Annual Committee Action Plan
2010-2011

Date: July 16, 2010

Committee Name: Patent Inter Partes Proceedings (Committee 104)

Chair(s) name and contact information:

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Vice-Chair name(s) and contact information:

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A. Committee Scope and Monitoring Policy Developments

1. Committee Scope- Does your committee scope accurately reflect the committee’s work and the reasons why someone would want to join your committee? If not, please suggest revisions. (NOTE: Revisions to your committee’s scope must be approved by your Division Chair, and by Council.)

We revised the description of our committee scope last year, although the revisions may not have been officially approved. As revised, the scope accurately reflects the committee’s work and the reasons why someone would want to join:

Our Committee is devoted to inter partes (or adversarial) practice before the United States Patent and Trademark Office. The two proceedings which presently fall into this category are interference proceedings and inter partes reexamination proceedings. Legislation is presently pending in Congress that would establish a third type of inter partes proceeding called a post-grant review or opposition proceeding. Our committee considers and addresses relevant legal precedent, proposed legislation and proposed USPTO rules relevant to such inter partes proceedings.
2. **Subcommittees**—List any subcommittees within your committee and provide the name and contact information for each subcommittee chair.

We have three subcommittees, one devoted to each type of *inter partes* proceeding (subcommittee chairs are listed in parentheses):

- Subcommittee A: Post-Grant Review Proceedings (chair not yet identified)
- Subcommittee B: Interference Proceedings (Herbert D Hart III)
- Subcommittee C: *Inter Partes* Reexamination Proceedings (chair not yet identified)

3. Describe how the committee will stay abreast of developments in the committee’s area of interest, including new cases, legislative proposals and policy initiatives.

   Subcommittee chairs will monitor developments in their respective areas and inform the committee as a whole. The Chair and Vice Chair will also monitor developments and bring them to the attention of the appropriate subcommittee chair.

B. **Committee Organization**—There are numerous ways in which a committee can be active, engage its members and develop policy and content. Below are some suggested activities. Think about which ways to engage your committee, and identify individuals who can be recruited to take the lead in each:

1. *Identify which person on the Committee Leadership team will have responsibility for the following and provide contact information.*

   a. Policy, Reports to the Section, Resolutions: Chair

   b. Committee Webpage: Vice Chair

   c. Annual Review Content Submissions: Vice Chair

   d. Other Publications (magazine articles; book ideas):

   e. Programs, including stand alone programs, Spring Conference panels, Roundtables and teleconferences: Chair
f. Committee newsletter: Rather than a formal newsletter, subcommittee chairs will send out e-mail updates to the committee.

g. Membership Recruitment and Involvement (The Section will retain its membership and attract new members, particularly young members and members from diverse backgrounds, by delivering high value for the dues paid and making meaningful opportunities for participation and leadership available to all): Chair and Vice Chair

i. Public Outreach:

2. Describe specifically how Committee Leadership will communicate as a group during the Section year (via meeting, conference call or e-mail) and how often it will do so.

The Committee Leadership will communicate through e-mail, listserv, teleconference, or in person. We plan to schedule a status telephone conference every other month. Additional teleconferences will be scheduled more frequently as needed to plan for specific events (CLEs and roundtables). In person committee meetings will be held during ABA meetings.

C. Activities and Projects- In light of substantive developments identified in section A, think about how you might develop content and activities on the subject.

1. Publications- Indentify your goals with respect to the Annual Review and other ABA-IPL publications (Landslide; books):

<table>
<thead>
<tr>
<th>Project</th>
<th>Goal</th>
<th>Completion Date</th>
<th>Responsible Person</th>
</tr>
</thead>
<tbody>
<tr>
<td>Participate in Annual Review per normal Section procedures</td>
<td>Contribute to Annual Review as appropriate when there are pertinent developments</td>
<td>Vice Chair</td>
<td></td>
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<tr>
<td>Landslide article</td>
<td>Encourage subcommittee chairs to contribute an article to Landslide if</td>
<td>Vice Chair</td>
<td></td>
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Subcommittee chairs
2. *Programs*- List all planned proposed programs; this includes stand alone programs, Spring Conference panels and teleconferences:

<table>
<thead>
<tr>
<th>Specific Program</th>
<th>Subject Matter</th>
<th>Proposed Date</th>
</tr>
</thead>
<tbody>
<tr>
<td>CLE Program at the ABA-IPL Annual Spring Meeting in Arlington</td>
<td>Topics being developed</td>
<td>March/April 2011</td>
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<td>Program</td>
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3. *Roundtables*- List all planned proposed Roundtable programs. Indicate if one of your Roundtables may have sufficient appeal to become a CLE teleconference (which involves charging a fee and providing written materials and CLE credit):

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<td>Roundtable</td>
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4. Other Activities and Projects - List any planned committee activities not described above:

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Subcommittees

Have you added or removed any subcommittees since completing your Committee Action Plan at the beginning of the year? If so, please detail below.

