would oblige any state party to the Convention to grant, without reciprocity, to applicants for industrial property rights who are nationals of any other state party to the Convention, treatment in respect of the protection of industrial property more favorable than that which such first mentioned state grants to its own nationals.

701 (Passed 1992 AR68-R102-1; **Retained 2003**)

Section favors in principle granting to an applicant for a U.S. utility patent the benefits of the Paris Convention for the Protection of Industrial Property based upon a prior application of that applicant filed in the United States.

702 (Passed 1983 SP 49-R103-4; **Retained 1998; Retained 2008**)

Section favors in principle the adoption of a United States Patent and Trademark Office practice of uniform interpretation of 37 CFR §1.141 for both national and international applications in accordance with Rule 13.2 of the Patent Cooperation Treaty.

702 (Passed 1997 AR61-R102-1; **Retained 2007**)

Section favors in principle that the Regulations under the Patent Cooperation Treaty (PCT) be amended to provide that it be possible for PCT applicants to avoid abandonment of a PCT application in cases where a Chapter II demand is filed with an International Preliminary Examining Authority ("IPEA") that is not "competent" as that term is defined in Articles 31 and 32 of the Patent Cooperation Treaty and in Rule 59 of the Regulations under the PCT; and Specifically, that the effect of filing a Chapter II demand in a "non-competent" IPEA shall be that the demand is transferred to a competent IPEA upon payment of a fee.

702 (Passed 1998 AR21-R102-4; **Retained 2008**)

Section of Intellectual Property Law favors, in principle, permitting access by third parties to all documents of record in the file of international patent applications throughout the period of enforceability of any patent granted thereon; and, specifically, favors a requirement in the PCT Rules that each Receiving Office, each International Searching Authority, each International Preliminary Examining Authority, and the International Bureau maintain in its files and make available to any person, for at least 30 years from the priority date of any international application, all papers it has received or prepared regarding that application.

702 (Passed 1999 AR101-R101-2; **Retained 2009**)

Section favors, in principle, the operation of United States patent practice according to the Unity of Invention standard that is currently applied to International Applications under the PCT, and Specifically, favors legislation replacing the provisions of Title 35, U.S.C. relating to U.S. restriction practice with provisions setting out the International PCT Practice relating to Unity of Invention.

702 (Passed 2000 AR27-R102-20)

Section favors, in principle, that the United States Patent and Trademark Office (“USPTO”) shall not require any document or evidence relating to the applicant’s entitlement, as of the international filing date, to apply for and be granted a U.S. patent, if a declaration as to that matter, in accordance with U.S. assignment law, is contained in the PCT Request or is submitted directly to the USPTO as a designated National Office, unless it has reasonable doubts as to the veracity of the declaration concerned, so as to have the USPTO consistent with all other PCT member States, and specifically favors the adoption of an amendment of the PCT Regulations accordingly.

702 (Passed 2002-R102-1)

Section supports in principle the extension of the time limit under Chapter I of the Patent Cooperation Treaty (PCT) for international applications to enter into the national stage to that currently available under Chapter II of the PCT; and Specifically, the Section favors the amendment of 35 U.S.C. §371 to provide an applicant with the option, at no charge, of delaying the entry into the national stage of an international application designating the United States under Chapter I of the PCT from twenty (20) months to thirty (30) months.

702 (Passed 2002-R102-6)

Section opposes, in principle, any measure or practice implemented by the European Patent Office which discriminates against Patent Cooperation Treaty (PCT) Applicants of United States origin in the PCT examination process.

702 (Passed by Council 5/2006-R102-2)

Section opposes, in principle, the treatment being proposed by the United States Patent and Trademark Office under the proposed Changes to Practice for Continuing Applications, in connection with the two alternative methods of securing a U.S. patent from a PCT application, and Specifically, the Section opposes prohibiting the filing as a matter of right of a continuing application of a section 111 application that claims the benefit of the PCT application (by pass route), and only permitting the filing as a matter of right of a continuing application after the filing of an application that entered the National Stage under 35 U.S.C. 371 (perfection) except in the situation where the PCT application has both entered the National Stage under section 371 and sought the benefit of the PCT application in a filing under section 111 that claims the benefit of the PCT application.

702c (Passed 2002-R102-3)

Section favors, in principle, efforts by the members of the Patent Cooperation Treaty (PCT) designated as International Searching Authorities to standardize search objectives, databases, procedures, and reports within the context of PCT examination.

702c (Passed 2002-R102-4)

Section favors, in principle, establishing uniform quality control benchmark standards for searches completed within the context of PCT examination by members of the Patent Cooperation Treaty (PCT) designated as International Searching Authorities.

702c (Passed 2002-R102-5)

Section favors, in principle, establishing provisions for providing full faith and credit to PCT search reports that meet the uniform quality control benchmark standards of the PCT as provided by members of the Patent Cooperation Treaty that are designated as International Searching Authorities.

704 (Passed 1995 AR94-R102-6; **Readopted 2006**)

Section favors, in principle, the use by WIPO, the European Patent Office and the U.S. PTO of computerized documentation in the filing and prosecution of PCT applications; and Specifically, the Section favors a computerized documentation system for on-line filing of PCT applications at WIPO, the European Patent Office and the U.S. PTO.

705 (Passed 1990 SP32-R102-2; **Retained 2001**)

Section opposes in principle in any treaty relating to the international harmonization of provisions for the protection of inventions, any provision which requires a country to provide or maintain a system by which a patent may be revoked in administrative proceedings for reasons other than the effect of prior patents and printed publications on novelty or obviousness.

705 (Passed 1990 SP33-R102-3; **Retained 2001**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision which would prohibit pre-grant oppositions but would require each member state to grant third parties the right to cite prior patents and publications and submit arguments during the examination period of an application provided that such citations and arguments do not extend the duration of the examination and provided that the patent office shall not communicate with the third party.

705 (Passed 1990 SP55-R102-6; **Retained 2001**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision requiring that each contracting state provide at least the following remedies for infringement irrespective of whether or not the infringer possesses an improvement patent:

- (i) injunctive relief for infringement of a granted patent;
- (ii) pecuniary compensation to compensate for the actual damages suffered as a result of the infringement of a granted patent, but no less than a reasonable royalty, and which, at the option of a contracting state, may be increased up to threefold for willful cases of infringement; and
- (iii) pecuniary compensation for actual damages, but not less than a reasonable royalty, suffered for infringement of any claim of a published application provided that a claim of substantially the same scope is contained in the granted patent and the infringer is given or can be proved to have had actual notice of the infringement in sufficient detail to link the patent application in question with the particular infringing subject matter.

