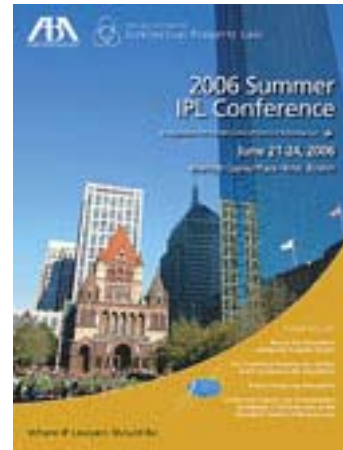


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## 2005-2006 PROPOSED RESOLUTIONS With Classifications Made by Council on May 2, 2006

### [PROPOSED RESOLUTION 102-1 – Patent Harmonization - PCT Reform: Class 2 - Recommend](#)

RESOLVED, that the Section of Intellectual Property Law opposes, in principle, the growing trend of outsourcing examination and searching of PCT applications filed in the United States Patent and Trademark Office as the receiving office to other national patent offices and commercial firms in order to reduce the workload of US Patent Examiners without first having in place a well-defined and proven program which ensures the quality of patent examination and search; and

SPECIFICALLY, if the search and examination of PCT applications filed in the United States Patent and Trademark Office as the receiving office impose enough burden which prevents the US Patent and Trademark Office from reducing the current backlog of US domestic patent applications, the Section, in principle, supports the United States Patent and Trademark Office to decline to act as an International Search and Examination Authority.

### [PROPOSED RESOLUTION 102-2 – Patent Harmonization - PCT Reform: Adopted by Council, as amended, on May 2, 2006](#)

RESOLVED, that the Section of Intellectual Property Law, opposes, in principle, the inconsistent treatment being proposed by the United States Patent and Trademark Office under the proposed Changes to Practice for Continuing Applications, Requests for Continued Examination Practice, and Applications Containing Patentably Indistinct Claims between a PCT application nationalized

~~under 35 USC 371 and a U.S. national application filed under 35 USC 111 based on a PCT application (the so-called “by-pass” route), resulting in only the application filed under the “by-pass” route being automatically deemed a “continuation” under the proposal, 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.~~

**PROPOSED RESOLUTION 102-3 – Patent Harmonization - PCT Reform: Class 1 – Full Debate**

RESOLVED, that the 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.

**PROPOSED RESOLUTION 102-4A – Patent Harmonization - PCT Reform: Class 2 - Recommit**

RESOLVED, that the 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, that there be limitations on the usage of the Abstract section of a Specification, and

SPECIFICALLY, the Abstract should not be used for prior art purposes nor for disclosure support purposes.

**PROPOSED RESOLUTION 102-4B – Patent Harmonization - PCT Reform: Class 2 - Recommit**

RESOLVED, that the 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, that there be limitations on the usage of the Abstract section of a Specification, and

SPECIFICALLY, that the Abstract can not be used for prior art purposes but still be used for disclosure support purposes.

**PROPOSED RESOLUTION 102-4C – Patent Harmonization - PCT Reform: Class 2 - Recommit**

RESOLVED, that the 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, that there be limitations on the usage of the Abstract section of a Specification, and

SPECIFICALLY, that the Abstract can be used for prior art purposes but should not be used for disclosure support purposes.

**PROPOSED RESOLUTION 102-5 – Patent Harmonization - PCT Reform: [Class 2 - Recommit](#)**

RESOLVED, that the 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, that there be prior art dates fixed for matter deleted from pending applications, and

SPECIFICALLY, that subject matter deleted from an application after filing should be considered prior art as of the date of the filing of the application.

**PROPOSED RESOLUTION 103-1 – Patent and Trademark Office Affairs – Proposed New Patent Rules: [Adopted, as Amended, by Council on May 2, 2006](#)**

RESOLVED, that the Section of the Intellectual Property Law opposes arbitrary limitations on number of claims to be examined in an application; and

SPECIFICALLY, the Section opposes the [Patent-Office's U.S. Patent and Trademark Offices'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).

**PROPOSED RESOLUTION 103-2 – Patent and Trademark Office Affairs – Proposed New Patent Rules: [Class 2 - Recommit](#)**

RESOLVED, that the Section of the Intellectual Property Law opposes shifting the burden of examination from the Patent Office to Applicant in an application; and

SPECIFICALLY, the Section opposes the [Patent-Office's U.S. Patent and Trademark Offices's](#) proposed rule 37 C.F.R. §1.261, 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 an “Examination Support Document” would be required for examination of more than ten independent or representative claims, for which Applicant must perform a detailed search, and submit a detailed analysis of the search and pending claims, including applying each of the references found to the claims.

