



# THE BOSTON PATENT LAW ASSOCIATION NEWSLETTER

Serving the  
New England  
Intellectual  
Property Bar  
Since 1924

February 2000

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## JUDGE PAUL R. MICHEL ADDRESSES BPLA ANNUAL MEETING

### Jurist Discusses Issues of Concern to Practitioners

The Honorable Paul R. Michel, Senior Judge of the Court of Appeals for the Federal Circuit, addressed the 1999 BPLA Annual Meeting at the Seaport Hotel in Boston as the guest speaker. Judge Michel's topic was the legal bars to the application of the doctrine of equivalents in patent infringement actions beyond prosecution history estoppel.

Judge Michel discussed the *Warner-Jenkinson* case, a landmark U.S. Supreme Court patent decision that both reaffirmed the doctrine of equivalents, and highlighted some of its limitations. The doctrine of equivalents provides that a patent can be infringed if the alleged infringing article, composition or method differs in a minor respect from the claimed invention. While straightforward in theory, the doctrine can

be intractable in its application, leading some sitting CAFC judges to advocate its abolition.

Judge Michel stated that rather than abolish the doctrine of equivalents, he would prefer to focus on ways to improve the doctrine. One way to improve the doctrine is to present the Court with cases which focus on shortcomings of the doctrine so that it can be reviewed by the Court, and perhaps clarified and rationalized for the benefit of practitioners, lower courts and lay jurors. The Judge mentioned the pending *Sexton* and *Festo* cases as examples of this approach.

Judge Michel discussed several legal bars to the doctrine of equivalents. One bar is the "all limitations" or "legal equivalency" rule of the *Pennwalt* case, which holds that an issue as to whether a claim limitation is missing must, as a matter of law, be resolved by the

court. If the court finds that the limitation is absent from the claim, the doctrine does not apply.

The doctrine of equivalents does not extend to infringing devices found in the prior art. This was the holding in the *Wilson Sporting Goods* case. Accordingly, an accused device or process cannot infringe a patent claim if it is an obvious variation of a prior art invention.

File-wrapper estoppel is an additional bar to the application of the doctrine. Subject matter that has been surrendered during prosecution of a patent application cannot be subsequently recaptured under the doctrine of equivalents. Judge Michel pointed out that providing the public with notice is a

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## DAVID J. THIBODEAU ELEVATED TO BPLA PRESIDENT; THOMAS J. ENGELLENER ELECTED PRESIDENT-ELECT

The mantle of the Boston Patent Law Association Presidency was passed from Walter F. Dawson to David J. Thibodeau at the Annual Meeting of the Association in December. Mr. Thibodeau had served as President-Elect for the Association during 1999. Upon the elevation of Mr. Thibodeau to President, Mr. Dawson assumed the position of Past-President of the Association. Mr. Thibodeau is an attorney with the law firm of Hamilton, Brook, Smith & Reynolds, P.C., in Lexington.

Thomas J. Engellenner was elected President-Elect. Under the By-laws of the Association, Mr. Engellenner will automatically assume the office of President next year. Mr. Engellenner is an attorney with the law firm of Nutter, McClellan and

Fish in Boston.

The other officers of the Association elected during the Meeting were William G. Gosz, Vice-President; Peter C. Lando, Treasurer; and Peter F. Corless, Secretary. The newly elected Governors were Ingrid A. Beattie of Fish Richardson, P.C. and Lee C. Bromberg, of Bromberg & Sunstein, L.L.C.

During the Annual Meeting the winners of the 1999 BPLA Writing Competition were announced and recognized. J. Scott Southworth of Framingham, Massachusetts was presented with the First Place Prize of \$500; and Scott P. Zimmerman of Apex, North Carolina was presented with the Second Place Prize of \$200.

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## Farewell from Past President Dawson



Walter Dawson  
Pearson & Pearson

Well, I finally achieved the long sought after position of immediate Past President, and for that I thank the membership for giving me the opportunity and honor to serve as your President in 1999. We worked hard to organize and provide the BPLA functions expected by the membership, and we closely monitored expenses with our Treasurer, Bill Gosz, resulting in a financially successful year.

We particularly want to thank the many Committee Co-Chairs who organized our programs on software patent prosecution, trade secrets, licensing the Corporate IP portfolio, new copyright laws, patenting methods of gene therapy, PCT Easy software, new trademark laws, advanced PCT practice, computational chemistry, Moot Court competition and the law students writing competition. In appreciation for and recognition of their work, all the Co-Chairs received the new President's Award at our 75th Anniversary

### Annual Meeting.

In addition, we held the Judges Dinner at the Weston Hotel, the summer social on the Spirit of Boston and the Annual Meeting at the Seaport Hotel with the Honorable Judge Paul Michel of the CAFC as our guest speaker. In this regard, we thank our Activities Co-Chair, Mary Dawson, my Legal Assistant, my wife and friend for all her time and effort in planning these events. However, Mary has been a dedicated worker for the BPLA the past 12 years, particularly working on the Corporate Practice Committee meetings.

