



# **AIPLA**

American Intellectual Property Law Association

# **Past Action Manual 1982-2022**

11/18/2022

# **Past Action Manual**

**1982–2022**

This Manual contains actions taken by the Board of Directors or by the membership during the past 40 years of the Association. The individual resolutions are viewed as the official position of the Association on the issue at hand.

For several years, the Board of Directors has thoroughly reviewed the Past Actions and has taken numerous steps to bring this Manual up to date. First, the Board instituted a policy whereby all Past Actions more than ten years old will be reviewed on an annual basis by the AIPLA committee of interest. The committee then is to recommend to the Board whether the given resolution should be retained or retired. Second, unless decided otherwise, the Board will retire all resolutions contained in the previous Past Action Manual which are more than ten years old. Third, the Board retired several Past Actions less than ten years old, all of which were viewed as no longer applicable or relevant. Therefore, where you see apparent gaps in the numbering of resolutions, this indicates previous Past Actions have been retired. Last, several changes were made to the organization and numbering system of the Manual to correlate it, where possible, with the American Bar Association, Section of Intellectual Property Law Past Action Book.

The actions taken by the Board and reported herein are almost all positive actions on issues or questions which establish an Association policy or position. This Manual is intended to provide information and guidance to the members of the Board of Directors and the Committee Leadership as they carry out their responsibilities to the Association.

**[This document includes AIPLA Board actions through September 30, 2021.]**

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**(Through July 30, 2022)**

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## **PATENTS**

### **210-01 PTO as a Government Corporation**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors establishing the United States Patent and Trademark Office as a government corporation, independent from the Department of Commerce.

(Board of Directors Meeting – October 19, 1991.

Retained by Board of Directors – January 25, 2003, and February 1, 2014.)

### **210-03 PTO Public Advisory Committees**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors the appointment to the Public Advisory Committees, as provided in 35 U.S.C. Sec. 5, of individuals who are highly knowledgeable concerning the affairs of the U.S. Patent and Trademark Office (PTO), and specifically, favors the appointment of at least some individuals who practice before the PTO or who are affiliated or employed by entities that practice before the PTO.

(Board of Directors Meeting – January 29, 2000.

Retained by Board of Directors – January 30, 2010; and

Retained by Board of Directors – September 11, 2020.)

### **214-01 Fee Diversion**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors in principle that all revenue generated by fees paid by users of the services of the United States Patent and Trademark Office for application processing be made promptly available to the USPTO without limitation to provide such services, and

Specifically, the Association opposes the withholding or diversion of any such revenue to fund any non-USPTO programs.

(Board of Directors Meeting – July 10, 2000:

Retained by Board of Directors – February 5, 201; and

Retained by Board of Directors – September 10, 2021.)

### **214-03 USPTO Fee-Setting Authority**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) supports extending the authority of the U.S. Patent and Trademark Office to set the rates and fees that it charges the public, consistent with the manner provided for in the America Invents Act.

(Board of Directors Meeting – May 17, 2018.)

**218-01****Markush Practice**

On September 2, 1986, the PTO circulated an informal proposal entitled, "Proposed Approaches to Markush Practice." The proposal was considered by the Chemical Practice Committee. The Board adopted the following resolution recommended by the Committee:

RESOLVED, that the American Intellectual Property Law Association opposes any effort to change the current law or practice as it relates to the option of an application to present and prosecute claims of the Markush type.

(Board of Directors Meeting – October 10, 1986.

Retained by Board of Directors – January 25, 2003, and February 1, 2014.)

**218-02****PTO Rules Changes****Requirement to Identify Support for Amendments to Claims**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) would oppose, in principle, a requirement that an explanation of support in the disclosure of a patent application for any amendment to a claim shall be applicable to all patent applications.

**Make Administrative Procedures and Policies Similar in Reexamination and Reissue Proceedings to the Extent Practicable**

RESOLVED, that AIPLA favors, in principle, adoption of similar administrative policies, practices, and procedures for reissue applications and reexamination proceedings to the extent practicable.

(Board of Directors Meeting – October 24, 1996.

Revised and retained by Board of Directors – January 24, 2007.

Retained by Board of Directors – July 19, 2017)

**220-03****Interference**

RESOLVED, that when a paper is filed in an application seeking an interference, the PTO should automatically mark that application file "Special" and act on it promptly until an interference is either declared or finally refused, including cases returned to the Examiner by the Board.

(Board of Directors Meeting – January 27, 1996.

Edited and retained by Board of Directors – January 24, 2007.

Retained by Board of Directors – July 19, 2017.)

RESOLVED, that the American Intellectual Property Law Association (hereinafter referred to as “AIPLA”) favors, in principle, the participation of the Solicitor’s Office as an *amicus curiae* in the court review of any decision by the Patent Trial and Appeal Board (“PTAB”) (hereinafter referred to as “the Board”) in an interference where the decision of the court is likely to affect the institutional interests of the Patent and Trademark Office (“the PTO”); and

Specifically, AIPLA favors the amendment of the Board’s Standing Order to provide that each party to court review under either 35 USC § 141 or 35 USC § 146 of a decision by the Board in a patent interference must serve on the Solicitor copies of all substantive papers, subject to any protective orders, that it files in the court on the same date that it files those papers, and AIPLA favors participation of the Solicitor’s Office as an *amicus curiae* in that court review whenever the decision of the court is likely to affect the institutional interests of the PTO.

(Board of Directors Meeting – February 2, 2011; and  
Retained as amended by Board of Directors – September 10, 2021.)

RESOLVED, that the American Intellectual Property Law Association (“AIPLA”) favors, in principle, a change in the metric that the Patent and Trademark Office (hereinafter referred to as “the PTO”) uses to judge the timeliness of dispositions of interferences by the Patent Trial and Appeal Board (hereinafter referred to as “the PTAB”); and

Specifically, that AIPLA favors an additional metric to the metric that the PTO currently uses to judge the timeliness of the dispositions of all interferences (namely, that judgment be entered within two years of declaration) whereby credit would be given the PTAB for minimizing the period between the panel hearing on the motions and the decision on the motions.

(Board of Directors Meeting – May 12, 2011; and  
Retained as amended by Board of Directors – September 10, 2021.)

RESOLVED, that the American Intellectual Property Law Association (AIPLA) opposes any extension of the transitional Covered Business Methods (CBM) program as enacted in the American Invents Act, and also supports maintaining the current sunset period and discontinuing the program as of September 16, 2020.

(Board of Directors Meeting – May 17, 2018.)

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors in principle, to cure any Constitutional infirmity under the Appointments Clause to the extent one exists, legislative action to create within the U.S. Patent & Trademark Office (USPTO) administrative patent judges (APJs) who are principal officers of the United States (“Principal APJs”) appointed by the President with the advice and consent of the Senate, to review decisions by APJs of the Patent Trial and Appeals Board (PTAB); and

SPECIFICALLY, to cure any such infirmity AIPLA supports Congressional action that includes:

1. THAT Principal APJs are located administratively within the USPTO.
2. THAT Principal APJs are appointed for terms extending for a sufficient period of time to attract well-qualified candidates (*e.g.*, 15 years) and on a staggered basis to ensure that experienced and otherwise well-qualified Principal APJs hold office at all times as vacancies arise and are filled consistent with constitutionally established Commissions.
3. THAT Principal APJs have tenure security and sufficient protections from removal and other provisions to attract well-qualified candidates (*e.g.*, during each appointed term, a Principal APJ’s compensation and benefits may increase, but cannot be decreased, and will continue to the end of the term even if the Principal APJ is removed, unless that removal is done consistent with the applicable standards for removal found in Title 5, U.S.C.).
4. THAT the number of active Principal APJs and funding thereof are sufficient for the USPTO to meet deadlines and other requirements in executing its mission.
5. THAT one or more Principal APJs will review each final decision by APJs and be able to adopt, modify or set aside each decision within a limited time frame.
6. THAT Principal APJs are appointed pursuant to the Appointments Clause, U.S. Constitution, Article II, Section 2, Clause 2.
7. THAT the Principal APJs meet a minimum standard of qualification similar to those currently in place under 35 U.S.C. § 3 for the Director and Commissioners of the USPTO.

(Board of Directors Meeting – September 11, 2020).

Upon the recommendation of the Committee on Relations with the Patent and Trademark Office, the Board adopted the following resolution:

BE IT RESOLVED that the American Intellectual Property Law Association disapproves in principle replacing the present initial pre-issuance examination system with a patent registration system or any other form of incomplete initial examination, either per se or coupled with some other form of post-issuance examination.

This resolution had been suggested after it was learned that the Office of Management and Budget was conducting a thorough study of the Patent Office procedures and management and it is hoped that a special committee of AIPLA members will find an opportunity to discuss with



representatives of OMB the need for the retention of the present initial examination system in patent prosecution.

(Board of Directors Meeting – June 11, 1979.

Retained by Board of Directors – January 25, 2003.

Amended and retained by Board of Directors – February 1, 2014.)

## **230-03**

### **Patent Law – General Legislative Agenda**

RESOLVED, that AIPLA supports the principle that the first inventor to file an application for patent containing an adequate disclosure (35 U.S.C. §112) of an invention should have the right to patent the invention and

SPECIFICALLY, AIPLA supports such principle as the “best practice” for improving the domestic patent system.

RESOLVED, that AIPLA supports, in principle, the adoption of a grace period in which a disclosure of information anywhere in the world which would otherwise affect the patentability of an invention shall not affect the patentability of an invention claimed in an application where the information was disclosed directly or indirectly by the inventor, or by a third party which obtained the information directly or indirectly from the inventor, during the 12 months preceding the filing date, or where priority is claimed, the priority date of the application.

FURTHER RESOLVED, that until a similar grace period is effective in the patent laws of the member states of the European Patent Convention and in the patent law of Japan, the period of grace shall only apply to disclosures made 12 months preceding the effective filing date in the United States.

RESOLVED, that AIPLA supports, in the context of the adoption of a first-inventor-to-file-system:

- (1) eliminating abandonment as set forth in 35 U.S.C. § 102(c),
- (2) eliminating premature foreign patenting as set forth in 35 U.S.C. § 102(d), and
- (3) substituting for the “in public use or on sale” standard as set forth in 35 U.S.C. § 102(b) the “known or used” standard, i.e., that subject matter that is reasonably and effectively accessible to persons of ordinary skill in the art anywhere in the world qualifies as prior art.

RESOLVED, that AIPLA reaffirms its support, in principle, for permitting an application for patent to be filed by the assignee of the inventor.

RESOLVED, that AIPLA reaffirms its support, in principle, for eliminating the requirement that an application for patent include a disclosure of the “best mode” contemplated by the inventor carrying out the invention.

RESOLVED, that AIPLA reaffirms its support, in principle, for a definition of prior art based prior knowledge, use, or sale that has no geographical restrictions.

RESOLVED, that AIPLA favors, in principle, having a definition of prior art which has no geographical restrictions, i.e., disclosure anywhere in the world which is reasonably and effectively accessible to persons of ordinary skill in the art should be considered as prior art.

RESOLVED, that AIPLA favors, in principle, defining “prior art” to require that, for patents and published patent applications that have a prior art effect from their effective filing date, the prior art effect shall be for the purposes of both novelty and obviousness.

RESOLVED, that AIPLA favors, in principle, defining “prior art” to require that, for patents and published patent applications that have a prior art effect from their filing date, a published international application for patent shall be treated the same as a national application filed in the United States.

RESOLVED, that AIPLA favors, in principle, defining “prior art” to require that no earlier-filed application or patent shall have a prior art effect from its filing or priority date with respect to a later-filed application (or any patent issuing thereon) if the later-filed application or patent names the same inventor or, at the time the later application is filed, is owned by the same person or subject to an obligation of assignment to the same person as the earlier-filed application or patent.

RESOLVED, that AIPLA favors, in principle, expressly codifying that the right to patent is solely the right of the individual(s) who made the invention sought to be patented or the assignee of such individual(s).

RESOLVED, that AIPLA favors, in principle, that if the inventor’s right to patent is expressly codified, section 102(f) of title 35, United States Code, be repealed.

RESOLVED that AIPLA supports in principle, legislation to codify an exemption from infringement under which uses of a claimed invention related to scientific or philosophical inquiry are exempted as acts of infringement, and

SPECIFICALLY, the Association supports legislation providing, *inter alia*, that acts of infringement shall not extend to making or using patented subject matter to discern or discover:

- (1) the validity of the patent and the scope of protection afforded under the patent;
  - (2) features, properties, inherent characteristics or advantages of the patented subject matter;
  - (3) novel methods of making or using the patented subject matter; and
  - (4) novel alternatives to the patented subject matter, improvements thereto or non-infringing substituted therefore.
- (*But see* Past Action 230-05, Board of Directors Meeting, March 17, 2005.)

RESOLVED, that AIPLA supports in principle elimination of special exceptions to full publication of pending US patent applications as permitted under the American Inventors Protection Act of 1999, and

SPECIFICALLY, AIPLA supports repeal of 35 U.S.C. §122(b)(2)(i)-(v).

RESOLVED, that AIPLA supports in principle that commercial use (including substantial preparations for commercial use) should be recognized as a personal defense to patent infringement, if undertaken in good faith by a person who has reduced the patented invention to practice prior to the effective filing date of a patent, and

SPECIFICALLY, AIPLA supports amendment to the provisions of the AIPA of 1999 providing for such rights to remove restrictions on the enjoyment of such rights inconsistent with this principle.

(Board of Directors – March 18, 2004.

Revised in part by Board of Directors – May 15, 2004, and July 14, 2004.

Retained by Board of Directors – July 15, 2015.)

## **230-06**

### **Patent Law – Experimental Use**

RESOLVED, that AIPLA supports, in principle, legislation to codify an exemption from infringement under which uses of a claimed invention related to scientific, research, or experimental inquiries are exempted as acts of infringement, and

SPECIFICALLY, the Association supports legislation providing that acts of infringement shall not extend to making or using patented subject matter solely to discern or discover:

- (1) the validity of the patent and the scope of protection afforded under the patent;
- (2) features, properties, inherent characteristics or advantages of the patented subject matter;
- (3) methods of making or using the patented subject matter; or
- (4) alternatives to the patented subject matter, improvements thereto or substitutes therefore.

(Board of Directors Meeting – March 17, 2005.

Retained by Board of Directors – July 15, 2015.)

## **230-13**

### **Patent Law – Compulsory License**

RESOLVED, that the American Intellectual Property Law Association opposes, in principle, state or territory legislation that would give it the right to grant a compulsory license to a patent to a third party to make, have made, use, sell or import a pharmaceutical patented product within the state or territory.

(Board of Directors Meeting – July 17, 2005.

Retained by Board of Directors – July 15, 2015.)

**230-18****International Trade Commission**

RESOLVED, that the American Intellectual Property Law Association ("AIPLA") supports, in principle, amending 19 U.S.C. 1337 ("Section 337") to grant authority to the U.S. International Trade Commission to issue Limited Exclusion Orders against downstream products of non-parties in Section 337 investigations, provided such non-parties are given notice; and

FURTHER RESOLVED, that if such relief is warranted, any implementing legislation or rules must require parties seeking such downstream relief to provide prompt and timely specific notice to affected manufacturers and importers of such downstream products.

(Board of Directors Meeting – May 6, 2010; and  
Retained by Board of Directors – September 11, 2020.)

**230-19****International Trade Commission**

The Board of Directors adopted the following:

That AIPLA take the position that the *eBay* factors should not apply in Section 337 actions and that the ITC Committee's white paper be finalized as a position paper, subject to final approval by the Executive Committee;

Further, that AIPLA state there is no need to change the current domestic industry standard at the ITC; and

Further, that AIPLA take the position that SEPs should not be categorically excluded from ITC proceedings.

(Board of Directors Meeting – July 11, 2012; and  
Retained by Board of Directors – September 25, 2022.)

**230-20****Patent Law – Legislation**

Resolved that AIPLA supports the passage of H.R. 6621, except for the two provisions as noted above, regarding the GATT-related provisions and the (d)(2) dead zones related to reissues, as currently drafted. The motion was approved unanimously.

Further resolved, AIPLA supports an amendment to correct Section 371 regarding oaths to make specific reference to plant and design patents.

(Board of Directors Meeting – December 12, 2012.)

**230-21****Patent Law – Legislation**

RESOLVED, that AIPLA opposes enactment of H.R. 845, the “SHIELD Act” (as introduced), as the provisions of the bill (e.g., posting a bond) address perceived abuses in patent litigation by targeting a category of plaintiff rather than by addressing the abusive activity itself, an approach which will prevent some parties from enforcing their valid patent rights.

(Board of Directors Meeting – May 3, 2013.)

**230-22****Patent Law – Legislation**

RESOLVED, that AIPLA opposes in principle amending 35 U.S.C. § 285 to provide that a court must award attorneys’ fees to the prevailing party in every case.

FURTHER RESOLVED, that AIPLA supports in principle amending 35 U.S.C. § 285 to provide that a court may award to the prevailing party reasonable attorneys’ fees, unless the position and conduct of the non-prevailing party was objectively reasonable and substantially justified, or exceptional circumstances make such an award unjust.

FURTHER RESOLVED, that AIPLA also supports retaining the provisions of Title 28 governing awards of costs and expenses in their present form.

(Board of Directors Meeting – June 20, 2013.)

**230-23****Patent Law - State Demand Letters**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) is opposed, in principle, to patent demand letter legislation at the state level which creates non-uniform requirements for demand letters across various jurisdictions and increases compliance costs for legitimate businesses engaged in good-faith licensing and dispute resolution efforts.

FURTHER RESOLVED, AIPLA believes that federal legislation regulating bad faith demand letters should preempt specific state legislation on patent demand letters, except that such legislation should not impact a state’s authority to police fraudulent activity under consumer protection laws when warranted.

(Board of Directors Meeting – December 11, 2014.)

**230-23****Patent Law – PTAB Legislation**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors in principle, to cure any Constitutional infirmity under the Appointments Clause to the extent one exists, legislative action to create within the U.S. Patent & Trademark Office (USPTO) administrative patent judges (APJs) who are principal officers of the United States (“Principal APJs”) appointed by the President with the advice and consent of the Senate, to review decisions by APJs of the Patent Trial and Appeals Board (PTAB); and

SPECIFICALLY, to cure any such infirmity AIPLA supports Congressional action that includes:

8. THAT Principal APJs are located administratively within the USPTO.
9. THAT Principal APJs are appointed for terms extending for a sufficient period of time to attract well-qualified candidates (*e.g.*, 15 years) and on a staggered basis to ensure that experienced and otherwise well-qualified Principal APJs hold office at all times as vacancies arise and are filled consistent with constitutionally established Commissions.
10. THAT Principal APJs have tenure security and sufficient protections from removal and other provisions to attract well-qualified candidates (*e.g.*, during each appointed term, a Principal APJ's compensation and benefits may increase, but cannot be decreased, and will continue to the end of the term even if the Principal APJ is removed, unless that removal is done consistent with the applicable standards for removal found in Title 5, U.S.C.).
11. THAT the number of active Principal APJs and funding thereof are sufficient for the USPTO to meet deadlines and other requirements in executing its mission.
12. THAT one or more Principal APJs will review each final decision by APJs and be able to adopt, modify or set aside each decision within a limited time frame.
13. THAT Principal APJs are appointed pursuant to the Appointments Clause, U.S. Constitution, Article II, Section 2, Clause 2.
14. THAT the Principal APJs meet a minimum standard of qualification similar to those currently in place under 35 U.S.C. § 3 for the Director and Commissioners of the USPTO.

(Board of Directors – September 11, 2020)

## **230-24**

### **Patent Law – PTAB Legislation**

#### **1. Transparency/Code of Conduct**

WHEREAS, AIPLA recognizes that the public should have confidence in the Patent Trial and Appeal Board and assurances that the members of the Board act fairly and impartially;

RESOLVED, that Administrative Patent Judges (APJs) of the Patent Trial and Appeal Board (PTAB) should be required to comply with the Code of Conduct for United States Judges when performing the duties of the PTAB.

#### **2. Review Authority of Director**

WHEREAS, AIPLA recognizes that the Director must have review authority over decisions of the PTAB;

RESOLVED, that the Director has the authority to review, modify, or set aside any decision of the PTAB, including on the Director's own initiative.

### **3. Review and Rehearing of Board Decisions**

WHEREAS, AIA trial proceedings should provide for a generally cost-effective, streamlined, and efficient mechanism for review of validity challenges to issued patents;

WHEREAS, parties who are dissatisfied with a decision on institution may request rehearing of the decision;

RESOLVED that the Director should not be required to review institution decisions of the PTAB;

FURTHER RESOLVED that AIPLA opposes any requirement that the Director must review institution decisions of the PTAB in AIA Trial Proceedings;

FURTHER RESOLVED that AIPLA opposes, in principle, providing further means beyond requests for rehearing for parties to seek Director review of institution decisions via petition or additional briefing.