**PROPOSED RESOLUTION 103-3 – Patent and Trademark Office Affairs – Proposed New Patent Rules: [Adopted, as Amended, by Council on May 2, 2006](#)**

RESOLVED, that the Section of the Intellectual Property Law favors in principle the full examination of each claim in an application prior to grant; and

SPECIFICALLY, the Section opposes the [Patent-Office's U.S. Patent and Trademark Offices'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.

**PROPOSED RESOLUTION 103-4 – Patent and Trademark Office Affairs – Proposed New Patent Rules: [Adopted, as Amended, by Council on May 2, 2006](#)**

RESOLVED, that the Section of Intellectual Property Law opposes implementation of rules that could unfairly restrict the opportunity of inventors to protect inventions disclosed in an application for patent,

SPECIFICALLY, the Section opposes the [Patent-Office's U.S. Patent and Trademark Offices'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).

**PROPOSED RESOLUTION 103-5 – Trilateral Cooperation: [Class 2 – Approve as Amended](#)**

RESOLVED, that the Section of the Intellectual Property Law favors, in principle, [programs for 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, the Section 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.

**PROPOSED RESOLUTION 108-1 – Prescription Drug Compulsory Licensing: Class 1 – Full Debate as Amended**

RESOLVED, that the Section of Intellectual Property Law is opposed, in principle, to 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, or local or territorial legislation that provides for compulsory licensing of a patented pharmaceutical product or process.

**PROPOSED RESOLUTION: 108-2 – Written Description: Class 2 - Recommit**

RESOLVED, that the Section of Intellectual Property Law favors in principle the consideration of predictability of the relevant art as a basis for determining whether a patent specification must describe multiple embodiments of a claimed invention in order to satisfy the written description requirement set forth in 35 U.S.C. §112, ¶1.

**PROPOSED RESOLUTION: 108-3 – Patentable Subject Matter for New Forms of Invention: Class 2 - Approved**

RESOLVED, the Section of Intellectual Property Law 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, the Section 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.

**PROPOSED RESOLUTION: 108-4 – Amendment of 35 U.S. C. § 271(f): Class 2 Recommit**

RESOLVED, that the Section of Intellectual Property Law 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) in the following, or similar, form:

(f)(1) Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such a manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer as to patented combinations assembled from the components so supplied or caused to be supplied.

(f)(2) Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or so adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer as to patented combinations assembled from the components so supplied or caused to be supplied.

(f)(3) Liability for infringement under sections (f)(1) and (f)(2) does not encompass combinations of components when all components of the combination are made outside the United States and not imported into the United States.

**PROPOSED RESOLUTION: 108-5 – Amendment of 35 U.S. C. § 284 and 285: Class 2 Recommit**

RESOLVED, the Section of Intellectual Property Law favors in principle the amendment to 35 U.S.C. §§ 284 and 285 to limit the circumstances under which a court may increase damages for patent infringement and award attorney fees, respectively; and

Specifically, the Section favors an amendment to §§ 284 and 285 to provide that:

(i) the court shall not increase damages based solely on the failure to present evidence of advice of counsel, nor shall it increase damages if the infringer had an informed good faith belief, which may be established by reasonable reliance on advice of counsel, that the patent was invalid or unenforceable or that it would not be infringed by the conduct later shown to constitute infringement of the patent; and

(ii) that the court may receive expert testimony as an aid to the determination of damages or of what royalty would be reasonable under the circumstances.

**PROPOSED RESOLUTION 160-1 – “Natural Phenomena” Issue – Lab Corp. v. Metabolite Decision: Class 3 – Rest as a Committee Report**

RESOLVED, the Section of Intellectual Property Law supports, in principle, that an invention covering a new and useful process is not unpatentable subject matter solely because it relies in part on a scientific principle or natural phenomenon, and

SPECIFICALLY, the Section supports filing an *amicus curiae* brief in the U.S. Supreme Court in *Laboratory Corporation of America Holdings v. Metabolite Laboratories, Inc.*, No. 04-607, to support the respondent/patentee’s position that claim 13 of U.S. Pat. No. 4,940,658 satisfies the requirements of 35 U.S.C. § 101 and constitutes patentable subject matter, and advancing the following arguments:

(1) claim 13 of the ‘658 patent must be read as a whole, and should not be invalidated on the grounds that it incorporates or relies on a “basic scientific relationship” or on the ground that claim 13 includes a mental step;

(2) the prohibition against patenting “laws of nature, natural phenomena, and abstract ideas,” as articulated in *Parker v. Flook*, 437 U.S. 584 (1978) and *Diamond v. Diehr*, 450 U.S. 175 (1981), is not implicated by claim 13 of the ‘658 patent; and

(3) any decision invalidating all patents that incorporate or rely on a “basic scientific relationship” or natural phenomenon will result in an enormous adverse impact.

