BOSTON PATENT LAW ASSOCIATION NEWSLETTER

Serving the New England Intellectual Property Bar Since 1924

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ANNUAL BPLA JUDGES DINNER

The annual Boston Patent Law Association Judges Dinner was held on Friday, May 25, 2001, at the Federal Court House in Boston. Despite the long holiday weekend, the turnout for this year's Annual Judges Dinner was impressive with over 200 attendees. Eleven judges and magistrates from the District of Massachusetts were present. Judges Alan D. Lourie and Paul Michel from the Court of Appeal for the Federal Circuit made a special trip to attend this gala event. Robert Neuner, president of the New York Intellectual Property Law Association, was a special guest.

The featured speaker was National Public Radio's commentator Nina Totenberg. She is well known as National Public Radio's legal affairs correspondent. Her reports air regularly on NPR's critically acclaimed newsmagazines, All Things Considered, Morning Edition, and Weekend Edition. She has been honored eight times by the American Bar Association for continued excellence in legal reporting and has received a number of honorary degrees.

On a lighter note, in 1992 and 1988, Esquire magazine named Nina one of the "Women We Love." And, with her characteristic quimsical nature, she participated in an "All Things Considered" piece on women's designer shoes. A few of us got

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Nina Totenberg addresses the crowd at the BPLA 2001 Judges Dinner

President Tom Engellenner addresses the almost 200 members and guests at the Annual Judges Dinner

For more photos from the Annual Judges Dinner go to Pages 6-7

Members of the Board with Nina Totenberg at the annuals Judges Dinner (l-r) David Thibodeau, Past President; Ingrid Beattie, Board of Governors; Nina Totenberg; Tom Engellenner, President; and Bill Gosz, President-Elect

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MESSAGE FROM PRESIDENT ENGELLENNER

Thomas J. Engellenner

Have you ever wondered about the purpose of the figure 8 chart, which is often printed on globes? It's called an Analemma and it explains an odd phenomenon. Even though the longest day of the year is June 21st, the actual time of sunset continues to occur later for almost a week — and it takes another week of slightly earlier sunsets to get back to the sunset time on June 21st. The same phenomenon occurs in reverse in winter. While the shortest day of the year is December 21st, sunrises don't actually start to occur earlier until January.

There are two reasons for this oddity. First, the earth's axis is tilted and second, the earth's orbit around the sun is not a perfect circle.

Because of the tilt in the earth's axis, the sun takes different paths through the sky in winter and summer. In summer, the sun will rise higher in the sky at noon than in winter (at least in our hemisphere). Not only will the sun drift to the north (or south) but also to the east (or west) depending upon the season. The drift from east to west and back again represents a difference between true sunset and the theoretical sunset time if the earth's axis was not tilted. The drift causes sunset to be as much as ten minutes late in February and again in August.

The second factor at play here is the earth's orbit. Because of the path that the earth takes around the sun is elliptical, the speed of the earth in orbit changes throughout the year. In January, the earth is at perihelion (nearest to the sun) and moving faster athan it does in July. When the earth is moving its fastest, it doesn't quite complete a full rotation (from the sun's perspective) in 24 hours; instead, it comes up short by about 8 seconds. This shortfall is cumulative, starting in September, so that by January the earth's rotation is nearly 10 minutes behind schedule.

Add these two effects together and you get as much as 16 minutes variance between clock time and real time at various points in the year. Thus, the figure 8 chart of the Analemma allows one to determine how far ahead or behind of your watch the earth is on any day in the year.

Speaking of oddities in timing, a decision of the Court of Appeals for the Federal Circuit last month is noteworthy, if not alarming. The case of *Eli Lilly and Co. v. Barr Laboratories, Inc.,* 58 USPQ2d 18, was decided on June 30, 2001 and has sent many practitioners and commentators into orbit because of the new rules on timing that the decision sets down for double patenting.

To briefly summarize the facts, Eli Lilly researchers began to study fluoxetine hydrochloride (Prozac) in the early 1970's. In 1974, a patent application in the name of inventor Molloy was filed. During the next twelve years this application spawned four divisional applications, three continuations and ultimately six patents. The first of this family of patents issued in February, 1982, with claims to treatment of depression with Prozac. The last of the Molloy family of patents issued in December, 1986 with more general claims to methods of blocking serotonin uptake by administering Prozac.

