

January 20, 2016 Meeting

The meeting was called to order on January 20, 2016 by Howard Speight. The following people attended:

Howard Speight, Betsy King, Jason Sander, Shawn Foster, Iona Kaiser, Steven Boyd, Carlyn Burton, Todd Bynum, Tanya Chaney, Andrea Tran, Albert Liou, Lee Eubanks, Keana Taylor, Ted Roe, Priya Prasad, Jennifer Sickler, Ifti Ahmed

Approval of December minutes: Iona moved to approve. Shawn seconded. None opposed. Minutes were approved.

Judge's Dinner: Ted Ro reports 150 people registered at 14 tables and seven judges. The speaker is confirmed.

Treasurer's Report: Our CPA had not yet finalized the December numbers. The majority of fall institute expenses have been accounted for. Carlyn is getting ready to close the numbers on the fall institute and cut UofH the check.

Moot Court: We have three teams signed up. The reception will be at Birraporetti's, downtown.

Fall Institute 2016: Paul Janicke is stepping back as vice-chairman with Greg Vetter filling the role. Professor Janicke will remain active on the program selection committee. The program selection committee will meet in February. A keynote speaker has not yet been identified.

Probono: Albert received 86 responses to the pro bono survey. 60% of the respondents indicated that they are interested in pro bono. Of those that were interested, 75% stated they would need malpractice. Albert continues to explore the malpractice issue.

Amicus Briefs : Lee explained that Federal Circuit has granted *en banc* rehearing for this case, which generally concerns the on-sale bar, the contours of a "commercial" offer for sale, and whether there should be a supplier exception to the on-sale bar. Lee says the Amicus Committee recommends HIPLA participation in this case in support of Medicines Co.

In this case, Medicines Co. hired a third party to manufacture batches of a pharmaceutical for testing and validation purposes according to a process developed by Medicines Co., and filed a patent application more than one year later with claims covering the pharmaceutical. The Federal Circuit has asked for briefing on these questions:

- 1) **Do the circumstances presented here constitute a commercial sale under the on-sale bar of 35 U.S.C. §102(b)?**
 - (a) Was there a sale for the purposes of § 102(b) despite the absence of a transfer of title?
 - (b) Was the sale commercial in nature for the purposes of § 102(b) or an experimental use?
- 2) **Should this court overrule or revise the principle in *Special Devices, Inc. v. OEA, Inc.*, 270 F.3d 1353 (Fed. Cir. 2001), that there is no "supplier exception" to the on-sale bar of 35 U.S.C. § 102(b)?**

The Amicus committee proposes that HIPLA participate by filing a brief along these lines:

- For question 1(a)—no, the transaction described was not a sale for the purposes of § 102(b)).
- For question 1(b)—even if there were a sale, it should be considered an experimental use.
- For question 2—Yes, the principle in *Special Devices* should be overruled or revised in that there should be at least a "prototype exception" to the on-sale bar of 35 U.S.C. § 102(b) for prototypes purchased by inventors (or their successors) from suppliers.

Howard moved to approve the Amicus Committee to prepare the brief, with the request that the board review and approve/reject the brief prior to its filing. Betsey seconded. The board voted: Howard – approved; Betsy – approved; Ted – approved; Jason – pass; Shawn – approved; Tanya – approved; Andres – approved; Albert – approved. The motion passed.

Upcoming Luncheons: We will not have a lunch in February to avoid conflicts with the judges' dinner. The lunch in March will be the elections.

Inventor of the Year: Jennifer Sickler said that the forms will go out in mid-March.

Science Fair: Keith Tackett said the science fair is set for February 27, 2016 at UofH.

Lunches: Tammy said the December holiday-lunch lost money. She said generally that our numbers are strong and we could consider limiting attendance to ensure timely delivery of food.

Motion to adjourn. Albert moved to adjourn. Shawn seconded. None opposed. Adjourned.