#### **1. Timelines for Rehearings/Remands**

RESOLVED that AIPLA supports, in principle, providing specific timelines to facilitate review or remand of decisions involved in AIA trial proceedings and to increase transparency regarding how cases will be handled;

FURTHER RESOLVED that AIPLA specifically supports requiring specific timelines for decisions on rehearing requests and for decisions on Director review, and for other such processes and procedures;

FURTHER RESOLVED that AIPLA supports requiring specific timelines for handling AIA trial proceedings remanded from an appeal to the Federal Circuit.

#### **2. Transparency/Independence of APJs**

RESOLVED that AIPLA supports, in principle, that APJs should render their decisions without influence by Office leadership, provided that APJs may confer with others on procedural and substantive issues in order to maintain consistency across the PTAB.

#### **3. *Arthrex* and Appointments Clause Proposal**

RESOLVED that, as an alternative way to address *Arthrex* issues following the Supreme Court's decision, AIPLA supports legislative action to create within the USPTO a small set of APJs who are principal officers of the United States ("Principal APJs"), appointed by the President with the advice and consent of the Senate, to review decisions by APJs of the PTAB, and subject to the previously adopted resolutions regarding such Principal APJs.

#### **4. Expanded Prior Art**

WHEREAS, the grounds for inter partes review proceedings are limited to patents and printed publications that would anticipate or render obvious challenged claims under 35 U.S.C. §§ 102 and 103;

RESOLVED that AIPLA opposes, in principle, expanding the grounds for inter partes review proceedings;

RESOLVED that AIPLA specifically opposes adding applicant admitted prior art (AAPA) as a basis for inter partes review;

RESOLVED that AIPLA specifically opposes adding obviousness-type double patenting (OTDP) as a basis for inter partes review;

FURTHER RESOLVED that AIPLA specifically opposes adding statutory double patenting as a basis for inter partes review.

#### **5. Bad Faith Conduct**

WHEREAS, AIPLA agrees, in principle, that bad-faith conduct in AIA trial proceedings should be discouraged;

WHEREAS, the USPTO has the ability to regulate bad faith conduct and prescribe sanctions for improper conduct of those practicing before the PTAB and the USPTO has the ability to regulate improper conduct of those practicing before the Office of Enrollment and Discipline;

RESOLVED that AIPLA opposes further efforts by the USPTO to specifically regulate “bad-faith conduct” in AIA trial proceedings.

#### **6. Discretion to Institute AIA Trial Proceedings**

WHEREAS, AIPLA has supported the use of discretionary denials of institution of AIA trial proceedings to help avoid gamesmanship, and as a means to provide patent owners relief from harassment at the USPTO;

WHEREAS, AIPLA has generally favored USPTO rulemaking to establish standards for discretionary denial of institution and has tentatively supported the use of multi-factor tests developed through the USPTO’s precedential opinion panel process;

RESOLVED that the Director, and by delegation the Administrative Patent Judges (APJs) of the Patent Trial and Appeal Board (PTAB), should retain discretion to deny institution or institute inter partes review or post grant review proceedings, including in view of past requests for reexamination, prior or co-pending petitions for inter partes review or post grant review, or contentions raised in prior or co-pending district court lawsuits in which the petitioner or the petitioner’s real parties in interest or privies assert invalidity of the same claims of the same patent challenged in the petition.



## **7. Appeals from Institution Decisions**

RESOLVED that appeals from institution decisions in inter partes review or post grant review proceedings should be prohibited only for determinations relating to whether the information presented in the petition and any response shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

## **8. Claim Construction Standard in AIA Trial Proceedings**

RESOLVED that AIPLA favors the PTAB using the same claim construction standard used in district court proceedings for inter partes review and post grant review proceedings.

## **9. Real-Party-in-Interest Evidence**

RESOLVED that AIPLA favors, in principle, requiring automatic disclosure of evidence identifying real parties in interest of the petitioner in inter partes review and post grant review proceedings.

## **10. AIA Trial Proceedings as a Cost-Effective Alternative**

WHEREAS, post grant trial proceedings before USPTO were intended to provide a cost-effective and efficient alternative to patent challenges in district court proceedings;

WHEREAS, over eighty percent of post grant trial proceedings before the USPTO involve patents that are the subject of co-pending litigation;

WHEREAS, some patent disputes are protracted as a result of perceived overuse of post grant proceedings;

RESOLVED that AIPLA favors, in principle, legislative, regulatory, and judicial efforts to ensure post grant proceedings before the USPTO operate as intended—as an efficient alternative to district court challenges that balance the interests of patent owners, accused infringers and the public and avoids abuse of judicial and agency resources through gamesmanship.

## **11. Time Bar and Settlement Agreements**

RESOLVED that the American Intellectual Property Law Association (AIPLA) favors, in principle, applying the time bar for filing a petition for IPR after filing of a civil action in a manner that balances (1) providing sufficient time to prepare a petition with (2) obtaining timely resolution in an IPR proceeding so that it may fulfill its purpose of being an alternative to district court litigation;

FURTHER RESOLVED that AIPLA favors, in principle, decreasing the time bar from one-year to a shorter period of time;

FURTHER RESOLVED that AIPLA favors, in principle, enforcement of provisions in a settlement or other agreement between parties concerning whether a party may file an IPR/PGR petition or whether an instituted IPR/PGR proceeding may continue; and

FURTHER RESOLVED that AIPLA favors, in principle, not applying a time bar for filing a petition seeking to institute an IPR after the filing of a civil action (a) if the civil action was dismissed without prejudice and filing a petition does not conflict with any settlement or other agreement between the parties of that civil action, or (b) if claims in a patent were added or amended in reexamination after the complaint was filed, in which case the time bar should be triggered based on an unambiguous, concrete event, such as upon issuance of a reexamination certificate.

## **12. PTAB Considering Parallel Court or ITC Proceedings**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, the PTAB at all times prior to and after a decision to institute an IPR/PGR having discretion whether and to what extent to consider the full record of related proceedings before a district court or the ITC, and the PTAB should articulate its reasoning for deciding to follow or not follow determinations made in a district court or ITC.

## **13. Standing to Appeal**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, applying traditional Constitutional principles for standing in deciding whether a party has standing to appeal a PTAB decision, and AIPLA does not favor legislation that attempts to create standing that otherwise would not exist under Constitutional requirements.

## **14. Burden of Proof/Presumption of Validity in AIA trial proceedings**

RESOLVED that AIPLA supports applying a presumption of validity for patents challenged in AIA trial proceedings;

FURTHER RESOLVED, that AIPLA supports changing burden of proof for petitioners challenging issued claims in AIA trial proceedings from the preponderance of the evidence standard to the clear and convincing evidence standard.

## **15. Off Ramp for Proposed Amended Claims**

WHEREAS Patent Owners should have the ability to amend claims that are challenged in AIA trial proceedings;

WHEREAS the timing of AIA trial proceedings often does not provide sufficient time or expertise for evaluating proposed amended claims and the PTAB does not engage in examination of claims in the first instance;

WHEREAS the USPTO has an examination corps with requisite experience and expertise to examine proposed amendments to claims in issued patents;

RESOLVED THAT AIPLA supports, in principle, an “off ramp” by ex parte reexamination or another expedited proceeding for amendments to claims challenged in AIA trial proceedings, provided that such “off ramp” provides a meaningful mechanism for claim amendments, intervening rights apply to newly issued claims, the “off-ramp” would not impact the timing for final written decisions in trial proceedings, and the “off-ramp” would be conducted with “special dispatch.”

## **16. Funding for Small and Micro Entities**

WHEREAS AIPLA recognizes that challenges to issued patents of patent owners who qualify as small and micro entities may be costly in terms of financial and personnel resources;

WHEREAS AIPLA supports in principle efforts to lessen burdens of challenges to such patent owners, provided that doing so can be achieved in a fair and balanced manner;

RESOLVED THAT AIPLA opposes, in principle, the Office covering attorney's fees, costs, and expenses of any patent owner for expenses associated with AIA trial proceedings, unless it can be accomplished in a manner that avoids gamesmanship and provides appropriate incentives/disincentives to interested parties.

(Board of Directors – July 14, 2022)

**232-01 Patents/Medical**

RESOLVED, that the AIPLA opposes in principle any attempt to restrict patentable subject matter under 35 U.S.C 101, and, specifically, opposes passage of any legislation which would prevent the issuance of any patent on a process for performing a surgical or medical procedure, administering a surgical or medical therapy, or making a medical diagnosis.

(Board of Directors Meeting – July 22, 1995.

Retained as amended by Board of Directors – May 5, 2006.

Retained by Board of Directors – July 13, 2016.)

**232-02 Patents/Business Methods**

RESOLVED, that the American Intellectual Property Law Association supports in principle that

(A) Business method inventions should be protected under the same framework of laws under which other inventions are protected,

(B) No special test or interpretation of the law should be applied to business method inventions, and

(C) U.S. inventors of business method innovations should not be substantively or procedurally disadvantaged compared to their foreign competitors by changes in the U.S. patent laws.

(Board of Directors Meeting – May 19, 2000;

Retained by Board of Directors – February 5, 2011; and

Retained by Board of Directors – September 10, 2021.)

**234-01 Patent Law – Patentability**

RESOLVED that the American Intellectual Property Law Association (AIPLA) favors, in principle, amending 35 U.S.C. § 101 to recite the following:

**Eligible Subject Matter**

a) Whoever invents or discovers, and claims as an invention, any useful process, machine, manufacture, composition of matter, or any useful improvement thereof, shall be entitled to a patent therefor, subject only to the conditions and requirements set forth in this title.

### **Sole Exceptions to Subject Matter Eligibility**

b) A claimed invention is ineligible under subsection (a) if and only if the claimed invention as a whole (i) exists in nature independently of and prior to any human activity or (ii) is performed solely in the human mind.

### **Sole Eligibility Standard**

c) The eligibility of a claimed invention under subsections (a) and (b) shall be determined without regard to:

- (i) the requirements or conditions of sections 102, 103, and 112 of this title;
- (ii) the manner in which the claimed invention was made or discovered; or
- (iii) whether the claimed invention includes an inventive concept.

(Board of Directors Meeting – March 23, 2017.

Amended and retained by Board of Directors – January 27, 2018.)

## **245-02**

### **Patent Term Restoration Act**

RESOLVED, the American Intellectual Property Law Association supports in principle that the provisions of the U.S. patent laws providing for restorations of patent term in the case of products requiring federal pre-marketing regulatory approval should be amended to afford an extension of term of up to 10 years from the pre-restoration expiration date of the patent.

RESOLVED, the American Intellectual Property Law Association supports in principle that the provisions of the U.S. patent laws providing for restorations of patent term in the case of products requiring federal pre-marketing regulatory approval should be amended to afford a maximum post-marketing patent term of 15 years.

RESOLVED, the American Intellectual Property Law Association supports in principle that the provisions of the U.S. patent laws providing for restorations of patent term in the case of products requiring federal pre-marketing regulatory approval should be amended to provide that a single patent can be made the subject of multiple extensions in the case where the patent claims two or more products subject to regulatory approval that are otherwise independently eligible for regulatory approval, provided that:

- (1) each such extension shall afford enforceable rights only with respect to the particular product on which the extension was based and
- (2) each such extension applies from the expiration date of the patent determined without reference to any prior extension based on a regulatory approval.

RESOLVED, the American Intellectual Property Law Association supports in principle that the provisions of the U.S. patent laws providing for restorations of patent term in the case of products requiring federal pre-marketing regulatory approval should be amended to remove the deductions from the regulatory review period attributable to the period before an application for regulatory approval is filed.

RESOLVED, the American Intellectual Property Law Association supports in principle that the provisions of the U.S. patent laws providing for restorations of patent term in the case of products requiring federal pre-marketing regulatory approval should be amended to afford restorations of patent term for agricultural chemicals, including pesticides, herbicides, rodenticides, and the like, on substantially the same basis that other regulated products are afforded restorations of patent term.

(Board of Directors Meeting – February 4, 1995.  
Retained in part by Board of Directors – May 13, 2005.  
Retained by Board of Directors – July 15, 2015.)

## **260-02**

### **Venue**

RESOLVED that the American Intellectual Property Law Association (AIPLA) favors, in principle, amending 28 U.S.C. § 1400 by substituting the following for subsection (b):

(b) A civil action for patent infringement or an action for a declaratory judgment that a patent is invalid, unenforceable, or not infringed may be brought only in a judicial district

(1) where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business;

(2) where the defendant has agreed or consented to be sued in the instant action;

(3) where (i) the defendant has committed acts of infringement, (ii) a plaintiff owns, controls or operates a regular and established place of business, and (iii) either research or development relating to a patent-in-suit occurred prior to the patent's priority date, or the patent rights holder is manufacturing a product claimed in the patent-in-suit at the time the complaint is filed; or

(4) where, in the case of a defendant not resident in the United States, in any judicial district, in accordance with section 1391(c)(3).

(Board of Directors Meeting – January 24, 2018.)

**264-01****Court of Appeals for the Federal Circuit**

RESOLVED that the American Intellectual Property Law Association opposes, in principle, the requirement that judges of the Federal judicial circuit reside with fifty miles of the District of Columbia, and specifically, that the American Intellectual Property Law Association recommends that Section 102(b) of Public Law 97-164 be repealed.

(Board of Directors Meeting – September 17, 1999.  
Retained by Board of Directors – January 30, 2010; and  
Retained by Board of Directors – September 11, 2020.)

**264-02****Judicial Salaries**

RESOLVED, that the American Intellectual Property Law Association favors, in principle, legislation that would increase the salaries of United States federal judges to ensure the recruitment and retention of well-qualified candidates.

(Board of Directors Meeting – January 26, 2008.  
Amended and retained by Board of Directors – July 18, 2018.)

**264-03****Judicial Security**

RESOLVED, that the American Intellectual Property Law Association favors, in principle, legislation that would increase the security of United States judges.

(Board of Directors Meeting – March 25, 2021.)

**266-01****Courts – Protective Orders**

RESOLVED, that the America Intellectual Property Law Association is opposed to legislative efforts that would limit a judge’s discretion in entering a protective order governing the disclosure of information obtained through discovery, the terms of a settlement agreement, or access to court records in a civil case.

(Board of Directors Meeting – July 16, 2009.  
Retained as amended by Board of Directors – October 26, 2019.)

**266-03****Courts – Privilege**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, recognizing that confidential communications between a client and a Patent Agent within the scope of the Agent’s legal authority are privileged and therefore protected from forcible disclosure, unless and until the client waives such privilege. For purposes of this resolution, Patent Agents includes both domestic patent agents and those in other countries—who may have titles such as “patent attorney”—with ethical or legal responsibilities to maintain client confidences but who are not an attorney at law.

(Board of Directors Meeting – December 15, 2016.)

RESOLVED, that the American Intellectual Property Law Association (AIPLA) opposes, in principle, any legislative, judicial or regulatory action that would prevent settlement of litigation or that would characterize such settlements as a *per se* violation of the antitrust laws, including litigation brought pursuant to the Drug Price Competition and Patent Term Restoration Act of 1984 (the Hatch-Waxman Act) under 35 U.S.C. § 271(e)(2).

RESOLVED, that the American Intellectual Property Law Association (AIPLA) believes that, depending on the facts of a particular case, the settlement of litigation brought pursuant to the Hatch-Waxman Act under 35 U.S.C. § 271(e)(2) may be in the public interest.

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, allowing parties involved in litigation brought pursuant to the Hatch-Waxman Act under 35 U.S.C. § 271(e)(2) to settle such litigation in a manner that satisfies antitrust concerns under the “rule of reason” analysis.

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, the enactment of a legislative framework to facilitate settlement of litigation brought pursuant to the Hatch-Waxman Act under 35 U.S.C. § 271(e)(2) that immunizes the parties from antitrust liability if the settlement is judicially determined to be reasonable.

(Board of Directors Meeting – March 15, 2007.  
Retained by Board of Directors – July 19, 2017)

RESOLVED, that the American Intellectual Property Law Association (AIPLA) is opposed, in principle, to any exception to the Noerr-Pennington antitrust exemption for litigation to enforce intellectual property rights that would not require proof that the infringement litigation was objectively baseless; and

SPECIFICALLY, AIPLA opposes denying Noerr-Pennington protection to owners of intellectual property rights accused of a pattern or practice of successive filings by applying a standard based solely on subjective factors in the case of multiple similar or related lawsuits, as articulated in cases like *USS-POSCO Indus. v. Contra Costa Cty. Bldg. and Constr. Trades Council*, 31 F.3d 800 (9th Cir. 1994) and *Prime Time 24 Jt. Venture v. NBC*, 219 F.3d 92 (2d Cir. 2000).

(Board of Directors Meeting – March 15, 2007.  
Retained by Board of Directors – July 19, 2017)

RESOLVED, that the American Intellectual Property Law Association favors the practice by standards development organizations (SDOs) of making information relating to the SDOs' standards development as well as their intellectual property rights/licensing and disclosure policies clear and publicly available, and reasonable accessible to the public.

RESOLVED, that AIPLA favors SDOs having the flexibility to formulate their own policies and procedures, and AIPLA does not support legislative, regulatory, judicial, or administrative action that requires all SDOs to adopt a single prescribed intellectual property rights/licensing and disclosure policy.

(Board of Directors Meeting – October 21, 2010; and  
Retained as amended by Board of Directors Meeting – September 10, 2021)

RESOLVED, that the American Intellectual Property Law Association (AIPLA) supports, in principle, the codification of provisions relating to patent damages that provide in substance the following:

- (1) if an apportionment of economic value is necessary to assure that damages based upon a reasonable royalty do not exceed the economic value properly attributable to the use made of the invention, such apportionment shall exclude from the reasonable royalty calculation the economic value shown by the infringer to be attributable to the infringer's incorporation into the infringing product or process of features or improvements, whether or not themselves patented, that contribute economic value to the infringing product or process separately from the economic value properly attributable to the use made of the invention;
- (2) where the claimant shows that 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; and
- (3) the court shall identify all factors relevant to the determination of a reasonable royalty, and the court or the jury, as the case may be, shall consider such factors in making the determination.

(Board of Directors Meeting – March 15, 2007.  
Retained by Board of Directors – July 19, 2017.)

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, legislation to amend the provisions of 35 U.S.C. § 289, 19 U.S.C. § 1595a, and 19 C.F.R. 133 to provide statutory and regulatory authority for the U.S. Customs and Border Protection (CBP) to extend full border enforcement protection to design patents by creating a registry similar to that which currently exists for goods protected by trademarks or copyrights.



RESOLVED, that AIPLA specifically favors amending the provisions of 35 U.S.C. § 289 as follows:

35 U.S.C. § 289. Additional remedies for infringement of design patent

- (a) Whoever during the term of a patent for a design, without license of the owner, (1) applies the patented design, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or (2) sells or exposes for sale any article of manufacture to which such design or colorable imitation has been applied shall be liable to the owner to the extent of his total profit, but not less than \$250, recoverable in any United States district court having jurisdiction of the parties.
- (b) No articles of manufacture bearing the patented design, or any colorable imitation thereof, shall be imported, transshipped or exported without license of the patent owner, and infringing copies shall be subject to seizure, forfeiture and destruction for violation of the customs laws contained in Title 19.
- (c) Nothing in this section shall prevent, lessen, or impeach any other remedy which an owner of an infringed patent has under the provisions of this title, but he shall not twice recover the profit made from the infringement.

