

AMERICAN BAR ASSOCIATION  
SECTION OF PATENT, TRADEMARK AND COPYRIGHT LAW

ACTION ON RESOLUTIONS AT THE ANNUAL MEETING IN  
DALLAS, TEXAS - AUGUST, 1979

(As Taken From The Notes Of The Secretary)

RESOLUTIONS ADOPTED

RESOLUTION 101-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle the enactment of appropriate legislation to provide re-examination by the U.S. Patent and Trademark Office of any U.S. patent at any time during its term on the basis of patents and printed publications which had not been previously considered by the U.S. Patent and Trademark Office when requested by any person provided the patentee has the opportunity to amend to limit the scope of any claim of the patent in order to distinguish from patents and printed publications considered during re-examination or to cancel any claim from the patent and the opportunity ex parte to rebut any determination of unpatentability and provided that: (i) any party other than the patentee who has initiated a re-examination proceeding shall have an opportunity to submit a single written response to statements filed by the patentee; and (ii) if the patent subject to reexamination is or becomes involved in litigation, the court before which the litigation is pending is given discretion as to whether such litigation shall be stayed to permit re-examination of the patent by the U.S. Patent and Trademark Office; and  
Specifically, the Section of Patent, Trademark and Copyright Law favors the enactment of legislation by the 96th Congress of the identical S. 1679 (Bayh) 96th Congress and H.R. 5075 (Butler) 96th Congress.

RESOLUTION 102-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes any amendment of the Paris Convention for the protection of Industrial Property which would delete Article 5 Quater or which would modify Article 5 Quater in violation of the principle of national treatment.

RESOLUTION 102-2A

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes any revision of the Paris Convention for Protection of Industrial Property and by less than the unanimous vote of member countries of the Union present and voting.

RESOLUTION 102-2B

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes the adoption by the revision conference of the Paris Convention for the Protection of Industrial Property of any voting rule for revision by other than unanimous vote of the member countries of the Union present and voting.

RESOLUTION 102-3

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes promulgation by WIPO pending the outcome of the Diplomatic Conference for Revision of the Paris Convention for the Protection of Industrial Property to be held at Geneva in February, 1980, of any final text of the WIPO Model Law for Developing Countries of Inventions and Know-How which contains provisions which are inconsistent with the latest (Stockholm) text of said Convention.

RESOLUTION 102-4

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes any provision in the WIPO Model Law for Developing Countries on Inventions and Know-How which would provide that if prior to the ex-

piration of a license contract with respect to any patent application or patent, the patent is finally declared invalid or the application for patent fails to result in the granting of a patent, the licensee need no longer make payment and also shall have the right to repayment of any payments already made unless the licensor can prove that repayment would be inequitable under the circumstances and SPECIFICALLY the Section opposes Section 146 of the Draft Model Law as set forth in WIPO Document WG/ML/INV/VII/1 dated December 20, 1977.

RESOLUTION 103-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle adoption of a procedure permitting reopening of the prosecution of a patent application after final rejection upon payment of a fee, with the procedure making available to applicants action paralleling as nearly as possible action presently available under 37 C.F.R. 1.60.

RESOLUTION 103-2

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle adoption of a procedure under which, in situations in which restriction between claims in a patent application is now required, applicants, by paying a fee not greater than the filing fee which otherwise would be incurred for the filing of one or more divisional applications, may retain for examination in a single application all claims that are examinable by the same examining Group within the Patent and Trademark Office and if those claims are otherwise allowable, may have those claims issued in a single patent, with the procedure otherwise paralleling as nearly as possible present practice under 37 C.F.R. 1.141-1.146 and 1.60 and applying to all claims regardless of format.

RESOLUTION 103-4

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle adequate funding for the Patent and Trademark Of-

office to permit high quality examinations, reasonably prompt disposition of patent applications and to provide adequate services to the public, and submits that patent-related fees should be set at a level appropriate to cover a reasonable portion of costs while not being at such a level as to discourage inventors.