Last but not least I want to particularly express my appreciation to the Board of Governors for their support this past year. Most BPLA members may not know that your board meets every month at the President's office, and this year every board member had the pleasure of receiving a free parking space, when attending the Board meetings in nearby Lowell.

We improved the Web Site during 1999, and you can now update your address and telephone numbers yourself. Soon the Board may be able to poll the membership on various questions put on the Web Site in the Members Only section.

The BPLA has grown significantly in the past 10 years, and there will be infrastructure hurdles to overcome, particularly if it continues to grow. We do not have an office or staff for maintaining our records or to service our members and this will be a consideration for the Board of Governors in the not too distant future. Someday you may even get a BPLA membership certificate and membership card! Again, thank you.

## Welcome to New

### 1999 BPLA Members

Allen, Theodore R.	Lavoie, Teresa
Andersen, Jessica S.	Lenich, Catherine
Beberman, Julie A.	Lockwood, Kurt W.
Bresnahan, Theresa A.	Lowrie, Matthew B.
Burns, David Robert	Ludwig, Kenneth B.
Bynes, Patricia J.	Martinson, Leigh John
Chapman, Kathleen	McLoughlin, Daniel P.
Chisholm, Patricia L.	Meyer, Kim
Clarkin, Cheryl A.	Mukerji, Indranil
Cocks, Elijah E.	Paglierani, Paul Joseph
Crockett, Robert G.	Plotkin, Robert
Dagg, David	Raskind, Kathy
Dailey, Kirk	Robrish, Mona
Decker, Robert J.	Sanft, Renee Diana
DeVaul, William D.	Schultz, Christopher S.
Dietz, III, Frederick	Shtivelband, Inna
Douros, Timothy J.	Singmaster, Amanda
Erickson, William N.	Smith, DeAnn Foran
Erlacher, Heidi A.	Stevens, Jr., Richard L.
Fenney, Alan Frederick	Stickevers, John Joseph
Ferraro, Neil P.	Stone, Andrew G.
Flynn, Marianne	Susan, Janine Marie
Forcier, John V.	Swiszcz, Lisa
Foster, Dorene	Sykes, Tracy A.
Gates, Edward R.	Tocci, Patricia
Gimeno, Carlos J.	Vallabh, Rajesh
Gorecki, John C.	Verga, Michael C.
Grenache, Kerri	Vignola, Evelyn J.
Grewal, Monica	Vitello, Diane
Hagar, Thomas E.	Walat, Robert H.
Holmes, Jennifer K.	Walsh, Raymond
Holmes, Roxanne	Webstad, W. Eric
Hsi, Jeffrey D.	Whitcomb, Brenda J.
Jepson, Craig Steven	Wiener, Beth
Kanik, Cynthia L.	Winsor, Lisa E.
Kim, Elbert B.	Witham, Lisa R.
King, Kerrie A.	Wudyka, Alexandria
Konzak, Kristin E.	Zale, Lawrence P.
Laporte, Claire	

## Comings and Goings

In the future, we would like to publish a listing of members who have had recent changes in position or location. If you have recently changed jobs, are in the process of doing so, or know someone who has, please email the information to us at [info@bpla.org](mailto:info@bpla.org), and we will see that it is published in forthcoming issues of the newsletter.

**The Boston Patent Law Association**  
8 Faneuil Hall, Boston MA 02109, Telephone: (617)973-5021

### Board of Governors:

President:	David Thibodeau, Hamilton, Brook, Smith & Reynolds, P.C. (781) 861-6240 david.thibodeau@hbsr.com
President-Elect:	Tom Engellenner, Nutter, McClennen & Fish, L.L.P. (617) 439-2948 tje@nutter.com
Vice-President:	William Gosz, Wolf, Greenfield & Sacks, P.C. (617) 720-3500 wgosz@wgslaw.com
Treasurer:	Peter Lando, Wolf, Greenfield & Sacks, P.C. (617) 720-3500 plando@wgslaw.com
Secretary:	Peter Corless, Dike Bronstein, Roberts & Cushman, L.L.P. (617) 523-3400 pfc1@dbrc.com
Past-President:	Walter Dawson, Pearson & Pearson (978) 452-1971 wfd@pearson-pearson.com
Board Member:	Doreen Hogle, Hamilton, Brook, Smith & Reynolds, P.C. (781) 861-6240 doreen.hogle@hbsr.com
Board Member:	Ingrid Beattie, Fish & Richardson, P.C. (617) 542-5070 ibeattie@fr.com
Board Member:	Lee Bromberg, Bromberg & Sunstein, L.L.P. (617) 443-9292 lbromberg@bromsun.com



David Thibodeau

Hamilton, Brook, Smith & Reynolds, P.C.