705 (Passed 1992 AR73-R102-8; **Defeated** by ABA 1993; **Retained 2003**)

Section approves in principle and recommends to the ABA House of Delegates the rescission of those two Resolutions of the Section that were adopted in 1967 by the Board of Governors and the House of Delegates, respectively, which read as follows:

1. "RESOLVED, that the American Bar Association is opposed in principle to: Any change in the law which would have the effect of awarding the patent only to the applicant who is the first to file his application."
2. "RESOLVED, that the American Bar Association approves in principle: Mutual efforts among foreign countries and the United States to improve the international operability of patent systems throughout the world, but opposes in principle changes in the United States patent statutes made to increase uniformity with

foreign patent systems, unless it be shown that such changes will favorably affect the domestic operation and effectiveness of the United States patent system."

FURTHER, the Section recommends and approves the replacement of the above-identified 1967 resolutions with the adoption as a basic policy statement of the American Bar Association of the Section's Resolution 102-1 of 1991, which reads as follows:

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle an amendment of the United States patent laws to provide that except in cases of derivation, the first-to-file a patent application among rival applicants for the same invention is the applicant entitled to a patent if, but only if, the foregoing be part of a patent harmonization treaty wherein other countries agree to changes in their systems sufficiently beneficial to United States applicants and their assignees."

705 (Passed 1993 AR470-R-SCH-Twenty-3; **Retained 2004**)

Section favors in principle should the United States adopt a first-to-file system, the recognition of prior user rights, provided that as a minimum:

1. such rights shall be in the nature of a personal defense against a claim based on any patent alleged to cover an activity of the prior user;
2. the prior user activity began prior to the earliest filing date to which the patent is entitled and, at the time of said earliest filing date such activity had not been abandoned;
3. the prior user activity was not based on information obtained or derived from the patentee or those in privity with the patentee;
4. the prior user activity took place within the territory covered by the patent;
5. prior to said earliest filing date the prior user had demonstrated operability of the invention covered by the patent and had taken significant steps toward its commercialization; and
6. such rights shall be available only to the party performing the activity on which the defense is based and to those in privity with such party; and shall be nonassignable and nontransferable except with a transfer of that part of the business of the party to which the activity pertains;

and further, the Section favors rescision of Resolution SP-131-R206-1 (1982) and recommends rescision of Resolution S.SP 27-ABA 1968.

705 (Passed 1993 AR471-R-SCH-Twenty-7; **Retained 2004**)

Section favors in principle rescision of Resolution S.SP 27-ABA 1968.

705 (Passed 2002-R101-8)

Section supports, in principle, that desirable changes to be enacted by any legislation to implement the Patent Law Treaty developed by the WIPO Standing Committee on the Law of Patents and adopted at the May 11 – June 2, 2000 Diplomatic Conference in Geneva not be delayed for perhaps a long period of time until the effective date of the Treaty; and

SPECIFICALLY, the Section favors that any legislation to implement the Patent Law Treaty have an effective date which does not depend on the status of the ratification of the Treaty.

705 (Passed 2006 – R102-3)

Section supports, in principle, in the context of ratification of an international harmonization treaty involving at least Japan and major European countries that is based on a first-inventor-to-file system and includes an international type grace period eliminating from prior art disclosures made by an inventor or by others who obtained the subject matter disclosed either directly or

indirectly from the inventor during the 12 months preceding the filing date, that there be limitations on the application of the grace period, and Specifically that such grace period should not apply to a publication resulting from the 18 month publication after filing of an application for a patent by an inventor or on his behalf.

705 (Passed – Council Conference Call 9/2006 – R102-1)

Section favors, in principle, the People’s Republic of China’s amending its patent laws to more closely harmonize those laws with the patent laws of most other industrialized nations and international patent law treaties; and Section favors the comments set forth in the August 29, 2006, report prepared by the joint task force of the Section of International Law and Section of Intellectual Property Law, joined by the Section of Science and Technology Law, in response to the Third Proposed Amendments to the Patent Law of the People’s Republic of China published on July 31, 2006.

705 (passed by Council Conference Call 10/2008; Joint Task Force with Section of International Law PRC-TF-01)

Section favors, in principle, the People’s Republic of China’s amending its patent laws to more closely harmonize those laws with the patent laws of most other industrialized nations and international patent law treaties; and
NOW THEREFORE, the Section endorses the October 12, 2008 report prepared by the joint task force of the American Bar Association Section of International Law and Section of Intellectual Property Law in response to the Third Proposed Amendments to the Patent Law of the People’s Republic of China published on August 29, 2008, and endorses transmittal of this report to the Peoples Republic of China.

750 (Passed 1939 SP 11-ABA 1940; **Retained 1997; Retained 2007**)

Section approved a bill amending R.S. 487 (U.S.C. Title 35, Sec. 11) to give the Commissioner of Patents power to protect inventors by establishing adequate standards of professional conduct among attorneys.

800 (Passed 1995 AR239-R205-1; **Readopted 2006**)

Section favors, in principle, uniform law(s) for the right of publicity.

900 (Passed 2003-R501-1)

Section approves that the Section Manual be revised to provide in “II. Committees, Organization and General Operation, A. Appointment of Committees,” a new first paragraph, which reads as follows:

The Chair-Elect appoints division and committee chairs for the year during which he or she will be Section Chair. These appointments are made sufficiently in advance of the Summer Conference that a Planning and Coordination Meeting of all division and committee chairs can be held at the Summer Conference. At this meeting the committee chairs present their plans for the year for purposes of coordination and interaction with the activities of other committees.

900 (Passed 2003-R501-2)

Section approves that a new committee designated as 413 – Licensing and Related Transactional Issues be established with five standing subcommittees as follows:

SUBCOMMITTEE A. Patent Licensing (including subject matter formerly in Committee 104)
SUBCOMMITTEE B. Trademark Licensing
SUBCOMMITTEE C. Copyright Licensing
SUBCOMMITTEE D. International Technology Transfer (formerly subject matter of Committee 404)
SUBCOMMITTEE E. Software Licensing; and that the scope of Committee 413 be as follows:
Scope of Committee: All issues relating to intellectual property licensing and other contracts involving the ownership, transfer or exchange of intellectual property rights, excluding security interests which are within the scope of Special Committee 457 and UCC issues which are under the scope of Special Committee 458 and excluding franchising issues which are within the scope of Committee 207.

900 (Passed 2003-R501-3)

Section approves that Special Committee 152 be abolished and that a new Committee 104 – Interferences, be established. The scope of this Committee would be as follows:

Scope of Committee: All aspects of interference practice within the USPTO and the Courts.