**PROPOSED RESOLUTION 160-2 – “Natural Phenomena” Issue – Lab Corp. v. Metabolite Decision: Class 2 – Approve as Amended**

RESOLVED, the Section of Intellectual Property Law supports, in principle, that an invention covering claimed as a new and useful process is not unpatentable patent ineligible subject matter solely because it relies in part on a is based upon one or more scientific principle principles or natural phenomenon phenomena.

**PROPOSED RESOLUTION 205-1 – Amendments to Trademark Dilution Act: Subsumed by new Resolution 205-1**

~~RESOLVED, that the Section of Intellectual Property Law opposes in principle any legislation that would exclude completely all famous marks in the form of product configuration from potential protection under the federal trademark dilution laws.~~

**PROPOSED RESOLUTION 205-2 – Amendments to Trademark Dilution Act: ~~Subsumed by new Resolution 205-1~~**

~~RESOLVED, that the Section of Intellectual Property Law opposes in principle any legislation that would exclude completely all famous marks in the form of trade dress from potential protection under the federal trademark dilution laws.~~

**PROPOSED RESOLUTION 205-3 – Amendments to Trademark Dilution Act: ~~Subsumed by new Resolution 205-1~~**

~~RESOLVED, that the Section of Intellectual Property favors in principle protection of famous inherently distinctive marks in the form of trade dress under the federal trademark dilution law.~~

**PROPOSED RESOLUTION 205-4 – Amendments to Trademark Dilution Act: ~~Subsumed by new Resolution 205-1~~**

~~RESOLVED, that the Section of Intellectual Property Law favors in principle protection of famous marks in the form of product configuration that have acquired distinctiveness from use in the marketplace under the federal trademark dilution law.~~

**PROPOSED RESOLUTION 205-5 – Amendments to Trademark Dilution Act: ~~Subsumed by new Resolution 205-1~~**

~~RESOLVED, that the Section of Intellectual Property Law favors in principle protection of famous marks in the form of trade dress that have acquired distinctiveness from use in the marketplace under the federal trademark dilution law.~~

**NEW PROPOSED RESOLUTION 205-1 – Amendments to Trademark Dilution Act: ~~Class 1 – Full Debate~~**

RESOLVED, that the Section of Intellectual Property Law 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, and:

SPECIFICALLY, the Section favors protection under the federal trademark dilution law of famous inherently distinctive marks in the form of trade dress, and

SPECIFICALLY, the Section favors protection under the federal trademark dilution law of famous marks in the form of trade dress, including product configuration, that has acquired distinctiveness from use in the marketplace, and

SPECIFICALLY, the Section favors protection under the federal trademark dilution law of famous marks in the form of trade dress that have acquired distinctiveness from use in the marketplace.

**PROPOSED RESOLUTION 304-1 – New Committee Scope: ~~Class 3 – Rest as a Committee Report~~**

RESOLVED, that the Section of Intellectual Property Law should change the name and scope of Committee 304 to read as follows:

“COMMITTEE 304 –VISUAL ARTS AND DRAMATIC WORKS

“Scope of Committee: Copyright and related legal issues in creating, exploiting, and protecting the following categories of works: (1) visual arts comprising pictorial, graphic, and sculptural works, including 2-dimensional and 3-dimensional works of fine, graphic, and applied art, photographs, prints and art reproductions, maps, globes, charts, technical drawings, diagrams, architectural works and models; and (2) dramatic works,

including choreography, pantomimes, plays, treatments, and scripts prepared for cinema, radio, and television.”

**PROPOSED RESOLUTION 413-1 (same as 108-1) – Prescription Drug Compulsory Licensing: Class 1 – Full Debate as Amended**

RESOLVED, that the Section of Intellectual Property Law ~~is opposed, in principle, to~~ 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, ~~or local or territorial~~ legislation that provides for compulsory licensing of a patented ~~pharmaceutical~~ product or process.

