

BOSTON PATENT LAW ASSOCIATION NEWSLETTER



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Federal Circuit to Visit Boston

Several panels of the Court of Appeals for the Federal Circuit will sit in Boston during the week of October 7, 2002. Currently, seven Federal Circuit Judges are planning to be in Boston.

This is a great opportunity for local practitioners to see the Federal Circuit. The Court's Boston calendar is available at www.fedcir.gov/calendar. Oral arguments will be heard Tuesday October 8 through Thursday October 10 at Boston's Joseph J. Moakley Courthouse.

On Wednesday evening, October 9, the Boston Patent Law Association together with several other bar associations will host a dinner and reception for the Judges at the Federal Courthouse. The event commences with a reception at 6:30 pm followed by dinner at 7:30 pm.



The Boston Patent Law Association's Annual Summer Outing

The Annual BPLA summer Outing, held on July 12, was a sunset cruise. The 50 attendees were treated to a three hour trip around Boston Harbor as well as excellent food and drink.

The evening's weather was superb and great views were enjoyed by all. Selected photographs from the event can be found on page six.



The dramatic facade of Boston's Federal Courthouse as viewed during the BPLA Summer Outing

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President's Message

First of all, I certainly hope everyone had a restful and enjoyable summer. As in previous years, the activity level of the organization was at a relatively low level during the summer as people took time off from their busy schedules to relax a bit. However, we did have a few activities which I would like to report on. Perhaps more importantly, we have a busy fall schedule, and I would like to comment on that as well.

In July, we embarked on a cruise of the Boston Harbor as our traditional summer outing. The cruise left from the Rowes Warf Pier at 6:00 pm on July 12, and returned at about 9:00 pm. We sailed past the USS Constitution, and had a good look at this venerable old vessel on our way back to the dock. From the comments I received, most of the attendees thoroughly enjoyed themselves during the cruise.

The BPLA also participated in a seminar co-sponsored by the Chemistry and the Law section of the American Chemical Society. The seminar was held on August 19, at the Copley Place Marriott, and featured presentations by Art Morgenstern, Peter Corless, Doreen Hogle and Geoff Davis. I would like to extend my thanks and appreciation to BPLA member Art Morgenstern who took the lead in organizing and planning this event, and to all of the participating speakers.

As the Fall season approaches, we have several major events planned, and I wanted to make sure that these events were on everyone's calendar. The two most significant events are the dinner we are hosting for the visiting judges of the Federal Circuit on Wednesday, October 9, and the Annual Meeting scheduled for Wednesday, December 4.

Boston is honored this year to be named as a host city for the Court of Appeals for the Federal Circuit, which will be sitting here to hear oral

arguments in pending cases during the week of October 7. The Federal Circuit will be sitting at the Joseph J. Moakley Courthouse and local law schools during that week. During the visit, we are planning to co-host a dinner and



*BPLA President
William Gosz*

reception for the judges and their staff on Wednesday, October 9, at the Courthouse. The other organizations participating in the dinner include the Federal Circuit Bar Association, the Federal Bar Association, the Boston Bar Association and the Mass. Bar Association. As of this writing, there will be a total of seven CAFC judges in Boston that week. The planned dinner is certainly an excellent opportunity for us to meet with the judges of the Federal Circuit in a relaxed and congenial atmosphere. Please visit the calendar page of our web site at www.bpla.org for more information on the dinner. I would encourage all members interested in attending to make reservations early

as seating capacity at the Courthouse is limited.

On December 4, we will hold our Annual Meeting at the Seaport Hotel in Boston. As in the past, the meeting will include the election of new BPLA officers and directors, and I will be giving a year end summary of activities for the past year. In addition, this year we are privileged to have Under Secretary of Commerce and USPTO Director James E. Rogan as our featured speaker. This will be a wonderful opportunity to hear the views of the new Director, particularly in light of the PTO's recent plans for privatizing some of its key functions. I will be providing more details of the annual meeting as soon as our plans for this event are finalized.

