REPORT OF THE DELEGATION OF THE INTELLECTUAL PROPERTY LAW SECTION OF THE STATE BAR OF CALIFORNIA TO WASHINGTON, D.C.
March 28 - 29, 2011

For the last several years in early spring the Executive Committee of the Intellectual Property Law Section of the State Bar ("IP Section") has sent a delegation to Washington, D.C. to visit officials and other persons in the federal government of importance to intellectual property law. The Section does so in order to establish and maintain contacts that will assist the Section in carrying out its educational mission and to gather information and encourage the dissemination of information on an ongoing basis that will enable the Section to carry out its functions and inform its members. Continuing this practice, the Section sent a delegation in March 2011 that met with selected judges, officers, and staff of the federal government involved in intellectual property in Washington D.C. and Alexandria, Virginia.

The 2011 Delegation consisted of the following members of the Executive Committee:

1. Warren Dranit, chair of the Executive Committee of the IP Section;

2. Mark Leonard, secretary of the Executive Committee of the IP Section, chair of the Delegation, vice chair of the Legislation Standing Committee of the IP Section, and secretary of the Trademark Standing Committee of the IP Section;

3. Karen Canady, member of the Executive Committee of the IP Section;

4. Amanda Nye, member of the Executive Committee of the IP Section;

5. T.J. Singh, advisor to the Executive Committee of the IP Section;

6. Andrew Stroud, incoming secretary of the Executive Committee of the IP Section.

March 28, 2011

Trademark Office

The Delegation's first meeting was with the Trademark Office. There we met with Deborah Cohn, Commissioner for Trademarks and Sharon Marsh, Deputy Commissioner for Examination Policy. One of the first issues we discussed was the upcoming USPTO report on trademark litigation tactics (the report was subsequently released on April 27 and is available here). Commissioner Cohn stated that the impetus for the report was a Congressional mandate and that Congress directed the USPTO to examine whether small businesses were being harmed by overly aggressive trademark owners asserting their rights and the best use of Federal Government services to help protect trademarks and prevent counterfeiting.

We next discussed some of the Trademark Office's educational efforts. Deputy Commissioner Marsh informed us that the Office would once again be holding a Trademark Expo this year which is a two-day event is designed to educate the public about the value of trademarks in the global marketplace. The Expo will be at the USPTO's headquarters in Alexandria, Virginia on October 14 and 15, 2011. Commissioner Cohn discussed the Trademark Information Network ("TMIN"), which is a series of videos in a news style format to help educate trademark owners about the trademark application process (TMIN is available here). She stated that the program has been well received and asked for suggestions on additional topics that TMIN should address as well as suggestions on other public education efforts the Trademark Office might undertake.

We also discussed the Office's technology initiatives. Commissioner Cohn reported that work is moving forward on upgrading the Trademark Office's technology resources. That initiative, called Trademarks Next Generation is considering features such as an automated monitoring service that notifies the requestor of certain status changes in any application or registration. The Delegation noted that TARR had recently experienced occasionally significant slowdowns and outages. Commissioner Cohn explained that those problems are likely the result of heavy usage on the patent side and because the USPTO's computer systems are shared, such usage would affect trademark resources such as TARR and TEAS. She also noted that Trademarks Next Generation would help to address that issue by creating a separate computer network for the Trademark Office.

Commissioner Cohn and Deputy Commissioner Marsh also gave us a better understanding of the Trademark Office's quality control procedures for Examining Attorneys. There is a separate office within the Trademark Office that conducts quality review that includes a random review of office actions and statistical sampling as well as real time review of some actions. The Office also conducts quality control reviews of searches by Examining Attorneys. In addition to monitoring for potential problems, the Office also gives Examining Attorneys positive feedback for their work. Under its "Excellent Office Action" program the Office highlights exemplary office action based on the comprehensive quality of the first office action search, evidence, writing and decision-making as well as the percentage of issues that are settled or clarified through a phone call.

USPTO Lunch

Following the meeting with the Trademark Office, we met with a number of USPTO officials, for what has become our customary no-host lunch. We were joined by Commissioner for Trademarks Debbie Cohn, General Counsel Bernard Knight, Chief Administrative Trademark Judge Gerald Rogers, Deputy General Counsel for Intellectual Property Law and Solicitor Ray Chen, Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the USPTO Teresa Stanek Rea, Senior Advisor Joni Chang, and Board of Patent Appeals and Interferences Acting Chief Judge James Moore. All of these individuals have supported the Section's educational programs by either speaking or providing speakers. We enjoyed the opportunity to meet with them in an informal setting and renew our relationships.