The Seaport Hotel in Boston provided a majestic venue for the BPLA Annual Meeting on December 1, 1999. Our invited guest speaker was the Honorable Paul R. Michel of the Court of Appeals for the Federal Circuit (CAFC). Judge Michel discussed recent CAFC decisions addressing diverse issues ranging from the non-obviousness test for patentability to infringement under the doctrine of equivalents. He is genuinely interested in the details of patent law practice and in the day-to-day lifestyles of patent lawyers. Judge Michel also mentioned that he always welcomes our thoughts as to what can be done to make the patent system more effective. The day's activities concluded without a hitch, thanks to careful planning by our immediate Past-President, Walter Dawson, his Activities Chair, Mary Dawson, and the courteous and professional staff at the Seaport Hotel. We will definitely want to return there again.

These days it seems that inventors increasingly expect to use various forms of intellectual property to protect their ideas, and that our law makers and the court system are ever ready to respond to these expectations. Scientific developments at the intersection of biotechnology and computer science present new challenges in proper patent drafting strategies. Changes enacted to our patent laws late last year will have a profound affect on the way we procure and enforce patents. Other recent changes to the trademark laws provide for new remedies and new forums to more effectively resolve disputes over domain names. These and other current topics should provide more than enough subject matter for association activities in the coming months.

## Message from New President Thibodeau

Bioinformatics. This emerging science presents a new challenge to patent lawyers. Biotechnologists among us are normally tasked with recognizing the need for drafting new patent applications in this area. In many ways, however, the technical subject matter is more akin to traditional computer science technologies. But the biotechnologists among our membership are often typically not familiar with the Patent and Trademark Office's (PTO's) computer related invention guidelines; the computer scientists among us will sometimes throw up their hands in frustration at having to learn about biology.

The BPLA is planning a morning seminar on February 11 at the Swisshotel in Boston to shed some light on these issues. Our panelists will include: Mr. Michael Woodward, U.S. Patent and Trademark Office; Dr. George M. Church, Department of Genetics, Harvard Medical School; Ms. Karen Buchanan, Esq., Bromberg & Sunstein, L.L.P.; and Mr. Scott Brown, Esq., Millennium Pharmaceuticals, Inc. Many thanks to Doreen Hogle and Patricia A. McDaniels for their efforts in organizing this event.

Recent Changes in the Patent Act. A number of changes to the Patent Act are in store as a result of the bill signed by President Clinton this past November. These changes will have a significant impact on our future practice, and it is for us all to become familiar with the law's provisions well prior to their effective dates.

In perhaps the most significant change to patent practice, U.S. applications filed after November 28, 2000 will automatically be published at 18 months. (Publication can be delayed if secrecy is explicitly requested.) Applicants will obtain two new benefits in exchange for this loss of secrecy. First, a type of provisional protection will be available with respect to published claims, such that damages will be available against an infringer who is given actual notice. Published applications will also be effective as prior art as of their filing date against later filed applications.

An expanded *inter partes* reexamination proceeding will be available to challenge the validity of applications filed after November 28, 2000. This new proceeding will permit fuller participation by the requester, including a right of appeal within the PTO. One

possible disadvantage for the requester is that a reexamination decision under the new law is supposed to have a collateral estoppel effect as to all validity issues that "could have been decided" in the reexamination.

A new application of the defense of prior invention will also be available. The defense will apply if the patent relates to a method of doing business, the accused infringer acted in good faith and reduced its own method to practice more than one year prior to the filing date of the patent in question, and if the accused product was used commercially in the U.S. prior to the filing date of the patent. On the downside for the infringer, this defense will have to be proven by clear and convincing evidence.

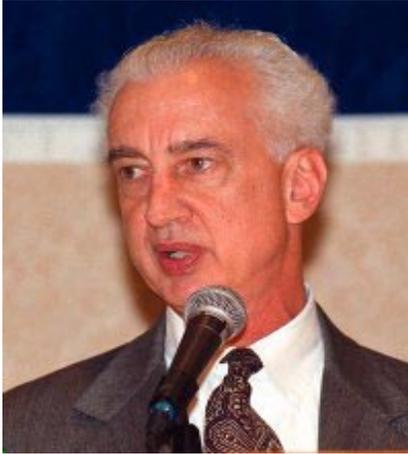
We are still in the planning stages of suitable forum to discuss these important changes to the patent laws. Please contact our President-Elect, Tom Engellenner, or me, if you are able to participate in and help organize this event.