In April 1983, Lilly filed a separate patent application, naming a different inventor (Stark) with claims to the treatment of anxiety with Prozac. The Patent Office properly found the earliest (February, 1982) Molloy patent to be a 102(b) and 103 reference against the Stark application but concluded that Stark's discovery was patentably distinct and issued the Stark patent in May, 1986.

In the course of recent patent infringement litigation by Lilly against various generic drug manufacturers, Barr Laboratories raised a very peculiar defense, which was adopted by Judges Mayer, Friedman

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Articles of Incorporation

The Boston Patent Law Association will place a bylaw amendment be put before the membership at a special meeting sometime in the near future. In all likelihood the special meeting will coincide with one of our upcoming seminars and, in any event, the membership will receive formal notice at least a month in advance of the meeting.

As you know the BPLA is an organization of over 700 membres who practice intellectual property law in New England. Our organization is nealy eighty years old but it appears that we are operatng without any formal charter document.

While the BPLA does have a set of by-laws that do a very good job of defining how the organization is run, the Board of Governors, on advice of counsel, believes we should take the necessary steps of incorporating as a not-for-profit corporation under Chapter 180 of the Massachusetts General Laws.

The Articles do not change the By-Laws in any way. The reason for incorporation is simply to ensure that our status as a non-profit organization under state law and the U.S. Internal Revenue Code is properly documented.

Update on the .biz and .info Top-Level Domains

by Michael A. Albert and Michael N. Rader
Wolf, Greenfield & Sacks

Just when we IP attorneys, and our clients, have gotten used to the three unrestricted "top-level domains" (TLDs), ".com," ".net" and ".org," two additional TLDs are now being introduced. The new players are ".biz" (for businesses) and ".info" (for unrestricted use). In addition, five more TLDs are slated to arrive later this year or early next.

The availability of .biz and .info is a double-edged sword, creating both opportunities and concerns for trademark owners. While new domain name registrations will be available to clients, the additional TLDs also open the door for competitors and cybersquatters to capture potentially important (or confusion-causing) domain names.

The companies responsible for administration of the new TLDs have taken some steps to facilitate smooth registration processes. The procedures they chose, however, do not offer foolproof protection. These procedures also have generated controversy and even litigation.

The .biz Registry's "IP Claim" Service

Early on, the .biz registry (www.neulevel.com) decided to offer a service designed to alert trademark owners to attempts by other parties to register domain names exactly matching the owners' marks during an initial "land-rush" domain name application period. (This period ends on September 17). To participate, a trademark owner must have submitted an "IP Claim" to the registry. The deadline for submitting IP claims was originally July 9, but NeuLevel subsequently extended it to August 6, and then again to August 8.

In the event of a conflict, the .biz registry will notify both the applicant and the IP Claimant, and put the application on a temporary 30-day hold to enable the IP Claimant to resolve the matter or initiate an action under the registry's Start-up Trademark Opposition Policy ("STOP"). Only trademark owners who submitted an IP Claim by August 8 may access STOP. Also, only exact matches will trigger notification – for example, if a trademark owner filed an IP Claim for "mark.biz" and another party then filed an application for "mymark.biz," the trademark owner will not be notified.

The advantage of STOP over existing dispute resolution procedures such as ICANN's Uniform Domain-Name Dispute Resolution Policy ("UDRP") is that it carries a lower burden of proof. A STOP claimant can prevail by showing either use *or* registration of the mark in bad faith, while the UDRP requires both. Although the registry has not yet established clear rules, failure to withdraw a registration after notification of an IP Claim might be deemed evidence, in and of itself, of bad-faith registration. If so, STOP could prove a quick and effective tool for trademark owners to stop cybersquatters.

NeuLevel reports that approximately 50% of all IP Claims were filed by U.S.-based entities. 32% of all IP Claims came from Europe, 11% from the Asia/Pacific region, and 7% from other areas of the globe.

Failure to Submit an IP Claim

In the absence of an IP Claim, any competing applications for identical domain names will be resolved by random draw at the end of September. Then, after October 1, 2001 (when .biz goes "live"), subsequent applications will be considered on a first-come, first-served basis.

Note that filing an IP Claim does not eliminate the need to file one's own .biz domain name application; it merely entitles the IP Claimant to notification of any conflicting application filed during the land-rush period, and the right to proceed under STOP.