**PROPOSED RESOLUTION 601-1 – Electronic Discovery: Subsumed by new Resolution 601-1**

~~RESOLVED, that the Section of Intellectual Property Law supports, in principle, the approval by the Judicial Conference Committee on Rules of Practice and Procedure of the proposed amendments to the Federal Rules of Civil Procedure, as amended after publication and public comment, respecting the discovery of electronically stored documents and information, and~~

~~SPECIFICALLY, the Section supports approval of the proposed amendment to Rule 16 of the Federal Rules of Civil Procedure (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~~

**PROPOSED RESOLUTION 601-2 – Electronic Discovery: Subsumed by new Resolution 601-1**

~~RESOLVED, that the Section of Intellectual Property Law supports, in principle, the approval by the Judicial Conference Committee on Rules of Practice and Procedure of the proposed amendments to the Federal Rules of Civil Procedure, as amended after publication and public comment, respecting the discovery of electronically stored documents and information, and~~

~~SPECIFICALLY, the Section supports approval of the proposed amendment to Rule 26(f) of the Federal Rules of Civil Procedure (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.~~

**PROPOSED RESOLUTION 601-3 – Electronic Discovery: Subsumed by new Resolution 601-1**

~~RESOLVED, that the Section of Intellectual Property Law supports, in principle, the approval by the Judicial Conference Committee on Rules of Practice and Procedure of the proposed amendments to the Federal Rules of Civil Procedure, as amended after publication and public comment, respecting the discovery of electronically stored documents and information, and~~

~~SPECIFICALLY, the Section supports approval of the proposed amendment to Rule 26(b)(2)(C) of the Federal Rules of Civil Procedure 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.~~

**PROPOSED RESOLUTION 601-4 – Electronic Discovery: Subsumed by new Resolution 601-1**

~~RESOLVED, that the Section of Intellectual Property Law supports, in principle, the approval by the Judicial Conference Committee on Rules of Practice and Procedure of the proposed amendments to the Federal Rules of Civil Procedure, as amended after publication and public comment, respecting the discovery of electronically stored documents and information, and~~

~~SPECIFICALLY, the Section supports approval of the proposed amendment to Rule 26(b)(5)(B) of the Federal Rules of Civil Procedure 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.~~

**PROPOSED RESOLUTION 601-5 – Electronic Discovery: Subsumed by new Resolution 601-1**

~~RESOLVED, that the Section of Intellectual Property Law supports, in principle, the approval by the Judicial Conference Committee on Rules of Practice and Procedure of the proposed amendments to the Federal Rules of Civil Procedure, as amended after publication and public comment, respecting the discovery of electronically stored documents and information, and~~

~~SPECIFICALLY, the Section supports approval of the proposed amendment to Rule 33 of the Federal Rules of Civil Procedure (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.~~

**PROPOSED RESOLUTION 601-6 – Electronic Discovery: Subsumed by new Resolution 601-1**

~~RESOLVED, that the Section of Intellectual Property Law supports, in principle, the approval by the Judicial Conference Committee on Rules of Practice and Procedure of the proposed amendments to the Federal Rules of Civil Procedure, as amended after publication and public comment, respecting the discovery of electronically stored documents and information, and~~

~~SPECIFICALLY, the Section supports approval of the proposed amendment to Rule 34 of the Federal Rules of Civil Procedure (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.~~

**PROPOSED RESOLUTION 601-7 – Electronic Discovery: Subsumed by new Resolution 601-1**

~~RESOLVED, that the Section of Intellectual Property Law supports, in principle, the approval by the Judicial Conference Committee on Rules of Practice and Procedure of the proposed amendments to the Federal Rules of Civil Procedure, as amended after publication and public comment, respecting the discovery of electronically stored documents and information, and~~

~~SPECIFICALLY, the Section supports approval of the proposed amendment to Rule 37 of the Federal Rules of Civil Procedure (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.~~

**NEW PROPOSED RESOLUTION 601-1 – Electronic Discovery: Class 2 - Approved**

RESOLVED, that the Section of Intellectual Property Law 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, the Section 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.

**PROPOSED RESOLUTION 603-1- ITC Practice and Procedure: Class 2 – Approve as Amended**

~~RESOLVED, Committee 603 favors the ABA providing written support to Chairman Koplan for the appointment of a fifth Administrative Law Judge and provision of a third courtroom at the International Trade Commission (ITC) to accommodate the continually increasing number of Section 337 complaints being filed each year at the ITC.~~

RESOLVED, that the Section of Intellectual Property Law 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.

**PROPOSED RESOLUTION 701-1 – Anti-Spyware Legislation: Class 1 – Full Debate as Amended**

RESOLVED, that the Section of Intellectual Property Law favors, in principle, in the absence of comprehensive federal legislation on spyware, the survival of state laws, ~~neutral as between intrastate and interstate commerce, that which~~ regulate the dissemination of spyware over the Internet and which are neutral as between intrastate commerce and interstate commerce, when those state laws are against challenges challenged based on the "dormant" Commerce Clause or the First Amendment of the United States Constitution.

**PROPOSED RESOLUTION 701-2 – Extraterritorial Application of § 271(a) to Distributed Systems Involving Computer Programs: Class 1 – Full Debate**

RESOLVED, that the Section of Intellectual Property Law 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.