Trademark Law Changes Address Cybersquatter Concerns. Cybersquatting has become a favorite past-time for those looking for a way to "get rich quick" off the Internet. The media continue to report high profile cases in which celebrities, sports teams, and corporations have paid \$100,000 and even more for access to particular domain names which incorporate the buyer's own personal name, corporate name or trademark.

The Anticybersquatting Consumer Protection Act is an attempt to ban the practice of registering domain names in the hope of selling them at huge profits to trademark owners. The statute also makes available some new remedies, including forfeiture or cancellation of the domain name, and awards of attorneys fees, profits, and actual damages, with statutory damages of up to \$100,000 also being available.

In a separate development, the recently formed Internet Corporation for Assigned Names and Numbers (ICANN) now has authority to order forfeiture or transfer of Internet domain names. As of January 1, ICANN has adopted a uniform policy that provides for swift resolution of disputes, with decisions being handed down within a matter of weeks. As of this writing, ICANN has appointed the World Intellectual Property Law Organization (WIPO), the eResolution Consortium, and the National

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Judge Paul R. Michel  
Court of Appeals for the Federal Circuit

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key function of patent claims, and an understanding of this function leads to greater predictability in outcomes.

Distinct from subject matter which has been surrendered during patent prosecution is the issue of "dedication" of the invention to the public. If subject matter is disclosed in a patent application but not claimed, it has effectively been dedicated to the public and cannot be subject to the doctrine of equivalents.

Finally, for claims drafted using "means-plus-function" language as provided in 35 USC §112, ¶6, the application of the doctrine is limited to later-developed technologies, and does not apply to technology which existed at the time the patent issued.

A common feature of all of the legal bars to the doctrine of equivalents is that they are matters of law to be decided by the court. For such issues, the patentee's motivation is not a factor. This issue then becomes ripe for pre-trial disposition by a summary judgement motion.

Judge Michel stated that better tests are needed for instructing lay jurors regarding the factual equivalency required under the doctrine of equivalents. One such test was suggested

by Judge Helen Nies in the *Roton Barrier* case. This test would involve an inquiry as to whether it would have been obvious to substitute the infringing element for the claimed element. An additional test involves the question of "known interchangeability" of claim elements. Another test was suggested in the *Lear Siegler* case, and involved the alignment of the claim element with the substituted element using the function/way/result analysis. These tests, if adopted by the Court, could supply needed predictability to the doctrine of equivalents.

Finally, Judge Michel rejected the notion that decisions of the Court are impacted by "panel dependency." The Judge attributed seeming discrepancies between panels to divergent factual situations presented in individual cases, rather than to serious disagreements among the judges concerning substantive issues of law.

## BPLA TO CO-SPONSOR RICH MOOT COURT COMPETITION AGAIN

### Volunteers Sought to Grade Briefs and Judge Arguments

The Boston Patent Law Association is pleased to announce the AIPLA Annual Giles Sutherland Rich Moot Court Northeastern Regional Competition which will be held again in Boston from Friday evening, March 17 through Sunday, March 19, 2000. This year's competition marks the 27th time law students from across the nation will take up the challenge of briefing and arguing an AIPLA intellectual property problem.

Law students representing law schools from Boston, Portland, New York, Philadelphia, Washington, D.C. and other cities are expected to attend this year's Northeast Regional competition in hopes of moving on to the National Finals in Washington, D.C. The competition provides a unique opportunity for members of the intellectual property community to meet and interact with the region's top law students.

The Regional Competition relies upon members of the local intellectual property community to volunteer to both grade student briefs and judge oral arguments. It is anticipated that 6 to 8 teams of students will compete this year, once again making it necessary to assemble a large number of intellectual property attorney volunteers. Your help is very much appreciated.

Each brief grader will receive a copy of the problem and a bench memorandum on which arguments for each side of the issue will be based and compared. In mid-February, student briefs and grading forms will be provided to the volunteer brief graders, who will be asked to read the briefs critically and to grade them.

Each volunteer judge will sit on a panel of three volunteer judges hearing two teams' arguments; each round of arguments should take about an hour. Thereafter, the judge panel will grade the participants and provide their comments.

Anyone interested in being a volunteer, either by evaluating briefs or by serving as a judge, should contact Christopher Centurelli at Fish & Richardson (Phone: 617-542-5070; Fax 617-542-8906, E-mail: centurelli@fr.com).

This year the oral arguments will be held at Suffolk University Law School. The schedule is as follows: Friday, March 17, 6-9 p.m.; Saturday, March 18 and Sunday, March 19, 10 a.m. - 1 p.m.