The Lottery

One of the quirks of the .biz registration process is that filing multiple applications increases the chance of winning the draw if others apply for the same domain name. Currently, the registry is charging $2 per application (or "ticket," as some have begun to call it).

As a result, NeuLevel has been criticized for allegedly running a for-profit "lottery." One Arizona businessman filed a class action suit against NeuLevel, alleging that NeuLevel was "engaged in a criminal lottery enterprise." More recently, on August 9, NeuLevel filed a declaratory judgment action against online retailer amazon.com in the Eastern District of Virginia, seeking a declaration that its registration process does not violate federal trademark statutes and cannot be subjected to regulation by the states because it "involves matters of federal concern with respect to which NeuLevel is immune from suit." The NeuLevel suit was brought in response to a threatening letter received from amazon.com.

Developments in these two lawsuits could prove to have a substantive impact on the registration process.

Pre-Registration for .INFO During the "Sunrise Period"

The registration process for .info (www.afilias.com) is even more favorable to trademark owners than the .biz procedure because it enables them to pre-register their marks as .info domain names during an exclusive "Sunrise Period." The Sunrise Period was originally scheduled for June 25 to July 24, but the deadline was extended to August 27.

The Sunrise process is open only to marks registered in a national trademark office (such as the U.S. Patent and Trademark Office) by October 2, 2000. Submitting a Sunrise application on behalf of your

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and Gajarsa of the CAFC in their June 30, 2001 decision. The panel found Molloy's broad 1986 patent invalid on double patenting grounds because it had issued seven months after the Stark patent and, consequently, would unfairly extent Lilly's monopoly beyond the seventeen years granted in the Stark patent.

One must remember that double patenting has nothing to do with priority dates. Even though Molloy was entitled to 1974 priority date, and clearly disclosed a seminal discovery, the law of double patenting is only concerned the *sunset* of patent rights, not the sunrise.

Even though priority dates are irrelevant to a finding of double patenting, the issue of obviousness is very much a part of the analysis. The prohibition on double patenting is judge-made law and invoked primarily to prevent patent owners from getting one patent after another on obvious variants of the same invention.

One problem with the *Lilly* decision lies in the double standard it imposes on improvement patents by the same corporate entity. If Stark had worked for some other drug company and had been awarded his patent as an unobvious improvement or extension of Molloy's discovery, double patenting would not come into play. The *Lilly* decision, thus punishes a company for making an improvement that any of it competitors could have made and patented without any adverse consequences.

Fundamentally, however, the decision appears to overturn a long-standing rule that says when a basic patent is filed before but issued after an improvement patent, the order of issuance is disregarded so long as the improvement patent is not obvious in light of the basic patent.
The decision takes the judicial doctrine of obviousness-type double patenting to a new height. Instead of limiting the doctrine to situations where there is truly only one invention in two patents, that is, a two-way test where the claims of *each* patent would have to be obvious over the claims of the *other*, the *Lilly* panel has invoked a more restrictive *one-way test*: if Molloy's claims are obvious in light of Stark (or *vice-versa*), double patenting had occurred.
The holding seems fundamentally flaw when one considers that the Court is really saying that Lily's patent on a genus is invalid because of a patent application on species, filed nine years after the genus patent application, issued first.

The panel justifies the application of a more restrictive "one-way" test because the PTO was not "*solely* responsible" for the delay in issuance of the Molloy patent. The notion that *any* delay on the part of the applicant can throw a broad patent into this Alice-in-Wonderland situation of invalidity based on an invention not yet made should be disturbing to anyone (everyone) who has ever filed a request for an extension of time. Frankly, the issuance of six patents on a fundamental invention over a period of twelve years does not seem that extreme, especially when the PTO had imposed multiple restriction requirements.

To those who already fear an era of more restrictive holdings by the CAFC on patent prosecution is dawning, it must also be noted that the Lilly decision not only found double-patenting but also *invalidated* the 1986 Molloy patent. Instead of permitting Lilly to file a terminal disclaimer to give up those seven months between the expiration date of the Stark patent and the subsequent Molloy patent, the court found no such remedy was available because Lilly had previously abandoned the Stark patent.