USPTO Leadership

After lunch our first meeting was with David Kappos, Under Secretary of Commerce for Intellectual Property and Director of the USPTO, Teresa Stanek Rea Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the USPTO, Chief of Staff Drew Hirshfeld, and Senior Advisor Joni Chang.

Director Kappos began the meeting with a discussion of the current Patent Reform Act that had recently passed the Senate (S.23). In general, Director Kappos was pleased with the process to date for this legislation and reiterated the PTO's position that the legislation was a balanced approach to the issue. He noted that we are not done yet, however, and discussed refinements to post-grant procedure. He seemed to support the first-to-file system compared to our current first-to-invent system. He also mentioned the different possible threshold for inter partes reexam: substantial new question of patentability versus reasonable likelihood of success. He considers the former to be slightly better policy as it prevents false negatives. Director Kappos indicated that he would be testifying on Wednesday, March 30th at a hearing before the IP Subcommittee of the House Judiciary Committee.

With regard to prior user rights, Director Kappos said he would testify on Wednesday that this is a pro-business and university provision that carves out university interests. He stated that there is not much objection to the change in the grace period, and there has been no pushback on third party submissions. He noted that the six-reference limit prevents such submissions from delaying examination. He noted also that one hour has been added to the time allotted for initial examination to allow time for examiners to read the specification and look at it in relation to the claims. Microentity fees have been included to benefit small businesses. This will provide a 75% reduced fee for Track I accelerated examination.

We next discussed the role of the USPTO in advising the Administration on intellectual property issues. Director Kappos informed us that, by statute, the Director is the sole official advisor to the Administration on all intellectual property matters and he has been working with a number of federal agencies, including the Department of Justice, the Small Business Administration, and the Federal Trade Commission, to develop IP policies for those agencies. Director Kappos also stated that during his tenure he has worked to include the Copyright Office in IP policy deliberations more frequently. The USPTO also worked with the Administration's Intellectual Property Enforcement Coordinator on its recent "White Paper on Intellectual Property Enforcement Legislative Recommendations" (a copy of which is available here).

Director Kappos and Deputy Director Rea then updated us on a number of current USPTO initiatives including the Green Tech program that offers expedited review of patent applications for environmentally friendly technologies. A new initiative that recently launched, ePetitions, allows patent practitioners to receive immediate decisions on certain types of petitions filed electronically with the USPTO.

Director Kappos also discussed the planned three-track system for patent review including an accelerated examination process. He was hopeful that this system would substantively assist applicants to achieve their prosecution goals more effectively by providing multiple cost/time

options. They received many comments in particular on Track 3 examination, which would allow applicants to delay the docketing of a new case for examination by up to 30 months. They will do a notice & comment with some revisions to this plan: (1) requiring publication at 18 months; (2) a low fee required at filing; (3) a communication at 15 months indicating that the applicant must pay the search fee and that the search report will be published with the application; and (4) an opportunity for members of the public to pay the examination fee to trigger an immediate exam, otherwise the applicant would get a letter at 30 months requesting the exam fee. This would be an elective benefit; applicant must agree that a prior user has intervening rights; patent term adjustment would be the same as if Track 3 was not entered.

The USPTO is also continuing to assess opening new offices. A California office does remain in the mix. However, the PTO is also balancing out the merits of additional offices with the value created by increasing the use of distributed examiners who tele-work for the PTO.

Prior IP Section delegations have generally not had the opportunity to meet with the Director of the USPTO and we greatly appreciated the time and in depth discussion Director Kappos and the other USPTO senior leadership were able to share with us.

Trademark Trial and Appeal Board (TTAB)

Our next meeting was with Gerard Rogers, Chief Administrative Trademark Judge for the Trademark Trial and Appeal Board. Initially, there was an in depth discussion with regard to the TTAB's Accelerated Case Resolution program (ACR). Judge Rogers highlighted that there has been increased interest by litigants in the use of ACR but the Board is looking to further expand its use.

Judge Rogers shared several approaches for ACR that have been proposed by the American Intellectual Property Law Association (AIPLA). The Board's goal is to encourage a broad range of predefined options that would be available to the litigants. The Board would not endorse any particular set of proposals. Rather, it intends to publish the options so that the litigants can select the best option for themselves. In the future, Judge Rogers hopes that the ESTTA systems will be able to automatically schedule an ACR program.