Last week Council approved an expansion in scope of Committee 104 to cover all post grant patent office practice. In view of this, I expect we will be adding at least one new subcommittee (directed to Ex Parte Reexamination), and perhaps more. We will have a Committee leadership meeting within the next several weeks to discuss the change in scope and what new subcommittees we want to set up.

None of the previously-existing subcommittees have been removed.

Which of your subcommittees are working well? Which, if any, need assistance?

They are all working well. They have not been very active but that is because there has not been a lot of activity in the respective areas this year.

When we add the subcommittee(s) referred to above, we will need to find individuals to lead and contribute to those.

Policy Development

How is the committee staying abreast of possible developments in the committee’s area of interest and expertise?

The subcommittee chairs are responsible for keeping abreast of developments and bringing them to the committee’s attention. For
example, our subcommittee chair for post-grant review gave the committee an update on pending reform legislation, our subcommittee chair for interferences provided and update on some recent interference law, and our subcommittee chair for inter partes reexamination provided an update in that area as well.

The Chair and Vice Chair have also been keeping abreast of developments (such as rule proposals by the PTO) and bringing those to the attention of the Committee.

Has the committee developed any resolutions this year or are any in the planning stages currently?

In conjunction with Section leadership (primarily Will Jones), we developed a resolution to expand the name and scope of the committee. I presented the resolution at the Council meeting last week, where it was passed after modification.

We have developed a joint resolution with Committee 101 pertaining to the PTO’s Humanitarian Reexamination proposal. This resolution has been approved by Will Jones and approved by votes of both committees. I understand that it is being evaluated by the Division Chair and will be placed on the schedule for the Council meeting at the Winter Leadership Conference.

We started working on a resolution proposing an ombudsman program to help move the inter partes reexamination process along. Committee 104 Vice Chair Scott McKeown was taking the lead on this. However, we recently learned that the PTO would be issuing a comprehensive new rules package for both ex parte and inter partes reexamination. Scott will lead an action group that will consider and comment on these proposed rules. Since some of these rules may render the need for an ombudsman program moot, we decided to table work on this proposed resolution until after we review the proposed rules package.
Leadership Development

Have you identified any individuals within your committee who have become active or increased their voluntary responsibility, or any individuals whom you believe are good candidates for potential leadership positions? If so, please give names and examples below.

Kevin Greenleaf volunteered to serve as chair for our Post-Grant Review subcommittee. There has not been much for him to do since there has been little legislative activity, but he seems enthusiastic.

Do specific individuals handle your committee homepage content, membership recruitment and outreach, or CLE development? If so, please list member names and responsibilities below.

Vice Chair Scott McKeown is in charge of the home page, which he has already updated at least once.

Chair and Vice Chair are responsible for membership recruitment. I will be in contact with Division leadership about this given the recent expansion in scope of the committee.

I am responsible for CLE development. We have an approved CLE program that will take place at the Spring IPL meeting in Arlington. Speakers include two Administrative Patent Judges from the Board.

Committee Projects and Activities

Please list any projects, content development, or goals laid out in your Committee Action Plan that your committee has accomplished to date.

At least two committee members (Scott McKeown and Kevin Greenleaf) have committed to working with young volunteers to author articles for Landslide. I understand that these articles are in progress.
As noted above, we developed and are putting on a CLE program at the Spring meeting. The program focuses on strategic uses of contested patent office proceedings, and is in the corporate track. I will be moderating the panel.

Please see the above for the various resolution activity the Committee has been and continues to be involved in.

What is the status of current committee projects, substantive content development, or activities whether or not they are listed in the Action Plan?

See the various activities and projects discussed above.

As also noted above, Scott McKeown is heading up an action group that will consider and develop Section commentary on the upcoming proposed rules package for ex parte and inter partes reexamination. Scott worked to put this group together in advance so that when the rules package is published, they can act quickly on it.

I expect the resolution regarding the Humanitarian Reexamination proposal to be presented at the next Council meeting. If it is passed, I expect we will work with Committee 101 to draft a letter to the PTO to express the Section’s views.

Have you encountered any obstacles to implementing the goals or activities set forth in your Action Plan? If so are there ways the ABA Staff might assist you?

As mentioned above, we will be having a Committee meeting to discuss the expansion in the scope of 104. We may have trouble finding people from within the present committee to assist with the new scope. We may turn to Division leadership or the staff for assistance in this regard (ideally we will recruit some folks from Committee 103 who are interested in reissue and ex parte reexamination).
Do you have plans for future activities or content development? If yes what are the rough descriptions and deadlines?

**Future activities are discussed above.**