To return to the Analemma, there are rules that are necessary to correct errors in timing. Unfortunately, the rules set out in the *Lilly* decision impose a rather Draconian solution. Eli Lilly & Co, as well as numerous amici are seeking *en banc* reconsideration. Let's hope, in this instance, the *Lilly* rule does not withstand the test of time.

BPLA PRESENTS AWARD AT MASS SCIENCE FAIR

On Saturday, May 5, 2001, William G. Gosz, President Elect of the Boston Patent Law Association, presented an award in the amount of $1000 to Gudrun Wu Lowenhaupt at The Annual Massachusetts State Science Fair.

The BPLA award was for a biology project Ms. Lowenhaupt had completed dealing with the binding of granulocyte stimulating factor to its receptor.

The Massachusetts State Science fair is an annual event held to recognize outstanding achievements in science by Massachusetts high school students. This year, the event was held in the Kresge Auditorium on the MIT campus.

The Boston Patent Law Association is pleased to be a sponsor of this worthy event.

New PCT Contracting State

On 17 May 2001, the Philippines deposited its instrument of ratification of the PCT, and on 17 August 2001, became bound by the PCT.

Consequently, in any international application filed on or after 17 August 2001, the Philippines may be designated and, because it will be bound by Chapter II of the PCT, may also be elected.

Furthermore, nationals and residents of the Philippines will be entitled from 17 August 2001 to file international applications under the PCT.

Patent Fees Adjusted

Effective October 1, 2001, patent fees will be adjusted for the PTO fiscal year 2002. Any fee paid on or after October 1, 2001 is subject to the new fee schedule and must be paid in the adjusted amount.

Check the PTO website for further particulars - http://www.uspto.gov.

Breakfast Seminar in October

On October 26, 2001, the Chemical Patent Practice Committee will host a breakfast seminar on practice before the USPTO Board of Patent Appeals and Interferences.

Featured speakers will include PTO Administrative Patent Judges from both the interference and ex parte appeals groups of the Board.

The seminar will be held at the Boston Omni Parker House Hotel from 9:00 to 11:15 am. A meeting announcement with further details will be mailed to all BPLA members by early October.

USPTO to jointly develop XML DTDs

The USPTO, the European Patent Office (EPO), the Japan Patent Office (JPO), and the World Intellectual Property Organization (WIPO), are jointly developing document-type definitions (DTDs) for use with the electronic filing of Patent Cooperation Treaty (PCT) applications. When finalized in December 2001, these DTDs will enable applicants to create extensible-markup language (XML) international patent applications that can be processed by machine.

In April 2001, the USPTO, EPO, and JPO agreed that they will accept national applications filed electronically using the same international patent application formats. This will enable applicants to create an application once and submit it to EPO, JPO, USPTO, and PCT (WIPO) with only minor modifications.

The USPTO plans to accept national electronic applications using the PCT DTDs through its electronic filing system (EFS) starting in October 2002. The USPTO plans to publish patent applications and grants using new publishing DTDs based on the PCT filing DTDs starting January 2003.

The current draft of the PCT DTDs can be found at http://pcteasy.wipo.int/efiling_standards/schemaDocs/schemaDocs.htm with further information about their use at http://pcteasy.wipo.int/efiling_standards/EFPage.htm.

Upcoming Events

September 28

Program:
What's New in the European Patent Office
Location:
Omni Parker House
Time:
8:30 am - 11:00 am

October

(date to be announced)
Program:
Patent e-Filing and Advanced Patent Practice
Location:
TBD
Time:
TBD

October 26

Program:
Breakfast Seminar - Practice before the USPTO Board of Patent Appeals and Interferences.
Location:
Boston Omni Parker House Hotel **Time:**.
9:00 am - 11:15 am

November

(date to be announced)
Program:
Seminar - Electronic Trademark filings - The Trademark Office goes e-government (co-spon sored by the the BPLA and the Suffolk University Center for Advanced Legal Studies
Location:
Suffolk University Law School
Time:
TBD

November

(date to be announced)
Program:
Luncheon -Guest Speaker: Chief Adminstrative Law Judge David Sams of the Trademark Trial and Appeal Board Work shop
Location:
Boston Harbor Hotel, Wharf Room
Time:
11:30 am - 1:30 pm

November

(date to be announced)
Program:
Workshop - Exparte and Interparte Trademark Practice Tips
Location:
Boston Harbor Hotel, Wharf Room
Time:
2:00 pm - 4:00 pm

December 12

Program:
Annual Meeting -Guest Speaker: Trademark Commissioner : Anne H. Chasser
Location:
Seaport Hotel
Time:
11:30 am - 2:00 pm

David Conlin, Ron Kransdorf, Molly Conlin and CAFC Judge Michel (L-R) are shown together at the Annual Judges dinner.