We also have two other seminars currently scheduled for the Fall. On September 26, 2002, the biotechnology committee has scheduled a breakfast meeting at the Omni Parker House in Boston. This meeting will feature presentations by EPO Examiners on new developments at the EPO, and helpful EPO prosecution tips. We thank Doreen Hogle, co-chair of our biotechnology committee, for arranging and hosting this meeting.

On November 6-7, we are co-sponsoring a meeting with the International Society for Law and Technology at the Cambridge Marriott. The BPLA will be providing speakers for a panel discussion to be held during this event. We will post additional details of this event on our web site calendar as they become available.

BPLA MEMBERS WHO HAVE NOT PAID 2002 DUES

Pursuant to the BPLA By-Laws, notice is hereby given of the expiration of memberships granted to the following individuals for failure to pay year 2002 dues. Unless payments are received by the treasurer before July 31, 2002, the following individuals will be removed from the membership roster (the dues payment form can be found on the BPLA Web site).

Gregory Aharonian	Frederick Dietz, III	Eric Henshaw	Barbara McCarthy	Christopher W. Stamos
Jessica S. Andersen	Susan M. Dinsmore	Patricia Hillery	Willial H. McNeill	Michael Paul Stanley
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Carl M. DeFranco, Jr.	Norma E. Hederson	Allison McCabe	Michelle Small	

Joint Boston Patent Law Association and American Chemical Society Seminar

by: Arthur S. Morgenstern

Weingarten, Schurgin, Gagnebin & Lebovici, LLP

On August 19, the BPLA jointly sponsored a seminar with the American Chemical Society (ACS) Division of Chemistry and the Law, during the ACS National Meeting in Boston.

The seminar, which was chaired by Art Morgenstern (Weingarten, Schurgin), drew about 100 attendees and covered a wide range of topics of interest to those in the IP area: Art Morgenstern spoke on revisions in PCT practice resulting from changes at EPO. Patent protection for new chemical technologies was discussed by Peter Corless (Edwards & Angell). Steve Davis (Hamilton, Brook) covered Court of Appeals for the Federal Circuit court decisions in biotechnology. Geoff Davis

(Ropes & Gray) reviewed recent developments in pharmaceutical licensing transactions.

The seminar was followed by a reception to allow networking between the BPLA and members of the ACS's Division of Chemistry and the Law. BPLA Treasurer Doreen Hogle and the ACS Division Chair each offered welcoming remarks at the reception.

This was the first seminar that ACS has co-sponsored with a local patent organization. ACS was very pleased with the program and the turnout and plans to include similar joint seminars with local IP groups as part of its future national meetings.



Art Mogenstern presents at the ACS/BPLA joint seminar

The 21st Century Strategic Plan – a Bold “E”-initiative to Improve the Trademark Office

by: *Andrea A. Jacobs,*
Edwards & Angell, LLP

This year marks the 200th anniversary of the United States Patent and Trademark Office. Along with the celebration came an aggressive top-to-bottom review of the USPTO in an effort to identify new and improved ways for the USPTO to conduct its business. On July 5, 2002 the USPTO unveiled its 21st Century Strategic Plan (the “Strategic Plan”). The Strategic Plan proposes a complete overhaul of the USPTO system, including, patent and trademark application processes, examination procedures, employee hiring and retention policies, quality assurance policies, and fee structures. The key objectives that the USPTO is trying to accomplish through its Strategic Plan are as follows: **1.** Enhance quality by consolidating all quality assurance activities; **2.** Reduce patent and trademark pendency; **3.** Reduce patent application inventory; **4.** Implement a Trademark electronic file management system and begin e-government operations by October 1, 2003; and **5.** Implement electronic patent application processing by October 1, 2004.