A reception following Friday night's opening round activities will be held for students, coaches and volunteers at the offices of Fish & Richardson, P.C., 225 Franklin Street in Boston.

## AMERICA'S "OLDEST" PATENT ATTORNEY ATTENDS ANNUAL MEETING



C. Yardley Chittick (pictured above), officially recognized by the U.S. Patent and Trademark Office as the "oldest living practitioner on record" attended the BPLA Annual Meeting in December. Mr. Chittick was introduced to the members in attendance by Walter F. Dawson, who commented that there are not many living registered patent practitioners with registration numbers under 14,000 (Mr. Chittick's registration number is 13,782). Mr. Chittick was born on October 22, 1900, and he resides in Concord, New Hampshire.

## PRESIDENT'S MESSAGE

*Continued from page 3*

Arbitration forum as authorized arbiters of these disputes.

Year 2000 Judges Dinner. We have arranged to hold our annual Judges Dinner in honor of the local Federal judiciary at the new Federal courthouse in Boston. Please keep Friday evening, April 28, open for this event. Prior to the dinner itself, we can expect to be treated to tours of the courthouse by the Judges, including a tour of their chambers and other areas not normally accessible to the public. We already owe a debt of thanks to our Activities Chair, Mark Solomon, for his work and advance planning for this event. More details will follow as our arrangements for a special guest speaker are confirmed.

New Gavel. To end on a somewhat lighter note, a new BPLA gavel was pressed into service at the December 1, 1999 Annual Meeting. Judge Michel had the honor of taking an inaugural ceremonious rap of the new gavel to bring to order the business portion of the meeting. If any of you happen to find the old gavel for sale in an antique shop or listed on ebay, please let me know. And, for any past President or Presidents out there who may still be holding the old gavel hostage, please be advised that the present BPLA administration will entertain your ransom demands.

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## WRITING COMPETITION WINNERS ANNOUNCED AT ANNUAL MEETING

*Continued from page 1*

The 1999 Boston Patent Law Association Writing Contest was won by J. Scott Southworth, for his paper entitled "Software Beta Testing and the On-Sale Bar to Patentability: Valid Experimental Use Exception or Mere Marketing." Second Place was awarded to Scott P. Zimmerman, for his paper entitled, "Hughes Aircraft and Warner-Jenkinson Presumption: The Certiorari That Should Have Been."

## Web Site Improvements

If you have accessed the Boston Patent Law Association's web site recently, you may have noticed some changes. The web site, [www.bpla.org](http://www.bpla.org), is now divided into a general public section and a members only section. The members only section contains a current listing of the active members of the Association, including current addresses, telephone numbers, and email listings.

All members are urged to update their membership information, since the web site listing will be used by the Association as the primary database for contacting members regarding upcoming events and seminars. Membership information can be updated by simply entering the username and password, and then clicking on the member's name and typing in the updated information. It is the individual member's responsibility to make sure that this information is current, as the organization will no longer separately update the listing or maintain a separate paper membership listing. The username/password has been distributed to the membership, but those members who have misplaced or forgotten it can obtain it by contacting the web site administrator at [info@bpla.org](mailto:info@bpla.org).

Members who desire to actively participate in particular committees of the organization should contact that committee through the web site. Each committee has, or is in the process of having, a brief description of its mission statement and its chair contact information posted on the web site.

The web site also contains a calendar of upcoming organizational activities, and dues payment information. We will be adding additional sections to the web site in the future, and reorganizing existing sections. We have a very active web site and it is our aim to make the site as user friendly and informative as possible. If any members would like to assist us in web site construction, please contact us at [info@bpla.org](mailto:info@bpla.org).

## ANNOUNCING THE 2000 WRITING COMPETITION sponsored by the BPLA

**1st Prize: \$300  
2nd Prize: \$200**

will be awarded to the author of the best article on a subject relating to the protection of intellectual property written or published between August 1, 1999 and July 31, 2000

### CONTEST RULES

To be eligible for consideration, the articles must have been written solely by a student or students either in full time attendance at a law school (day or evening) within the jurisdiction of the First Circuit, or prepared in connection with a course at a law school situated in the First Circuit. The article must be submitted to the Boston Patent Law Association on or before July 31, 2000.

Papers should be no more than the equivalent of 10 law review pages including footnotes (30-40 pages typed copy). Submission of 5 copies is required. Submissions must include the submitter's name, current address, current telephone number, law school and present employment, if applicable.

Judges will consider the merits of the article as a contribution to the knowledge respecting intellectual property.