The Board is currently working with the Trademark Public Advisory Committee (TPAC) to define a system where the Board would require litigants to participate in a settlement conference. The contours of this program are not currently well defined. However, the USPTO recently concluded a public comment period about whether the Board should become more involved in settlement discussions for TTAB proceedings.

The Board is also developing new metrics to assess the pendency of matters before the Board. Judge Rogers noted that it is difficult to measure pendency based on the start-to-finish time of a proceeding. Too much of the proceeding is out of the Board's control including the amount of time litigants choose to take to try to settle the matter without the Board's involvement.

Among the target areas for improvement is that the Board wants to reduce the average pendency of a motion for summary judgment to ten weeks. The ten-week period would be calculated based

on when the litigants submit all paperwork to the Board.

Judge Rogers noted that the pendency rates have risen as the Board has focused on finalizing the revised *Trademark Trial and Appeal Board Manual of Procedure* (TBMP). Eight judges have been working, at least part time, on producing the revised manual. Moreover, as part of the revision process, the Board has been updating the format of the manual to be consistent with the PTO's new reference document management system. This new system will allow the Board to more easily update and revise the TBMP as changes are necessary. Judge Rogers expects that the Board will move to semiannual updates.

The main content of the TBMP was completed as of November 2010. Judge Rogers expects that the new manual will be posted fairly soon. Once available, the revised TBMP will become the manual to be cited in all cases except those filed prior to 2007.

Judge Rogers was very gracious with his time and thorough in his responses to the Delegation's questions. We thank him for his hospitality and look forward to working with him in the future.

Patent Office

For the Patent session, the USPTO representatives present included Peggy Focarino, Deputy Commissioner for Patents, James Moore, BPAI Acting Chief Judge, Robert Bahr, Acting Associate Commissioner for Patent Examination Policy and Frederick Schmidt, Director, Office of Patent Information Management.

The meeting began with an invitation to our USPTO hosts to share with us any general comments they had for the California Bar. They wanted us to know that there have been many initiatives under Director Kappos, making this an exciting time to be at the USPTO. They have had a chance to try a lot of things, many of which require negotiation with the union. Director Kappos has enabled collaborative efforts with the unions on matters such as the green tech program, revising the count system, etc., all of which affect working conditions. Normally negotiating such changes to examiner working conditions would take about 2 years for each such initiative. Director Kappos has created an environment in which the management side and the union side look at ways they can try to improve the system. They agree to try a given initiative and, if doesn't work, they will stop and re-group.

The PTO gave each examiner more time to work on each case under the new count system, and the examiners now do a better quality job and dispose of applications more efficiently. After giving examiners more time to work on each case, output is up, even though that may seem counterintuitive. They also believe that the lower attrition rate has a big role in improving productivity and quality. They have found that examiners who have been at the PTO at least 3 years are much less likely to leave. They have now reached that point with many examiners so the situation is looking much better. They are also finding that retirement-eligible examiners are staying, adding valuable experience to the examining corps.

A. Patent Reform Act 2011

Our discussion turned to the Patent Reform Act. The time period for reform implementation is usually 18 months. When asked how the new first-to-file rule will affect existing cases, we were told that the new rule will not apply to applications already on file as of the effective date, nor will it apply to continuations and divisionals of pending cases. It will depend, however, on an application's continuation status, as a continuation-in-part filing would come under the new rules.

We asked about the expected effect on revenue due to the creation of microentity fees. The fee-setting authority requires a balance of revenue in and expenditures out. This system allows the PTO to maintain that balance. Currently, small entities make up about 20-30% of filings, and they expect the microentities will be in the 5% range, so the fee discount for this small group is not expected to have a big impact on their overall revenue.

Training and staffing for post-grant procedures and third party pre-issuance proceedings came up next. Regarding the derivation proceedings, only a small impact is expected. They reason that such cases are currently handled through interference proceedings.

As to post-grant review, they are aware that it may be a resource issue. The PTO may need 120 more new judges to handle post-grant proceedings. They are currently thinking about how to set up proceedings there at the PTO. They want to keep it like a trial proceeding. The implementation timeline is 12 months after the Act's effective date. Post-grant review will not apply to cases filed under the old system.