Members and guests shown mingling during the Annual Judges Dinner Reception at the Federal Court House in Boston

Above are Massachusetts District Court Judge Saris and CAFC Judge Lourie

Below are members of the BPLA Board of Governors Doreen Hogle (secretary), Ingrid Beattie, David Thibodeau(Past President), Tom Engellenner (President), Leslie Meyer- Leon and Bill Gosz (President-Elect)

Greg Madera with Leslie Meyer-Leon enjoying themselves

Michael Twomey and David Cavanaugh (below) chatting at the Judges Dinner Reception

Judge Keeton keeps the attention of Jack Skenyon and Maggie Skenyon

District Court Judges Young and Saris with CAFC Judge Lourie

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the inside line on the subject (off the record!).

Ms. Totenberg was fresh back from an NPR "Citizens of the World" tour of Paris. She delighted the assembled audience of judges, attorneys, and guests with her views on the inner workings of the Supreme Court and of how the recent upheavals in the composition of the U.S. Senate would affect the judiciary. Ms. Totenberg predicted that that the departure of Senator Jeffords (VT) from the Republican Party, and ensuing change in the control of the U.S. Senate in favor of the Democrats, would have a wide and immediate effect upon federal appointments. She reminded us that despite Clinton's eight years in office, his effect on the judiciary was minimal because court appointments was a relatively low priority and many nominations went unconfirmed in the final weeks of his term. Ms. Totenberg stated that judges are now more carefully screened for all of their political philosophies and also let us in on a little known "secret" process by which Supreme Court nominees may be nipped in the bud. Either senator from a given state can block a nomination by simply not returning a "blue sheet," a procedure that President Bush will face with vacancies in his administration.

What's New in the European Patent Office

The Boston Patent Law Association is pleased to present a seminar by European Patent Office Examiners covering new developments in the EPO and EPO prosecution tips.

The visiting Examiners have experience in searching, examination and oppositions, and include:

Dr. Herbert Richter, who has been with the EPO since 1986 and specializes in polymers, dyestuffs and organometallic compounds;

Mr. Jos Klaver, with EPO since 1989, specializes in blood/organ preservation and water treatment;

Dr. Gatson Williere, also with the EPO since 1989 and has been involved with the development of examination-specific software;

Ms. Karin Douschan, who has been with the EPO since 1986, has a background in pharmacology and is currently involved with training EPO examiners;

Dr. Mark Weaver, with the EPO since 1988, who has worked as an examiner in the area of diagnostics, pharmaceuticals and biotechnology and has responsibility for PCT substantive examination at EPO headquarters in Munich, and PCT reform and development issues within the EPO; and Dr. Klaus-Peter Dopfer, who joined the EPO in 1990 and works in the areas of search, examination and opposition for diagnostics, pharmaceuticals and biotechnology.

This event will be held Friday, September 28, 2001 at the Omni Parker House. Registration and a continental breakfast begins at 8:00 am. If you are interested contact katie.norris@hbsr.com.

If you have any information you would like to include in the next newsletter please send it to:
Peter Lando
Wolf, Greenfield & Sacks, P.C.
600 Atlantic Avenue
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or via e-mail at plando@wolfgreenfield.com

Lack of Response to OED Survery

The Office of Enrollment and Discipline (OED) conducted a survey of the active registered practitioners whose registrations numbers are 12,379 through 20,892, inclusive. The purpose of the survey, begun on April 24, 2001, was to ascertain whether these practitioners wish to remain on the register. OED received numerous responses.

Most practitioners responding to the survey provided information that enabled OED to confirm and update records regarding the responding practitioner's address and telephone number. Other practitioners requested removal of their names from the register of attorneys and agents. Their names have been removed.