900 (Passed 2003-R501-4)

Section approves that Special Committee 553 Corporate Practice, be abolished and reinstated as permanent Committee 511 – Corporate Practice, and that the scope of this committee be as follows:

Scope of Committee: All aspects of intellectual property practice unique to corporate practitioners that do not specifically fall within the scope of another committee.

900 (Passed 2003-R501-5)

Section approves that the “Special” Committee on Patent Experts (655) be made permanent as Committee 606, that “Patent” be deleted from its title, and that the scope of this committee be as follows:

Scope of Committee: All aspects of expert testimony.

900 (Passed 2003-R501-7)

Section approves that the word “Data” in the Committee “Rights of Contractors with the Government” (401) be changed to “Proprietary” and that the scope of this committee be as follows:

Scope of Committee: Problems of all proprietary rights, including know-how and data, arising solely in connection with governmental contracts and policies, including:

- (1) legislation and regulation affecting the proprietary rights of contractors with the government;
- (2) breach of confidential obligation and misappropriation of know-how involved in governmental transactions;
- (3) transmittal of know-how and proprietary data to foreign countries by governmental agencies;
- (4) procurement policies of the various governmental agencies with respect to proprietary data of contractors; and
- (5) the effect on contractors with the government of any data bank which may be established on environmental technology.

900 (Passed by Council Conference Call 12/2006-605-1)

In the event a Petition for Writ of Certiorari is filed in the Supreme Court of the United States in the matter captioned *Amgen, Inc. v. Hoechst Marion Roussel, Inc. et al.*, Civ. No. 05-1157 (Fed. Cir. 2006), the Section shall request that the American Bar Association file an amicus brief in support of the grant of certiorari.

1000 (Passed by Council 5/90; ABA 6/90; **Retained 2001**)

Resolved that the American Bar Association favors, in principle, the continuation of the existing exclusion of lawyers from requirements of the Foreign Agents Registration Act of 1938; and specifically, the Association opposes the adoption of Section (c) of S.176 or equivalent.

1000 (Passed 1992 AR321-R507-1; **Retained 2003**)

Section favors in principle that the American Bar Association provide accreditation to appropriate providers of certificates of specialization.

1000 (Passed 1992 AR321-R507-2; **Retained 2003**)

Section favors in principle that the American Bar Association provide accreditation to appropriate providers of certificates of specialization in particular fields of intellectual property law.

1000 (Passed 1992 AR321-R507-3; **Retained 2003**)

Section opposes in principle the American Bar Association through its entities issuing individual certificates of specialization.

1000 (Passed 1996 AR192-R-201-3; **Retained 2007**)

Section favors in principle an amendment to Section 42 of the Lanham Act making clear that the Customs Service is obligated to block the importation of materially different gray market goods even when the U.S. and foreign owners of the trademark on the goods are under common ownership or control.

1000 (Passed 2000 AR186-R301-1; **Retained 2010**)

Section favors, in principle, that Congress give notice and conduct hearings on proposed substantive amendments to the Federal intellectual property laws.

1000 (Passed 2005-R703-1)

Section 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, supports H.R. 29, the SPY ACT in its form as proposed by Representatives Bono and Towns.

1000 (Passed 2006-R601-1)

Section approves, in principle, the proposed amendments to the Federal Rules of Civil Procedure respecting the discovery of electronically stored documents and information, which proposed amendments (a) were approved by the Judicial Conference of the United States on September 20, 2005, and (b) were promulgated by the Supreme Court and will go into effect on December 1, 2006, unless Congress intervenes, and Specifically, supports approval of the proposed amendments of:

- (1) Fed. R. Civ. P. 16 (Pretrial Conferences; Scheduling; Management) that would alert the court to the possible need to address the handling of discovery of electronically stored information early in the litigation if such discovery is expected to occur, and to incorporate provisions in the scheduling order that reflect any agreements that may minimize the risk of waiver of privilege or work-product protection;
- (2) Fed. R. Civ. P. 26(f) (General Provisions Governing Discovery; Duty of Disclosure) that would require that parties must discuss during the discovery-planning conference any issues relating to the disclosure and discovery of electronically stored information, including the form of production, also discuss issues relating to the preservation of electronically stored information and other information, and also discuss whether the parties can agree to production on terms that protect against privilege waiver;
- (3) Fed. R. Civ. P. 26(b)(2)(C) providing that a party need not provide electronically stored information in response to a discovery request if the information is not reasonably accessible, except that the court may order its production, with or without conditions, if the requesting party shows good cause;
- (4) Fed. R. Civ. P. 26(b)(5)(B) establishing a procedure for a party to assert that it has produced privileged information without intending to waive the privilege, by allowing the responding party to notify the receiving party, who must then return, sequester, or destroy the information and may not disclose it to third parties, pending the court's ruling, on a motion to compel or for protective order, whether the information is, in fact, privileged and whether any privilege has been waived or forfeited by production;
- (5) Fed. R. Civ. P. 33 (Interrogatories to Parties) to make it explicit that an answer to an interrogatory involving review of business records should involve a search of electronically stored information and permit the responding party to answer by providing access to that information;
- (6) Fed. R. Civ. P. 34 (Production of Documents and Things and Entry Upon Land for Inspection and Other Purposes) to provide a distinction between electronically stored information and "documents," expansively defining each to avoid limitation to existing technologies, and permitting the requesting party to specify the form in which electronically stored information is to be produced and permit the responding party to object to the requested form, and, if there is no request for any such specific form, allowing the producing party the option to either produce the information in a form in which it is ordinarily maintained, or in an electronically searchable form; and
- (7) Fed. R. Civ. P. 37 (Failure to Make Disclosure or Cooperate in Discovery; Sanctions) to add new subdivision (f) that protects a party from sanctions under the Civil Rules for failing to provide electronically stored information lost because of the routine operation of the party's computer system, but disallowing this "safe harbor" if the party violated an order issued in the action requiring it to preserve electronically stored information, or if the party failed to take reasonable steps to preserve the information after it knew or should have known the information was discoverable in the action. This new section addresses a necessary feature of computer systems – the automatic recycling, overwriting and alteration of electronically stored information.

1000 (Passed by Council Conference Call 7/2008; Copyright Law Reform Task Force CRTF-1) Section favors in principle the establishment of a permanent structure for coordination among U.S. government agencies to promote the effective enforcement of intellectual property laws within the United States and internationally, and NOW THEREFORE the Section supports the enactment of S. 522, 110th Congress (Bayh-Voinovich), or similar legislation.