RESOLUTION 103-5

RESOLVED, that the Section of Patent, Trademark, and Copyright Law favors in principle that any person selected to be Commissioner of Patents and Trademarks be a lawyer having experience in patent and trademark law, knowledgeable of both domestic and international laws concerning these matters, and well qualified to represent the United States Patent and Trademark Office domestically and to advocate United States positions on patent and trademark matters internationally.

RESOLUTION 105-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes in principle the enactment of any legislation pursuant to which a contractor, who has retained title to an invention made or conceived in the course of or under a Government research and development contract and has profited from that invention, would be required to pay back to the Government all or any part of the Federal funding which was expended on the making of the invention.

RESOLUTION 106-2

RESOLVED, that the Section of Patent, Trademark and Copyright Law approves the publication by the Section of an advisory pamphlet designed to provide basic advice regarding the patenting of an invention and to explain to inventors possible techniques for reducing the cost for obtaining patent protection.

RESOLUTION 108-2

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors the principle that the patent statutes permit a complete change

of inventive entity in a patent or patent application rather than merely substitution or elimination of less than all joint inventors, provided such change is necessary because the originally named inventor or inventors were named in error and without deceptive intention.

RESOLUTION 110-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors ratification by the United States of the International Convention for the Protection of New Varieties of Plants as adopted by the International Union for the Protection of New Varieties of Plants on October 23, 1978.

RESOLUTION 201-3

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle the concept of a federal antidilution statute which would be available in appropriate situations to the owners of federal trademark registrations.

RESOLUTION 203-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle increased funding for the operation of the Trademark Division to reduce pendency to a reasonable level and to restore adequate search room and other services.

RESOLUTION 203-2

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle increased funding for the operation of the Trademark Division of the Patent and Trademark Office to permit high quality examination, to reduce pendency to a reasonable level commensurate with high quality examination, and to restore adequate search room and other services, and submits that fees related to examination and other services be set at a level appropriate to cover a reasonable portion of costs while not being at such a level as to

discourage application for registration and use of the Trademark Division services.

RESOLUTION 401-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes in principle legislation which would eliminate the original or removal jurisdiction of the federal district courts based upon diversity of citizenship.

RESOLUTION 401-2

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes in principle legislation which would curtail the original or removal jurisdiction of the federal district courts based upon diversity of citizenship other than by merely increasing the jurisdictional amount from \$10,000 to \$25,000, exclusive of costs.

RESOLUTION 401-6

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle the promulgation of uniform national standards for admission to practice in the federal courts in an effort to raise the minimum level of competence in federal advocacy; and Specifically the Section approves in principle the Report and Tentative Recommendations of the Committee to Consider Standards for Admission to Practice in the Federal courts to the Judicial Conference of the United States, 79 F.R.D. 187 (1978), which is the report of the so-called "Devitt Committee," except that the Section favors the use of different examinations for admission to practice in civil, as distinguished from criminal, cases.

RESOLUTION 401-7

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle legislation which would confer exclusive appellate jurisdiction on a single federal court of appeals for any United States court action in which (1) there was a claim or counterclaim for

(a) patent infringement or (b) a declaratory judgment as to the (i) validity, (ii) infringement or scope, or (iii) enforceability of a patent and (2) the appeal or any cross-appeal involves a question of federal patent law, the decisions of said single court of appeals being subject to final review by the United States Supreme Court.

RESOLUTION 404-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle the development by the United States Patent and Trademark Office of a computerized patent and prior art search system, and, Specifically, the Section favors the recommendation of the Advisory Committee on Industrial Innovation that the Patent and Trademark Office undertake at the earliest possible date to complete the development of an effective computer based search and retrieval system for its own use and to provide search services to users.

RESOLUTION 407-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle repeal of the carryover basis provisions of the Tax Reform Act of 1976.

RESOLUTION 409-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes in principle the concept of corporate innovation certificates; and Specifically, the Section of Patent, Trademark and Copyright Law opposes provisions in the WIPO Draft Model Law, Part V: Innovations, which would provide for the issuance of an innovation certificate to an employee, remuneration for the use of an innovation and reversion of an innovation to the employee in the event the employer does not intend to use the innovation or does not in fact use the innovation within six months of a notice of intent.