**Send papers to:  
The BPLA Writing Competition  
c/o Attorney Ingrid A. Beattie  
Fish & Richardson, P.C.  
225 Franklin Street  
Boston, MA 02110**

## Notice to All BPLA members who have not yet paid their 2000 dues:

The annual BPLA membership fee of \$55.00 is due by February 1, 2000. A \$25.00 late fee is due for renewals submitted after February 1, 2000. Membership renewal forms can be obtained from BPLA Treasurer Peter Lando at (617) 720-3500 or via the internet from our web site [WWW.BPLA.ORG](http://WWW.BPLA.ORG)

## BPLA COMMITTEES

To switch committees (or to join another committee), members are encouraged to contact the committee chairpersons listed below to have their names added to committee rosters. Most committee chairpersons can be contacted through the BPLA web site: [www.bpla.org](http://www.bpla.org) (For committees that have co-chairs, please contact the person marked by the asterisk.)

### Activities and Public Relations

Committee e-mail - [activities@bpla.org](mailto:activities@bpla.org)

*Mark Solomon - (781) 861-6240*

The Biotechnology and Computer Law committees are cosponsoring a seminar on Bioinformatics on February 11 at the Swissotel Boston, beginning with a Continental breakfast at 8:00 a.m., with the program beginning at 9:00 a.m. Panelists include: Mr. Michael Woodward, USPTO; Dr. George M. Church, Department of Genetics, Harvard Medical School; Ms. Karen Buchanan, Esq., Bromberg & Sunstein, LLP; and Mr. Scott Brown, Esq., Millennium Pharmaceuticals, Inc. The Moderators for this program will be Doreen M. Hogle, Esq., Hamilton, Brook, Smith & Reynolds, P.C. and Patricia A. McDaniels, Esq., Diatide, Inc. The BPLA would like to provide insight to the biotech specialists who wish to understand more of the guidelines for patenting computer inventions, and to the computer specialists, who wish to understand what the scientists are seeking to learn from the data.

### AIPLA Moot Court

Committee e-mail - [mootcourt@bpla.org](mailto:mootcourt@bpla.org)

*\*Christopher Centurelli - (617) 542-5070*

*Merton Thompson - (617) 542-5070*

See the announcement on page 4 for details of the 2000 Moot Court Competition.

### Antitrust Law

Committee e-mail - [antitrust@bpla.org](mailto:antitrust@bpla.org)

*\*Paul R. Gupta - (617) 338-2482*

*Martin O'Donnell - (617) 951-2500*

### Biotechnology

Committee e-mail - [biotechnology@bpla.org](mailto:biotechnology@bpla.org)

*\*Patricia A. McDaniels - (603) 437-8790*

*Doreen M. Hogle - (781) 861-6240*

### Careers in IP Law

Committee e-mail - [careers@bpla.org](mailto:careers@bpla.org)

The BPLA is currently seeking volunteers to chair or co-chair this committee.

### Chemical Practice

Committee e-mail - [chemical@bpla.org](mailto:chemical@bpla.org)

*\*Peter F. Corless - (617) 523-3400*

*Maggie Kanter - (617) 252-7500*

### Community Service

Committee e-mail - [community@bpla.org](mailto:community@bpla.org)

*David J. Pousner - (617) 248-5000*

### Computer Law

Committee e-mail - [computer@bpla.org](mailto:computer@bpla.org)

*\*Edward W. Porter - (617) 494-1722*

*Lee Carl Bromberg - (617) 443-9292*

The BPLA Computer Law Committee is interested in hearing from BPLA members about what computer-law-related subjects they would like our committee to have programs on. We are considering having several small lunch-time discussions in the near future and perhaps a larger meeting next Fall.

Some subjects under consideration are: software and Internet related claiming; how to get broad protection of software inventions given the recent CAFC tendency to interpret claims narrowly; cost/quality trade offs in obtaining patent protection for software inventions, including the use and value of provisional applications; and a discussion with venture capitalists and businessmen about the value of patents in computer and web related inventions.

If you are interested in any of these subjects or if you have suggestions for any other subjects, please email or phone either Ed Porter ([ewporter@msn.com](mailto:ewporter@msn.com)) or Lee Bromberg ([lbromberg@bromsun.com](mailto:lbromberg@bromsun.com)).

### Copyright Law

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*\*Charles ("Buzz") Gagnebin - (617) 542-2290*

*Thomas M. Saunders - (617) 227-0700*

### Corporate Practice

Committee e-mail - [corporate@bpla.org](mailto:corporate@bpla.org)

*\*Walter F. Dawson - (978) 452-1971*

*Faith F. Driscoll - (978) 294-6165*

We are currently planning a meeting with a speaker that will be of interest to our Corporate Practice members. It will be a breakfast meeting as we have held in the past or a luncheon meeting depending on the speaker's availability. One of the topics being considered is the examination of business method patent applications and another topic relates to IP protection for internet businesses.