1000 (Passed by Council 6/2009-R108-3)

Section favors in principle prohibiting the outsourcing of patent work to a foreign country without obtaining appropriate clearances from US government departments and agencies with export licensing responsibilities (such as the United States Department of Commerce, bureau of Industry and Security) if such outsourcing activity would violate such departments and agencies' regulations without a license or other authorization. This prohibition includes, but is not limited to, the prohibition of the outsourcing of patent application drafting and prosecution, patent drawings, patent proofing, patentability searches and opinions, and freedom-to-operate opinions. NOW THEREFORE, the Section favors efforts to revise ABA Formal Opinions 08-451 to address export regulations that may be implicated by the outsourcing of patent work.

1100a (Passed 2001 AR763-R702-1B)

Section favors, in principle, the adoption of federal legislation prohibiting the misappropriation of databases that would: (1) protect databases, including substantial parts thereof, that result from the investment of considerable human, technical or financial resources, from unauthorized distribution that causes injury to the producer of that database; (2) respect the legitimate interests of news reporters, educators, researchers, consumers and others by incorporating appropriate limitations and exceptions adapted from the "fair use doctrine" in the copyright law; (3) contain limitations on liability and remedies regarding nonprofit educational and scientific research institutions, nonprofit libraries and internet service providers; (4) provide a term of protection that encourages the creation, improvement and dissemination of databases; (5) protect the right of the public to use databases created by federal, state or local governments, while preserving the incentive for private parties to create value-added databases containing government information; (6) provide a private cause of action coupled with adequate remedies to compensate injured database producers and to deter future violations; (7) promote national uniformity by preempting equivalent state laws; and (8) apply to unlawful acts that occur after the effective date of the legislation with respect to databases created before or after the effective date, but not make unlawful acts of distribution after the effective date when the information was lawfully extracted from a database before the effective date.

1200 (Passed 1997 AR309-R457-2; Amended by Council 5/98 - Added language underscored; deleted language bracketed; **Retained 2008**)

Section opposes, in principle, any provisions in the [proposed] Uniform Commercial Code [Article 2B - Licenses ("UCC 2B")] which authorize the transfer of a licensee's interest in a license of intellectual property, to a third party having a financing interest in the licensee, without the consent of the licensor.

1200 (Passed 1997 AR309-R457-4; Amended by Council 5/98 - Added language underscored, deleted language bracketed; **Rescinded 1999**)

Section opposes, in principle, any provisions in the [proposed] Uniform Commercial Code [Article 2B - Licenses ("UCC 2B")] which render automatically unenforceable or ineffective, in a contractual license of intellectual property, a term restricting or prohibiting the transfer, creation, or enforcement of a security interest in said intellectual property.

1200 (Passed 1999 AR268-R457-2)

Section opposes, in principle, any provision in the Uniform Commercial Code which would render automatically unenforceable or ineffective, in a contractual license of intellectual property, a term restricting or prohibiting the transfer of, or enforcement of a security interest in, said license of intellectual property.

1200 (Passed 1999 AR268-R457-4)

Section opposes, in principle, any provision of the Uniform Commercial Code which renders automatically unenforceable or ineffective, in a contractual license of intellectual property, a term restricting or prohibiting the creation, attachment or perfection of a security interest in said license of intellectual property, unless said provision of the Uniform Commercial Code renders such a term unenforceable or ineffective only to the extent that the contractual restrictions or prohibitions would otherwise prevent creation, attachment or perfection of a security interest, and such provision of the Uniform Commercial Code does not: (a) make the security interest enforceable against the other party to the license, (b) impose a duty or obligation on the other party to the license, (c) require that the other party to the license recognize the security interest, pay or render performance to a secured party or accept payment or performance from the secured party, (d) entitle the secured party to use or assign the rights of the party granting the security interest, (e) entitle the secured party to use, assign, possess or have access to any trade secrets or confidential information of the other party to the license, or (f) entitle the secured party to enforce the security interest in the license; and Specifically, the Section approves Section 9-408 in the November 16, 1998 draft of Revised Article 9 of the Uniform Commercial Code.

1300 (Passed 2000 AR189-R302-1)

Section favors, in principle, that the identification of all domain name applicants be freely available to the public; and Specifically the Section favors a requirement by the Internet Corporation for Assigned Names and Numbers (ICANN) that all accredited domain name registrars provide continued, free access to "whois" information obtained from domain name applicants.

1300 (Passed 2000 AR360-R756-1)

Section favors, in principle, that any additional Top Level Domains ("gTLDs") be added in an orderly and fair manner, and with adequate protection for intellectual property rights.

1300 (**Defeated** 2006-R701-1)

Section favors, in principle, the survival of state laws, neutral as between intrastate and interstate commerce, that regulate the dissemination of spyware over the Internet against challenges based on the "dormant" Commerce Clause or the First Amendment.

1300 (Passed by Council Conference Call 9/2009-R254-1A)

Section favors in principle the implementation of procedures to protect the rights of trademark owners in conjunction with any proposed introduction of new generic top-level domains ("gTLDs"); and

NOW THEREFORE, in the event the Internet Corporation for Assigned Names and Number (ICANN) approves or introduces any new gTLDs, the Section favors the implementation of at least the following procedures to protect the rights of trademark owners in conjunction with ICANN's proposed launch of new gTLDs:

- I. the adoption of an “IP Clearinghouse” to centralize the storage and validation of data regarding the legal rights of trademark owners and to support registry operators in creating their own Rights Protection Mechanisms (RPMs);
- II. the adoption of a list of “Globally Protected Marks” (GPMs) with respect to which proposed gTLDs and second-level domain names that are identical and/or confusingly similar to GPMs would be barred;
- III. the adoption of a “Uniform Rapid Suspension System” (URS) that would allow trademark owners to quickly and inexpensively suspend domain name registrations that are identical or confusingly similar to identified registered trademark rights;
- IV. the adoption of a post-delegation dispute resolution mechanism that would allow trademark owners to challenge a gTLD registry’s violation of its agreements with ICANN with respect to protection of intellectual property rights; and
- V. the adoption of a “Thick WHOIS” database that would centralize into a single database detailed and accurate WHOIS information for every domain name registrant.

ARCHIVED RESOLUTIONS

210 (Passed 1989 SP51-R407-1; **Retained 2000; Archived 2010**)

Section favors in principle that the master plan of the USPTO for the Automated Systems include provisions in the planning and implementation thereof for public access to those automated patent and trademark data bases as they are deployed so that the public and the USPTO examiners have access to the same files.

210 (Passed 1989 SP51-R407-2A; **Retained 2000; Archived 2010**)

Section favors in principle that, with respect to any document access that is to be automated by the PTO, current capabilities for public access to such documents should be maintained until the automation of such document access is completed by the USPTO.