As of July 30, 2001, OED did not receive any response or communication from more than 900 practitioners. They are given an additional 30 days to respond and provide the requested information. They are requested to complete and return a blue Data Sheet on or before October 4, 2001. Thereafter, the names of practitioners on the list who fail to reply and give the requested information will be removed from the register, and the names of individuals so removed will be published in the Official Gazette. Upon payment of the fee set forth in 37 CFR 1.21(a)(3), the name of any individual so removed may be reinstated on the register as may be appropriate.

A blue Data Sheet may be obtained by contacting LouWilda Turner or Shirley (Rasheed) Brown via mail addressed to the Commissioner of Patents and Trademarks, Box OED, Washington, D.C. 20231, or via e-mail addressed to Louwilda.Turner@uspto.gov or Shirley.Rasheed@uspto.gov. They may also be reached through the following telephone number: (703) 306-4097.

Practitioners who may know that a former colleague whose name appears on the list below is deceased are encouraged to so inform OED.

BPLA Hosts Panel on Festo Decision

On May 1, the BPLA, Patent Law Committee hosted a session on the recent Festo decision. James Foster of Wolf Greenfield moderated the event and opened with a brief background of the case. James Lampert of Hale and Dorr, who was involved with the case, provided insight into the history of the Festo decision. George Neuner of Dike, Bronstein, Edwards & Angell followed with the challenges of prosecuting patent applications in light of Festo and Dean Bostock of Weingarten, Schurgin, Gagnebin & Hayes discussed the effects of Festo on litigation. A lively question and answer session followed, which generated some practice tips:

• A structure once literally claimed but not covered in an issued claim gives rise to a Festo situation;

• Omit non essential language from claims when filing; consider filing two applications on the same day to create independent prosecution histories (one application would support and claim the invention narrowly, the other would support and claim the invention broadly)

• Prepare fuller specifications (if something is known at filing, include it. Do not rely on the DOE to cover it)

• If ranges are claimed, make sure the specification includes alternative ranges to support amendments that may be nec essary

• Avoid run on claim language. Break out each element into a separate paragraph

• Claim all disclosed embodiments

• Consider filing means plus function claims in addition to structural claims

• Avoid making amendments, instead make more arguments

• Clearly state the purpose of an amendment

• Be careful when amending claims for clarification

• Revisit opinions written before the Festo Decision

• Review client files for new opportuni ties to design around

News Flash: Supreme Court Grants Review

On June 18th, the Supreme Court granted Festo's petition for certiorari. The questions presented in Festo's petition were:

(1) whether every claim-narrowing amendment designed to comply with any provision of the Patent Act automatically creates prosecution history estoppel regardless of the reason for the amendment, and

(2) whether the finding of prosecution history estoppel completely bars the application of the doctrine of equivalents.

Revised International Trademark Classifications Effective January 1

The USPTO has revised trademark classes effective as of January 1, 2002 as follows:

Class 42: Scientific and technological services, and research and design relating thereto Industrial analysis and research services. Design and development of computer hardware and software; Legal Services.

Class 43: Services for providing food and drink. Temporary accommodation.

Class 44: Medical services, Veterinary services. Hygienic and beauty care for humans or animals. Agriculture, horticulture and forestry services.

Class 45: Personal and social services rendered by others to meet the needs of individuals (e.g., social event services, funeral services, matrimonial agencies, etc.). Security services for the protection of property and individuals

Board of Governors

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client does not guarantee that the client will receive the registration. If Sunrise applications for identical domain names are submitted by more than one trademark owner (e.g., owners of identical marks for different goods or in different countries), the registration is randomly assigned to one of the applicants through a "round-robin" process described on the Afilias web site.

Challenging Sunrise Registrations

Registrations obtained through the Sunrise process can be challenged during the Sunrise Challenge Period, which runs for 120 days from the day after the Sunrise Period ends (now August 28). Sunrise Challenges are subject to the Sunrise Registration Challenge Policy (much like the UDRP) and a set of accompanying Rules (much like the UDRP Rules). Under the Policy, challenges to Sunrise registrations may be based on an assertion that (a) the registrant did not possess a trademark in the domain name, (b) the domain name is not identical to the trademark on which the Sunrise application was based, (c) the trademark on which the Sunrise application was based is not of national effect, or (d) the trademark on which the Sunrise application was based did not issue prior to October 2, 2000.