We also asked about the impact of first-to-file on pending applications and how they will be handled. They believe that going to the first-to-file system will be easier for examiners. The improvement to PTO funding will help the Office to reduce pendency.

B. USPTO 2010-2015 strategic plan

We asked if they had any message to the IP Section members regarding the strategic goals. The Patent Prosecution Highway (PPH) program now has 15 countries under agreements with the USPTO. They find that, when it works, it works great. The first action allowance rate is 25%. The challenge with PPH is trying to have it used a lot. They report that examiners like it, even if the search results from the other patent office differ. Examiners report that more search results are always helpful to them in the examination process; whether it confirms their search results or helps them to improve their search strategies by alerting them to missed results.

Information Disclosure Statements: The PTO is working on changes to how the information can be presented. For example, they may develop easier ways to provide copies of items that are already in an IFW, such as by making it easier to make the necessary certifications. They also want to allow the examiner to admit new information without requiring the filing of an RCE. They are close to finishing stage one, which means the stage of recommending some new approaches.

MPEP revision: The PTO is currently working on the way they publish it. As with the TMEP,

they first want to convert it to a format capable of being published in multiple formats and easier to revise and search. Then they will make the appropriate revisions.

1. Update on measures taken for improving patent quality.

As indicated on the PTO dashboard, the PTO has recently adopted a new metric for measuring quality of examination. They now look more at the front end of the examination process rather than focusing only on the quality of the final allowance decision and the adverse influence created by the previous "second pair of eyes" approach. They now look at both the number of second non-final actions as well as final rejections after which prosecution is reopened.

We asked about their sense of the value of the new metric. They are very happy with these measures. They report that a survey of examiners shows that there is a 96% satisfaction rate amongst examiners with both internal (within the PTO) and external (dealing with applicants and their representatives) aspects of the new examination process.

The PTO is continuing to encourage telephone interactions, especially for those examiners working from home because it makes it harder for them to conduct in-person interviews. Telephone interviews are also being encouraged to improve prosecution at the "front" end so that applications can be resolved at the earlier stages.

Bob Bahr mentioned that the PTO recently put out new materials on examining under section 112 as an example of their ongoing efforts to improve examination quality.

2. First Action Interview Pilot

They are seeing calls being made by Examiners to the applicants before the first action even if the case is not in the pilot program. They believe this is probably due to examiners having positive experiences with benefits of the pilot program and wanting to approach other cases in the same way.

They are working with the union to expand this program to other art areas. They have been doing lots of interview training lately, which also raises awareness of how and why to conduct examiner-initiated interviews. The emphasis is being placed on compact prosecution, which is enhanced by examiner-initiated interviews.

3. Update on the ombudsman program

The ombudsman has had over 400 contacts.

To identify examiners who might benefit from additional training and guidance, they have been mining data in the system for outliers. For example, if a particular examiner has lots of non-final office actions, or has a significantly higher rejection rate compared to others in the same art unit, they will take a look to see if there is a pattern or other indication that further training or guidance is needed.

They noted that a problem with denial of interviews would be hard to spot unless the attorney

requesting the interview complains to a supervisor. They are thinking of making it possible to make a request for interview via PAIR so that the Office knows if a request has been denied. They will also look for cases being reopened after appeal. They noted that a low allowance rate for that art area is another signal. They look also at trends in art units.

C. Appeals

We asked Judge Moore if he had any advice for attorneys to consider before filing an appeal brief. In response, he advised against trying to get evidence in late through attorney arguments. Remember to get evidence into the record early, as new evidence cannot be brought in at the appeal stage. If you will need a declaration, it has to be submitted during prosecution before the examiner.

D. Detroit Office

The Detroit Office is in early stages of planning and implementation. It will be a first test of what issues arise and how useful a remote office can be. This model will be watched and guide decisions for any future office locations. Factors that influence office location choices include: cost of real estate and cost of living, proximity/accessibility to major cities and transportation, availability of technical personnel and educational institutions.

A California office is certainly a consideration, but the cost of real estate and cost of living are significant concerns and will be factored into any decision on where in California would be best.

E. Update on RCE/Examiner counts

Progress is being made on reducing the backlog. How much that progress will continue, and at what rate, will be influenced by funding issues and the potential government shutdown. The PTO is seeing a reduction in the number of RCE filings. They believe that IDS changes could help that further. They want to focus on addressing the application before them and then moving on to the next one, rather than churning the work. At the same time, their quality measures are showing improvement as well, so they are not concerned that the increased productivity has been detrimental to quality.