210 (Passed 1989 SP51-R407-3; **Retained 2000; Archived 2010**)

Section favors in principle that planning be undertaken by the USPTO for remote public access to the automated patent and trademark databases from outlying locations.

210 (Passed 1989 SP51-R407-5; **Retained 2000; Archived 2010**)

Section favors in principle, that the USPTO seek appropriated funds to improve maintenance of current search files and application file histories in the USPTO for public access pending full deployment of the automated patent and trademark data bases.

210 (Passed 1989 SP54-R408-1; **Retained 2000; Archived 2010**)

Section favors in principle the amendment of the Patent and Trademark Office rules to record security interests in patents, patent applications, applications for trademark registration, and registered trademarks, and of releases of such security interests, provided that the documents submitted for record adequately identify the applications, patents and registrations, and the parties.

210 (Passed 1989 SP54-R408-2; **Retained 2000; Archived 2010**)

Section favors in principle the prompt recorda by the PTO of documents relating to title, license and security interests in patents and trademarks, and the establishment of a publicly accessible database of the index to the recorded documents.

216 (Passed 1984 SP 69-R502-1; **Retained 2000; Archived 2010**)

Section favors in principle the adoption by the U.S. Patent and Trademark Office of the ABA Model Rules of Professional Conduct as disciplinary rules for those representing applicants and others before the Patent and Trademark Office and provide for (1) a Director of Enrollment and Discipline having responsibility for conducting investigations of possible violations of the disciplinary rules and, with the consent of the Committee on Discipline, initiating disciplinary proceedings; (2) a Committee on Discipline, which shall include the Director of Enrollment and Discipline, having the responsibility for determining whether there is probable cause to initiate disciplinary proceedings; and (3) an Administrative Law Judge to preside at hearings and render initial decisions in disciplinary proceedings.

218 (Passed 1999 AR404-R1004-2; **Archived 2010**)

Section opposes in principle the imposition by the United States Patent and Trademark Office of certain requirements in connection with the submission of information as part of an Information Disclosure Statement (IDS) in a patent application which could have unforeseen and unintended consequences during litigation involving the patent maturing from that application; and

Specifically, the Section opposes the implementation of Topics 9 and 10 of the ANPR or any similar measure.

218a (Passed 1988 SP 73-R605-1; **Retained 1999; Archived 2010**)

Section favors in principle the concept that 35 U.S.C. Section 112 does not and should not require patent application disclosures to include mechanical tolerances of any particular specimen or model embodying the invention beyond that sufficient to enable a person of ordinary skill in the art to which the invention pertains to make and use the invention utilizing the engineering of those of such ordinary skill; and, Specifically, the Section believes that the Federal Circuit opinion in *Christiansen v. Colt Industries* __ F2d __, 3 USPQ2nd 1241 (Fed. Cir. 1987) is essentially correct insofar as it concerns the disclosure requirements of 35 U.S.C. Section 112.

222 (Passed 1987 SP 66-R103-3; **Retained 1999; Archived 2010**)

Section favors in principle the enactment of legislation providing for the recordal by the Patent and Trademark Office of security interests in patent and trademarks and that this recordal shall preempt other places of recording and provide superior rights over later bona fide purchasers.

222 (Passed 1988 SP 67-R408-2; **Retained 1999; Archived 2010**)

Section favors in principle the enactment of legislation specifically providing for Patent and Trademark Office recordal of security interests in patents, and providing superior rights to the holders of such recorded security interests in patents over later bona fide purchasers.

222 (Passed 1988 SP 67-R408-3; **Retained 1999; Archived 2010**)

Section favors in principle the enactment of legislation specifically providing for Patent and Trademark Office recordal of security interests in registered trademarks and providing superior rights to the holders of such recorded security interests in registered trademarks over later bona fide purchasers.

222 (Passed 1988 SP 67-R408-4; **Retained 1999; Archived 2010**)

Section favors in principle limiting the fees for recordal of security interests to the cost of processing; and Specifically, the Section urges the Patent and Trademark Office to set the fee for recordal of security interests in trademarks and other marks at the cost of processing such recordal.

232 (Passed 1986 SP 80-R110-3; **Retained 2000; Archived 2010**)

Section favors in principle legislation which would amend Section 337 of the Tariff Act of 1930 (19 U.S.C. Section 1337), to define as an unfair trade act, the unauthorized importation of an article, which if made, produced, processed, or mined in the United States, would infringe a valid United States patent.

232 (Passed 2000 AR33 -R103-1; **Archived 2010**)

Section favors, in principle, maintaining the Statutory Invention Registration procedures set forth under 35 U.S.C. § 157 and 37 C.F.R. 1.293-1.297; and Specifically, that the Section favors maintaining the SIR procedures, even though the American Inventors' Protection Act of 1999 provides for publication of applications, at least until regulations governing publication are issued and evaluated.

261 (Passed 1986 SP 71-R402-3; **Retained 2000; Archived 2010**)

Section favors in principle the amendment of Rule 408 of the Federal Rules of Evidence, to expressly state that the prohibition on admissibility of evidence of conduct or statements made in compromise negotiations extends not only to parties, but also to any other person who may participate in the compromise negotiation including but not limited to arbitrators, mediators, and neutral advisors.

266 (Passed 1987 SP 72-R401-1; **Retained 2000; Archived 2010**)

Section favors in principle the enactment of legislation amending the written notice requirements of the third paragraph of 35 U.S.C. §282 to provide that the party asserting invalidity or non-infringement shall give the notice required by §282 in the pleadings or otherwise in writing to the adverse party at least 30 days prior to the date set by the district court by submission of a joint pretrial order, or 45 days prior to trial, whichever is earlier, and further to provide that prior art not contained in such notice shall be excluded from evidence except where the party asserting invalidity or non-infringement shows, to the satisfaction of the district court, that earlier notice could not have been given, and in that event or in any event where one of the parties shows unfair or prejudicial harm, the Court shall normally exercise its discretion in reopening or extending scheduled discovery or continuing a scheduled trial of the cause.

266 (Passed 1988 SP 67-R401-2; **Retained 2000; Archived 2010**)

Section favors in principle an amendment to Title 28, United States Code to provide that all papers may be filed with the United States courts using the "Express Mail Post Office to Addressee" service of the United States Postal Service and be considered as having been filed with the court on the date the paper is shown to have been deposited as "Express Mail" with the United States Postal Service using a procedure paralleling that of 37 C.F.R. Section 1.10.