RESOLVED, that AIPLA specifically favors amending the provisions of 19 U.S.C. § 1595a (c) as follows:

19 U.S.C. § 1595a. Forfeitures and other penalties

**(c) Merchandise introduced contrary to law**

Merchandise which is introduced or attempted to be introduced into the United States contrary to law shall be treated as follows:

- (1) The merchandise shall be seized and forfeited if it—
  - (A) is stolen, smuggled, or clandestinely imported or introduced;
  - (B) is a controlled substance, as defined in the Controlled Substances Act (21 U.S.C. 801 et seq.), and is not imported in accordance with applicable law;
  - (C) is a contraband article, as defined in section 80302 of title 49; or
  - (D) is a plastic explosive, as defined in section 841 (q) of title 18, which does not contain a detection agent, as defined in section 841(p) of such title.
- (2) The merchandise may be seized and forfeited if—
  - (A) its importation or entry is subject to any restriction or prohibition which is imposed by law relating to health, safety, or conservation and the merchandise is not in compliance with the applicable rule, regulation, or statute;
  - (B) its importation or entry requires a license, permit or other authorization of an agency of the United States Government and the merchandise is not accompanied by such license, permit, or authorization;
  - (C) it is merchandise or packaging in which copyright, design patent, trademark, or trade name protection violations are involved (including, but not limited to, violations of section 1124, 1125, or 1127 of title 15, section 506 or 509 of title 17, [[or]] section 2318 or 2320 of title 18, or section 289 of title 35);
  - (D) it is trade dress merchandise involved in the violation of a court order citing section 1125 of title 15;

- (E) it is merchandise which is marked intentionally in violation of section 1304 of this title; or
  - (F) it is merchandise for which the importer has received written notices that previous importations of identical merchandise from the same supplier were found to have been marked in violation of section 1304 of this title.
- (3) If the importation or entry of the merchandise is subject to quantitative restrictions requiring a visa, permit, license, or other similar document, or stamp from the United States Government or from a foreign government or issuing authority pursuant to a bilateral or multilateral agreement, the merchandise shall be subject to detention in accordance with section 1499 of this title unless the appropriate visa, license, permit, or similar document or stamp is presented to the Customs Service; but if the visa, permit, license, or similar document or stamp which is presented in connection with the importation or entry of the merchandise is counterfeit, the merchandise may be seized and forfeited.
- (4) If the merchandise is imported or introduced contrary to a provision of law which governs the classification or value of merchandise and there are no issues as to the admissibility of the merchandise into the United States, it shall not be seized except in accordance with section 1592 of this title.
- (5) In any case where the seizure and forfeiture of merchandise are required or authorized by this section, the Secretary may—
- (A) remit the forfeiture under section 1618 of this title, or
  - (B) permit the exportation of the merchandise, unless its release would adversely affect health, safety, or conservation or be in contravention of a bilateral or multilateral agreement or treaty.

RESOLVED, that AIPLA specifically favors amending the provisions of 19 C.F.R. 133 to generally mirror the existing trademark and copyright regulations with respect to design patents.

(Board of Directors Meeting – December 12, 2012.)

## **TRADEMARKS AND UNFAIR COMPETITION**

### **410-01 Trademark – Prosecution**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) believes, in principle, that misstatements in the identification of goods and/or services in filings before the U.S. Patent and Trademark Office occasioned by an honest mistake, carelessness, inadvertence, oversight, language difficulties, misunderstanding of the law, or the like, and not made with an intent to deceive, should not constitute fraud.

(Board of Directors Meeting – May 9, 2007.  
Retained by Board of Directors – July 19, 2017.)

### **410-02 Trademark – Prosecution**

RESOLVED, that the American Intellectual property Law Association (AIPLA) favors, in principle, that a trademark application or registration that contains a misstatement in the identification of goods and/or services occasioned by an honest mistake, carelessness, inadvertence, oversight, language difficulties, misunderstanding of the law, or the like, and not made with an intent to deceive, should be permitted to be amended or restricted under Section 18 of the Lanham Act, 15 U.S.C. § 1068 to amend or delete the excess goods and/or services, and should not result in the entire application being voided or the registration cancelled.

(Board of Directors Meeting – May 9, 2007.  
Retained by Board of Directors – July 19, 2017.)

### **410-03 Trademark – Prosecution**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) believes, in principle, that where a trademark applicant or registrant erroneously states in filings before the U.S. Patent and Trademark Office that it is using the mark in commerce on or in connection with particular goods and/or services, such misstatement alone should not be deemed “material” for purposes of analyzing whether the applicant/registrant committed fraud on the Office if (1) the party was in fact using the mark in commerce on or in connection with other similar or related goods or services identified in the application or registration as of the filing dates for an application under Lanham Act Section 1(a), an affidavit under Lanham Act Section 8, a renewal under Lanham Act Section 9, a Statement of Use, or an Amendment to Allege Use; and (2) the applicant/registrant would have been entitled to a registration covering those other goods or services.

(Board of Directors Meeting – May 9, 2007.  
Retained by Board of Directors – July 19, 2017.)

RESOLVED, that the American Intellectual Property Law Association (“AIPLA”) favors, in principle, revision of the Lanham Act, 15 U.S.C. § 1051, *et seq.*, to provide that a non-functional product configuration or design can be deemed inherently distinctive when the requirements for inherent distinctiveness applied to trade dress are met.

RESOLVED, that the American Intellectual Property Law Association (“AIPLA”) favors amending the Lanham Act by adding the following to Section 45, 15 U.S.C. § 1127:

Non-functional trade dress (including a product configuration or design) which is “inherently distinctive” is registrable under section 2 and protectable under section 43 of this Act. In determining whether a product configuration or design is “inherently distinctive” under this Act, the following factors shall be considered:

- (1) whether the configuration or design is a common basic shape or design;
- (2) whether the configuration or design is unique or unusual in the particular field involved;
- (3) whether the configuration or design is a mere refinement of a commonly-adopted and well-known form of ornamentation for the particular class of goods involved;
- (4) whether the configuration or design is capable of creating a commercial impression distinct from any accompanying words; and
- (5) any other factor which may tend to show that the configuration or design would be inherently recognized by members of the relevant public as an indication of the source of the goods.

RESOLVED, that the American Intellectual Property Law Association (“AIPLA”) favors, in principle, revision of the Lanham Act § 1051, *et seq.*, to provide that the degree to which granting protection would hinder competition shall be considered in determining the functionality of a product feature for which trade dress protection is sought.

RESOLVED, that the American Intellectual Property Law Association (“AIPLA”) favors amending the Lanham Act to add the following to Section 45, 15 U.S.C. § 1127:

The term “functional” means that the matter sought to be protected under this Act is so important for its utilitarian purpose that to afford it protection under this Act would significantly hinder effective competition. In determining whether matter is functional under this Act, the factors to be considered shall include, but not be limited to:

- (1) whether effective alternative designs are available to competitors;
- (2) whether the matter yields a significant utilitarian advantage over alternative designs;
- (3) whether the matter achieves economies in the manufacture or use of the goods or services, reduces their cost, or enhances their quality;
- (4) whether the party seeking to protect the matter has touted its utilitarian advantages; and

(5) whether the matter is or has been claimed in a utility patent or patent application.

(Board of Directors Meeting – October 18, 2001;  
Retained by Board of Directors – January 26, 2012; and  
Retained by Board of Directors – September 25, 2022.)

#### **425-02 Trademark – Domain Names**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, that domain name registrant information should be complete and accurate and publicly available through “WHOIS” searches.

(Board of Directors Meeting – March 18, 2004.  
Retained by Board of Directors – July 15, 2015.)

#### **425-10 Trademark – Counterfeit Goods**

1) RESOLVED, that the American Intellectual Property Law Association favors in principle, providing protection against trafficking in counterfeit labels, patches, and medallions that are unattached to any goods.

(2) RESOLVED, that the American Intellectual Property Law Association favors in principle, providing mandatory destruction, forfeiture and restitution provisions, for trafficking in counterfeit labels, patches and medallions that are unattached to any goods, as well as civil equitable and monetary remedies, to trademark owners that are similar to those already granted to copyright owners.

(Board of Directors Meeting – January 26, 2005.  
Retained by Board of Directors – July 15, 2015.)

#### **425-11 Trademark – Licensee Estoppel**

RESOLVED, that the American Intellectual Property Law Association supports in principle the continuing recognition of the doctrine of licensee estoppel in trademark cases and that the decision to apply or not to apply that doctrine in cases involving certification marks should be made on a case-by-case basis; and

Specifically, does not support amending 15 U.S.C. § 1054 of the Lanham Act to overturn the decision of the Second Circuit Court of Appeals in *Idaho Potato Commission v. M&M Produce Farm & Sales*, 335 F.3d 130 (2d Cir. 2003).

(Board of Directors Meeting – March 17, 2005.  
Retained by Board of Directors – July 15, 2015.)

RESOLVED, that the American Intellectual Property Law Association ("AIPLA") favors, in principle, revision of the Lanham Act, 15 U.S.C. § 1051, *et seq.*, to incorporate provisions that explicitly provide protection for marks that are not used or registered in the United States.

RESOLVED, that AIPLA favors amending the Lanham Act by amending Sections 2, 43 and 45 to explicitly protect well-known marks, including any reproduction, imitation, translation, or transliteration of a well-known mark that is likely to cause confusion, mistake, or to deceive, or that would be likely to cause dilution by blurring or dilution by tarnishment of a well-known mark, whether or not registered with the Patent and Trademark Office.

(Board of Directors Meeting – May 15, 2009.

Retained as amended by Board of Directors – October 26, 2019.)

RESOLVED, that the American Intellectual Property Law Association ("AIPLA") favors, in principle, legislation to amend the provisions of the Lanham Act relating to awards of actual damages and accountings for unjust enrichment profits for the purposes of clarifying the availability of and prerequisites for such awards in cases arising under that Act; promoting uniformity and predictability in the courts' application of those provisions; and furthering the policies of that Act of protecting the public against likelihood of confusion, protecting businesses' investments in trademarks and other commercial indicia from injury, and making trademark infringement and other acts of unfair competition unprofitable to the infringer; and it is further

RESOLVED, that AIPLA specifically favors amendment of the remedial provisions of the Lanham Act for the purpose of effectuating these reforms, as follows:

- To provide that, upon a finding of trademark or service mark infringement a court should award monetary relief measured by:

[i] the infringer's unjust enrichment profits attributable to the infringement and/or;

[ii] the mark owner's actual damages including lost profits on but-for sales, and effect on goodwill and reputation,

taking into account factors including, but not limited to, the position of the parties in the marketplace, actual confusion, and the conduct of the infringer, but in no event shall the mark owner be entitled to less than a reasonable royalty for the infringement; and

- To provide that these amendments are not intended to change restrictions on an award of double recovery or otherwise affect the availability of other remedies under existing case law, to the extent not in conflict with the above.

RESOLVED, that the American Intellectual Property Law Association (“AIPLA”) favors, in principle, legislation to amend the provisions of the Lanham Act relating to monetary relief for the purposes of clarifying the availability of and prerequisites for awards of such relief in cases arising under that Act; promoting uniformity and predictability in the courts’ application of those provisions; and furthering the policies of that Act of protecting the public against likelihood of confusion, protecting businesses’ investments in trademarks and other commercial indicia from injury, and making trademark infringement and other acts of unfair competition unprofitable to the infringer; and it is further

RESOLVED, that AIPLA specifically favors amendment of the remedial provisions of the Lanham Act for the purpose of effectuating these reforms, as follows:

- To provide that, upon a finding of willful trademark or service mark infringement and subject to the principles of equity, a court may enhance the amount of any monetary award based on an infringer’s unjust enrichment profits attributable to its use of the infringing mark, the mark owner’s actual damages measured by lost profits on sales it would have made but for the infringement, and/or a reasonable royalty, up to three times the amount of such award;
- To provide that these amendments are not intended to change restrictions on an award of double recovery or otherwise affect the availability of other remedies under existing case law, to the extent not in conflict with the above.

RESOLVED, that AIPLA favors, in principle, legislation to amend the provisions of the Lanham Act providing for injunctive relief for the purpose of providing that, in trademark or service mark infringement cases where all other prerequisites for a preliminary and/or permanent injunction are met, a finding of probable success on the merits of the mark owner’s likelihood of confusion claim (with respect to a preliminary injunction) or a finding of a likelihood of confusion (with respect to a permanent injunction) shall give rise to a rebuttable presumption of irreparable injury sufficient to support entry of an injunction; and it is further

RESOLVED, that AIPLA specifically favors amendment of the remedial provisions of the Lanham Act for the purpose of effectuating these reforms, as follows:

- To provide that, in cases where all other prerequisites for the entry of preliminary and/or permanent injunctive relief for trademark or service mark infringement are met, a finding of probable success on the merits of the mark owner’s likelihood of confusion claim (with respect to a preliminary injunction) or a finding of a likelihood of confusion (with respect to a permanent injunction) shall give rise to a rebuttable presumption of irreparable injury sufficient to support entry of an injunction.

(Board of Directors – September 14, 2012.)

## **425-15**

### **Trademark – Legislation**

RESOLVED, that the American Intellectual Property Law Association favors amending the federal Lanham Act, including through Section 3 of H.R. 6196, to codify the long-standing acceptance by the U.S. Patent and Office of ex parte letters of protest. AIPLA supports that the proposed amendment:

(1) requires the screening of letters of protest by the Commissioner for Trademarks before the evidence accompanying those letters is forwarded to examining attorneys; and

(2) sets a deadline of two months for the office of the Commissioner for Trademarks to determine whether the evidence accompanying those letters should be forwarded to examining attorneys.

RESOLVED, that the American Intellectual Property Law Association favors in principle amending the federal Lanham Act, including through Section 4 of H.R. 6196, to authorize the Director of the Patent and Trademark Office to recognize exceptions to the standard six-month deadline for responding to communications from trademark examining attorneys. AIPLA urges that:

(1) shortened sixty-day response deadlines be reserved for purely procedural issues; and

(2) applicants receive the opportunity to request an extension of any reduced deadline to the standard six months with a single filing.

RESOLVED, that the American Intellectual Property Law Association favors in principle legislation amending the federal Lanham Act to authorize the administrative invalidation by the Director of the U.S. Patent and Trademark Office of registrations covering marks that either have never been used in commerce, or are not used in commerce by the relevant date under the statute for obtaining a registration.

RESOLVED, the American Intellectual Property Law Association favors the incorporation of the following into H.R. 6196 or any legislation to amend the federal Lanham Act to authorize administrative proceedings by the Director of the U.S. Patent and Trademark Office to invalidate registrations covering marks that either have never been used in commerce or are not used in commerce by the relevant date required under the statute:

- (1) a standing requirement for the initiation of such a proceeding;
- (2) authorization of a single type of proceeding to address both registrations of marks that have never been used in commerce and registrations of marks that were not used in commerce by the relevant date (as opposed to separate expungement and reexamination proceedings);
- (3) a clear definition of the responsive showing required of the owners of registrations of marks for which prima facie showings of nonuse have been made;
- (4) a minimum response date for the owners of registrations of marks for which prima facie showings of nonuse have been made; and
- (5) a mandate that the Director of the Patent and Trademark Office set limits on the number of administrative proceedings targeting individual registrations.

(Board of Directors – May 21, 2020)



RESOLVED, that the American Intellectual Property Law Association (“AIPLA”) favors in principle amending the federal Lanham Act to add a cause of action for contributory trademark liability for online platforms for a third-party seller’s sales through such online platforms of goods and services under counterfeit marks. AIPLA supports the key points of the SHOP Safe Act of 2021, or any similar legislation, that:

- (1) incentivize online platforms to follow best practices in addressing the increasing problem of goods and services sold online under counterfeit marks; and
- (2) provide a safe harbor from contributory trademark infringement for those platforms that follow the best practices.

RESOLVED, the AIPLA favors the following amendments to the SHOP Safe Act of 2021, or any other similar legislation to amend the federal Lanham Act to incentivize online platforms to take action to prevent sales under counterfeit marks of goods and services sold through the platforms:

- (1) remove any limitation that the provisions apply only to the sale of goods that implicate health and safety, so that the law applies to all goods and services sold under counterfeit marks; and
- (2) clarify or amend any best practice regarding (a) a requirement that the platforms must adopt “reasonable proactive technological measures for screening goods before displaying the goods to the public to prevent any third-party seller’s use of a counterfeit mark in connection with the sale, offering for sale, distribution, or advertising of goods on the platform,” or (b) a requirement that platforms must adopt “reasonable technological measures for screening third-party sellers to ensure that sellers who have been terminated do not rejoin or remain on the platform under a different seller identity or alias.”

(Board of Directors – June 14, 2021)

RESOLVED, that the American Intellectual Property Law Association supports the promulgation of sensible, efficient and coherent rules for implementing the Madrid Protocol and the Madrid Protocol Implementation Act.

(Board of Directors Meeting – May 16, 2003;  
Amended and retained by Board of Directors – February 1, 2014.)

RESOLVED, that the American Intellectual Property Law Association (AIPLA) supports, in principle, a notification process by which (i) Registry Operators will be notified if domains they seek to reserve have been registered with the Trademark Clearinghouse,

and (ii) rights holders who have registered their trademarks with the Trademark Clearinghouse will be notified if a Registry Operator seeks to reserve their marks;

FURTHER RESOLVED, that AIPLA supports, in principle, the establishment of a dispute resolution procedure to resolve conflicts in which a brand owner objects to a Registry Operator's reservation of a domain name identical or confusingly similar to a brand owner's mark.

(Board of Directors Meeting – March 20, 2014.)

#### **455-05 Trademark Law – ICANN**

WHEREAS, the National Telecommunications and Information Authority (“NTIA”) has contractual control over key internet domain name functions (the Internet Assigned Number Authority “IANA” functions), and

WHEREAS, the United States Department of Commerce has recently announced its intention to transfer the IANA functions to a “global multi-stockholder community,” and

WHEREAS, brand owners and trademark owners have a strong interest in the continuance of the free flow of information regarding their products and services over the Internet;

It is therefore RESOLVED, that the AIPLA opposes the transfer of the IANA contracts unless the following criteria are satisfactorily achieved:

- (a) a new, multi-stakeholder system can meet the high standards of security and openness set by the NTIA,
- (b) there is assurance that no government, coalition or international body will be empowered to negatively impact these standards, and
- (c) any proposed transfer plan is publicized well in advance of a proposed transition date, and stakeholders have evaluated and confirmed the viability of the plan.

(Board of Directors Meeting – September 19, 2015.)

#### **455-06 Trademark Law – Plain Packaging**

WHEREAS, the American Intellectual Property Law Association (“AIPLA”) promotes strong trademark rights domestically and globally and recognizes and acknowledges the important public interest in improving health and safety;

RESOLVED, that AIPLA opposes, in principle, any plain packaging legislation/regulation that prohibits outright the use of a trademark owner's otherwise lawful trademarks (including brand names, house marks, product marks and/or logos) on particular types of lawful products; and

RESOLVED, that AIPLA opposes, in principle, any plain packaging legislation/regulation that violates International law (treaties) directed to trademarks.

(Board of Directors Meeting – January 30, 2016.)

## **COPYRIGHTS**

**510-01**

### **Copyright – Copyright Office**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, legislative action to appropriately modernize the U.S. Copyright Office (the “Office”), in order for the Office to be able to meet the ever-expanding needs and expectations of Congress, its stakeholders, and the public; and

SPECIFICALLY, AIPLA supports Congressional action to appropriately modernize the U.S. Copyright Office, including the following elements:

1. That the U.S. Copyright Office be led by an individual, appointed by the President and confirmed by the Senate;
2. That the U.S. Copyright Office have control over its own budget, staffing, IT, and copyright policy;
3. That the U.S. Copyright Office be adequately funded through appropriations, which should be comprised of both user fees and taxpayer dollars;
4. That the U.S. Copyright Office be given the authority to set appropriate fees as necessary to carry out its responsibilities and modernize, with a proper level of Congressional oversight of the fee structure;
5. That the U.S. Copyright Office be given sufficient control over the use of its fees, subject to appropriate Congressional oversight, and the Office should be provided access to such funds over multiple years and through a multi-year budget cycles (*i.e.*, a revolving fund); and
6. That the U.S. Copyright Office be authorized and adequately funded to improve the registration and recordation processes, and re-design and re-structure its IT system to provide accurate, up-to-date, searchable, and comprehensive public records.

(Board of Directors Meeting – September 11, 2016)

**515-04**

### **Copyright – Fair Use**

RESOLVED, that AIPLA adopts the position that it is fair use under the Copyright Act for a patent applicant or an applicant’s representative, in the course of preparing and prosecuting patent applications, to reproduce and distribute, to the extent reasonably necessary, journal articles and other copyrighted non-patent literature relevant to such applications.

(Board of Directors Meeting – October 27, 2012.)

RESOLVED, that AIPLA supports efforts to address the issue of orphan works under U.S. Copyright law.

FURTHER RESOLVED, that AIPLA supports additional legislative, regulatory, and voluntary solutions to address the use of orphan works on an occasional or case-by-case basis, using a flexible approach which analyzes various factors to determine whether the user has conducted a reasonably diligent search for the copyright owner and is using the orphan work in good faith, including, for example, by searching according to Copyright Office published and industry “best practices” and providing as much attribution to the author or copyright owner as possible and appropriate under the circumstances, which would in turn limit the remedies available to an aggrieved copyright owner, but in any event provide for reasonable compensation for the past and continued use of the work; and

SPECIFICALLY, that application of the legislative, regulatory, and voluntary solutions with regard to occasional or case-by-case basis should also be applied equally to mass digitizers, and mass digitizers should not be granted a safe-harbor;

- (i) A definition for "mass digitization" should account for the unique policy concerns surrounding the issue which are, according to the U.S. Copyright Office's Notice of Inquiry, that "[orphan] works may in fact have copyright owners, but it may be too labor-intensive and too expensive to search for them, or it may be factually impossible to draw definitive conclusions about who the copyright owners are or what rights they actually own;
- (ii) AIPLA recognizes that recent scholarship and court decisions indicate that fair use is a possible solution for certain mass digitization projects; and
- (iii) AIPLA does not support a compulsory licensing scheme for orphan works in favor of development of a legal landscape relative to use of orphan works in various contexts, including mass digitization.