RESOLUTION 410-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law

favors in principle the CONTU recommendations that Section 117 of the Copyright Act of 1976, Pub. L. No. 94553, 90 STAT. 2541, freezing the law as of December 31, 1977 on the use of copyrighted works in conjunction with certain automatic systems, be repealed.

RESOLUTION 410-2

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle the CONTU construction that the 1976 act as written makes it clear that the placement of any copyrighted work into a computer is a preparation of a copy and therefore, a potential infringement of copyright.

RESOLUTION 410-3

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle the CONTU recommendation that the new copyright law should be amended to make it explicit that computer programs are a proper subject matter of copyright; and

Specifically, the Section of Patent, Trademark and Copyright Law favors in principle that Section 101 of the new Copyright Law be amended to add the following CONTU proposed definitions:

A "Computer program" is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.

RESOLUTION 410-4

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle the CONTU recommendation for a new Section 117 in the Copyright Law providing that it is not an infringement for the rightful possessor of a copy of a computer program to make or authorize the making of an adaption of that computer program provided that such adaption is created as an essential step in the utilization of the computer program in conjunction with a machine, and that it is used in no other manner.



RESOLUTION 410-5

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle the CONTU recommendation for a new Section 117 in the Copyright Law providing that it is not an infringement for the rightful possessor of a copy of a computer program to make or authorize the making of another copy of the program, provided (1) that such a new copy is created as an essential step in the utilization of the computer program in conjunction with a machine, and that it is used in no other manner, or (2) that such a new copy is for archival purposes only and that all archival copies are destroyed in the event that continued possession of the computer program should cease to be rightful, or in the event that the possession of the computer program shall itself cease.

RESOLUTION 410-6

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle the CONTU recommendation for a new Section 117 in the Copyright Law providing that any exact copies prepared in accordance with the provisions of a new Section 117 may be leased, sold, or otherwise transferred, either (1) along with the copy from which such copies were prepared, only as part of the lease, sale, or other transfer of all rights in the copy of the program, or (2) with the authorization of the copyright owner.

RESOLUTION 410-7

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle the CONTU recommendation for a new Section 117 providing that adaptations prepared in accordance with the provision of a new Section 117 may be leased, sold, or otherwise transferred only with the authorization of the copyright owner.

RESOLUTION 502-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law approves, in principle, amending the Code of Professional Responsibility

to allow lawyers to indicate they are engaged both in the practice of law and in the another profession, and specifically, approves deletion of DR 2-102(E) from the Code of Professional Responsibility.

RESOLUTION 502-2

RESOLVED, that the Section of Patent, Trademark and Copyright Law approves in principle amending the Code of Professional Responsibility to prohibit lawyers from holding themselves out as in partnership with professional corporations unless they are in such partnership, and, specifically approves amendment of DR 2-102(C) of the Code of Professional Responsibility by adding "or professional corporations" after the word "lawyers" therein.

RESOLUTION NR-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law disapproves in principle any revision of the Paris Convention for the Protection of Industrial Property which would require member countries to prohibit the use of a geographical indication, or its registration as a trademark, except in circumstances where (1) the use of the geographical indication misleads the public as to the true country of origin or (2) the indication is the subject of a trademark registration or application and its use is of a nature as to mislead the public as to the true country of origin.

RESOLUTION NR-3

RESOLVED, that the Section of Patent, Trademark and Copyright Law, recognizing that strong patent and trademark systems are vital to the economy of the United States, favors in principle legislation to remove the United States Patent and Trademark Office from the Department of Commerce and make it a separate and independent agency.

RESOLUTION NR-4

RESOLVED, that the Section of Patent, Trademark and Copyright Law urges the prompt consideration by Congress of legislation to effect

the changes in the Lanham Act required to enable the United States to ratify the Trademark Registration Treaty (TRT).

RESOLUTION NR-5

RESOLVED, that the Patent, Trademark and Copyright Law expresses its concern that the problems caused by the serious deficiencies in the space available to the Patent and Trademark Office have not been properly addressed by the General Services Administration and the Section recognizes that a serious space problem exists and urges that adequate contiguous space in Crystal City, Virginia, be made available for use by the Patent and Trademark Office.