274 (Passed 1984 SP 41-R401-1; **Retained 2000; Archived 2010**)

Section opposes in principle amendment of Rule 68 to require the payment of attorney fees of an adversary by a party who declines to accept the adversary's offer of judgment and Specifically, the Section opposes the proposed amendment to Rule 68 set forth in the preliminary draft of proposed amendment to the Federal Rules of Civil Procedure made by the Committee on Rules of Practice and Procedure of the Judicial Conference of the United States in August, 1983.

284 (Passed 1985 SP 40-R107-2; **Retained 1999; Archived 2010**)

Section favors in principle the establishment of an administrative appeal procedure for prompt resolution of conflict between the contractor and Contracting Officer concerning rights of the agency in technical data and computer software.

284 (Passed 1989 SP43-R107-1; **Retained 2000; Archived 2010**)

Section favors in principle the enactment of legislation and the establishment of federal procurement regulations which distinguish between the ownership of technical documents delivered under a contract and the ownership of proprietary rights in technical information embodied within the documents.

284 (Passed 1989 SP43-R107-2; **Retained 2000; Archived 2010**)

Section favors in principle the enactment of legislation and the establishment of federal acquisition regulations fully protective of contractor's proprietary rights in technical information created in whole or in part with contractor funds.

284 (Passed 1989 SP72-R107-3; **Retained 2000; Archived 2010**)

Section favors in principle the enactment of legislation and the establishment of federal acquisition regulations which preserve contractor's sole proprietary rights in technical information created with contractor funds only, irrespective of whether the technical information is used for the design or manufacture, or otherwise relates to an item, component or process subsequently developed with Government funds.

284 (Passed 1989 SP43-R107-5; **Retained 2000; Archived 2010**)

Section favors in principle the enactment of legislation and the establishment of federal acquisition regulations which limit the acquisition by the Government of technical documents or computer software embodying technical information created with contractor funds to cases where 1) the Government has identified a specific need for such documents or computer software, and 2) the need cannot be met through other means, such as direct licensing, or procurement under form, fit, and function or performance specifications.

284 (Passed 1989 SP43-R107-6; **Retained 2000; Archived 2010**)

Section opposes in principle any federal acquisition regulations which prevent contractors from affixing proprietary rights notices to documents embodying technical information created in whole or in part with contractor funds, and which, without the authorization of the contractor, permit the government to remove proprietary rights notices from such documents.

284 (Passed 1989 SP43-R107-7; **Retained 2000; Archived 2010**)

Section opposes in principle any federal procurement regulations which require evidentiary records for supporting contractor notifications, listings, justifications and representations, or the like, in respect of proprietary technical information created prior to the effective date of the regulation.

288 (Passed 1987 SP 73-R407-1; **Retained 1999; Archived 2010**)

Section favors in principle the enactment of legislation restoring the availability to individual holders of long term capital gains preference under 26 U.S.C. §1235; but in the absence of full restoration thereof, the Section favors, as a minimum objective for the stimulation of the creation and development of United States technology, the enactment of legislation providing long term capital gains preference for United States resident individual holders who create or invest in patentable inventions in the United States; and in addition, the Section favors in principle extending capital gain preference to individuals and small businesses who, even if not holders, invest in such inventions or in enterprises for the development in the United States under conditions of high risk.

410 (Passed 1986 SP 44-R203-6; **Retained 2000; Archived 2010**)

Section favors in principle the enactment of legislation amending the "Balanced Budget and Emergency Deficit Control Act of 1985", commonly referred to as Gramm-Rudman-Hollings, by including in Section 255 of the law an exemption from the budget cuts mandated by law funds generated by, or equivalent to, user fees paid to the Patent and Trademark Office and the Copyright Office.

700 (Passed 2000 AR13 -R102-2; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty provide that where a part of the drawing or description is missing, that within a prescribed time limit, the applicant has the option of: (1) submitting such missing part and obtaining the date on which such missing part has been submitted, or (2) where priority has been claimed to rely on the material from the priority

document, or (3) rely upon the material originally submitted and obtain the original filing date, and particularly overrules Resolution SP86-R1O2-2 to the extent that it differs herefrom, and more particularly favors the adoption of those portions of Article 5 and its associated Regulations of the proposal for the Patent Law Treaty relating hereto.

700 (Passed 2000 AR13 -R102-3; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty provide that in the case of a derivative filing either in the same country or a different country which corresponds to a previously filed application, a filing date will be awarded on request, together with a submission of an identifying reference to the previously filed application; provided that all filing requirements are satisfied within a prescribed time limit, and particularly overrules Resolution SP87-R1O2-4 to the extent that it differs herefrom, and more particularly favors the adoption of those portions of Article 5 and its associated Regulations of the proposal for the Patent Law Treaty relating hereto.

700 (Passed 2000 AR14 -R102-4; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty provide that in connection with obtaining a filing date through initial submissions or submissions within time limits prescribed, that the filing date shall be no later than the specific date on which the office receives the filing requirements, thereby permitting each Contracting State to grant an earlier date should they so desire based upon their national law, and particularly overrules Resolutions SP86-R1O2-2, SP87-R102-4 and SP89-R102-5 to the extent that they differ herefrom, and more particularly favors the adoption of those portions of Article 5 and its associated Regulations of the proposal for the Patent Law Treaty relating hereto.

700 (Passed 2000 AR15 -R102-5; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty provide that the requirements relating to form or content which are provided for with respect of international applications under the Patent Cooperation Treaty, as well as the particular request form or format of an international application under the Patent Cooperation Treaty be acceptable to satisfy national or regional applications, and particularly overrules Resolution SP87-R1O2-4 to the extent that it differs herefrom, and more particularly favors the adoption of those portions of Article 6 and its associated Regulations of the proposal for the Patent Law Treaty relating hereto.

700 (Passed 2000 AR15-R102-6; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision which permits a country to require: (1) a translation of the application; (2) the payment of fees for applying for the application; (3) a translation of the priority document only where the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable, and (4) any additional evidence relating to the filing but only where the country may reasonably doubt the veracity of the submissions or the accuracy of the translation, and wherein all of the above are to be submitted only upon a notification within an adequate prescribed time limit to respond, and particularly overrules Resolution SP87-R1O2-3 to the extent that it differs herefrom, and more particularly favors the adoption of those portions of Article 6 and its associated Regulations of the proposal for the Patent Law Treaty relating hereto.

700 (Passed 2000 AR16-R102-7; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision which may require that a representative be appointed for the purposes of any procedure before the office, however, the applicant himself must also be permitted to file various documents, fees, and

other submissions to the broadest extent possible without a representative, and particularly favors the adoption of those portions of Article 7 and its associated Regulations of the proposal for the Patent Law Treaty relating hereto, without the inclusion of any brackets limiting the submissions directly by the applicant himself.