(Board of Directors Meeting – February 2, 2013, and  
Executive Committee Meeting – March 19, 2013.)

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, legislation to provide prompt, inexpensive, and effective protection against copying the appearance of articles of apparel.

(Board of Directors Meeting – July 19, 2007.  
Retained by Board of Directors – July 19, 2017.)

**530-02****Copyright Law/Enforcement**

WHEREAS, the American Intellectual Property Law Association (“AIPLA”) believes that online sale of counterfeit and piratical goods harms the investments made by companies in developing their brands and creating works of authorship, and

WHEREAS, AIPLA also believes intellectual property laws should protect consumers to ensure their confidence in the type and quality of goods they purchase online;

THEREFORE, BE IT RESOLVED, that AIPLA favors, in principle, that intellectual property legislation should be enacted which imposes penalties against websites dedicated to the sale of infringing, piratical or counterfeit goods *in rem*, and also imposes penalties against registrants, owners and operators of such websites, *in personam*; and

SPECIFICALLY, AIPLA favors passage of S. 968, the Preventing Real Online Threats to Economic Creativity and Theft of Intellectual Property Act, or PROTECT IP Act (Leahy) 112th Cong. 2d Sess. (2011), or similar legislation, which targets the most egregious actors of online infringement, copyright piracy and trademark counterfeiting.

(Board of Directors Meeting – September 16, 2011; and  
Retained by Board of Directors – September 25, 2022.)

**540-01****Copyright Law – Marrakesh Treaty**

RESOLVED the American Intellectual Property Law Association (AIPLA) supports, in principle, the objectives of the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired, or Otherwise Printed Disabled: and

SPECIFICALLY RESOLVED, that AIPLA favors, in principle, that implementation of the Treaty by the way of the “Marrakesh Treaty Implementation Act of 2016,” or similar legislation.

(Board of Directors Meeting – March 17, 2016.)

**545-02****Copyright Law – Small Claims**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, legislative action to create an alternative dispute resolution program for copyright small claims; and

SPECIFICALLY, AIPLA supports Congressional action to create a copyright small claims program (the “Program”) that includes the following elements:

1. THAT, any tribunal created to adjudicate small claims matters should have jurisdiction over

- a. Claims for violation of an exclusive right under 17 USC 106, declarations of non-infringement of such rights where an actual controversy exists, and claims for misrepresentation in connection with a DMCA notice or counter notice pursuant to 17 USC 512(f);
  - b. Counterclaims that arise out of the same transaction or occurrence as an asserted claim of infringement, non-infringement, or misrepresentation or that arise out of an agreement that is the subject of an asserted claim of infringement;
  - c. Defenses (whether legal or equitable) in response to asserted claims and counterclaims including, by way of example and not limitation, the fair use defense.
2. That such claims, counterclaims and defenses may involve any categories of copyrighted works.
3. THAT, the Program be authorized to provide the following remedies:
  - a. Actual damages and profits, subject to the limits described in section 4 of this resolution;
  - b. Limited statutory damages, subject to the limits described in sections 4 and 5 of this resolution; provided that an agreement to cease the accused activity may be considered by the tribunal in determining how much limited statutory damages to award;
  - c. If a party agrees to cease or mitigate the accused activity, the tribunal shall include such agreement as a requirement in its determination;
  - d. In cases of bad faith only, attorneys' fees and costs, subject to an appropriate monetary cap.
4. THAT, the total damages available in any one proceeding brought pursuant to the Program be capped at a dollar value high enough to make the Program useful to would-be plaintiffs and low enough to create an incentive for would-be defendants to participate in the program.
5. THAT, the maximum amount of limited statutory damages available per work infringed be set at a dollar value high enough to create a deterrent to infringement and low enough to create an incentive for would-be defendants to participate in the program. Provided further, that limited statutory damages of a lesser amount be available even for works that were not registered in accordance with Section 412 of the Copyright Act.
6. THAT, participation in the Program shall be voluntary on the part of both plaintiffs and defendants.
7. THAT, a registration or delivery to the Copyright Office of a completed application to register the work(s) at issue, deposit and required fee shall be a prerequisite to filing a claim before any small claims tribunal.
8. THAT, all proceedings shall be conducted in a streamlined manner, including:
  - a. Proceedings will presumptively be conducted in writing and, if any hearings or conferences are deemed necessary, those will be conducted via teleconference, video conference or other similar technology.
  - b. Parties may be represented by counsel or by a law student qualified to practice under applicable law or may participate *pro se*.

- c. The tribunal will not be required to apply formal rules of evidence and expert witness testimony will be permitted only in exceptional circumstances.
  - d. Limited discovery shall be available.
9. THAT, if requested by a party and for good cause shown, the small claims tribunal shall be permitted to issue a protective order to limit disclosure of confidential information.
  10. THAT, the tribunal shall hold all hearings on the record, set forth all factual and legal findings in writing and that all determinations and other appropriate records, redacted as necessary, shall be made publicly available (e.g., via a website).
  11. THAT, determinations by the tribunal may not cited or relied upon as legal precedent in any other action or proceeding before any court or tribunal, including the small claims tribunal but that such determinations shall preclude relitigation by the parties to any action of all claims and counterclaims asserted and determined by the tribunal.
  12. THAT, the Copyright Office be empowered to create rules and regulations to administer such a tribunal.

(Board of Directors – February 4, 2017)

## TRADE SECRETS

600-01

### Trade Secrets

WHEREAS, The National Security Agency has described recent trade secret theft as the greatest transfer of wealth in history, estimating the losses of theft of trade secrets and cyber breaches to be in excess of \$334 billion per year; and

WHEREAS, the Federal Bureau of Investigation has estimated that \$13 billion in trade secrets have been stolen from American businesses; and

WHEREAS, in February 2013, security company Mandiant issued a report finding that the Chinese government was sponsoring cyber-espionage to attack top U.S. companies; and

WHEREAS, PricewaterhouseCoopers recently issued a report in which it estimated trade secret theft ranges from one to three percent of the GDP of the United States; and

WHEREAS, in recognition of that emerging threat, President Obama's Administration released a 150-page report last year that presented a government-wide strategy designed to reduce trade secret theft by hackers, employees, and companies. In that plan, the Administration has recognized the accelerating pace of economic espionage and trade secret theft against U.S. corporations; and

WHEREAS, in response to a request for public comments for "Trade Secret Theft Strategy Legislative Review" by the U.S. Intellectual Property Enforcement Coordinator last year, AIPLA supported a federal civil remedy for international trade secret misappropriation; and

WHEREAS, the Trade Secret Law Committee and its members have observed an increase in trade secret theft and cybersecurity intrusion, particularly involving foreign actors or conduct that appears to be for the benefit of foreign powers or companies; and

WHEREAS, the Trade Secret Law Committee and its members strongly support efforts to strengthen domestic and foreign trade secret protection; and it is therefore

RESOLVED, that AIPLA favors, in principle, federal legislation creating a civil cause of action to a trade secret owner that does not preempt or undermine existing trade secret remedies provided under state law; and it is further

RESOLVED, that AIPLA specifically favors passage of the Defend Trade Secrets Act of 2014, S-2267, or similar legislation, amending the provisions of Section 1836 of title 18, United States Code, to create a civil cause of action to a trade secret owner; and it is further

RESOLVED, that, as an alternative, AIPLA also favors passage of the Future of American Innovation and Research Act of 2013, S. 1770, or similar legislation, providing for a civil cause of action to a trade secret owner.

(Board of Directors Meeting – May 15, 2014.)



## INTERNATIONAL

### 700-03

#### Japan Patent Act

RESOLVED, that AIPLA favors, in principle, that employers and employed inventors have the flexibility to reach agreements concerning the compensation paid to employees for inventions made by such employees in the course of their employment and that such agreements be respected by the courts except where such agreements are entered as a result of fraud or improper coercion; and,

Specifically, AIPLA supports amending Article 35 of the Japan Patent Act to provide that remuneration to an employee, who has assigned to his/her employer ownership of and the right to obtain a patent on an invention made in the course of his/her employment, shall be governed by an enforceable employment or other applicable contract entered by the employee and employer, and any service regulations or other stipulations furnished by the employer to the employee expect in cases of fraud or improper coercion.

(Board of Directors Meeting – July 17, 2003;  
Retained by Board of Directors – February 1, 2014.)

### 700-04

#### Electronic Filing Standards

RESOLVED, that AIPLA favors, in principle, the accommodation of electronic filing of international applications for patent, and specifically favors an electronic filing regime that embraces at least the following Guiding Principles:

- a) Promotes uniformity between the international filing system and national filing systems;
- b) Considers existing regimes of non-patent electronic commerce;
- c) Utilizes commercially available technology where feasible, including facilitating e-signatures;
- d) Accommodates varying member state laws;
- e) Minimizes complexity consistent with security requirements;
- f) Establishes appropriate legal presumptions and burdens of proof consistent with those presently extant in the paper filing regime;
- g) Facilitates the acquisition and confirmation of a valid filing date; and
- h) Reduces the cost to users of filing an international application.

RESOLVED, AIPLA favors, in principle, the accommodation of electronic filing of international applications for patent, and specifically favors a system that insures maintenance of and accessibility to electronic file histories sufficient to support future requirements of users for a period not less than the 30 years required by the present rules for paper file histories.

(Board of Directors Meeting – April 24, 1998.  
Revised and retained by Board of Directors – February 3, 2001, January 26, 2012, and September 25, 2022.)

**700-05****Convention on Biological Diversity**

RESOLVED that the American Intellectual Property Law Association supports, in principle, the objectives of the Convention on Biological Diversity to preserve biodiversity, to provide for the sustainable use of biodiversity, and to provide for the fair and equitable sharing of benefits through the use of material transfer agreements between a user of a genetic resource and the member state from which it is obtained to provide certainty to both parties.

RESOLVED that the American Intellectual Property Law Association opposes, in principle, the mandatory retroactive application of any access and benefit sharing mechanism which might be enacted in furtherance of the CBD.

(Board of Directors Meeting – February 2, 2006.  
Retained by Board of Directors – July 13, 2016.)

**700-07****European Patent Office Practice**

RESOLVED, that AIPLA favors having the USPTO include in the ADS Form, as part of the Authorization section permitting pre-publication transmittal of priority documents, an Authorization for providing the EPO as well as any other foreign patent office wherein priority is being claimed and also requesting it pre-publication access to the bibliographic data and search results, and that such entire Authorization section be re-cast in the form of an “opt-out” provision.

(Board of Directors Meeting – May 1, 2013.)

**700-08****Convention on Biological Diversity**

WHEREAS the World Intellectual Property Organization Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC) has scheduled two meetings in 2016 to focus on the topic of genetic resources and benefit sharing, and

WHEREAS the American Intellectual Property Law Association supports, in principle, the objectives of preserving sustainable biodiversity, and to provide for the fair and equitable sharing of benefits through the use of material transfer agreements between a user of newly identified genetic resource and the member state from which it is obtained to provide certainty to both parties,

NOW THEREFORE, BE IT RESOLVED that the American Intellectual Property Law Association opposes a mandatory disclosure of origin or source requirement for genetic resources and/or traditional knowledge in patent applications

(Board of Directors Meeting – March 17, 2016.)

WHEREAS, the Trans-Pacific Partnership Agreement (TPP) seeks to promote trade and strengthen relationships among its signatory countries (namely, Australia, Brunei, Canada, Chile, Japan, Malaysia, Mexico, New Zealand, Peru, Singapore, United States and Vietnam), including by strengthening intellectual property rights among signatory countries;

WHEREAS, the TPP includes an Intellectual Property Chapter, Chapter 18, which requires signatory countries to affirm and/or ratify international IP agreements to which the United States is already a party;

WHEREAS, the IP Chapter of the TPP further requires signatory countries to meet IP standards which, for the most part in principle, are already in effect in the United States and/or are required by the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), but are not in effect in all signatory countries;

WHEREAS, the IP Chapter of the TPP generally requires signatory countries to meet standards that are higher than those currently in effect in at least some non-US signatory countries including with respect to laws to combat counterfeiting, piracy and other infringement, including trade secret theft;

WHEREAS, the IP Chapter of the TPP generally provides enforcement provisions with respect to intellectual property rights, including civil and administrative procedures and remedies and criminal procedures and remedies, which, for the most part in principle, are in effect in the United States but not in all signatory countries;

WHEREAS, the IP Chapter includes certain minimum threshold IP-related requirements that either are or may be construed to be less than those currently imposed under US IP laws, including with respect to Articles 18.28 (Domain Names), 18.38 (Grace Period), 18.47 (Protection of Undisclosed Test or Other Data for Agricultural Chemical Products), 18.50 (Protection of Undisclosed Test or Other Data), and 18.51 (Biologics);

RESOLVED, if the United States ratifies the TPP or a similar multi-lateral free trade agreement with the TPP signatory countries, the American Intellectual Property Law Association (AIPLA) supports in principle, as part of that ratification, the adoption of the Intellectual Property Chapter of the TPP and any necessary implementing legislation, provided that such implementing legislation would not lessen or negatively impact the standards currently provided for by US IP laws, including with respect to use of identical or similar signs/trademarks, domain names, grace period, data protection for certain pharmaceutical products and biologics.

SPECIFICALLY, AIPLA supports in principle the adoption of the IP Chapter, and as part of that ratification legislation that would accomplish this adoption.

(Board of Directors Meeting – October 29, 2016)

**702-09****Patent Cooperation Treaty**

RESOLVED, that the American Intellectual Property Law Association supports an appropriate reduction in the total fees (other than excess claim fees) for a national stage application having a Positive Report.

(Board of Directors Meeting – March 17, 2005.  
Retained by Board of Directors – July 15, 2015.)

**702-12****Patent Cooperation Treaty**

RESOLVED, that AIPLA favors, in principle, expanding the publicly available and easily accessible information regarding entry into the national/regional stage from international (PCT) patent applications to include information for all treaty members; and

Specifically, supports (1) requiring all elected and designated Offices to timely report such information to the WIPO International Bureau in a complete and uniform manner, and (2) requesting that the International Bureau, in addition to regularly tabulating and publishing the reported information, strongly encourage non-compliant Offices to fully comply with the established reporting requirements.

(Board of Directors Meeting – July 12, 2006.  
Retained by Board of Directors – July 13, 2016.)

**702-13****Patent Cooperation Treaty**

RESOLVED, that American Intellectual Property Association (AIPLA) favors, in principle, the harmonization and streamlining of formal procedures in respect of national and regional patent applications and patents to make such procedures more cost effective, consistent and simple, and

FURTHER RESOLVED, that AIPLA supports the withdrawal of the proposed reservation that Article 6.1 of the Patent Law Treaty adopted at Geneva on June 1, 2000, as submitted by the President to the Senate for advice and consent on September 5, 2006 shall not apply to any requirement relating to unity of invention applicable under the Patent Cooperation Treaty to an international application at the earliest possible time.

(Board of Directors Meeting – October 21, 2006.  
Revised and Retained by Board of Directors – July 19, 2017.)

**702-14****Patent Cooperation Treaty**

RESOLVED, that AIPLA favors, in principle, improving the quality of international searches and international preliminary examinations, conducted by each International Authority appointed by the Assembly of the Patent Cooperation Treaty, to equal the quality of searches and examinations by such Authority for national or regional patent applications filed with it; and,

FURTHER RESOLVED, that AIPLA favors, in principle, maximizing the exploitation of such equal quality international searches and international preliminary examinations, conducted by International Authorities appointed by the Assembly of the Patent Cooperation Treaty, to avoid duplication of work by national and regional patent offices.

(Board of Directors – May 14, 2008.

Retained by Board of Directors – July 18, 2018.)

**702-18****Patent Cooperation Treaty**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors the United States Patent and Trademark Office (USPTO) in its examination of a U.S. national phase from a Patent Cooperation Treaty application, giving presumptive and substantial deference to findings of the International Searching Authority of the USPTO, and to findings of the International Preliminary Examining Authority of the USPTO, subject to any required top-up search.

(Board of Directors Meeting – October 25, 2014.)

**702-19****Patent Cooperation Treaty**

RESOLVED, that AIPLA favors the USPTO in its role as PCT Receiving Office considering requests for restoration of priority based upon the “due care” standard in addition to the “unintentional” standard.

(Board of Directors Meeting – January 28, 2015.)

**702-20****Patent Cooperation Treaty**

RESOLVED, that the American Intellectual Property Law Association (hereinafter referred to as “AIPLA”) favors, in principle, facilitation of electronic filing and management of international patent applications using the most modern validation approaches; and

Specifically, AIPLA favors updating of the foreign filing license rules of the United States Patent and Trademark Office (“USPTO”) so as to facilitate the use of the ePCT system of the World Intellectual Property Organization so that a PCT Request may be prepared for downloading to a user's computer and uploaded to USPTO's e-filing systems.

(Board of Directors Meeting – February 1, 2019.)

RESOLVED, the American Intellectual Property Law Association (AIPLA) favors, in principle, that WIPO, in coordination with the PCT International Searching Authorities, and as a matter of high priority, identify and implement a system that will allow copies of non-patent literature cited in PCT international search reports to be made available on a free of charge or minimal charge basis to applicants of PCT international applications.

(Board of Directors Meeting – September 11, 2019.)

### 1. First to File vs. First to Invent:

**AIPLA POSITION:** AIPLA believes that the first to file standard is the best practice for a harmonized patent system.

Rationale: AIPLA has previously supported first to file in the context of a balanced overall harmonized patent system, and continues to be supportive of first to file in that context. Indeed, the significant changes in the global patent systems, via the URAA, AIPA, and PLT have significantly increased the desirability of a first to file system in the US.

Changes in the US, including the ability to file a provisional application quickly and inexpensively with a minimum of formalities, and the complex, global nature of inventorship proofs, make first to file an imperative for a truly harmonized and balanced patent system.

### 2. Patentable Subject Matter:

**AIPLA POSITION:** AIPLA supports a patent harmonization treaty that would provide patent eligibility for all subject matter that can be shown to provide a “useful, concrete and tangible result,” but does not support any requirement for patent-eligible subject matter to have a “technical effect” or reside in a field of “technology.” This would, in fact, be essentially retaining the standard set forth in 35 USC 101.

Rationale: As technology has progressed into previously uncharted areas, the US patent system has been the incubator for groundbreaking means to provide incentives for innovation, ahead of other highly developed patent systems in, e.g., Europe or Japan. Many of the advances in biotechnology, computer software, and business methods do not fall into a particular technical fields, nor can they always be categorized by traditional notions relating to “technical effect” or “industrial applicability” (see also questions 4 and 6). The flexible US standard was the first to provide protection in these important areas.

### 3. Best Mode Requirement:

**AIPLA POSITION:** AIPLA supports a treaty provision which would cause the US to remove the best mode requirement. No justification exists to retain this provision, which has evolved into a requirement to disclose the personal contemplations of the

**inventor, rather than a means to insure that the invention is effectively disclosed to the public.**

Rationale: See *Glaxo Inc. v. Novopharm Ltd.*, 34 U.S.P.Q.2d 1565, 52 F.3d 1043 (Fed. Cir. 1995), in which the court noted that the best mode "belongs" to the inventor. Little justification would seem to exist to retain this provision, which in the end only becomes fodder for litigation, and does little to enhance the objective assessment of the completeness of the description of the invention. Although the best mode requirement still exists under 35 U.S.C. §112(a), the failure to disclose the best mode is no longer a basis for invalidation. This addresses a significant prior concern of AIPLA regarding best mode as a litigation tool, so that rationale has been removed from the prior position. However, because the best mode requirement still exists (albeit in this more diluted form), AIPLA recommends retaining the prior position as modified.

#### **4. Identification of Technical Fields:**

**AIPLA POSITION: AIPLA supports a harmonization treaty where the identification of technical fields is not required.**

Rationale: As technology has progressed into previously uncharted areas, the US patent system has been the incubator for groundbreaking means to provide incentives for innovation, ahead of other highly developed patent systems in, e.g., Europe or Japan. Many of the advances in biotechnology, computer software, and business methods do not fall into a particular technical field, nor can they always be categorized by traditional notions relating to "technical effect" or "industrial applicability," yet they are clearly worthy of patent protection. (See also questions 2 and 6).

#### **5. PCT Unity of Invention Standard:**

**AIPLA POSITION: AIPLA supports a "unity of invention" standard, similar to the PCT, for examination of patents under a patent harmonization treaty. At the same time, no patent should be invalidated on the basis of a later determination of a lack of unity.**

Rationale: The US is alone in its restrictive practices regarding unity of invention. The unity of invention standard as applied in the PCT has proven to be an effective global standard for patent examination. Indeed, as a result of the *Caterpillar* decision, the US was required to use the broader PCT standard for the national phase of PCT cases designating the US. Applicants have chosen to enter the US via the PCT. Thus, the US is already using this standard for some applications. Of course, the protective features of 35 USC 121, which prohibit the invalidation of patents which may later be determined to include more than one invention, should remain in place in order not to work an unfairness to applicants in the event of inconsistent application of the standard.