RESOLUTION NR-7

RESOLVED, that the Section of Patent, Trademark and Copyright Law expresses its gratitude and admiration for the superior leadership of its retiring chairman, Robert B. Benson, for his clear and forceful articulation during the past year of the views and positions of this Section, for his judicious disposition of the business of the Section throughout the year but especially at the Annual Meeting, for his preparation of a most informative program of the highest professional quality for the Annual Meeting, but above all for his personal and professional qualities which mark him as a good friend to us all and a leader of the patent, trademark and copyright bar of whom we are all proud.

RESOLUTIONS DEFEATED

RESOLUTION 108-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle a change in the patent statutes and the practices of the Patent and Trademark Office to provide that knowledge available to the art, prior to the effective date of the application involved, in the form of printed publications, including patents, may be added to the specification of that application during its pendency and that such additions shall not be treated as new matter.

RESOLUTION 301-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law approves in principle legislation providing for the elimination of all copyright notice requirements under the Copyright Law of the United States.

RESOLUTION 402-2

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle legislation providing that one who has elected to practice the use of an invention as a trade secret rather than to patent it shall have no supervening right to continue practicing it as against one who independently invents and patents the invention.

RESOLUTIONS RECOMMITTED

RESOLUTION 106-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes in principle the proposed 138% increase of fees for the Patent and Trademark Office on the basis that such an increase would have a negative impact on the filing of patent applications, particularly by individual inventors, to the overall detriment of our national well-being.

RESOLUTION 106-3

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle the enactment of State legislation directed toward protecting inventors from unfair and deceptive practices often indulged in by those offering invention development services; and SPECIFICALLY, the Section of Patent, Trademark and Copyright Law supports enactment by each State of legislation proposed by the Committee on Suggested Legislation of the Council of State Governments as proposed to be amended by the Section, a copy of the legislation with said amendments appears in the Appendix, Part B.

RESOLUTION 201-2

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle revision of Section 15 and Section 33(b) of the Lanham Act to express more accurately the concept of incontestability and its application to adversary proceedings.

RESOLUTION 401-3

RESOLVED, that the Section of Patent, Trademark and Copyright Law approves in principle the procedure set forth in Rules 3-13 of the Rules of Practice adopted by the Supreme Court to govern procedure in copyright infringement cases for the seizing and impounding, during the pendency of a copyright infringement action, of the allegedly

infringing copies and of records, plates, molds, matrices, or other means for making allegedly infringing copies. (Committee 301 to study)

RESOLUTION 401-4

RESOLVED, that the Section of Patent, Trademark and Copyright Law approves in principle amending Rules 1 and 3 of the Rules of Practice adopted by the Supreme Court to govern procedure in copyright infringement cases to the extent necessary to make the language of those rules consistent with the current copyright laws, 17 U.S.C. app. Sections 101-810 (1976). (Committee 301 to study).

RESOLUTION 409-2

RESOLVED, that the Section of Patent, Trademark and Copyright Law reaffirms its opposition in principle to the adoption of UNCTAD of a code of conduct for technology transfer which is legally binding, and Specifically, the Section of Patent, Trademark and Copyright Law urges that, if such code of conduct is adopted, it shall not apply to the following transfer of technology transactions: (1) a naked assignment, sale or license of patents, inventor's certificates, utility models, industrial designs, trademarks, service marks and trade names; (2) where no know-how and technical information is included which is provided from one party to another across national boundaries; (3) when the acquiring party is located in a developed country; (4) when the supplying party is a small business (as defined by the U.S. government), a university or one or a small number of individuals; (5) an employment or consultant agreement or an agreement which has research and development as one of its purposes; (6) when the technology is transferred within national boundaries between the supplying party and the acquiring party; or (7) when both parties agree that the contemplated payments involved for the first five years of the agreement shall not exceed, say, \$1,000,000 based on the value of the U.S. dollar as of, say, January 1, 1980.