F. Restriction practice

Bob Bahr mentioned that last year the PTO published a request for comments on restriction practice. They received many comments in response. The comments mostly fit into one of two categories: those urging the PTO go to a unity of invention standard, and those raising issues with the current system of restriction practice. The PTO intends to respond first with fixes to the current system, and then they will look at the merits of going to a unity of invention standard.

The changes will be to examiner training, and they plan to make it easier to get petitions regarding restriction reviewed. Their goal is to achieve consistency. When asked if e-petitions will be available for restriction challenges, they indicated that e-petitions are being set up for things that can be reviewed and responded to quickly, like withdrawal as attorney of record, late payment of a maintenance fee, and not for matters requiring a judgment call, like restrictions. They may consider, however, allowing for a fast electronic method for filing the restriction

petition, but not with a response while you wait.

Regarding the possibility of switching to a unity of invention standard, the next step will be to ask questions about what approach to unity should be adopted (e.g., the JPO or EPO approach). They will lay out the issues and invite comments. They usually go with a 60-day comment period (there is no mandatory comment period, but they find that 60 days allows enough time for bar groups to prepare comments).

March 29, 2011

House Judiciary Committee Staff Meetings

In addition to the Delegation, present at the morning meeting in Room 107 of the Capitol Building was Stephen M. Pinkos, Policy Director and General Counsel to Kevin McCarthy Majority Whip. The Delegation then met later in the afternoon with David Whitney Majority Counsel, House of Representatives, in the conference room in the main office of the Judiciary Committee in the Rayburn Building.

Meeting with Stephen Pinkos

Mr. Pinkos started the discussion by addressing the issue of rogue sites. He referred to Representative Bob Goodlatte, Chairman of the House Committee on the Judiciary Subcommittee on Intellectual Property, Competition, and the Internet, as spearheading an effort to move forward the issue of using the DNS to stop rogue sites from infringing intellectual property rights. Mr. Pinkos noted that the issue of how to stop rogue sites is recognized as a difficult one. It requires a solution that will protect the due process and free speech rights of individual domain name owners while at the same time is effective enough to stop large web site that host bulk amounts of unauthorized material from doing so. According to Mr. Pinkos, acting against these websites through governmental action is the top priority after patent reform. Mr. Pinkos noted that Demand Media's eNom was working with Chairman Goodlatte in a positive way to help come up with a solution to this issue of rogue sites.

Mr. Pinkos went on to say that a "significant privacy bill is likely this session." Chairman of the House Communications and Technology Subcommittee, Rep. Greg Walden, is heading a panel with direct oversight of the Federal Communications Commission, cable operators, broadcasters, telephone carriers, and satellite TV providers. The issues expected to be addressed include Net Neutrality, the effects of FCC regulation, and online privacy.

Mr. Pinkos also spoke to the Patent Reform Act, noting that the House had just introduced its version of the Senate bill, which largely tracks the senate bill, but with some significant differences. The most significant differences are the House "first to file" not "first to invent"; some differences to the post-grant opposition system; greater power for the Patent Office to set its own funding, and expansion of prior use defense beyond process claim to any patent claim. The Senate bill left damages out as a "bone to the techies," but the House wants damages back in

the bill. There is a question as to whether the House bill will extend the grace period. Chairman Lamar Smith is vested in getting this bill passed as he has spent seven years on it in response to the tech community, as way of managing patent litigation and creating a more efficient system. Mr. Pinkos noted that the difference between the consideration of patent reform today and twelve years ago when the first rumblings began is that there is a broader base of people looking at the issue.

The House is also looking to give priority to a review of some international trade agreements that were created to foster world-class IP standards in an effort to strengthen support for them. In particular, The Anti-Counterfeiting Act (ACTA) is being looked at as well as the Trans Pacific Partnership (TPP). The ACTA is being looked at from a standpoint of buy-in from developing countries and accountability. Insofar as the TPP is concerned, Mr. Pinkos noted that there had been some erosion in the standards used to promote DMCA type claims, and noted that this is alarming some people who are asking that the Obama administration look into this from a policy perspective. The USTR issues are also coming before the House for briefing.

Lastly, Mr. Pinkos announced that Representative Goodlatte would be looking again at the DMCA to strengthen the enforcement and liability provisions.