700 (Passed 2000 AR16-R102-8; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision that a country shall accept the appointment of a representative in a separate communication such as a power of attorney signed by the applicant, owner or other interested person, which communication be submitted in a language accepted by the office, but no other formal requirements, and specifically excluding notarizations, legalizations, certifications and the like, and particularly favors the adoption of those portions of Article 7 and its associated Regulations of the proposal for the Patent Law Treaty relating hereto.

700 (Passed 2000 AR17-R102-9; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision that no country be obliged against its wishes to accept the filing of applications in electronic form or by electronic means to the exclusion of filing applications on paper, however, after a period of 10 years, a country may exclude the filing of communication on paper but must nevertheless accept such communications on paper with respect to meeting a time limit deadline, although a subsequent electronic form may have to be submitted, and particularly favors the adoption of those portions of Article 8 and its associated Regulations of the proposal for the Patent Law Treaty relating hereto.

700 (Passed 2000 AR17-R102-10; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision that a county may require a signature for the purposes of any communication, such signature to be accepted without any attestation, notarization, authentication, legalization or other certification, however, the country may also require the capacity in which the person signed, an indication of the date on which it was signed and an address for correspondence and/or legal service, and particularly favors the adoption of those portions of Article 8 and its associated Regulations of the proposal for the Patent Law Treaty relating hereto.

700 (Passed 2000 AR18-R102-11; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision that a country may provide notification to any specified address, or if no address is specified, to any address contained within its documentation, however, failure of an office to send a notification does not relieve the applicant, owner or other interested party to comply with any requirement under the Treaty; and non-compliance of formal matters shall not affect the validity of any patent granted despite the failure of compliance; and the Section particularly favors the adoption of those portions of Articles 9 and 10 and the associated Regulations of the proposed Treaty relating hereto.

700 (Passed 2000 AR18-R102-12; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision that once a patent has been granted, it may not be revoked or invalidated either totally or in part on the ground of noncompliance with one or more formal requirements, which although needed for the processing of the application, are not essential to the content of the granted patent, except where the noncompliance of the formal requirement occurred as a result of a fraudulent intention; and where such patent may be revoked or invalidated, the owner must be given at least

one opportunity to make observations on the intended revocation or invalidation and to make amendments and corrections where permitted under the applicable law, within a reasonable time, and particularly favors the adoption of those portions of Article 10 and its associated Regulations of the proposed Treaty relating hereto.

700 (Passed 2000 AR18-R102-13; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision that with respect to time limits that are fixed by the Patent Office of a country, that the country provide for either an extension of such time limits or provisions for continued processing beyond such time limits without the loss of any rights, and wherein the applicant is not required to state the grounds on which such request is based, however, and that any exceptions to such relief shall be strictly limited as much as possible, and particularly favors the adoption of those portions of Article 11 and its associated Regulations of the proposed Treaty relating hereto, without the portions presently contained in brackets, which add additional restrictions.

700 (Passed 2000 AR19-R102-14; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision that each country must provide for the reinstatement of rights with respect to an application or patent following failure to comply with a time limit for an action in a procedure before the Office and that failure had the direct consequence of causing a loss of rights with respect to an application or patent, wherein such reinstatement is subject to a finding by the Office that the failure occurred in spite of all due care required by the circumstances or, at the option of that country, was unintentional, and further that any exceptions to this right of reinstatement be limited as much as possible, and more particularly favor the adoption of those portions of Article 12 and its associated Regulations of the proposed Treaty relating hereto, without the portions presently contained in brackets.

700 (Passed 2000 AR20-R102-15; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision that an applicant have the ability to correct or add a priority claim, on or after the filing date, to an application which could have claimed the priority of such earlier application but did not do so within a prescribed time limit, provided that the International Patent Law Treaty contains no requirement that a claim be considered timely if the claim is filed after the period specified in existing PCT Rule *26ibis*; and provide a remedy for an applicant where a right of priority is lost because of the failure on the part of the Office with which an earlier application was filed to provide a copy of that application in time to comply with required time limits for submission of the priority document despite a timely request for that copy having been made, and particularly favors the adoption of those portions of Article 13 and its associated Regulations of the proposed Treaty relating hereto.

700 (Passed 2000 AR20-R102-16; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision for the restoration of the priority right where a subsequent application is filed after the expiration of the priority period, but within a period of not more than two months thereafter, and where the failure to file the application within the priority period occurred in spite of all due care required by the circumstances having been taken, or, at the option of the country, was unintentional, and particularly favor the adoption of those portions of Article 13 and its associated Regulations of the proposed Treaty relating hereto.

700 (Passed 2000 AR21-R102-17; **Archived 2010**)

Section favors, in principle, that any International Patent Law Treaty contain a provision for standardized procedures concerning: (1) requests for recordation of a change in the name or address of an applicant or owner where there is no change in the person of that applicant or owner; (2) requests for recordation of a change in the person of an applicant and owner, in particular, changes resulting from a change of ownership; (3) requests for recordation of a licensing agreement or security interest; and (4) requests for correction of a mistake, and particularly favors the adoption of those portions of Article 14 and its associated Regulations of the proposed Treaty relating hereto.

702 (Passed 2000 AR24-R102-19; **Archived 2010**)

Section favors, in principle, Patent Cooperation Treaty (PCT) Regulations: (1) limiting documents and evidence which may be required under national law for filing patent applications and including the use of declarations using standardized wordings to satisfy evidentiary requirements of such documents and evidence; (2) requiring translations of priority documents only in those cases where the validity of the priority claim is relevant to the determination of whether the cognizant invention is patentable; (3) restricting the ability of a National Office to require that translations of international applications be certified to cases where reasonable doubt exists as to the accuracy of the translation; (4) giving applicants an opportunity to comply with national requirements in a time not less than two months from the date an invitation to comply has been sent; and (5) permitting PCT Requests to indicate registration numbers of applicants and agents when such applicants and agents are registered before a National Office, and Specifically, the Section favors amendments of the PCT Regulations as proposed in document PCT/CAL/7/2 dated October 18, 1999, said documents relating to the pending draft Patent Law Treaty as proposed by the World Intellectual Property Organization in documents PT/DC/3, PT/DC/4 and PT/DC/5.

705 (Passed 1989 SP86-R102-2; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions provide that fulfillment of the following requirements shall be sufficient for granting a filing date for a patent application: (1) a request which may be implied from the character of the document submitted (2) an indication or sufficient information that allows the establishment of the identity of the applicant and (3) a written description of the invention in any language together with any drawing necessary to the description.