A. The Move to an E-Government.

Specifically, with respect to Trademarks, the Strategic Plan contemplates the Trademark Office redesigning its operations to fully implement e-Government in fiscal year 2004 as the primary means of doing business with applicants and registrants, and as the sole means for processing work inside the examining operation. In this regard the Trademark Office has set the following goals: (i) 50% of all new applications are to be filed electronically by September 30, 2002; (ii) 80% of all new applications, Intent to Use and Post-Registration documents are to be filed electronically by September 30, 2003; and (iii) 80% of all communications between the USPTO and applicants and/or registrants are to be completed electronically by September 30, 2004. Additionally, all files handled by the Trademark Office will be electronic files managed by an electronic management system (called the Trademark Information System “TIS”), which is scheduled to be implemented on October 3, 2002. The Trademark Office anticipates that TIS will accelerate processing time and eliminate the potential for lost or missing papers, a problem that for too many years has overwhelmed the Trademark Office.

B. Expansion of the Work at Home Program.

The Strategic Plan also calls for an expansion of the trademark work at home program. Under the Strategic Plan more employees would be included in the program, and the program would be transformed from “work at home” to “hoteling”, whereby employee participants will work 90% of the time out of their home and, therefore, will not maintain permanent personal offices within the USPTO. During the times when such employees will be working at the USPTO rather than home, such employees will reserve an office for the necessary time period. As a result of this program, the USPTO will significantly increase the amount of office space available for other uses and reduce overhead expenses.

C. Improvement to the Quality of Trademark Examination.

In an effort to improve the quality of trademark examination, under the Strategic Plan the USPTO expects to implement the following program

- **In Process Review:** A statistically meaningful sample of all first actions and final actions will be pulled on a continuous basis and reviewed for quality and correctness;
- **Second Set of Eyes Review:** Any proposed substantive refusal of an application filed under a fast track examination option (Option 1 referenced below) will not be issued unless approved by a management level attorney;
- **Certification of Knowledge, Skills and Ability:** The USPTO will implement a program to certify and re-certify on a periodic basis that the examiners and managers possess the knowledge, skills and abilities needed to perform their jobs.

D. Legislative Changes.

Furthermore, implementation of the Strategic Plan contemplates several legislative and rule changes to the Trademark Act and to the Rules of Practice to achieve the following changes in practice: (i) eliminate the signature requirement for all trademark documents; (ii) impose a limitation to the examination of specimens of use submitted with use-based applications, allegations of use and post-registration documents; (iii) provide that for non-U.S. based applications appointment of a domestic representative is permissive, rather than mandatory; (iv) allow the submission of regular, rather than certified, copies of foreign registrations in connection with applications based on Section 44(e); (v) shorten the six-month response time for responding to refusals or for completing requirements, and permit the Director to prescribe these response times through rulemaking; (vi) provide applicants with four different application options (discussed below), depending on the completeness of the application, the fee paid and the priority of response and speed to registration desired; and

continued on the next page

(vii) allow the USPTO to promulgate rules to set fees and fee increases for fiscal year 2003, which exceed the increase in CPI, all at the discretion of the Director.

With respect to changes in the fee structure for trademarks, one significant factor contributing to such fee increases, is the desire to provide applicants/registrants with incentives for electronic filing or disincentives for paper filings. Specifically, the Strategic Plan proposes a \$50 additional per class processing fee for paper documents if an electronic form is available, in addition to lower filing fees for e-filing any document for which an electronic form is available. Additionally, the Strategic Plan proposes lower filing fees for filing "complete" applications (under Options 1 and 2 discussed below). The objective of such fee structure changes under the Strategic Plan is to establish fees according to a market and performance based concept in an effort to reflect more accurately the actual costs associated with the service and value provided. Following is a comparison of the current filing fees with the proposed filing fees for certain trademark filings.

<u>Trademark Filing</u>	<u>Current Fee</u>	<u>Proposed Fee</u>
Trademark Application (paper)	\$325	\$400
Trademark Renewal (paper)	\$400	\$610
Trademark Section 15 (paper)	\$200	\$400
TOTAL	<u>\$925</u>	<u>\$1,410</u>

E. Trademark Application Examination Options.

The multiple examination options, which the USPTO proposes to make available to applicants under the Strategic Plan, provide an applicant with a choice concerning the manner and speed in which an application will be examined. The filing fees increase incrementally with each Option choice set forth below. The four options are as follows:

OPTION 1: Applicants may file a complete application electronically. An application filed under this option will include a likelihood of confusion search conducted by an outside entity, certified by the USPTO. If the applicant complies with all filing and other requirements, its application will be examined on an expedited basis. The first action will be taken within one month, and the notice of allowance or the registration will be issued within six months. Option 1 will have the least expensive filing fee of the four options.