Meeting with David Whitney

Mr. Whitney spoke briefly to the re-enactment of the Satellite Home Viewer Act, and the need to address competition, compensation and to update cable and satellite TV licenses. He also mentioned, as had Mr. Pinkos, that Rep. Goodlatte was working on a draft bill to speak to insufficient penalties under the DMCA.

Mr. Whitney spent most of his time with the Delegation speaking about rogue websites or as he referred to them “para-sites”, and stated that this issue was the big issue for the House this year and one that would likely result in bill passage in this session. Mr. Whitney said that the issues to be addressed in such legislation would include insufficient protection of creator’s rights, GoogleBooks situation and orphan works. In terms of protecting creator’s rights, he stated the big issue would be when to engage, not whether to engage. Mr. Whitney added that this issue was particularly knotty in the context of aggregate rights and the need to give notice, balancing users’ rights versus owners’ rights, how to memorialize a good faith reasonable search so has to adequately defend against a claim of infringement.

According to Mr. Whitney, a bill addressing rogue web sites is expected this summer and is expected to be broader than what the Senate attempted to do by addressing trademarks, health and safety, online crime and streaming issues such as streaming of live sports.

Senate Staff Meeting

The Delegation met with Senator Boxer’s Senior Counsel, Derrick Brent and was later joined by Senator Leahy’s Senior Counsel, Aaron Cooper.

We first discussed major IP legislation that the Senate was likely to take up this session. Mr. Brent noted that there was still interest in moving ahead with a performance rights bill, but the Performance Rights Act (S.379) that was introduced last session was unlikely to be reintroduced until broadcasters and recording companies worked out their respective issues with that legislation. Mr. Brent also mentioned that it was unclear if another bill from last session, the Combating Online Infringement and Counterfeits Act ("COICA") (S. 3804) would be reintroduced. He stated the intent of COICA was to help shut down rogue websites that offered infringing products, but that the bill had a number of controversial provisions, such as requiring internet search engines to block access to rogue sites, that generated significant opposition. (Senator Leahy subsequently introduced a similar bill in the current session, S.968 the PROTECT IP Act)

Mr. Brent noted that there has been a great deal of discussion in the Senate on online privacy protection and that Senators Kerry, Pryor, and Rockefeller had all expressed interest in the issue. He also informed us that during these discussions some senators expressed concern that the Federal Trade Commission is already stretched thin and may not have the resources to take on new enforcement efforts.

The Delegation next asked about how the Patent Reform Act (S.23) was likely to fare in the House. Mr. Brent told us that he expected House Judiciary Committee Chairman Lamar Smith to introduce his own patent reform legislation, but that it would be very similar to S.23 and it is likely that the House and Senate would reach a compromise and pass a bill for the President to sign.

Copyright Office Meeting

The Delegation met with members of the leadership team at the Copyright Office ("Office"). This included Maria Pallante, Acting Register of Copyrights, David Carson, Copyright Office General Counsel, Michele Woods, Acting Associate Register for Policy & International Affairs, Tanya Sandros, Deputy General Counsel, and Rob Kasunic, Deputy General Counsel.

One of the primary topics of conversation was the search for a new Register of Copyrights following the retirement of Mary Beth Peters. It had been hoped that a new Register would be named at the first of the year but the selection had not yet been finalized at the time of our meeting. Maria Pallante reported that Dr. Billington, the Librarian of Congress, was reviewing the final candidates. She said that Dr. Billington was looking for a Register who had significant copyright expertise, including experience in all aspects of copyright law such as licensing and marketing, as well as registration issues. The personal qualities he desired were a sense of diplomacy and trust, as well as an appreciation for the necessity of transparency in the operation of the Office. Finally, an understanding of technology was also desired as the Office continues to update and improve its online operations and is becoming more technologically advanced. Ms. Pallante was subsequently appointed as Register on June 1.

Because the new Register had not yet been appointed, it was determined that the leadership of

the Office would not come to California for a special seminar this year. Due to the time and expense, the Office has been reluctant to commit to such a visit until a new Register is in place. Instead, it was determined that members of the leadership team would try and come to California in November and attend the IP Institute, where they would be involved in the program. This would also be an excellent opportunity for practitioners to meet the new Register as well. The leadership of the Institute and the Office has been working together on arrangements and the Office now plans on sending a delegation to the Institute, which should include the new Register, Ms. Pallante.