As soon as we have a speaker and a date we will post it on the BPLA web site followed by an announcement by mail. If you have not attended our previous meetings, you should call Walter Dawson to make sure we know of your interest.

On another matter, our annual Judges Dinner and Reception is scheduled for Friday, April 28, 2000 at the U.S. District Court in Boston. We are planning to have a few tables for Corporate members and you should call Walter to let us know of your interest in attending and reserving a place at these tables with your corporate colleagues. We had one corporate table last year and we are reserving three tables this year because we expect a strong attendance by the Federal Judges and our

members and their guests. Check the web site for further information about the Judges Dinner.

### International Practice

Committee e-mail - [international@bpla.org](mailto:international@bpla.org)

*\*Timothy A. French - (617) 542-5070*

*Thomas A. Turano - (617) 248-7378*

### Law Students

Committee e-mail - [students@bpla.org](mailto:students@bpla.org)

*Leigh Martinson - (617) 491-5758*

Current student members are requested to identify themselves by sending an e-mail to the [students@bpla.org](mailto:students@bpla.org).

### Licensing

Committee e-mail - N/A

*P.C. Lall - (401) 841-4736 (x24221)*

### Litigation

Committee e-mail - [litigation@bpla.org](mailto:litigation@bpla.org)

*\*Susan Glowsky - (781) 861-6240*

*Steven M. Bauer - (617) 248-7594*

### Patent Law

Committee e-mail - [patents@bpla.org](mailto:patents@bpla.org)

*\*Leslie Meyer-Leon - (617) 542-6000*

*Matthew B. Lowrie - (617) 720-3500*

### Patent Office Practice

Committee e-mail - [patentpractice@bpla.org](mailto:patentpractice@bpla.org)

*Grant Houston - (781) 861-6240*

*David Conlin - (617) 523-3400*

The Patent Office Practice Committee, in conjunction with the Young Lawyers Committee, will be holding a lunch seminar on Biotech Application Drafting. The guest speaker will be David G. Conlin of Dike, Bronstein, Roberts & Cushman, LLP. The seminar will be held on February 23, 2000 at Suffolk University from 11:30 a.m. - 1:00 p.m. in the function room. The cost to attend will be \$10. Please r.s.v.p. to Claudia Fagan at 781-861-6240 or email to [grant.houston@hbsr.com](mailto:grant.houston@hbsr.com).

### Trade Secrets

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The Trade Secrets Law Committee, at dates to be announced, will (1) meet on the bill in the State House to enact the Uniform Trade Secrets Act; and (2) conduct a program on Non-Compete Agreements and Technology Start-Ups.

### Trademarks & Unfair Competition

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## New Patent Bill Enacted Into Law

### Major Changes in Patent Practice Seen

The American Inventors Protection Act of 1999 was signed into law on November 29, 1999. The Act makes important changes to patent law, some of which are already in effect. The new law is still subject to PTO rulemaking. How the PTO interprets and implements the Act will determine how the Act affects our daily practice. Highlights of the act include:

#### Defense to Infringement Based on Earlier Inventor

The Act provides a new defense for potential infringers of method patents. The defense is available to infringers who, acting in good faith, have actually reduced the subject matter to practice at least one year before the effective filing date of the patent, and who have commercially used the subject matter at least one year before the effective date of such patent. The terms "commercially used" and "commercial use" are defined to include internal use and the arms-length sale of a useful end product. Use during a regulatory period is also "commercial use," and research laboratories and universities can also avail themselves of the defense under certain circumstances. "Method" is defined to mean "a method of doing or conducting business." The right to assert the defense is personal, and can only be transferred as part of the good faith transfer of the entire enterprise. This provision became effective on November 29, 1999, but does not apply to any actions for infringement pending on the date of enactment.

#### Patent Term Guarantee

The Act states that the PTO will provide applicants with a substantive response in an application within 14 months of the filing date, respond to a reply under § 132 or to an appeal under § 134 within 4 months, act on an application within 4 months of a decision of the BPAI or Federal Court, and issue a patent within 4 months of payment of the issue fee. To the extent that the PTO does not meet these goals, the term of the patent shall be extended by one day for each day of delay.

The Act also states that the PTO will provide no more than 3 years of overall application pendency. If issuance is delayed beyond 3 years due to a delay by the PTO, then the patent term will be extended one

day for each day of delay. Time consumed by a continuation application filed under § 132(b), interference proceedings, a secrecy order or any delay requested by the applicant, including taking more than 3 months to respond to an office action, shall not count toward the 3 years. Additionally, if the issuance of a patent is delayed due to inference proceedings, the imposition of a secrecy order, or review by the BPAI or Federal Court in which an adverse decision on patentability is reversed, the term shall be increased for each day of pendency of the proceeding. The effective date of this provision is six months from the date of enactment of the Act.