#### **6. Utility vs. Industrial Applicability:**

**AIPLA POSITION: AIPLA supports a harmonization treaty containing a utility, rather than industrial applicability, provision.**

Rationale: The utility requirement in the United States holding that the invention must be specific, substantial and credible should be followed to allow the patenting of any invention which is currently and practically useful, unless such use is for an insubstantial purpose or effect. Certain restrictions found in some patent systems denying patentability to specific medical treatments and therapies are too narrow. Further, as noted above in relation to items 2 and 6, as technology has progressed into previously uncharted areas, the US patent system has been the incubator for groundbreaking means to provide incentives for innovation, ahead of other highly developed patent systems in, e.g., Europe or Japan. Many of the advances in biotechnology, computer software, and business methods do not fall into a particular technical field, nor can they always be categorized by traditional notions relating to “technical effect” or “industrial applicability.”

#### **8. Use of Prior Filed, Later Published Applications as Prior Art:**

**AIPLA POSITION:** AIPLA supports a treaty providing that the effective global priority date may be used for purposes of both novelty and obviousness.

Rationale: The needs for certainty and uniformity in a truly harmonized patent system dictate unified treatment of prior art. No justification exists to allow minor overlapping variations on patented inventions filed by the same or different applicants. In addition, while it is appropriate to take into account the possibility of applicant’s own prior unpublished disclosure being used against an applicant, a consensus has not been established on how to best address this possibility.

#### **9. Grace Period:**

**AIPLA POSITION:** AIPLA supports a grace period that is personal, i.e., which covers pre-filing disclosures made by or on behalf of the applicant, thereby providing appropriate safeguards to applicants, while retaining an appropriate level of certainty and fairness to the public.

Rationale: While the certainty of an absolute novelty system is urged by some of our trading partners, most systems have at least some saving provisions in place to prevent rank unfairness to applicants engendered by inadvertent or even unauthorized disclosures emanating from the inventors. At the same time, retention of the US one year grace period for all disclosures in a first to file world would add unacceptable levels of uncertainty and complexity, even preventing someone from having the ability to publish their development and dedicate their invention to the public.

#### **10. Geographic Restrictions on Prior Art:**

**AIPLA POSITION:** AIPLA supports a treaty having a definition of prior art which has no geographical restrictions, i.e., disclosure anywhere in the world which is reasonably accessible to the public should be considered as prior art.

Rationale: In the age of the internet, information that is reasonably accessible to the public anywhere is available to the public globally. Thus, no justification exists to geographically limit prior art.

#### **11. Loss of Rights Provisions- 35 USC 102(a) Public Use and On Sale Bar:**



**AIPLA POSITION: AIPLA supports a treaty which would eliminate the loss of rights dictated under section 35 USC 102(a), particularly with respect to what constitutes public use for purposes of on sale bar.**

Rationale: AIA addressed AIPLA's prior positions with respect to abandonment under pre-AIA §102(c) and premature foreign patenting under pre-AIA §102(d). With respect to the remaining issue under now §102(a) as a corollary to the rationale in 10, to the extent something is *not reasonably publicly accessible to one of ordinary skill in the art*, no justification exists to deny a patent. See Elements Paper, Page 6, n.2: "IT3 expressly acknowledges that a disclosure, including but not limited to a sale, made under confidentiality is not 'public', as long as the confidentiality is respected. A non-confidential sale that embodies any or all elements of a claimed invention is a public disclosure only if such elements that can be accessed by one of ordinary skill in the art before the earlier of the filing date or priority date, e.g., by analysis or reverse engineering."

This differs from US law of *Helsinn Healthcare v. Teva Pharms. USA, Inc.*, No. 17-1229, 139 S.Ct. 628 (2019), where the Supreme Court "determine[d] that Congress did not alter the meaning of 'on sale' when it enacted the AIA, [and held] that an inventor's sale of an invention to a third party who is obligated to keep the invention confidential can qualify as prior art under [AIA 35 U.S.C.] § 102(a)." *Id.* at 634. Thus, a sale or offer for sale that does not disclose the subject matter of an invention or make the invention available to the general public may nevertheless qualify as prior art in an anticipation or obviousness rejection, regardless of whether the application or patent under consideration is subject to the FITF provisions of the AIA or the first to invent provisions of pre-AIA law. MPEP 2152.92(d).

## **12. Use of Multiple References for Novelty Rejections:**

**AIPLA POSITION: AIPLA favors a treaty where a novelty rejection must be based on a single reference. Additional references or extrinsic evidence should only be used to interpret the disclosure of the primary reference.**

Rationale: Most patent systems employ a novelty standard which requires the use of only one reference. The harmonization treaty should retain this standard, and should narrowly prescribe conditions in which anything beyond the primary reference can be consulted.

## **13. Obviousness a la *Graham v. John Deere* vs. Problem Solution:**

**AIPLA POSITION: AIPLA believes that the *Graham v. John Deere* type obviousness determination is the preferable approach in a global harmonization treaty, and believes that the European Patent Office "problem-solution" approach is unacceptable as in inflexible, unworkable solution.**

Rationale: The US provision regarding obviousness is the fairest to applicants, providing an analysis of the invention in the context of the art. The problem solution approach is highly inflexible, lead to extremely artificial definitions of “problems” solved, rather than focusing on the motivation of a person of skill in the field, the latter being more consistent with the purposes of the patent system.

The problem-solution approach requires that each claim solves the problem described, such that a claim drafted in a way that does not solve the described problem would not be patentable. This approach in essence limits the inventive step analysis to a showing of unexpected results, which is only one of the *Graham v. John Deere* factors. Further, an applicant faced with an obviousness/inventive step rejection where problem-solution approach is the standard, would be often required to produce experimental data showing that the described problem is solved by the invention, which data would otherwise be unnecessary to illustrate the invention. Moreover, the obviousness/lack of inventive step rejection may arise long after the inventor has moved onto other projects. Thus, to require development of new experimental data at the later date could place an unfair burden on the inventor in terms of additional expense to run experiments.

Additionally, under U.S. law, the recognition of a nonobvious problem (even with an obvious solution) can be the basis of patentability, while the EPO does not appear to recognize this as inventive contribution. Finally the EPO appears to want an improvement over the prior art (the old German influence) on which to predicate patentability. Again, under U.S. laws, any nonobvious solution, even if inferior to prior solutions, can be patentable.

#### **14. Multiple Dependent Claim Practice:**

**AIPLA POSITION:** AIPLA supports any procedure that would allow for the simple and inexpensive drafting and prosecution of claims and thus would support a treaty that would allow multiple dependent claims that depend from other multiple dependent claims, so long as it is clear that any multiple dependent claim should be construed to include all limitations of the claims from which it depends.

Rationale: AIPLA believes that this matter should be addressed in the regulations, not the treaty. Applicants should have substantial flexibility in pointing out what they regard as their invention, but examination offices need reasonable safeguards to address abuses that effectively diminish the quality of examination.

#### **15. Claim Interpretation: Peripheral vs. Central Claiming:**

**AIPLA POSITION:** AIPLA supports the approach that the language of the claim should be the exclusive measure of the legal rights under the patent for literal infringement.

#### **16. Doctrine of Equivalents:**

**AIPLA POSITION:** AIPLA supports an approach that allows for a Doctrine of Equivalents that provides a fair balance between the rights of patent owners and third parties.

Rationale: Although the Doctrine of Equivalents is interpreted under national laws, it is important that any harmonization treaty specifically allow for the use of a standard that does not unduly restrict the claims to a narrow literal construction. On the other hand, the treaty should also require that the claims are not to be viewed as mere suggestions or guidelines on defining the invention.

## **17. Assignee Filing:**

**AIPLA POSITION: AIPLA favors a system in which the patent application is filed by the real party in interest, whether that party is the individual inventor, a group of joint inventors or the assignee of the patent.**

(Board of Directors Meeting – May 11, 2001.

Amended and retained by Board of Directors – January 26, 2012 and September 25, 2022.)

## **705-07**

### **Harmonization**

RESOLVED, That the American Intellectual Property Law Association supports the principle of a balanced and harmonized worldwide patent system, and in order to clarify and update its positions on the topic, past actions of the Board of Directors numbers 218-1 (Board of Directors Meeting January 25, 1992), 218-2 (Board of Directors Meeting May 15, 1992), 705-1 (Board of Directors Meeting October 24, 1984), 705-2 (Board of Directors Meeting May 6, 1988), 705-4 (Board of Directors Meeting October 19, 1990), 705-5 (Board of Directors Meeting May 3, 1991), 705-6 (Board of Directors Meeting October 19, 1991), 705-7 (Board of Directors Meeting January 25, 1992), 705-8 (Board of Directors Meeting May 15, 1992), 705-10 (Board of Directors Meeting December 10, 1992), 705-11 (Board of Directors Meeting January 30, 1993), 705-12 (Board of Directors Meeting February 22, 1994), 705-14 (Board of Directors Meeting February 22, 1994), 705-15 (Board of Directors Meeting July 22, 1995) and 705-18 (Board of Directors Meeting October 26, 1996) are retired and the following actions are substituted therefor:

### **Harmonization/First-to-File**

RESOLVED, that, in the event the United States changes its patent laws to award patents based upon the "first-to-file" system, that the American Intellectual Property Law Association supports in principle the enactment, as a unitary package, the following collection of essential principles–

(1) **Proofs of pre-filing invention dates should be barred.** In addition to a "first-to-file" rule to be mandated in priority contests, that part of the "grace period" involving prior-filed, post-invention date subject matter should be eliminated.

(2) **"Prior art" as used to establish anticipation and obviousness should be expressly defined and limited to non-secret subject matter.** Prior art should consist to pre-filing patents and publications (appearing anywhere in the world) and pre-filing public knowledge or public use (occurring in the United States.)

(3) **"Foreign patenting," "abandonment," and "prior invention" bars to patenting should be removed.** Bars to patent set forth in §§102(c), 102(d) and 102(g) should be removed.

(4) **Non-obviousness criterion for patentability should be unchanged.**

(5) **Derivation bar (originality requirement) should be maintained.** First inventor to file, not merely first-to-file should be entitled to a patent.

(6) **Nature of the novelty bar should remain unchanged, i.e., be limited to subject matter identically disclosed or described in a single reference.** "Anticipation" should be interpreted as under existing case law.

(7) **Derivation bar and secret non-experimental use or on sale bars should continue to include "obviousness" considerations.** These "right to patent" bars should extend to subject matter that is the same as or an obvious variant of the subject matter that is derived, or used or sold.

(8) **"Grace period" with respect to "self-created" prior art should be maintained.** The inventor's own activities should not constitute prior art during a one-year grace period against the inventor.

(9) **Prior user rights should operate as a complete defense to infringement, being available to persons making good faith, pre-filing commercial use or sale of patented invention in the United States.** Such rights should be (1) personal, assignable with entire business, (2) available whenever effective and serious preparations for use or sale have taken place in the United States before filing, (3) based solely on activity in the United States, and (4) limited in scope to the subject matter of the pre-filing activity. Any requirement for "good faith" on the part of the prior user should be satisfied where the user comes into possession of the subject matter by legitimate means and does not make a prohibited use of the subject matter. The rights should not otherwise be restricted, i.e., by quantitative means or by the imposition of any obligation to the patentee.

(Board of Directors Meeting – January 25, 1992.

Revised by Board of Directors – September 12, 2003.

Retained by Board of Directors – February 1, 2014.)

## **705-09**

### **Harmonization**

A proposed Resolution on Harmonization of Patent Law issues was sent to the membership for vote. Approximately 700 members voted on the Resolution; 75% in favor and 25% opposed. The Resolution was approved by the Board and follows:

RESOLVED that the American Intellectual Property Law Association favors, in principle, international harmonization of patent laws to achieve more uniform treatment and results for patent applicants throughout the global marketplace and recognizes that to achieve harmonization, the U.S. would need to change its laws to (i) a first-to-file system for determining priority between more than one application to the same but independently created invention and (ii) give prior art effect to an application subsequently published as an application or granted as a patent as of its earliest filing or priority date provided that the following provisions which benefit U.S. applicants are accepted by other countries:

1. An effective grace period of one year applicable to public disclosures by the inventor, third parties who obtained information directly or indirectly from the inventor, or successors in title to the inventor, which grace period is not subject to dilution by prior user rights;
2. Applications may be filed in any language subject to submission of a translation within two months, which translation may be corrected at any time during pendency or subsequently as a granted patent provided that error may be demonstrated with reference to the original nonofficial language filing or a priority filing in another country;
3. Countries providing search and examination of patent applications should be required to do so with reasonable dispatch to obtain clarification of rights in a reasonable time period with every effort made to produce a search at the time of first publication, to begin examination no later than three years after filing and exert its best efforts to complete examination no later than five years from filing date;
4. Opposition or revocation procedures should not be available before patent grant so as not to delay the granting of a patent; and
5. An effective scope of protection will be provided by extending protection to reasonable equivalents as determined at the time of infringement and not limiting claims by detailed features of the described embodiments not contained in the claims.

(Board of Directors Meeting – October 19, 1990.

Revised by Board of Directors – September 12, 2003.

Retained by Board of Directors – February 1, 2014.)

## **705-10**

### **Harmonization**

RESOLVED the American Intellectual Property Law Association supports in principle:

- a) limiting to a minimum the optional provisions of the Patent Law Treaty (PLT) in order to assure that the substantive patent law provisions, filing requirements and patent office procedures are made uniform among all adherents to the PLT, and

- b) providing for globalized publicly accessible prior art in the patent law amendments implementing the PLT.

(Board of Directors Meeting – December 10, 1992.

Revised by Board of Directors – September 12, 2003.

Retained by Board of Directors – February 1, 2014.)

## **705-11**

### **Harmonization**

RESOLVED, that the American Intellectual Property Law Association favors in principle:

As a first step toward harmonization and enhanced efficiency, the adoption by patent offices of a common patent application format for a global patent application so that conforming applications (i) can be filed, preferably electronically, in any patent office without the need for any change in the submitted application to accommodate national/regional rules, and (ii) aid in facilitating machine translation of the applications.

(Board of Directors Meeting – July 14, 2004.

Retained by Board of Directors – July 15, 2015.)

## **705-12**

### **Harmonization**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, patent offices developing mechanisms for electronic exchange of priority documents, and devising electronic procedures for applicants to authorize and request the exchanges of priority documents; and

SPECIFICALLY, AIPLA supports additional bilateral agreement between the USPTO and WIPO for free-of-charge electronic exchange of certified copies of priority documents between the two offices.

AIPLA supports the goal of transmitting priority documents from one patent office to another patent office using the Global Dossier infrastructure.

(Board of Directors Meeting – March 15, 2007.

Revised and Retained by Board of Directors – July 19, 2017.)

## **705-13**

### **Patent Law Treaty**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, that implementation of the Patent Law Treaty (Geneva 2000) (“PLT”) not reduce or eliminate existing rights or relief under US Patent Law; and

SPECIFICALLY, that AIPLA favors that any legislative action to implement the PLT makes it clear that the “unintentional delay” standard for granting an extension of time for a claim of priority under 35 USC 119(a) and (e)(1), and 35 USC 365(b) be at least as broad as the current standard for the revival of unintentionally abandoned patent applications under 37 CFR 1.137(b);

SPECIFICALLY, that AIPLA favors that any legislative action to implement the PLT allow an application that is filed without claims to be accorded a filing date;

SPECIFICALLY, that AIPLA favors that any legislative action to implement the PLT allow an application that includes the specification of another application by reference, without further disclosure at initial filing, to be accorded a filing date;

SPECIFICALLY, that AIPLA favors that any legislative action to implement the PLT provide for reinstatement by petition for unintentional abandonment of an application by failure to timely pay an issue fee;

SPECIFICALLY, that AIPLA favors that any legislative action to implement the PLT that allows for the restoration of a priority claim for an application filed after 12, but before 14, months of the filing date of another application for which priority is desired to be claimed require that the delay in filing the priority claim be unintentional; and

SPECIFICALLY, that AIPLA opposes any amendment to Section 122(b)(2)(B)(iii) of Title 35, United States Code, which would remove the existing right of an applicant to avoid the abandonment of an application where it could be shown, to the satisfaction of the Director, that the delay in filing a Notice of Foreign Filing after a non-publication request has been entered was unintentional.

FURTHER RESOLVED, that AIPLA favors the clarification and streamlining of formal procedures in respect of recordation of rights in intellectual property consistent with the intent of the PLT to make such procedures more cost effective, consistent and simple; and

SPECIFICALLY, that AIPLA favors that any legislative action to implement the PLT include appropriate amendments to 35 USC 261 to make explicit that the U.S. Patent and Trademark Office (USPTO) is authorized to record licenses and security interests in patents and patent applications in accordance with Article 14 of the PLT.

(Board of Directors Meeting – July 10, 2008.  
Retained by Board of Directors – October 26, 2019.)

## **705-14**

### **Industry Trilateral Global Application Format**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) favors, in principle, the implementation of the Industry Trilateral Global Application Format, and

SPECIFICALLY, that AIPLA favors legislative action, consistent with the Industry Trilateral proposal for a Global Application Format that would allow application cross-reference and federal funding legends to be contained, at the Applicant’s option, within an application data sheet or within the specification; and

SPECIFICALLY, that AIPLA favors legislative and regulatory action, consistent with the Industry Trilateral proposal for a Global Application Format that would permit the use of reference characters in the claims and abstract of an original application filing, yet preserve the estoppel effect of post filing activity in connection with the interpretation of claims that include reference characters, and therefore, should provide a legislative and regulatory prohibition against any estoppels based solely on the inclusion of reference characters in the abstract and claims of an application.

(Board of Directors Meeting – September 19, 2008; and  
Retained by Board of Directors – October 26, 2019.)

## 705-15

### Patent Law Treaty

The Board adopted the following proposed Resolution on Patent Law Treaty (PLT) Implementation Legislation (proposed additional language underlined):

35 U.S.C. 261 Ownership; assignment:

Subject to the provisions of this title, patents shall have the attributes of personal property. The Patent and Trademark Office shall maintain a register of interests in applications for patents and patents and shall record any document related thereto upon request, and may require a fee therefor.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States. A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, or apostille of an official designated by a foreign country which, by treaty or convention, accords like effect to apostilles of designated officials in the United States, shall be *prima facie* evidence of the execution of an assignment, grant, or conveyance of a patent or application for patent.

An interest that constitutes an assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

(Board of Directors Meeting – May 10, 2012; and  
Retained by Board of Directors – September 25, 2022.)



RESOLVED, that the American Intellectual Property Law Association (AIPLA) supports efforts to encourage IP offices around the world to accept and recognize e-signatures by all parties for office correspondence, declarations, powers of attorney, assignments, and any other documents that require signing, where prevailing laws permit. AIPLA encourages the IP offices to allow the use of e-signatures to help alleviate burdens associated with both hand-written signatures and in-person authentication. AIPLA supports efforts of the USPTO to work with the IP5 group to establish consistent rules and guidelines regarding the requirements of IP offices around the world for the acceptance of electronic signatures on documents utilized in intellectual property prosecution and for assignment of intellectual property rights.

(Board of Directors Meeting – November 2, 2020.)

## ASSOCIATION MATTERS

800-09

### Honorary Membership

RESOLVED, that, in accordance with Article II, Section 1(f) of the Bylaws of the American Intellectual Property Law Association (AIPLA), persons holding the following positions be granted Honorary Membership or be continued as Honorary Members in AIPLA for the period of time which he or she holds such position:

- Judges for the United States Court of Appeals for the Federal Circuit;
- Senior officials of the United States Patent and Trademark Office, particularly the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office, the Commissioner for Patents, and, the Commissioner for Trademarks;
- Senior officials of the United States Copyright Office, particularly the Register of Copyrights, the Associate Register of Copyrights and Director of Policy and International Affairs, the Associate Register of Copyrights and Director of Registration Policy and Practice, and the General Counsel and Associate Register of Copyrights.

(Board of Directors Meeting – December 7, 2000;  
Retained and edited by Board of Directors – February 5, 2011; and  
Retained and edited by Board of Directors – September 11, 2021.)