Ms. Pallante then discussed operational issues in the Office. At the time of the meeting, there was a substantial likelihood that a government shutdown would take place. As Acting Register, Ms. Pallante was extremely concerned about the impact of a possible shutdown on the Office. It was still being determined whether the Office would continue to take online registrations or whether the registration process would need to be halted entirely during the shutdown as the Office would only have a skeletal staff. At present the Office has approximately 500 employees, most of whom work in registration. If the shutdown occurred then the registration staff would be most severely impacted. Luckily, the shutdown was averted so registrations could continue.

Ms. Pallante urged the Delegation to encourage practitioners to do their registrations online if at all possible. The Office has committed substantial resources to make electronic registration easier and quicker. At present there was a backlog of 150,000 registrations, which she explained was fairly typical. We discussed the length of time in the registration process, from application to registration. The Office was working very hard to decrease the registration process time period. Ms. Pallante said that the goal was a four to six month time period between application and issuance of a certificate. The Delegation concurred that this seemed to be a reasonable time period and that the Office was issuing registrations more quickly than in previous years.

We then discussed several policy issues related to copyright law. Ms. Pallante had recently testified before Congress regarding the Combating Online Infringement and Counterfeits Act ("COICA"). While the Office is a proponent of COICA and preventing online infringement and counterfeiting, the Office is not in charge of enforcement and is concerned that enforcement actions be undertaken in a manner that complies with due process. So called "rogue websites" continue to cause substantial harm to copyright owners online because enforcement of copyright laws online is difficult to achieve. The Office will continue to work with Congress to determine how best to protect stakeholders= intellectual property in light of new technology that allows intellectual property to be infringed much more easily. It also appears that Congress may be interested in reviewing the Digital Millennium Copyright Act ("DMCA") to determine whether it is still an effective tool in dealing with online copyright protection as well.

Michelle Wood then talked about the international aspects of copyright law. The Office is very involved in reaching out to foreign nations and working with them to provide more robust protection for intellectual property internationally as well. The Office advises many countries, including emerging nations, in the establishment of copyright law and has looked at the laws of 47 different countries with respect to copyright protection issues. The Office also works closely with the World Intellectual Property Organization ("WIPO") in seeking to develop protection policies. One of the most significant tensions is between the establishment of property rights and

the exceptions that are created to those rights.

We also discussed the difficulties of establishing a registration system for fashion design. The Office is concerned about its ability to determine what aspects of a fashion design are worthy of protection under the copyright laws. They are continuing to work with the industry on this issue.

Finally, we discussed some recent 9th Circuit cases concerning the registration of photographs, the *Alaska Stock* and *Bean* cases. The Office has filed amicus briefs in both cases seeking to overturn the underlying decisions finding the registration of large quantity stock photographs to be invalid because the copyright holder did not adequately describe the content of each of the photos to be registered. Those actions are still pending.

Federal Circuit Meeting

The Delegation met with Federal Circuit Court Judge Pauline Newman and her clerks. Judge Newman was gracious and welcoming to the Delegation. The IP Section was introduced to the group and the role it plays in continuing education of its membership. The pending patent reform was mentioned during the discussion. Judge Newman emphasized California's role in intellectual property in general and patents in particular. She felt strongly that the legislature needs to hear from practitioners as to how the pending patent reform legislation may affect different constituents and stakeholders. She recognized that the IP Section cannot lobby on behalf of any particular group's interest, but she encouraged the Delegation members to at least express their individual views regarding patent reform. She also encouraged the Delegation to notify the IP Section membership regarding patent reform and encourage the membership to submit their views to the legislature.

The Delegation also invited Judge Newman to speak in California during one of the IP Section events. Although she did not accept the invitation, she seemed willing to help with the Section's continuing education efforts.

Conclusion

As in past years, the opportunity for delegates from the IP Section Executive Committee to meet in person with executive, judicial, and legislative officials and persons that are at the forefront of federal intellectual property law proved invaluable. Maintaining the relationships that past year's delegations have formed with these persons allows the IP Section to offer unique speakers and content at our conferences that are generally not available from other CLE providers. As one of the only state bar organizations that make the effort to meet with these persons, the DC meetings also reinforces the IP Section as one of the leading intellectual property law organizations in the country. Once again, the DC trip was highly successful and will provide great benefits to our Section's membership.