705 (Passed 1989 SP87-R102-3; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision which (i) permits a country to require that claims, fees and translations be requirements which must be satisfied within two months of filing to avoid abandonment of the filing date obtained by meeting the formal requirements and (ii) specifies that no additional requirements may be imposed except that the filing date may be subsequently found to be of no effect if the description does not meet the sufficiency requirements.

705 (Passed 1989 SP87-R102-4; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision which, in the case of a derivative filing either in the same country or a different country which corresponds to a previously filed application, requires that a filing date will be awarded on request together with submission of an

identifying reference to the previously filed application; provided that all filing requirements are satisfied within two months of the request.

705 (Passed 1989 SP89-R102-5; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision which requires that the names and addresses of inventors shall be given in the application but if not given at the time of filing shall be indicated at the invitation of the patent office, but no later than 16 months from filing or patent grant, whichever is earlier, based on the best information known to applicant and the applicant shall correct the inventors named in the application and resulting patent reasonably promptly whenever a change is indicated by new or corrected information to the best of applicant's ability without affecting validity of the resulting patent.

705 (Passed 1989 SP89-R102-6; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain an article providing (i) that any contracting state party to that treaty shall require a description which discloses the invention in a manner sufficiently clear and complete for the invention to be carried out by a person skilled in the art to which it pertains and (ii) that any country may require the best mode of carrying out the invention be set forth in said description.

705 (Passed 1989 SP89-R102-7; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision in its articles that the application shall contain one or more claims that are clear and supported by the description and define the invention for which protection is sought, and such claim or claims will be in acceptable form either if in a two-part "characterized by" type format or as a single statement of a combination of elements or steps.

705 (Passed 1989 SP97-R102-10A; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision providing that contracting states party to that treaty which examine patent applications as to their patentability shall obtain a search report of the prior art for each application within 18 months of the filing date.

705 (Passed 1989 SP98-R102-10B; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision providing that contracting states party to that treaty which examine patent applications as to their patentability shall begin substantive examination within 36 months of the filing date or the priority date of the application, if there is a priority date.

705 (Passed 1989 SP100-R102-12; **Retained 2000; Archived 2010**)

Section opposes in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision limiting the time, after patent grant, that oppositions or other revocation procedures may be brought.

705 (Passed 1989 SP102-R102-13A; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions shall provide that post grant patent corrections may be

made at the request of the patent owner to (i) correct obvious mistakes or clerical errors including translation errors, (ii) limit the extent of protection, or (iii) clarify ambiguities provided the change does not enlarge the extent of protection.

705 (Passed 1989 SP104-R102-13B; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions provide that a country may provide for post grant broadening corrections of a patent at the request of the patent owner provided that a request for correction is filed within two years after patent grant and provided the country may permit third parties to continue the activities which would have been permissible but for the corrections under circumstances in which it is considered appropriate in the country to do so.

705 (Passed 1989 SP106-R102-14; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions provide that the content of a previous application shall be considered as prior art as of the filing date or priority date where priority is claimed, for the sole purpose of determining novelty of a claimed invention in a subsequently filed application in the same contracting state provided that:

- (i) the previous application is not withdrawn prior to publication;
- (ii) a contracting state may choose to not extend such effect to a previous application based on an international application filed under the Patent Cooperation Treaty which has not entered the national stage in the contracting state; and
- (iii) a contracting state may choose not to extend such effect to a previous application filed by the same inventor or applicant.

705 (Passed 1989 SP108-R102-16; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision setting forth at least a minimum grace period, the duration of which would be 12 months preceding the filing date or the priority date, whichever is earlier, of a given application, during which information which otherwise would affect the patentability of an invention claimed in that application shall not affect the patentability of that invention if that information was disclosed: (i) by the inventor, or (ii) by an industrial property office and (a) the information was contained in another application filed by the inventor and should not have been disclosed by that office or (b) the information was contained in an application filed without the knowledge or consent of the inventor by a third party which obtained the information directly or indirectly from the inventor, or (iii) by a third party which obtained the information directly or indirectly from the inventor; where "inventor" means any natural person or legal entity which, at the filing date, was entitled to obtain a patent on the given application, such as the inventor's successor in title or, where the national law so provides, his employer, irrespective of whether that person or entity is the applicant of the given application.

705 (Passed 1989 SP111-R102-17; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision that patents relating to both products and processes be available for all fields of technology whether or not a country provides protection under other laws.

705 (Passed 1989 SP114-R102-18; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision providing that a patent owner shall have the right to prevent other parties from:

- (i) making, using or selling a patented product or a product resulting from a patented process or importing such a product for such selling or using, and
- (ii) using a patented process, including acts which constitute inducement or contributory infringement, but excepting the use or sale of the specific product that has been sold by or with the consent of the patent owner in the territory covered by the patent.

705 (Passed 1989 SP115-R102-19; **Retained 2000; Archived 2010**)

Section opposes in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision providing that a patent owner shall be denied the right to prevent other parties from the following acts:

- (i) making, using or selling a patented product or a product resulting from a patented process or importing such a product for such selling or using, and
- (ii) using a patented process, including acts which constitute inducement or contributory infringement, where (i) the act is done privately on a noncommercial scale; or (ii) the act is done for scientific research; or (iii) the act consists of the extemporaneous preparation of a medicine for individual cases in a pharmacy or by a medical doctor.

705 (Passed 1989 SP118-R102-20; **Retained 2000; Archived 2010**)

Section favors in principle that any treaty relating to the international harmonization of provisions for the protection of inventions contain a provision requiring (i) that the invention shall be given a reasonable scope of protection defined by the claims and elements thereof shall be interpreted to cover equivalents beyond the literal language of the claims permitted by the scope of the prior art which perform substantially the same function in substantially the same manner to achieve substantially the same result, and (ii) that the claims shall not be limited by detailed features of the described embodiments not recited therein.

705 (Passed 1989 SP120-R102-23; **Retained 2000; Archived 2010**)

Section of Patent, Trademark and Copyright Law opposes in principle in any treaty relating to the international harmonization of provisions for the protection of inventions any provision providing for prior user rights.

705 (Passed 2000 AR13-R102-1; **Archived 2010**)

Section favors in principle that any International Patent Law Treaty provide that fulfillment of the following requirements shall be sufficient for granting a filing date for a patent application: (1) an indication that an application is intended; (2) an indication allowing the identity of the applicant to be established or allowing the applicant to be contacted, (3) a part which on the face of it appears to be a description and which may be a drawing, such being provided in any language, and more particularly overrules prior Resolution SP86-R102-2 to the extent that it differs herefrom, and more particularly favors the adoption of the portions of Article 5 and its associated Regulations of the proposal for the Patent Law Treaty relating hereto.