800-24

### Honorary Membership

**Whereas**, AIPLA has enjoyed the knowledge, skills, and energy of Steve Noe as a member of the Association for over 20 years;

**Whereas**, AIPLA has benefited from the services of Steve Noe on the Board of Directors from 1991–1994 and on the Corporate Practice Committee, the Electronics and Computer Law Committee, the Inventor Issues Committee, the Copyright Law Committee, the Industrial Designs Committee, and the International Education Committee, as well as serving as Chair of the PCT Issues Committee, Vice Chair of the International and Foreign Law Committee, and Co-Chair and Chair of the IP Practice in Europe Committee;

**Whereas**, AIPLA has substantially benefited from the application of Steve Noe’s many talents and experience during his all-too-short tenure as a member of the AIPLA Headquarters Staff with regard to:

- Serving as the Board Liaison to the PCT Issues Committee and attending several sessions of the WIPO Working Group on PCT Reform,

- Substantially contributing to the development and success of the Industry Trilateral in Tokyo and Washington,
- Implementing an Annual Patent Quality Meeting between the European Patent Office and AIPLA and our sister IP organizations,
- Providing invaluable assistance in the planning and hosting of the Colloquium on Patent Quality in Amsterdam in June 2007, and
- Serving as an AIPLA representative to the US Bar/JPO Liaison Council;

**Whereas**, none of this would have been possible without the support and mentoring of his lifelong companion, Trudy, to whom we all give our thanks and appreciation for her support of AIPLA;

**NOW THEREFORE,**

**BE IT RESOLVED** that the AIPLA Board of Directors, in consideration of his many contributions to the American Intellectual Property Law Association, does on this day, September 7, 2007, elect Stephen L. Noe to the position of Honorary Member.

(Board of Directors Meeting – September 7, 2007.  
Retained by Board of Directors – July 19, 2017.)

**800-25**

### **Honorary Membership**

**Whereas**, AIPLA has benefited from the knowledge, skills, and energy of Mike Kirk as Executive Director of the Association for over 13 years;

**Whereas**, AIPLA has benefited from the service of Mike Kirk to the Officers, Board of Directors, and Members of the Association during his term as Executive Director, through his tireless efforts to educate and advocate the best interests of the IP community to the Administration, the Congress and the public, through his countless trips abroad to represent and protect the interests of our membership, through his prudent stewardship of AIPLA resources and leadership of headquarters staff, and particularly through his wise counsel and advice;

**Whereas**, AIPLA and the entire IP community have substantially benefited from the application of Mike's many talents and experience during his illustrious career which has included:

- Three decades of public service including Deputy Assistant Secretary of Commerce and Deputy Commissioner of Patents and Trademarks and a period as Acting Assistant Secretary of Commerce and Acting Commissioner of Patent and Trademarks,
- Service as the Chief U.S. Negotiator on TRIPS from 1990 until the conclusion of the Uruguay Round,
- Service as President of the Intellectual Property Constituency of the Domain Names Supporting Organization of the Internet Corporation for Assigned Names and Numbers (ICANN),
- Receipt of the 1999 Pasquale J. Federico Memorial Award and the 1992 Jefferson Medal for Contributions to American IP Law, and
- Receipt of the National Inventors' Hall of Fame Lifetime Achievement Award for significant contributions to the American system of intellectual property protection;

**NOW THEREFORE,**

(Board of Directors Meeting – May 14, 2008.  
Retained by Board of Directors – July 18, 2018.)

**WHEREAS**, AIPLA has enjoyed the knowledge, skills, and energy of Marybeth Peters as a member of the Association for many years and appreciates her generous and countless contributions to our educational programs.

**WHEREAS**, Marybeth Peters has received numerous awards for her work as Register of Copyrights, including:

- The 2005 Jefferson Medal, awarded by the New Jersey Intellectual Property Law Association, for exceptional contributions in the field of intellectual property,
- The 2004 Cyber Champion Award presented by the Business Software Alliance, for exceptional contributions in the field of computer law,
- The 2003 Computer Law Association Past President's Award for distinguished service to information technology lawyers throughout the world,
- An award from the American Society of Media Photographers for "exemplary fairness and contributions to photographers,"
- An award from the Graphic Artists Guild, the Women in Music 1999 Touchstone Award for legislative contributions that brought significant benefit to those in music,
- The Los Angeles Copyright Society's Lifetime Achievement Award, and significantly,
- The American Intellectual Property Law Association 2006 Excellence Award.

**NOW THEREFORE,**

**BE IT RESOLVED**, that AIPLA strongly supports the nomination of Marybeth Peters for the American Bar Association's Margaret Brent Women Lawyers of Achievement Award in recognition of her invaluable contributions to copyright law and the intellectual property system; and

**BE IT FURTHER RESOLVED** that the AIPLA Board of Directors, in consideration of her many contributions to the intellectual property community and to the American Intellectual Property Law Association, does on this day, October 23, 2010, elect Marybeth Peters to the position of Honorary Member, effective January 1, 2011.

(Board of Directors Meeting – October 23, 2010; and  
Retained by Board of Directors – September 10, 2021)

**800-36**

**Bylaws**

The Board adopted the following changes to the Bylaws:

*[New Section 1(e)]*

**(e)** There shall be a category of membership called government membership, consisting of persons qualified for regular or junior membership who are full-time employees of a government. Government members are entitled to the privileges of the membership category for which they are otherwise qualified.

*[New Section 2 preamble:]*

**Sec. 2.** There shall be the following categories of non-voting affiliates of the corporation: law student/graduate affiliate, patent agent affiliate, foreign affiliate, United States Patent

& Trademark Office professional affiliate, IP professional affiliate, IP paralegal/technical advisor affiliate, and government affiliate. Eligibility for such affiliate categories is for persons who meet the following criteria, and who have never been disbarred or suspended from the practice of law in any jurisdiction.

*[New Section 2 (e)]*

(e) The IP professional affiliate membership shall consist of persons who are otherwise not qualified for regular or junior membership or patent agent, foreign, or USPTO professional affiliate membership, but who are engaged in the field of intellectual property as professionals who negotiate and manage licensing, transactions, and technology transfer of IP assets; perform IP surveying, map or analyze IP portfolios, or have responsibilities with respect to intellectual property for a business entity. IP professional affiliates shall not be entitled to vote or to hold office.

*[New Section 2 (f)]*

(f) The IP paralegal/technical advisor affiliate membership shall consist of persons who are otherwise not qualified for regular or junior membership or patent agent, foreign, or USPTO professional affiliate membership, but who are engaged in the field of intellectual property substantively supporting the efforts of a person or persons qualified for membership in AIPLA specifically including technical advisors who assist with drafting patent applications and IP paralegals who assist with preparation of formal filing documents and IP litigation paralegals who assist with preparation of litigation documents. IP paralegal/technical advisor affiliates shall not be entitled to vote or to hold office.

*[New Section 2 (g)]*

(g) The government affiliate membership shall consist of (1) persons qualified for patent agent or foreign affiliate membership who are full-time employees of a government, or (2) persons who are not otherwise qualified for membership but are full-time professional employees of a government and whose role or department within the government has responsibilities with respect to intellectual property. Government affiliate members shall not be entitled to vote or to hold office.

*[Section 3 removed, integrated into Section 1(e) and 2(g) above.]*

(Board of Directors Meeting – February 14, 2013.)

## **800-37**

### **Bylaws**

RESOLVED that the AIPLA Bylaws, Article VIII (Committees and Committee Chairs), Sec. 1, shall be amended as follows:

**Sec. 1.** The standing committees of the corporation shall be appointed by the President-Elect with the approval of the Board of Directors no later than the meeting of the Board immediately preceding the Annual Meeting of the corporation. The chairs of the standing committees shall be appointed by the President-Elect and shall serve (1) typically for two years beginning at the close of the succeeding annual meeting, or (2) until their successors shall have been appointed. Members and affiliates in good standing of the corporation may be members of standing committees of the corporation, in accordance with guidelines the Board of Directors may from time to time establish. Any member of the Board may be a

non-voting member of any standing committee, and at least one member of the Board shall be specially designated as Board Liaison Officer to each standing committee.

To read as follows:

**Sec. 1.** The standing committees of the corporation shall be appointed by the President-Elect with the approval of the Board of Directors no later than the meeting of the Board immediately preceding the Annual Meeting of the corporation. The chairs of the standing committees shall be appointed by the President-Elect and shall serve (1) typically for two years beginning at the close of the succeeding annual meeting, or (2) until their successors shall have been appointed. Members and affiliates in good standing of the corporation may be members of standing committees of the corporation, in accordance with guidelines the Board of Directors may from time to time establish. Any member of the Board may be a non-voting member of any standing committee, and at least one member of the Board shall be specially designated as Board Liaison Officer to each standing committee.

### **Standing Committees – Categories and Membership**

RESOLVED, that the American Intellectual Property Law Association (AIPLA), through its Board of Directors, hereby establishes the following guidelines for membership on its standing committees.

There shall be three categories of standing committees:

1. Substantive Law Committees, which are committees focused on areas of substantive law;
2. Practice and Association Committees, which are committees focused on the practice of law, categories of membership, or general service to AIPLA; and
3. Appointed Standing Committees, which are committees whose membership is appointed by the President or President-Elect.

Should the Board of Directors establish additional standing committees, they should be classified as appropriate as Substantive Law, Practice and Association, and/or Appointed Standing Committees.

At the commencement of each committee year, members and affiliates in good standing of the corporation shall be entitled to be a member of an unlimited number of committees. However, unless otherwise authorized, a member or affiliate shall be limited to being a voting member of no more than three Substantive Law committees and no more than two Practice and Association committees, and committee members shall select their voting status on a year-by-year basis. Membership on an Appointed Standing committee shall not affect a member's or affiliate's limits on participation as a voting member on Substantive Law and Practice and Association committees. Only voting members of committees may vote on committee business, including resolutions and reports. However, all members of a committee should receive all committee information and otherwise obtain the full benefits of participation in a committee, other than voting status.

Committee leaders shall indicate in any request for a vote or other action by a committee's voting members that a failure to respond may result in a voting member's status being

moved to non-voting status. The committee chair shall have the discretion to reclassify a member as a non-voting member for the remainder of the committee year.

(Board of Directors Meeting – March 21, 2013.  
Amended and Retained by Board of Directors – July 18, 2018.)

## **800-38**

### **Bylaws**

After a brief discussion, Sharon Israel made a motion to adopt the version of the Bylaws, Article VI, as revised by the Board on September 10, 2013. Mike Martinez seconded the motion, and it was approved unanimously.

### **Article VI**

#### **Committees of the Board of Directors**

##### **Sec. 1. Designation of Committees.**

(a) The following shall be Committees of the Board of Directors:

1. Executive Committee
2. Audit Committee
3. Finance and Budget Committee
4. Investment and Financial Development Committee

(b) Each Board Committee shall consist of three or more Directors.

(c) Members of the Committees shall be appointed for a one-year term commencing on the close of the Annual Meeting and shall be appointed by the President whose term commences on that date.

(d) The President may also recommend to the Board of Directors for its approval one or more additional Board Committees to direct particular business of the corporation. Each such Board Committee may exercise the authority granted to it by the Board's enabling resolution.

**Sec. 2. Executive Committee.** The Executive Committee shall consist of the President, the President-Elect, the First Vice President, the Second Vice President, and the Immediate Past President.

(a) During the intervals between meetings of the Board of Directors, the Executive Committee shall, subject to Section 2 of this Article VI, possess and may exercise all the powers and functions of the Board of Directors in the management and direction of the affairs of the corporation in all cases in which specific direction shall not have been given by the Board of Directors.

(b) All material actions of the Executive Committee shall be reported to the Board of Directors at its next meeting succeeding such action. A record of the Executive Committee's decisions shall be kept.



- (c) The Executive Committee shall evaluate the appropriateness of compensation for the Executive Director and key employees of the association and assure that compensation decisions are tied to the executives' performance in meeting predetermined goals and objectives.

**Sec. 3. Audit Committee.** The Audit Committee shall consist of at least three members of the Board who are free from any relationship that would interfere with the exercise of their independent judgment on behalf of the Committee. They shall be appointed by the President and exclude any member of the current Executive Committee, the Executive Director, other Officers, and any person authorized to sign the corporation's checks or otherwise direct expenditures of Corporate funds. The Committee shall retain an independent auditor on an annual basis to audit the financial records of the Association and this Committee shall act as a liaison with the outside accounting firm that reviews and audits the Association's financial books and records and compliance with federal and state audit requirements. This Committee shall select any other services needed for the financial management, reviewing reports and determining adequate procedures and controls, and reviewing financial performance. It is preferred, although not mandatory, that at least one member of this Committee have some financial or accounting experience.

**Sec. 4. Finance and Budget Committee.** The Finance and Budget Committee shall be the committee principally charged to develop the proposed budget each year and will provide oversight to the Board throughout the year. The Finance and Budget Committee shall consist of the Treasurer, who shall serve as Chairperson of the Committee, the President-Elect, and at least three other members of the Board of Directors, who are appointed to the Committee by the President. The Finance and Budget Committee shall be responsible for the yearly budget of the Association, and it shall consult with the Executive Director on the financial and administrative needs of the Association. It also shall oversee the budget and make recommendations for any adjustments to the budget during the course of the year.

**Sec. 5. Investment and Financial Development Committee.** The Investment and Financial Development Committee shall consist of at least four members of the Board of Directors, who are appointed to the Committee by the President. This Committee shall review existing income to the Association and investigate additional revenue streams. The Committee shall develop a financial development program for income to support the Association and its goals and objectives. This Committee shall report at each Board Meeting on the progress of the goals of the financial development program. This Committee shall also develop and monitor a written investment policy to meet the Association's financial needs and risk tolerance that shall be reviewed and approved by this Committee and the full Board at least annually. The Committee shall consult with professional investment counsel as appropriate to comply with the investment policy objectives.

**Sec. 6. Limitation on Committee Powers.**

- (a) No Committee shall have the authority of the Board of Directors to amend, alter, or repeal these Bylaws; to elect, appoint, or remove any member of any such Committee or any Officer or Director of the corporation; to amend the Articles of Incorporation of the corporation; to restate the corporation's Articles of Incorporation; to adopt a plan of merger or adopt a plan of consolidation with another entity; to authorize the sale, lease, exchange or mortgage of all or substantially all of the property and assets of the corporation; to authorize the voluntary dissolution of the corporation or to revoke proceedings therefore;

to adopt a plan for the distribution of the assets of the corporation; to amend, alter, or repeal any resolution of the Board of Directors; to fill Board vacancies; or as otherwise may be prohibited by law.

- (b) No Committee shall have the authority of the Board of Directors without its delegation to authorize the filing of amicus briefs on behalf of the corporation or to approve an audit of the corporation's financial records.
- (c) Any Committee taking an action delegated to it by the Board shall report that action promptly to the Board

**Sec. 7. Committee Meetings.** Meetings of Committees of the Board of Directors may be called by the respective Chairs thereof or by any two members of the Committee. At all meetings of any Committee, a majority of the members of the Committee shall constitute a quorum for the transaction of business, and the act of a majority of the members of the Committee present at any meetings thereof at which there is a quorum shall be the act of the Committee.

(Board of Directors Meeting – September 10, 2013.)

## **800-39 Bylaws**

The motion, with its friendly amendment, was approved unanimously as follows:

Article II, Sec. 1 (a), as amended, reads:

- (a) The regular membership shall consist of persons who are interested in the branches of the law relating to patents, trademarks, copyrights, unfair competition and other intellectual property, whose practice in the opinion of the Board of Directors of the corporation conforms to the Code of Professional Responsibility of the corporation, and who shall be, and have been for a period of five years or more, members in good standing of the Bar of a court of record of the United States or any State or Territory thereof or of the District of Columbia or of the United States Patent and Trademark Office. Regular members shall have the right to vote and hold office.

Article II, Sec. 2 (b) is deleted and subsequent paragraphs relabeled (b)–(f).

(Board of Directors Meeting – March 20, 2014.)

## **800-40 Bylaws**

Following additional discussion, the motion to approve the resolution to expand eligibility for membership in the Fellows and to instruct the staff to revise the Bylaws accordingly was approved unanimously. The resolution is as follows:

RESOLVED, that the Fellows of the American Intellectual Property Law Association recommend to the AIPLA Board of Directors that the following categories of non-voting

affiliate members be made eligible for appointment as AIPLA Fellows: foreign affiliates, United States Patent and Trademark Office professional affiliates, IP professional affiliates, IP paralegal/technical advisor affiliates, and government affiliates.

(Board of Directors Meeting – July 23, 2014.)

## **800-41**

### **Bylaws**

Following additional discussion, the motion to approve the proposed amendment to Article III, Sec. 1. of the AIPLA Bylaws, including the friendly amendment, was approved unanimously.

ARTICLE III, Sec. 1, as amended, reads:

**Sec. 1.** The dues payable for each year by members and by affiliates shall be fixed from time to time by the Board of Directors at such amount as it deems desirable for the best interests of the corporation. In the event of any change in the dues payable by any class of membership, the members shall be notified thereof by a notice at least 45 days prior to the effective date of the change. The dues payable by law student/graduate affiliates shall be not more than one-half the dues payable by regular members, provided, however, that the Board may set a lower rate for newly elected members' dues for a limited period. The annual membership dues for United States Patent and Trademark Office affiliates shall be the same as for government members. Life members shall not pay dues; however, anyone who becomes a life member after October 1, 1998, and wishes to receive publications of AIPLA will be assessed a charge equal to the marginal costs of preparing and mailing such materials to that member. Honorary members shall not pay dues.

(Board of Directors Meeting – March 12, 2015.)

## **800-42**

### **Honorary Membership**

**Whereas**, AIPLA has benefited from the service of Hayden W. Gregory through his efforts to educate and advocate the best interests of the IP community to the Congress, the USPTO, the Copyright Office, other government entities, and the public, through his collaboration with AIPLA, whenever appropriate, and through his willing counsel and advice;

**Whereas**, AIPLA has benefited from the knowledge, skills, and energy of Hayden W. Gregory as a member of AIPLA for almost 20 years, and in his role as Legislative Consultant to the American Bar Association, Intellectual Property Law Section, for over 20 years;

**Whereas**, AIPLA and the entire IP community have substantially benefited from the application of Hayden's talents and experience during his illustrious career which has included:

- Service for nearly two decades on Capitol Hill, including serving with the U.S. House of Representatives as Chief Counsel of the Subcommittee on Courts and Intellectual Property;

- Serving as Legislative Consultant to the American Bar Association’s Intellectual Property Law Section, including working with the Section as it advised Congress on a significant number of important legislative issues, including the legislation that become the Leahy-Smith America Invents Act of 2011;
- Twenty years of attendance at in-person meetings of AIPLA’s Board of Directors, and providing counsel and guidance to the Board and headquarters staff; and
- Recipient of the 2014 Mark T. Banner Award, presented by the ABA, Section of Intellectual Property Law, for his impact on IP law and practice.

**NOW THEREFORE, BE IT RESOLVED** that the AIPLA Board of Directors, in consideration of his many contributions to the intellectual property community and to the American Intellectual Property Law Association, does on this day, July 15, 2015, elect Hayden W. Gregory to the position of Honorary Member.

(Board of Directors Meeting – July 15, 2015.)

## **800-43**

### **Bylaws**

A motion was made, seconded, and approved unanimously to amend Article II, Section 3, Fifth and Sixth Paragraphs of the Bylaws accordingly:

Sec. 3. The Fellows of the American Intellectual Property Law Association shall be a special category for regular, life, honorary, similarly qualified academic or government members, foreign affiliate, United States Patent and Trademark Office professional affiliate, IP professional affiliate, IP paralegal/technical advisor affiliate, and government affiliate members of the Association. Qualifications for election as a Fellow include (1) outstanding service to the Association, (2) prominence within the intellectual property profession, (3) learned contributions to the profession through teaching and writing, and (4) observance of the highest standards of ethical conduct.

The number of regular, life, honorary, similarly qualified academic or government members, foreign affiliate, United States Patent and Trademark Office professional affiliate, IP professional affiliate, IP paralegal/technical advisor affiliate, and government affiliate members elected and accepting designation as Fellows shall not in any year result in more than one percent of the then regular members of the Association having the status of Fellows, other than Senior Fellows; provided, however, that the Board of Directors may initially approve up to 20 of the regular members of the Association as “Founding Fellows” who may be excluded from the calculation of the foregoing numerical limitation on the number of Fellows.

The election as a Fellow shall be for a term of ten years, following which a Fellow shall have the status of a Senior Fellow for the duration of the Fellow’s tenure as a member of the Association. After the election of the “Founding Fellows,” the Fellows will nominate regular, life, honorary, similarly qualified academic or government members, foreign affiliate, United States Patent and Trademark Office professional affiliate, IP professional affiliate, IP paralegal/technical advisor affiliate, and government affiliate members, who

then must be individually approved by the Board for admission as Fellows of the Association.

Fellows may from time to time be requested by the Board of Directors to undertake projects, including those of a scholarly, educational, research or informational nature. Such projects shall be designed to provide the Board of Directors with a balanced and learned perspective on matters relating to public policy, jurisprudence, administrative procedure, international harmonization, comparative law or other matters of importance to the intellectual property profession and the Association.