RESOLUTIONS RESTED AS COMMITTEE REPORT

RESOLUTION 103-3

RESOLVED, that, in the absence of enactment of legislation providing for reexamination of issued patents at the request of third parties, the Section of Patent, Trademark and Copyright Law favors in principle amendment of the Rules of Practice to provide for rendering by the United States Patent and Trademark Office of an advisory opinion about the patentability of any claim or claims in any United States patent at any time during its term, when requested by any person upon payment of an appropriate fee and citation of a reasonable number of pertinent prior patents and publications, with the patentee having an opportunity to rebut any arguments of unpatentability and to file an application for reissue of the patent in order to amend or cancel one or more of the claims thereof or to present further arguments supporting patentability.

RESOLUTION 201-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law, for the purpose of responding to a request of the Commissioner of Patents and Trademarks for submission of its views on legislation to implement the Trademark Registration Treaty (TRT), is of the opinion that the proposed implementing legislation prepared by the Patent and Trademark Office and published in the July 11, 1978 Official Gazette effects the changes in the Lanham Act which are necessary to meet the requirements of TRT, if the United States ratifies the Treaty and the Treaty enters into force and also provides that applicants not filing under the Treaty will enjoy the same benefits and be subject to the same obligations as applicants filing under the Treaty.

RESOLUTION 401-5

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes in principle the federal appellate courts' practice of disposing of cases by unpublished opinions or orders.

RESOLUTION 402-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes in principle the inclusion in a proposed uniform state trade secrets act of a provision under which an innocent party who in good faith and without knowledge of any wrongdoing received a trade secret from one who misappropriated such trade secret may be liable for disclosure or use of the secret before learning of the misappropriation.

RESOLUTION 408-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law favors in principle an increased emphasis by the Patent and Trademark Office on maintaining the integrity of the search files in the search room; and  
Specifically, the Section favors the placing of consecutively numbered gummed labels on each patent in the search files so that one could easily determine if any patents are missing from a file.

RESOLUTION 507-1

RESOLVED, that the Section of Patent, Trademark and Copyright Law, although approving in principle the approach of Discussion Draft II circulated for comment by the ABA Standing Committee on Specialization, disapproves specifically the catalog of "Labels for Law Practice Categories" included therein as a recommended restatement of Disciplinary Rule 2-105(A)(2) of the Code of Professional Responsibility; and FURTHER RESOLVED that the Section recommends a general restructuring and refinement of that catalog to better provide a consistent scheme of classification and a flexibility and simplicity in stating categories applicable to a particular practice, thereby to afford greater usefulness to the public; and FURTHER RESOLVED, by way of example, that an appropriate scheme of categories applicable to the varying scope of the practices of the members of the Section in the general field of intellectual property would be to permit listing, singly or in any appropriate combination:



Appeals

Trials

Administrative Agency [Patent and Trademark Office, Copyright  
Office, Federal Trade Commission, U.S. International  
Trade Commission] Practice

Patent Law

Trademark Law

Copyright Law

Trade Secret Law

Unfair Competition Law

International Law

Franchise [Licensing] Law

Antitrust Law

as, for example, "Trademark Law, including Trials, Appeals, Patent and Trademark Office Practice, and matters of International, Franchise, and Antitrust Law Relating Thereto."

RESOLUTIONS REFERRED TO APPROPRIATE COMMITTEE

RESOLUTION NR-2

RESOLVED, that the Section of Patent, Trademark and Copyright Law, while recognizing the desirability of appropriately compensating inventors, opposes in principle legislation requiring corporations and other employers to pay compensation to employees over and above the salary, commissions and bonuses normally paid to them for their services, in return for assignment of exclusive rights in their inventions that are made through the use of employer resources, or arise from work done for the employer, or otherwise relate to the business or research and development of the employer. (Referred to Committee 104)

RESOLUTION NR-6

RESOLVED, that the Section of Patent, Trademark and Copyright Law opposes in principle legislation which would confer exclusive appellate jurisdiction on a single federal court of appeals for (1) appeals from any United States court action in which there was a claim or counterclaim for (a) patent infringement or (b) a declaratory judgment as to the (i) validity (ii) infringement or scope, or (iii) enforceability of a patent and also would confer exclusive appellate jurisdiction in the same federal court of appeals or (2) appeals from decisions of the Board of Appeals or the Board of Patent Interferences of the Patent and Trademark Office with respect to patent applications and interferences. (Referred to appropriate committee).