



Staff Memorandum

EXECUTIVE COMMITTEE Agenda Item #17

REQUESTED ACTION: Approval of request for the New York State Bar Association's ("NYSBA") Intellectual Property Section ("Section") to join the EPO¹/ US Bar Liaison Council ("Council").

Attached is a memorandum from the Section outlining its request for participation in the Council. The purpose of participating in the Council would be to permit the Section to take part in discussions with the European Patent Office ("EPO"), thereby representing the views and interests of NYSBA members before the EPO.

As noted in the memorandum, the Council has been operating for the many years and formed of U.S. representatives of various Intellectual Property Associations and representatives of the EPO. According to the EPO/ US Bar Council Liaison bylaws, the Council's goals are, among others, to serve as a forum for the exchange of ideas and information between Council delegates and the EPO, collect summarize, and disseminate to Council delegates information relating to U.S. applicants seeking patent protection in the EPO, advise the EPO of observations and experiences of U.S. applicants and their representatives on seeking patents protection with the EPO and seek from the EPO information regarding its observations and experiences regarding US-origin patent applications.

There is no membership fee. The only costs involved in joining the Council are travel expenses related to the participation in Council events. The Council has invited the Section to join its organization and nominate two participants. The Section has identified Philip Furgang (current co-chair of the Ethics Committee) as a participant, and plans to appoint another participant as an appropriate member is identified. The Section's representatives agree to participate at their own expense. However, if in the future, travel expenses cannot be covered by the Section's representatives themselves, the Section could cover travel expenses provided they are reasonable.

In 2004, the Executive Committee adopted a policy prohibiting a section or committee from becoming a member of another organization without the Executive Committee approval. The purpose of this policy is to ensure that the proposed participation does not create actual or potential conflict with Association policy or otherwise be detrimental

¹ EPO stands for European Patent Office

to the Association. It is the Section's view that the aims and objectives of the Council are not inconsistent with any NYSBA policy.

The report will be presented by David P. Miranda in his capacity as the section's Executive Committee liaison.

**NEW YORK STATE BAR ASSOCIATION
INTELLECTUAL PROPERTY SECTION**

MEMORANDUM

TO: NYSBA Executive Committee

FROM: Executive Committee of the Intellectual Property Section

DATE: April 4, 2013

RE: Participation of the Section in the EPO²/US Bar Liaison Council

This memorandum was prepared by the Intellectual Property Section ("Section") of the New York State Bar Association ("NYSBA") to seek approval of the NYSBA Executive Committee to participate in an established group called the EPO/US Bar Liaison Council ("the Council").

Background:

The Section was contacted under Paul Fakler's term, then Chair of the Section, inviting the Section to participate in the Council. The Section's Executive Committee discussed the matter and identified many benefits to participating in the Council and endorsed such participation.

In November 2004, the NYSBA Executive Committee adopted a policy prohibiting any section or committee from becoming a member of another organization without its prior approval. The policy was prompted by a concern that a NYSBA constituent might join an organization that "either had or adopts policy positions that could conflict with those of the [NYSBA] or addresses issues concerning which the NYSBA does not wish to take a public position." A copy of the policy is attached hereto as **Exhibit A** for the convenience of the Executive Committee.

In light of the policy, the Section would like to seek formal approval of the Executive Committee to join and participate in the Council.

About The EPO/US Bar Liaison Council

The EPO/US Bar Liaison Council was formed in 2009 as a forum of discussion between U.S. bar associations and the European Patent Office ("EPO"). The Council's bylaws were adopted on September 9, 2009. A copy of the bylaws is attached hereto as **Exhibit B**.

² EPO stands for European Patent Office.

According to its bylaws, the Council has four core goals: first, to serve as a forum for the exchange of ideas and information between Council delegates and the EPO; second, collect, summarize and disseminate to Council delegates information relating to U.S. applicants seeking patent protection in Europe; third advise the EPO of observations and experiences of U.S. applicants and their representatives on seeking patent protection in the EPO; and fourth, seek from the EPO information regarding its observations and experiences regarding US-originating patent applications.

Industry members who are participating in the Council must be representatives of national, regional or local U.S. intellectual property associations or U.S. bar associations.

The Council does not take formal positions in its own name. It is understood that views and opinions expressed by Council delegates are their own views and opinions, not those of the associations or bars they represent.

The Council is to meet with the EPO at least once a year, alternating between the EPO and the United States. Other meetings during the year are to be held either in person or via teleconference.

All expenses are to be borne by delegates themselves.

Benefits for the Section to Join The Council

It would be beneficial for the NYSBA and its members if the Section were to join the Council. Europe is a very important trading partner of the United States. Intellectual Property issues are always among the top priority issues in EU-US relations and talks. It is important for U.S. industry to be engaged in discussions with the EPO on IP issues.

IP lawyers in law firms or companies in New York, a great majority of which are members of the NYSBA, regularly face challenges with IP protection in Europe, be it related to patent, trademark or copyright.

Participating in the Council presents many benefits for the NYSBA, which are:

1. represent the NYSBA members' interests before the EPO;
2. raise the profile of the NYSBA with the EPO;
3. increase the international work of the NYSBA;
4. strengthen the patent work of the NYSBA;
5. educate NYSBA members about nuances of European patent law to help them navigate EPO's requirements;
6. raise the profile of the NYSBA with the U.S. and international patent community, including in-house patent counsel and U.S. government officials;

7. generate more interest in the NYSBA by patent outside and in-house counsel;
and
8. increase the NYSBA interactions with other U.S. bars.

Participation of the Section In The Council

The NYSBA would not formally join the Council. Participating in the Council would require the Section of the NYSBA to nominate two representatives who would then participate at their own expense in Council's meetings and events, including dinners with officials from the EPO and travel expenses to Europe.

Members representing the Section before the Council will be asked to bear all costs of participating in the Council on behalf of the NYSBA. If some members cannot bear the cost of their participation in the Council and it is the view of the Section that it would be in the interest of the Section to have that person participate in Council events, the Section may cover expenses of participation if reasonable.

The Section's representatives will report to the Section and the NYSBA membership on Council's discussions and events and EPO's related news. The views presented to the Council or during Council's events and discussions will always be viewed as the participants' personal views. Representatives of the Section before the Council will be either chairs or prominent members of the Section, to ensure the best NYSBA representation before the Council.

Conclusion

The Section's participation in the EPO/US Bar Liaison Council would be consistent with the Executive Committee policy on association membership and would greatly benefit the NYSBA. Thus, we hope that the Executive Committee will approve the Section's request for approval to become a member of the EPO/US Bar Liaison Council.

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