Members who accept election as Fellows will be expected to make contributions to a Fellows Fund in the amount of \$1000, payable at a rate of Two Hundred Dollars each year during the five-year period following acceptance of election as Fellows, or in such greater amount or shorter time frame as they may desire. Academic or government members may request a contribution level in proportion to their membership dues level. The Fellows Fund will be used exclusively by the Association for projects selected by the Fellows and approved by the Board of Directors to provide such awards, and honoraria and services for scholarly meaningful contributions to the intellectual property law profession, the mentoring and professional development of newer members of the profession and law school students with an interest in intellectual property law, educating the public about intellectual property, and supporting community service programs in which AIPLA members participate. In addition, the Fellows Fund may be used for other projects or purposes selected by the Fellows, and approved by Board of Directors' as the Board of Directors may from time to time authorize. Acceptance of election as a Fellow shall be in writing and contain an acknowledgment of (1) the elected Fellow's willingness for continued involvement and promotion of Association and Fellows activities, and (2) the expectation that the elected Fellow will make monetary contributions to the Fellows Fund.

With the approval of the Board of Directors and under the leadership of a chair appointed by the President-Elect, Fellows may undertake to organize themselves, elect leaders, and establish committees, recommend disposition of proceeds from the Fellows Fund. The Fellows of the Association will support and respect the Association objectives, principles and committee missions and activities, submit any additional proposed initiatives to be undertaken by the Fellows to the Board for approval, and submit any resulting studies, papers and proposals to the Board for its consideration and disposition.

(Board of Directors Meeting – September 19, 2015.)

**800-44**

## **Bylaws**

**RESOLVED**, that the Board of Directors amend Article VII of the Bylaws by amending the following provisions as annotated below:

### **Board Committees and Board Operations**

#### **ARTICLE VII**

##### **Officers and Executive Director**

**Sec. 1. Designation.** The officers of the corporation shall be a President, a President-Elect, a First Vice President, a Second Vice President, an Immediate Past-President, a Secretary and a Treasurer, all of whom shall be Directors of the corporation. These officers shall each serve for a term of one year, commencing at the close of the annual meeting of the corporation at which the election of the new Board of Directors and Officers is reported, but shall hold their respective offices until their successors shall have been elected and installed. In case of a vacancy in any one of these offices, the Board may, at its discretion, fill such vacancy for the balance of the unexpired term.

**Sec. 2. The President.** The President shall be the chief executive officer of the corporation and shall serve as chair of the Board of Directors. The President shall preside at meetings of the corporation, the Board of Directors and the Executive Committee, supervise the Executive Director and other officers of the corporation, perform such other duties as may be prescribed from time to time by the Board of Directors and have all other powers and duties that pertain to the position of chief executive officer and chair of the Board of Directors. In the President's absence from any meeting, one of the officers of the corporation, in the order in which they are designated in Section 1 above shall preside.

**Sec. 3. The President-Elect.** The President-Elect shall assist the President in carrying out the programs of the corporation and shall become the President at the close of the next succeeding annual meeting after the date of installation as President-Elect.

**Sec. 4. The Vice President(s).** The Vice President(s) shall assist the President in carrying out the programs of the corporation.

**Sec. 5. The Immediate Past President.** The Immediate Past President shall serve in an advisory capacity to the President and shall perform such other functions as may be designated for him or her by the Board of Directors.

**Sec. 6. The Secretary.** The Secretary or the Secretary's designee shall keep a record of the proceedings of all meetings of the Board of Directors and of the corporation, of all referendum votes, and of such other matters as may be deemed worthy of record. The Secretary or the Secretary's designee shall provide for the notification of the members and Directors of the corporation of their respective meetings in accordance with these Bylaws, shall be custodian of the corporate records and seal, shall furnish certifications of Board actions, Bylaws, organizational documents, and shall perform such other duties as may be assigned by the Board of Directors or the President.

**Sec. 7. The Treasurer.** The Treasurer or the Treasurer's designee shall collect and, under the direction of the Board of Directors, arrange for the care and distribution of all funds of the corporation and the keeping of full and regular accounts, which shall at all times be open to the inspection of any officer or Director. The Treasurer or the Treasurer's designee shall submit for approval of the Board of Directors a proposed budget for the ensuing fiscal year, and the Treasurer from time to time shall report to the Board of Directors the state of expenditures with reference to the budget. The Treasurer shall present to the corporation at its annual meeting a financial report for the past fiscal year. The fiscal year shall be from July 1 to June 30.

**Sec. 8. The Executive Director.** The Executive Director, under the supervision of the President, shall be primarily responsible for implementing the policies and procedures established by the Board of Directors and shall be responsible for conducting the business of the corporation. The Executive Director functions as the senior policy advisor to the

corporation's Board of Directors, Executive Committee and President, as well as the chief operating official of the corporation. The Executive Director is responsible for initiating, developing and implementing policy initiatives and programs to meet the ever-changing challenges in the fields of intellectual property law. The Executive Director promotes the strategic goals of the corporation by building and strengthening relationships with governmental and non-governmental organizations both in the United States and abroad. The Executive Director works with the corporation's committees to communicate the views of the corporation on important issues involving patent, trademark, copyright, trade secret law, and related areas of law and serves as the corporation's principal spokesman before Congress, governmental agencies and the media. The Executive Director, or his or her delegates, shall approve the expenditure of the monies approved by the Board and shall make periodic reports to the Board concerning the programs of the corporation. The Executive Director shall recommend to the Board of Directors for their approval the duties and compensation of the employees of the corporation, and all employees of the corporation shall report and be responsible to the Executive Director. The Executive Director, under the supervision of the President, shall have the power to employ and to discharge the other employees of the corporation.

**Sec. 9. Agents.** The Board of Directors may appoint such agents as it deems necessary or appropriate to further the corporation's business.

**Sec. 10. Removal of Officers and Agents.** Any officer, Board member or agent may be removed with or without cause whenever the Board of Directors in its sole discretion shall consider that the officer, Board member or agent's removal will serve the best interests of the corporation. Any agent appointed otherwise than by the Board of Directors may be removed with or without cause at any time by any officer having authority to appoint the agent whenever that officer in the exercise of his or her sole discretion shall consider that the agent's removal will serve the best interests of the corporation. Election or appointment of an officer, Board member or agent shall not of itself create contract rights.

(Board of Directors Meeting – January 30, 2016.)

## 800-45

## Bylaws

Resolved, that Article II, Section 3 of the AIPLA Bylaws be amended to clarify the number of members eligible for consideration as Fellows, as follows:

*Sec. 3. The Fellows of the American Intellectual Property Law Association shall be a special category for regular, life, honorary, similarly qualified academic or government members, international affiliate, United States Patent and Trademark Office professional affiliate, IP professional affiliate, IP paralegal/technical advisor affiliate, and government affiliate members of the Association. Qualifications for election as a Fellow include (1) outstanding service to the Association, (2) prominence within the intellectual property profession, (3) learned contributions to the profession through teaching and writing, and (4) observance of the highest standards of ethical conduct.*

*The number of individuals elected and accepting designation as Fellows shall not in any year result in more than one percent of the then total number of members in all eligible membership categories of the Association, other than Senior Fellows; provided, however, that the Board of Directors may initially approve up to 20 of the regular members of the*

*Association as “Founding Fellows” who may be excluded from the calculation of the foregoing numerical limitation on the number of Fellows.*

(Board of Directors Meeting – September 11, 2016)

**800-46**

## **Bylaws**

*RESOLVED*, that Article VI of the AIPLA Bylaws be amended as follows:

### **Article VI**

#### **Committees of the Board of Directors**

##### **Sec. 1. Designation of Committees.**

(a) The following shall be Committees of the Board of Directors:

1. Executive Committee
2. Audit Committee
3. Finance and Budget Committee

(b) Each Board Committee shall consist of three or more Directors.

(c) Members of the Committees shall be appointed for a one-year term commencing on the close of the Annual Meeting and shall be appointed by the President whose term commences on that date.

(d) The President may also recommend to the Board of Directors for its approval one or more additional Board Committees to direct particular business of the corporation. Each such Board Committee may exercise the authority granted to it by the Board’s enabling resolution.

**Sec. 4. Finance and Budget Committee.** The Finance and Budget Committee shall serve in an advisory and oversight capacity concerning the financial and investment policies of the corporation and will provide oversight to the Board throughout the year. The Finance and Budget Committee shall consist of the Treasurer, who shall serve as Chairperson of the Committee, the President-Elect, and at least three other members of the Board of Directors, who are appointed to the Committee by the President. The Finance and Budget Committee shall be responsible for advice and oversight of the yearly budget of the Association, and it shall consult with the Executive Director on the financial and administrative needs of the Association. It also shall oversee the budget and oversee making recommendations for any adjustments to the budget during the course of the year. This Committee shall monitor a written investment policy to meet the Association’s financial needs and risk tolerance that shall be reviewed and approved by this Committee and the full Board at least annually. The Committee shall consult with professional investment counsel as appropriate to comply with the investment policy objectives.

(Board of Directors – October 29, 2016)



Resolved, that Article II, Section 3 of the AIPLA Bylaws be amended to clarify the number of members eligible for consideration as Fellows, as follows: ...

*Sec. 3. The Fellows of the American Intellectual Property Law Association shall be a special category for regular, life, honorary, similarly qualified academic or government members, international affiliate, United States Patent and Trademark Office professional affiliate, IP professional affiliate, IP paralegal/technical advisor affiliate, and government affiliate members of the Association. Qualifications for election as a Fellow include (1) outstanding service to the Association, (2) prominence within the intellectual property profession, (3) learned contributions to the profession through teaching and writing, and (4) observance of the highest standards of ethical conduct.*

*The number of individuals elected and accepting designation as Fellows shall not in any year result in more than one percent of the then total number of members in all eligible membership categories of the Association, other than Senior Fellows; provided, however, that the Board of Directors ~~may~~ initially ~~approve up to 20~~ approved 18 of the regular members of the Association as "Founding Fellows" who ~~may be~~ were excluded from the calculation of the foregoing numerical limitation on the number of Fellows. Notwithstanding the above, when a nomination could result in the total number of Fellows, other than Senior Fellows, exceeding the one percent limitation in this section, the Fellows may nominate up to 5 individuals in any year for approval by the Board of Directors.*

(Board of Directors – July 16, 2020)

Resolved, that AIPLA amend Article II, Section 2 of the Bylaws, as follows:

(a) The ~~law student/graduate affiliate membership~~ shall consist of persons who are not a member of any Bar (except for patent agents registered before the USPTO), may not be qualified for regular or junior membership but who are regularly enrolled as candidates for a post-secondary professional law degree from an accredited post-secondary law school, and has an interest in intellectual property matters approved by the Association of American Law Schools, or who have graduated and received an undergraduate or postgraduate professional law degree within the past year from an accredited post-secondary school. law school approved by the Association of American Law Schools, and who would be otherwise qualify ied for junior or regular another category of membership if a member of the Bar. A person remains eligible for a law student/graduate affiliate membership for up to one year from his/her ~~their~~ the individual's date of graduation from law school. If a student affiliate member the law student/graduate affiliate becomes a member of the any Bar within that one-year period, the student affiliate member he/she may request transfer to junior another category of membership. ~~Law student/graduate affiliates shall n-Not be entitled eligible to vote or to hold office.~~

(Board of Directors – July 14, 2022)

**810-02****Quarterly Journal**

It was explained that a question had arisen regarding the editorial policy of the Quarterly Journal. To clarify that policy, it was proposed that the following principles apply:

Where AIPLA has a current, established, public position adopted by the Board of Directors, the Quarterly Journal will not publish an article expressing an opinion contrary to that position. The Quarterly Journal would only publish articles expressing views contrary to established positions of AIPLA in the context of a debate or symposium on the issue to assist the Association in determining if it wished to modify that position.

The editorial policy stated above was adopted by the Board.

(Board of Directors Meeting – July 22, 1995.

Retained by the Board of Directors – May 5, 2006.

Retained by the Board of Directors – July 13, 2016.)

**810-03****Counsel**

The Board adopted a Position Description as follows for a General Counsel of the Association:

**AIPLA GENERAL COUNSEL (PRO BONO)****Position Description****DUTIES:**

1. Render legal advice, on an on-going basis as requested, to AIPLA Officers, the Executive Committee, the Board of Directors, and Senior Staff regarding various issues affecting AIPLA, including:
  - past, pending, and prospective AIPLA activities
  - matters arising or alleged to arise from AIPLA activities, and specifically identified as involving possible liability to, or claims by, AIPLA or any employee or member acting or alleged to be acting on behalf of AIPLA
  - manage litigation, preparation for litigation and settlement of litigation
2. When available, attend Board meetings and study pending and prospective AIPLA Board and Executive Committee actions for purposes of rendering advice regarding the same.

REPORTS TO: President, AIPLA

APPOINTED BY: President, AIPLA

CONFIRMED BY: AIPLA Board of Directors

TERM: Not more than 3 years

**ASSISTANCE**

PROVIDED: To the extent possible, Senior Staff will provide all necessary

documents and information to facilitate execution of the duties of this position and to limit the time required for execution of these duties.

COMPENSATION: This position is pro bono. The person/law firm selected will receive no compensation, except under certain limited circumstances.

(Board of Directors Meeting – July 13, 1999.  
Retained by Board of Directors – January 30, 2010.  
Amended and retained by Board of Directors – October 20, 2011; and  
Retained by Board of Directors – September 25, 2022.)

## **810-06 Past Action Manual**

RESOLVED FURTHER THAT: Retired actions shall be maintained in a Past Action Archive.

(Board of Directors Meeting – January 22, 2003;  
Retained by Board of Directors – February 1, 2014.)

## **810-07 Budget Process**

RESOLVED that, AIPLA adopts the following procedure for approving its Annual Budget for the Association:

1. The Executive Director will solicit input from the President regarding the Association Budget for the coming Association Fiscal Year no later than the Mid-Winter Institute.
2. In determining the input to be provided to the Executive Director, the President shall seek advice from the President-Elect.
3. The Executive Director, with the assistance of the Chief Operating Officer and the Director of Finance, will present a draft Annual Budget to the President, for consideration at the time of the Board Meeting (typically in March and hereafter referred to as the “March Board Meeting”) next following the Board meeting(s) at the Mid-Winter Institute.
4. Following the March Board Meeting, the Chief Operating Officer will promptly present the draft Annual Budget, reflecting any adjustments made by the President, to the Finance and Budget Committee prior to the Spring Stated Meeting for its advisory role.
5. The Treasurer will present the draft Annual Budget to the Executive Committee for discussion and, thereafter with any changes accepted by the President, to the Board at the Board Meeting occurring at the Spring Stated Meeting.
6. The Board will approve and adopt the Annual Budget, with any necessary adjustments, preferably at the Board Meeting occurring at the Spring Stated Meeting, and in no case later than July 31<sup>st</sup> of the year in which that Annual Budget is to be effective.
7. Any substantial expenditure of the Association, not contemplated or authorized in the Annual Budget for the Fiscal Year in which the expenditure is to be made, must be presented to, and approved by, the Board of Directors before the expenditure can be made.

8. The fact that any budget or budget amendment would require the Association to run a deficit for any fiscal year, such as to reduce the reserves of the Association, must be specifically reported to the Board and, in that case, such budget or budget amendment must be approved by the Board before it can take effect.
9. A review of the Annual Budget for the current Fiscal Year will be conducted with the new President by the Executive Director shortly after the Annual Meeting to allow the new President to assess whether an amendment to the Annual Budget needs be made in view of any changed circumstances or priorities accompanying that President's and/or Board's Term.

(Board of Directors Meeting – January 25, 2003;  
Amended and retained by Board of Directors – February 1, 2014.)

#### **810-08 Policy on Board of Directors Meetings**

RESOLVED, that all Past Presidents have a standing invitation to attend meetings of the Board of Directors held during the Association's Mid-Winter stated meeting. The Executive Committee or Board, in the exercise of their discretion, may also invite any Past Presidents to attend any other meeting of the Board where it is believed that such Past President possesses special expertise, knowledge, or experience that would benefit the Board in its consideration of an issue before the Board.

(Board of Directors Meeting – March 13, 2003;  
Retained by Board of Directors – February 1, 2014.)

#### **810-09 AIPLA Political Action Committee**

RESOLVED, that the AIPLA Board of Directors establishes the following procedures for the administration of the "American Intellectual Property Law Association Political Action Committee:

1. The American Intellectual Property Law Association undertakes the establishment and administration of a Political Action Committee (hereinafter "PAC") pursuant to Federal Law for the purpose of supporting candidates for Federal office who, irrespective of political party or affiliation, can have a direct influence on legislation affecting intellectual property.
2. The PAC is organized to solicit and receive voluntary contributions from citizens of the United States who may lawfully contribute.
3. The PAC will accept only contributions made voluntarily and in accordance with all laws.
4. All moneys contributed to the PAC shall be maintained in an account of a bank designated by the Treasurer, and shall be segregated and kept apart from any funds of AIPLA or any other person, association, firm, or corporation.
5. No contributor to the PAC shall have any right to share personally in any of the

funds or assets of the PAC upon its dissolution, or at any other time.

6. The Executive Director of AIPLA shall be the Treasurer of the PAC. A Deputy Executive Director of AIPLA shall be the Assistant Treasurer of the PAC.
7. The Assistant Treasurer shall automatically assume the duties and responsibilities and exercise the authority of the Treasurer during the absence or incapacity of the Treasurer, or during a vacancy in that office.
8. No distribution shall be made from the PAC unless such distribution is approved by the President of AIPLA and the Treasurer.
9. Any distribution made by the PAC shall be by check drawn on the bank account of the PAC. All checks shall be signed by the Treasurer or the Assistant Treasurer.
10. The Treasurer shall be responsible for the care and custody of all the monies of the PAC. The Treasurer shall retain the accounts and records, prepare and deliver to individual contributors written receipts evidencing contributions to the PAC, and record information with respect to contributions to, and disbursements made by, the PAC, all as may be required by applicable law. The Treasurer shall also file reports required by law and shall prepare annually a report listing the distributions made by the PAC. All administrative records of the PAC shall be maintained and located at the headquarters of the American Intellectual Property Law Association.
11. The PAC shall remain in existence until dissolved by action of a majority of the AIPLA Board of Directors. In the event of such dissolution, all remaining monies shall be distributed in accordance with the principles enumerated above.
12. This resolution supersedes all previous Board actions, including any and all resolutions or Bylaws adopted by the Board, concerning the administration of the AIPLA PAC.

RESOLVED FURTHER, that the AIPLA Board of Directors ratifies past distributions from the AIPLA PAC made consistent with the procedures set forth in this policy.

(Board of Directors Meeting – March 13, 2003.  
Revised by Board of Directors – July 10, 2008.  
Retained by Board of Directors – October 26, 2019.)

## **810-14                                      Past Action Manual**

RESOLVED THAT: Annually and before the Annual Meeting, the Association will automatically retire, as a public statement of the Association, any action taken more than ten years previously, unless the Board of Directors votes to maintain such action as a public statement of the position of the Association.

(Board of Directors Meeting – January 22, 2003;  
Amended and Retained by Board of Directors – February 1, 2014.)

**RESOLVED**, that as a general rule, Members of the Board of Directors shall attend in person all meetings of the Board that are held at stated meetings and the Board retreat. If a Member has an unavoidable conflict that would prevent the Member from attending in person, the Member may seek permission to participate in a meeting by videoconference or other media platform as determined by the Executive Committee. That Member should seek permission, preferably at least one week in advance of the scheduled meeting, and should provide a specific reason for the request. The Executive Committee shall consult with the Executive Director for input before deciding on any such request, which must be approved by a majority of the Executive Committee; and

**RESOLVED**, that, as a general rule, Members of the Board of Directors shall attend all other meetings of the Board at least by videoconference or other media platforms, as determined by the Executive Committee, and optionally in person, if the Executive Committee makes this option available.

(Board of Directors Meeting – May 13, 2009.

Retained by Board of Directors – October 26, 2019; and

Revised and retained by Board of Directors – March 28, 2022)

**RESOLVED**, that the American Intellectual Property Law Association (AIPLA) adopts the policy that, during deliberations, the Committee on Nominations should refrain from nominating an individual who is a member of the same business entity as that of a Committee member.

(Board of Directors Meeting – January 5, 2012; and

Retained by the Board of Directors – September 25, 2022.)

For many disputes there are more effective methods of resolution than traditional litigation. When appropriately used, alternative dispute resolution procedures, either in conjunction with litigation or independently, can substantially reduce the cost and burdens of litigation and result in solutions not available in court.

Accordingly, it is resolved that—

Each practicing member of this Association is encouraged to be knowledgeable about alternative dispute resolution processes, and where appropriate, is encouraged to advise the member's clients of the availability, values and characteristics of these alternatives to litigation so that clients can make an informed choice concerning the use of litigation or alternative dispute processes, or both, for resolution of disputes, whether present or prospective.



The Association staff shall provide teaching materials and templates for committee chairs and other leaders as guides for effective polling of their committee members.

