

Minutes of the Inaugural Meeting of the Pauline Newman IP American Inn of Court
on October 11, 2011

On October 11, 2011, the Pauline Newman IP American Inn of Court had its inaugural meeting in the auditorium below the atrium of the Madison Building in the headquarters of the United States Patent and Trademark Office in Alexandria, Virginia. There was a reception from 6:30 p.m. to 7:30 p.m. At 7:30 p.m., the first President of the Inn, Albert Tramposch, called the meeting to order. Mr. Tramposch began the meeting by acknowledging the presence of some luminaries in the patent community. The luminaries included the Honorable Richard Linn and the Honorable Pauline Newman from the U.S. Court of Appeals for the Federal Circuit, the Honorable District Court Judge Liam O'Grady, Magistrate John F. Anderson from the Eastern District of Virginia, the Under Secretary of Commerce for the Intellectual and Director of the United States Patent and Trademark Office, David Kappos, and Chief Judge James B. Smith and Judge Jay Moore from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Ms. Clare Kissen, a barrister from the United Kingdom, provided insights as to the Inns of Court system among barristers in her country. She explained the long history of the Inns for relationship building and mentoring among barristers, and wished the Inn success in its future endeavors.

After thanking the Executive Committee of the Inn and the founding members, including Ronald Stern, Charles Wieland and Rob Burns, Mr. Tramposch introduced Judge Linn for opening remarks and presentation of the charter. Judge Linn provided an explanation of the Linn Inn Alliance of Inns specializing in Intellectual Property within the American Inns of Court, and presented the charter for the new Pauline Newman IP American Inn of Court to the Honorable Judge Pauline Newman, in honor of whom the Inn has been named.

Judge Linn provided insight into and praise for Judge Newman's work as a practicing lawyer, as a government servant, and particularly as a Circuit Judge on the Federal Circuit. Accepting the charter, Pauline Newman explained the value of such Inns, the history of the Inns, and her long history with the Giles Rich IP American Inn of Court.

The Honorable David J. Kappos then introduced Judge Newman by providing a tribute to her continuing career, her character and her contribution to the IP community. Mr. Kappos provided the framework for understanding why Pauline Newman is a luminary in the IP community.

Judge Newman provided a historical background for the many changes to the patent law under the Carter and Reagan administrations, including the formation of the Federal Circuit, and how these changes were so important to the patent.

Thereafter, Judges Linn and Newman joined the panel with Chief Judge James Smith, as well as Judge Walter Kelley of Jones Day and Todd Walters of Buchanan Ingersoll & Rooney for discussion on how the third party reforms of the Leahy-Smith America Invents Act may create new tools for litigation. Chief Judge Smith explained how the Patent Office was rapidly ramping up the number of APJs, including a round of fifty new APJs in the next few months, but

explaining that many of the changes, including the change of the name of his organization to the Patent Trial and Appeal Board would not occur for a year or eighteen months, depending on the section of the statute. Judge Linn opined that funding the PTO is a critical issue; that the Patent Office did its job to the best of its ability but needed to be funded.

With respect to the expanded post-grant review, Judge Walter Kelley and Todd Walters explained that the *inter parte* review and the post-grant review might become important tools to litigants, but as Judge Kelley explained, the process had to be fast and definitive if courts were to be expected to grant stays in litigation pending the results of the PTO proceedings. He explained that the current reexamination procedures were more in the nature of harassment, and that they take too long and the outcomes are not predicible. He suggested that unless the patent was declared unpatentable during the reexamination, the patent would be returned to the court without significantly reducing the issues and there was little reason for a court to grant a stay.

Todd Walters pointed out that these new procedures could create a new avenue for resolution of patent disputes at a much lower cost and that users would take advantage of the lower burdens of proof as compared to district court litigation.

Both Judge Kelley and Todd Walters thought that third party submissions might be used depending on the implementing regulations and the degree of trust the Patent Office earned in handling such submissions. Judge Kelley also volunteered that he thought the prior user rights might be a defense that is utilized insofar as many clients in current litigation submit that they had "been doing the same thing" for years and this new expanded prior user rights may provide the opportunity to explore that history as a defense.

Mr. Tramposch then closed the meeting by announcing that the next meeting would be held jointly with the Giles Rich IP Inn of Court on November 3, 2011, at the Madison auditorium of the United States Patent and Trademark Office. The Officers of the new Inn joined Judges Linn and Newman for a picture. The meeting was adjourned at 8:30 p.m.

The assistance of Charles Wieland in preparing these minutes is gratefully acknowledged.

Stephen Christopher Swift
Secretary-Treasurer
Pauline Newman IP American Inn of Court