#### Domestic Publication of Patent Applications Published Abroad

Perhaps the most controversial provision of the new Act is the requirement that applications shall be published 18 months after the earliest filing date for which benefit is sought. The publication provision does not apply to applications which are no longer pending, subject to a secrecy order, provisionals, design patent applications, or those applications that the applicant, upon filing, requests not be published. In order to avoid publication, the applicant must certify that the invention will not be the subject of an application in a foreign country having a publication requirement. The published application is also considered a reference under § 102(e), effectively creating a new category of prior art.

Publication entitles the patentee to certain "provisional rights," and specifically the right to obtain a reasonable royalty from an infringer from the date of publication until the patent issues. The infringer must have had actual notice of the published application, the invention claimed in the issued patent must be substantially identical to the invention claimed in the published application, and the action for royalties must be brought within six years of the date of issuance of the patent. The publication provisions of the Act apply to applications which are filed at least one year after the effective date of the Act.

#### Optional Inter Partes Reexamination Procedure

The Act adds an optional inter partes

reexamination provision to the existing reexamination provisions. Any party can request an inter partes reexamination. However, there are significant differences between "inter partes" reexamination and "ex parte" reexamination. An inter partes reexamination based on a request by a third party requestor provides the third party requestor with an opportunity to fully participate in the prosecution of the reexamined patent, including the right to comment on the patentee's responses to office actions, to independently appeal a decision which is favorable to patentability, or to be a party to any appeal taken by the patentee. A third party requestor is estopped from challenging any fact which was determined during the inter partes reexamination, including patentability over prior art.

Other significant features of the new Act include a reduction in certain patent fees, the reorganization and restructuring of the PTO to provide more autonomy and flexibility, and a requirement of full disclosure on the part of invention promotion organizations.

*Thomas G. Field, Esq., of Wolf Greenfield and Sacks, P.C., contributed to this article.*

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## Upcoming Events

#### February 11, 8 a.m. - Noon Bioinformatics and Patents Seminar:

Application of Computer Models for Analysis of Biological Information  
Swishshotel, Boston  
Contact Doreen Hogle (781) 861-6240

#### March 17, 18, 19 Giles Rich Moot Court Competition:

Suffolk University, Boston  
(See article on page 4.)

#### April 10 - Litigation Seminar:

Alternative Dispute Resolution  
Contact Susan Glovsky (781) 861-6240

#### April 28 - Judges Dinner

U.S. Federal Courthouse, Boston  
Contact Mark Solomon (781) 861-6240

#### June 3 - Annual Summer Outing

Mystic, Connecticut  
Contact Mark Solomon (781) 861-6240

## Advertisements

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## Positions Available

**AMERICAN SUPER CONDUCTOR** is expanding its corporate intellectual property group and has an opening for a patent attorney located in Westborough, MA (Rt. 495/Rt. 9). Completion of law school, registration to practice before the U.S. Patent and Trademark Office, admission to a state bar, and at least 2-5 years patent drafting experience are required. A bachelor's degree in a relevant technical discipline is required and higher technical degrees are preferred with the ability to rapidly grasp complex technology and integrate technical, business and legal issues. Experience including both patent and technology contracting is preferred. Responsibilities also include drafting and negotiating contracts involving intellectual property, including government contracts. Please send resumes referencing job code PA-BPLA to: American Superconductor, 2 Technology Drive, Westborough, MA 01581; Fax 508-366-1057; Email: [resumes@amsuper.com](mailto:resumes@amsuper.com). Visit our website at [www.amsuper.com](http://www.amsuper.com).

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### PATENT COUNSEL

An International Research-based group with major businesses in life sciences, polymers and speciality chemicals, is seeking a patent attorney for their U.S. based Pharmaceutical Corporation in the Northeast. The corporation has just announced plans for an \$80 million expansion with the centerpiece being a chemistry research building. This expansion will greatly increase future growth potential with the company. He/she will report directly to the VP of legal, enjoy visibility, recognition and independence. Work closely with the scientist on the development of patent applications and be an important player for new product and drug development. Must have 2-5 years experience, and a degree in a chemistry-related discipline. Company offers a competitive salary/bonus and a great relocation package. Contact Sandra Verner, 203-454-2920 Ext. 120, Fax 203-454-4643, Email [rosemary.cass01@snet.net](mailto:rosemary.cass01@snet.net).

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