(Board of Directors – November 1, 2003.  
Retained by Board of Directors – February 1, 2014.  
Retained by Board of Directors – July 15, 2015.)

**820-08**

### **AIPLA DIVERSITY STATEMENT**

Our mission at AIPLA is to lead and serve a diverse IP community by enhancing knowledge and shaping the future of IP law.

AIPLA believes that diversity among its membership is essential to our ability to accomplish this mission. Diversity embodies all those differences that make us unique individuals and includes people of different race, ethnicity, nationality, culture, sexual orientation, gender, gender identity, religion, age, practice area, and physical ability, as well as people of diverse opinions, perspectives, ideas, and thinking. Because diversity and individual uniqueness brings creativity and vitality to an organization, we recognize the importance of diversity to AIPLA. We are, therefore, committed to providing an environment of fairness and equitable treatment. Our goal is to effectively serve AIPLA members from all backgrounds, to encourage the professional growth of all members, and to embrace and celebrate the diversity of our membership.

To that end, AIPLA will continue to identify, and look for ways to reduce or eliminate, barriers to under-represented groups and will continue to look for ways to expand access to leadership opportunities within the organization in an effort to further strengthen our diversity. AIPLA, by and through its Officers, Directors, and Committee leaders, will encourage participation by qualified members of under-represented groups at all levels of the Association.

(Board of Directors Meeting – May 13, 2009.  
Retained as amended by Board of Directors – October 26, 2019.)

**830-14**

### **Amicus Brief Policy**

The Board of Directors decided that all briefs will list first the Association and the name of the President. Following that, the principal author will be listed as “counsel of record.” At the discretion of the principal author, others who made significant contributions to the brief will be listed as “of counsel.”

(Board of Directors Meeting – October 18, 1997.  
Amended and retained by Board of Directors – January 23, 2008 and July 18, 2018.)

**830-30**

### **Amicus Participation Conflict Guidelines and Amicus Brief Footnote**

1. The principal focus should be on maintaining the credibility of the AIPLA to the courts.



2. Promptly upon learning that the AIPLA Amicus Committee (“Committee”) or the Board, as the case may be, intends to consider whether to participate as an amicus in a matter, each member of the Committee and the Board shall undertake reasonable inquiry to determine whether the member may need to recuse himself from consideration of a brief. A member shall recuse himself if he or his firm represents a party to the matter to be considered in that matter. A member shall consider recusing himself if: (a) he or anyone associated with the member in a firm legally represents in any matter any party to the matter to be considered; or (b) his employer or any affiliated company or organization is related to any party to the matter to be considered as a parent, affiliate, or subsidiary company or in a joint venture. The member may voluntarily recuse himself, and shall recuse himself if the Board or Committee determines that to be appropriate under paragraphs 3 or 4. Recusal means that such member shall not be present, either in person or otherwise, during either the discussion or voting on such matter, and, further, means that such member shall not actively seek to influence any other member’s vote on that matter.
3. A member in doubt about recusing himself may present to the Board or Committee a statement of all facts known to the member that would be pertinent to a determination by the Board or Committee with regard to whether the member should be recused and shall recuse himself if the Board or Committee after full deliberation determines that to be appropriate.
4. (a) If any facts are known to a Board or Committee member that might, in the judgment of that member, create a conflict of interest, an appearance of a conflict of interest, or in any other way adversely affect the credibility of AIPLA, that member shall disclose those facts to the Board or Committee, as the case may be, to the extent permitted consistent with the member’s professional responsibility. If any Board or Committee member on behalf of another entity (including but not limited to an individual, commercial or not-for-profit enterprise, bar association, trade association, or NGO) has (i) substantive involvement in the development of any position for that entity in an actual or potential amicus submission, or (ii) a role in the preparation or approval of any such submission for the entity, then that member shall disclose those facts to the Board or Committee, as the case may be, to the extent permitted consistent with the member’s professional responsibility.  
  
(b) Upon receipt of a disclosure under subsection (a), the Board or the Committee, as the case may be, then shall decide by majority vote whether or not the member shall be recused or, if the vote had already occurred, whether any re-vote is necessary. Except for communications made to the entire Board or Committee, the member shall recuse himself from consideration of whether recusal or re-vote is necessary. If the member concludes that no disclosure is permissible consistent with the member’s professional responsibilities to the client, then the member shall recuse himself.
5. If a member believes that another member may have failed to disclose a representation or other facts required to be disclosed by these rules, that member shall so inform the President or Chair. If a member believes that the President or Chair has failed to disclose such matters, the member shall advise the Committee or Board as a whole.

6. If a member learns at a time before the brief is filed that he should have recused himself, he shall promptly so advise the Chair or President who shall decide whether or not a re-vote is necessary after advising the Committee or Board of the relationship.

The Board recommends that all briefs state in a footnote:

Pursuant to Supreme Court Rule 37.6, the Association states that this brief was not authored in whole or in part by counsel to a party, and that no monetary contribution to the preparation or submission of this brief was made by any person or entity other than the Association and its counsel. Specifically, after reasonable investigation, AIPLA believes that (i) no member of its Board or Amicus Committee who voted to file this brief, or any attorney in the law firm or corporation of such a member, represents a party to this litigation in this matter, (ii) no representative of any party to this litigation in this matter participated in the authorship of this brief, and (iii) no one other than AIPLA, or its members who authored this brief and their law firms or employers, made a monetary contribution to the preparation or submission of this brief.

(Board of Directors Meeting – March 14, 2002.

Revised by Board of Directors – February 2 and 4, 2006; December 12, 2012; and May 17, 2014.)

## **830-36**

### **Amicus Committee Policy and Procedures**

RESOLVED, that the Board of Directors adopts the following procedures for the Amicus Committee and for determining when the Association will file an amicus brief:

1. Foreign Affiliate Members are not eligible for membership on the Amicus Committee.
2. The Amicus Committee is charged with initial consideration of requests to review cases for possible amicus brief participation. As a result, all requests for the filing of amicus briefs are to be directed to the Chair of the Amicus Committee. The Chair of the Committee, after consultation with the Vice Chair, or the Board Liaison if one of them has a conflict, may elect not to distribute the materials to the Committee members if he or she believes the case is so inappropriate for consideration as not to require the investment of the time of the members of the Amicus Committee and Board. Any counsel taking exception to a ruling by the Chair of the Amicus Committee may contact the AIPLA President for reconsideration.
3. In responding to requests for the filing of amicus briefs, the Chair of the Amicus Committee is to provide written information to counsel for the parties to advise them of its operating procedures and policies, as well as those of the Association. Counsel for the parties should be particularly informed that:
  - a. The fact that AIPLA is considering whether to file a brief is not to be taken as suggesting that AIPLA believes that the Court has made an error, or that AIPLA will eventually decide to file a brief.

- b. If the Amicus Committee does not recommend the filing of a brief, or if the AIPLA Board decides not to file a brief, such a decision is not to be taken as a position by AIPLA on the issues in the case in question, and AIPLA would consider it inappropriate for a party to attach any particular significance to such action by AIPLA in any brief or argument to a court.
  - c. Once a case is considered by AIPLA, AIPLA retains total control over its position in the case, even if that position might be inconsistent or adverse to the position of the party who brought the case to AIPLA's attention. Consequently, any party who brings a case to the attention of AIPLA may not "withdraw" the case from consideration if such party does not agree with any position taken by AIPLA.
- 4. The operating procedures and policies of the Amicus Committee must comply with the Bylaws of the Association and any Past Actions of the Board of Directors which are still in effect. However, subject to approval of the Board, the Amicus Committee may establish such other procedures, policies and materials that are reasonably necessary for it to carry out its work.
- 5. After the materials are distributed to the Committee members, they may meet and discuss the case during the next regularly scheduled meeting of AIPLA. If time does not permit a face-to-face meeting, a vote will be taken by mail or email on whether each Committee member believes AIPLA should file a brief.
- 6. In cases in which the AIPLA Amicus Committee reaches a consensus that a brief should be filed, the Committee will make an appropriate recommendation to the Board of Directors. The Board then will consider this recommendation at its next meeting, or if time does not permit, by mail or e-mail, or in an emergency situation, through its Executive Committee or by telephone conference call.
- 7. A two-thirds vote of the Board of Directors voting is necessary to approve filing of any amicus brief on behalf of the Association.

(Board of Directors Meeting – November 1, 2003;  
Retained by Board of Directors – February 1, 2014.)

**830-40**

### **Amicus Policy and Procedures**

Whereas AIPLA's participation in litigation through its amicus curiae filings represents an important aspect of the Association's advocacy for improvements in intellectual property law; and

Whereas AIPLA's reputation as a source for highly substantive contributions in its judicial advocacy depends on careful attention to the quality of the Association's amicus briefs;

RESOLVED, that a 2/3 affirmative vote of a working quorum of the Board of Directors shall be required to approve each of:

- (1) A motion to participate in a case as amicus curiae;

- (2) A motion that states the substantive position to be articulated in an amicus brief;
- (3) A motion to appoint the author of the amicus brief, and
- (4) A motion to authorize the filing of a completed brief in the case at hand or to approve the brief substantially and delegate its completion and filing.

(Board of Directors Meeting – January 27, 2010.  
Retained as amended by Board of Directors – September 11, 2020)

#### **830-41                                      Public Appointments Committee**

That the Charter of the Public Appointments Committee be amended so that “office in the courts of the United States” reads “federal office,” thereby changing the jurisdiction of the Public Appointments Committee to candidates for office both in the executive branch, such as the USPTO, and the legislative branch, such as the Copyright Office, as well as in the judicial branch, such as the Federal Circuit.

(Board of Directors Meeting – February 14, 2013.)

#### **830-42                                      Amicus Policy and Procedures (PTAB)**

*RESOLVED*, with regard to an amicus brief for a Precedential Opinion Panel (“POP”) of the Patent Trial and Appeals Board (PTAB) at the USPTO, the President may decide the appropriate procedure to follow for the development and submission of such a brief, but any procedure must include review and approval of the brief by the Board of Directors.

(Board of Directors Meeting – July 17, 2019.)

#### **840-02                                      Quarterly Journal Editorial Board**

The Quarterly Journal Editorial Board members should serve three year, non-renewable terms. The Editorial Board members were divided up into three groups, based on expertise, with the initial terms beginning in October, 1997. The first group’s term would thus end in October of 1998, but those members’ terms could be renewed for three years. The second and third groups’ terms would end in October of 1999 and 2000 respectively and would not be renewable; however, a member shall not be prohibited from reapplying to the Editorial Board at any point following the end of the member’s term.

(Board of Directors Meeting – July 10, 1997.  
Retained by Board of Directors – January 23, 2008  
Amended and retained by Board of Directors – July 18, 2018.)

RESOLVED, it shall be the policy of AIPLA that the following disclaimer be used for any article, developed by a Committee or Subcommittee of the Association, published in the Quarterly Journal or other publication, and which expresses a view that has not been adopted by the Board of Directors as an official policy of the Association:

Unless expressly stated, material contained herein shall not be construed as actions or positions of the American Intellectual Property Law Association to be such.

RESOLVED FURTHER, the following illustrative disclaimer be used in connection with educational materials posted on the web site:

These materials have been posted by AIPLA for informational purposes only and are not legal advice. Do not act in reliance upon this information without seeking professional counsel. Unless expressly stated, materials posted on this web site should not be construed as actions or positions of the American Intellectual Property Law Association to be such.

(Board of Directors Meeting – December 3, 2003;  
Retained by Board of Directors – February 1, 2014.)

RESOLVED, that the American Intellectual Property Law Association adopts the following disclaimer to use with the trademark sample pleadings publication:

**Disclaimer**

AIPLA provides these sample pleadings “as is” for informational purposes only. These sample pleadings do not include or contain legal advice, do not create an attorney-client relationship between the AIPLA and you, and are not endorsed, sponsored, approved or otherwise sanctioned by AIPLA. These sample pleadings may not be up to date and may contain legal authority that is not controlling in your jurisdiction or be based on information that is not relevant to your case. You should not use these sample pleadings without seeking professional counsel.

AIPLA MAKES NO REPRESENTATIONS OR WARRANTIES OF ANY KIND, EXPRESS OR IMPLIED, AS TO THESE SAMPLE PLEADINGS. AIPLA EXPRESSLY DISCLAIMS ALL OTHER GUARANTEES, WARRANTIES, CONDITIONS AND REPRESENTATIONS OF ANY KIND, EITHER EXPRESS OR IMPLIED, WHETHER ARISING UNDER ANY STATUTE, LAW, COMMERCIAL USE OR OTHERWISE, INCLUDING IMPLIED WARRANTIES OF MERCHANTABILITY, FITNESS FOR A PARTICULAR PURPOSE, TITLE AND NON-INFRINGEMENT. IN NO EVENT SHALL AIPLA OR ANY OF ITS DIRECTORS, OFFICERS, EMPLOYEES, AGENTS OR AFFILIATES BE LIABLE, DIRECTLY OR INDIRECTLY, UNDER ANY THEORY OF LAW (CONTRACT, TORT, NEGLIGENCE OR OTHERWISE), TO YOU OR ANYONE ELSE, FOR ANY CLAIMS, LOSSES OR DAMAGES, DIRECT, INDIRECT, SPECIAL, INCIDENTAL, PUNITIVE OR CONSEQUENTIAL, RESULTING FROM OR OCCASIONED BY THE CREATION, USE OF OR RELIANCE ON THIS SITE (INCLUDING INFORMATION AND OTHER CONTENT) OR THE INFORMATION, RESOURCES OR MATERIAL ACCESSED THROUGH THIS WEBSITE.

This website may be considered advertising in your jurisdiction.

(Board of Directors Meeting – January 29, 2005.  
Retained by Board of Directors – July 13, 2016.)

**850-05****Meetings – Attendance**

The Board voted to invite the American Bar Association’s Intellectual Property Section’s Legislative Consultant to attend AIPLA Board meetings in addition to the Chairman.

(Board of Directors Meeting – January 24, 1996.  
Retained by Board of Directors – January 24, 2007.  
Retained by Board of Directors – July 19, 2017.)

**850-14****Meeting Materials**

RESOLVED, content from previous stated meetings and stand-alone CLE programs will be placed on the website in a searchable form, where appropriate and feasible, and an online index will be developed for content from previous stated meetings and stand-alone programs, whether the content is online or not.

(Board of Directors Meeting – March 13, 2003;  
Retained by Board of Directors – February 1, 2014.)

**870-01****Code of Professional Responsibility**

RESOLVED that the American Intellectual Property Law Association, in accordance with Article I of its Bylaws, hereby adopts as its Code of Professional Responsibility the Model Rules of Professional Conduct of the American Bar Association, including all amendments made thereto in the past or the future, except that (a) if a member objects to any future amendment within six months of its adoption by the ABA, that amendment will be considered by the Committee on Professionalism and Ethics, which shall make a recommendation to the Board if the Committee believes the amendment should not be part of the AIPLA’s Code of Professional Responsibility, and (b) the AIPLA will not object to actions taken by its members if they are in accord with standards of conduct adopted by a State in which the member is admitted to practice or by the United States Patent and Trademark Office.

(Board of Directors Meeting – April 22, 1999.  
Retained by Board of Directors – January 30, 2010; and  
Retained by Board of Directors – September 11, 2020.)

**900-03****Awards**

RESOLVED that, the administration of the Jan Jancin Award should be as follows:

1. The AIPLEF Foundation be and is hereby authorized to assume administration of the Jan Jancin Award in terms of: sending out letters to law schools to solicit nominees, reviewing all nominee materials received and making the selection as to the award recipient; it being understood that the Award criteria would remain unchanged.

2. The amount of the award be increased to \$5,000, with both AIPLA and the ABA-IPL Section contributing to the AIPLEF \$1,500 to fund the award, with the additional \$2,000 coming from the interest earned on the NCIPLA–Jan Jancin Endowment.
3. The award would continue to be given in alternate years by the ABA/IPL Section, and then by AIPLA, with the two organizations continuing to pay for travel for the award recipient and any related expenses for attending the meeting and social functions.
4. The Jan Jancin Award will continue to be recognized as sponsored by the ABA/IPL Section, AIPLA and the NCIPLA endowment.

(Board of Directors Meeting – January 25, 2003;  
Retained by Board of Directors – February 1, 2014.)

#### **900-04**

#### **Awards**

RESOLVED, that the Board establish AIPLA Awards in four categories:

1. Project Awards
2. President’s Awards for Outstanding Service in Fostering AIPLA’s Mission and Goals, and
3. Board Awards for Excellence in Fostering Intellectual Property Law
4. Committee of the Year Award

FURTHER RESOLVED, that the Board establish an Awards Committee composed of the Immediate Past President, outgoing Board Members, and Executive Director to receive and review Award nominations and to make recommendations to the President and to the Board respectively for specific Award recipients.

(Board of Directors Meeting – May 13, 2003.  
Revised by Board of Directors – May 3, 2013, and March 20, 2014.)

#### **900-05**

#### **Awards**

RESOLVED, that the American Intellectual Property Law Association adopts the following guidelines for the granting of AIPLA Awards:

1. The Awards Committee should solicit input from the President on nominations for individuals to be considered for the President’s Outstanding Service Award. After completing its deliberation, the Awards Committee should privately propose at least three individuals to the President for his or her consideration. Board approval of the individual selected for the President’s Outstanding Service Award is not required, although it is understood that a President may choose to consult with the Board on the selection.

2. Current members of the Board of Directors and Executive Committee are not eligible to be considered for any award. Past Presidents of AIPLA are eligible for the President's Outstanding Service Award, but only for service and contributions made after their term of office.
3. Not more than one President's Outstanding Service Award and one Board's Excellence Award should be presented each year in the absence of special circumstances.
4. The Awards Committee should present its recommendations to the Board for the Board's Excellence Award at the Spring Meeting (or at the latest, the July Board Meeting).
5. Conflicts
  - An Awards Committee member may not nominate nor participate in the consideration of a grant of an award to a member or employee of his or her firm or company.
  - A member of the Awards Committee may nominate and vote for an individual with which that member has a business relationship, but should disclose that relationship.
6. The Awards Committee should make efforts to tailor the physical award given, when possible, to reflect the specific contribution of the awardees. It is the consensus of the Committee that, in the long term, it would be beneficial for the form of the President's Outstanding Service Award and the Board's Excellence Award to be standardized, in order to add to the prestige and recognition of the award within the IP community. On a longer term basis, the Committee will begin work to standardize the physical awards for each category to reflect significance and importance of the awards.
7. The Awards Committee should emphasize the President's Outstanding Service Award is presented for service to or within AIPLA, while the Board's Excellence Award focuses on the impact to the larger intellectual property community.
8. The Awards Committee should solicit nominations of individuals for the AIPLA Project Award from Committee Chairs as well as from the Board and Executive Committee.
9. The Awards Committee shall solicit nominations for the Committee of the Year Award from the Board and Executive Committee.
10. The Committee of the Year Award shall be presented to the AIPLA committee, including any appointed or special committee, which has demonstrated extraordinary service to the organization, its members, and/or to the IP community. It shall be awarded in recognition of a committee's efforts and excellence in activities and communications, judged with reference to the Strategic Plan and the mission of the committee. The Committee of the Year Award typically shall be given to only one committee each year, but the Awards Committee can choose more, if appropriate. The Committee of the Year Award typically shall be



presented to the committee's leadership who led the committee during the year for which the Award is being given.

(Board of Directors Meeting – December 2, 2004.

Revised by Board of Directors – May 3, 2006; May 3, 2013; and March 20, 2014.)

## **900-06**

### **Fellows**

RESOLVED, that the American Intellectual Property Law Association (AIPLA) supports the creation of an Annual AIPLA Fellows Writing Competition as follows:

- (1) The Competition will be managed by the Fellows Committee under the oversight of the AIPLA Board of Directors;
- (2) The competition will be limited to members of AIPLA within certain defined classes of membership;
- (3) The topic for each Competition will be selected by the Fellows with the goal of fostering scholarship; and,
- (4) The prize will be provided by funds from the Fellows Fund as approved by the Board, and may be augmented by individual donations from the Fellows.

(Board of Directors Meeting – March 9, 2006.

Retained by Board of Directors – July 13, 2016.)

## **900-06**

### **Foundation for Advancement of Diversity in IP Law**

RESOLVED, the American Intellectual Property Law Association, as an element of its commitment to diversity and inclusion, and in recognition of its longstanding support for the Foundation for Advancement of Diversity in IP Law, in order to support Sidney B. Williams, Jr. Scholars, is willing to offer certain Scholars identified by the Foundation: (1) student membership in the Association for as long as they qualify for that category and (2) registration at one or more Stated Meetings of the Association that are held during the time the Scholar is enrolled in law school, up to a total annual cost to the Association not to exceed \$10,000.

(Board of Directors Meeting – February 8, 2021.)

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