Sunrise Challenges are decided in an administrative proceeding run by the World Intellectual Property Organization Arbitration and Mediation Center. Sunrise applicants are required to submit to the jurisdiction of the Center with respect to any challenges that may be filed.

Beyond the Sunrise Period

From August 28 through September 11, Afilias will observe a "Quiet Period" for testing and evaluation. During this period, no applications for registration will be accepted.

Starting on September 12, the .info registry will open to the public for a "Start-Up Period," during which registrations will be randomly assigned among all applicants for a particular name. Following the Start-Up Period, applications will be processed on a first-come, first-served basis. During and after this period, disputes will be handled in court or through the UDRP. The domain names in .info are expected to become functional on September 19.

Sua Sponte Challenge Planned by Afilias

After the first round of sunrise registrations were announced, it became a matter of public comment that numerous registrations appeared to have been made by entitites that did not own the trademark registrations on the basis of which they sought sunrise priority. Afilias recently admitted that fraudulent representations of trademark ownership have become a significant problem.

Responding to concerns that many of these registrations will remain unchallenged (since the incentive to challenge is limited because a prevailing challenger is not assured of being assigned the domain name), Afilias itself has announced plans to investigate and challenge registrations remaining after the 120-day window closes. Afilias plans to "bundle" the fraudulent registrations and send them to WIPO for a "bulk challenge." Any names won back by Afilias will be thrown back into the registry pool and will become available for registration by the general public.

Conclusion

The new TLDs coming on-line over the next several months present an opportunity for businesses, but also pose a potential threat of trademark infringement. The procedures made available to trademark owners by the .biz and .info registries should represent one component of an overall strategy to protect clients' trademarks and other intellectual property.

New PTO Rules

The United States Patent and Trademark Office ("USPTO" or "Office") is implementing rules relating to civil actions and claims involving the Office.

Specifically, the rules provide procedures for service of process, for obtaining Office documents and employee testimony, for indemnifying employees, and for making a claim against the Office under the Federal Tort Claims Act.

Notice to All BPLA members who have not yet paid their 2001 dues:

The annual BPLA membership fee of $55.00 is due by February 1, 2001. A $25.00 late fee is due for renewals submitted after February 1, 2001.
Membership renewal forms can be obtained from BPLA Treasurer Peter Corless at (617) 523-3400 or via the Internet from our web site www.BPLA.org

POSITIONS AVAILABLE

Subject to the availability of space, the BPLA publishes "Positions Available" advertisements by its members (and their firms or employers) for availability of employment positions. Ads of approximately 100 words or less costs 100.00 per issue. If you wish to submit an advertisement for publication in the next issue, please forwarde ad copy to plando@wgslaw.com. Please send check, (made payable to Boston Patent Law Association, Taxpayer ID# 04-2667161) for Peter Lando, Wolf, Greenfield & Sacks, P.C. 600 Atlantic Avenue, Boston, MA 02210.

AMERICAN SUPERCONDUCTOR

American Superconductor, located in Westborough, MA (Rt.495/Rt.9), is expanding its corporate intellectual property group and has an opening for a Patent Attorney. The successful candidate will be a highly motivated team player who can effectively internalize the business objectives and spirit of a rapidly developing, fast-paced, success-oriented and highly principled entrepreneurial company. Completion of law school, registration to practice before the U.S. Patent and Trademark Office, admission to a state bar, and at least 3-5 years of intellectual property, patent drafting and prosecution experience is 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. Excellent written and verbal communication skills including computer literacy are required. Writing samples may be requested. Experience including both patent and technology contracting is preferred. Responsibilities also include drafting and negotiating contracts involving intellectual property, including government contracts.

Please send resume referencing job code PA-BPLA to: American Superconductor, 2 Technology Drive, Westborough, MA 01581; Fax: (508) 366-1057; Email: resumes@amsuper.com

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Corex Technologies develops breakthrough technology for information extraction from the web. We already filed for 8 preliminary patents and plan filing 4-8 additional patents. We are seeking dedicated in-house patent writer to manage the writing and filing of the patents. Depending on candidate's qualifications actual filing might be overseen by our patent lawyer.

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Please send your resume in confidence to our Human Resources Department: Fax: 617-492-6659, mail: Corex Technologies Corp. 810 Memorial Drive 3rd Floor Cambridge, MA 02139, or email: quint@corex.com

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