OPTION 2: The same as Option 1, except that the likelihood of confusion search will be conducted by the USPTO, not by an outside certified search service and, therefore, the filing fee for an Option 2 applications will be greater as a result.

OPTION 3: Applicants may file an application electronically, that includes, at a minimum, those elements that are currently required for accordance of a filing date. The USPTO will examine the application for substantive and non-substantive elements. The likelihood of confusion search will be conducted by the USPTO. The first action will be taken within two months and the notice of allowance or the registration will be issued within six months; and

OPTION 4: The same as Option 3, except that the submission would not be made electronically.

F. Conclusion.

Although controversy surrounds the Strategic Plan, it is likely that much of the Strategic Plan, particularly as it relates to Trademarks will pass, the primary reason being the initiative to be one of the first fully operational e-Government agencies. The USPTO, through the recent change to 37 CFR 1.10 taking effect June 23, 2002, has already significantly increased the number of filings being made electronically, and with implementation of the Strategic Plan, the Trademark Office is confident it can be fully operational electronically by the end of 2004.

Photos from the Boston Patent Law Association's Annual Summer Outing



Walter Dawson and guests enjoying the early evening cruise.



On the cruise from left to right: Walter Dawson, Doreen Hogle, BPLA President Bill Gosz, Peter Corless and Mark Solomon

Positions Available

Edwards & Angell, LLP

Edwards & Angell, LLP, seeks patent attorneys, patent agents and technology specialists for our practice in biotechnology, organic chemistry, electronics and computer fields. Please visit our website at www.ealaw.com and send your resume in confidence to jgosnell@ealaw.com.

IP Legal Strategies Group P.C.

Growing IP firm seeks secretaries and paralegals in the areas of patents, trademarks, and technology licensing, to work in our office on Cape Cod, MA. Please send or fax resume to Leslie Meyer-Leon, Esq. at P.O. Box 1210, Centerville MA 02632-1210, or call Karen Herrand at (508) 790-9299.

Patent Attorney/Agent

Biotechnology arts, 3+ years experience. Prefer PhD; Mass and/or other state bar membership; some present practice/clients. Contact Susan Kinnear, Perkins, Smith & Cohen, LLP, skinnear@pscboston.com, with c.v. and a patent sample.

Upcoming Events

October 9 – Reception and dinner for the Federal Circuit Judges.

The Boston Patent Law Association will be hosting a reception and dinner at the Federal Courthouse on Wednesday, October 9, in honor of the visit of the Judges of the Federal Circuit to Boston. The reception will begin at 6:30 pm, followed by a dinner at 7:30 pm. Normal business attire is requested. The cost for the reception and dinner is \$165 per person. Please contact Martina Rozumberkova, Tofias PC, 350 Massachusetts Avenue, Cambridge, MA. 02139, by September 27, 2002, if you plan on attending. If you need further information or have any questions, please call Martina at (617) 761-0527, or email mrozumberkova@tofias.com.

November 6-7 – International Society for Law and Technology.

The BPLA will co-sponsor a meeting with the International Society for Law and Technology at the Cambridge Marriott Hotel. More details will be forthcoming.

December 4, 2002 — Annual Meeting

The Boston Patent Law Association Annual Meeting. The featured speaker for the event is the Honorable James E. Rogan, Under Secretary of Commerce and Director of the United States Patent and Trademark Office. The Meeting will also include the election of new officers and directors. Further details will be provided at a later date.

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President William Gosz, Ropes & Gray, One International Place, Boston, MA, ph (617) 951-7000, fax: (617) 951-7050, wgosz@ropesgray.com

President Elect Peter Lando, Wolf, Greenfield & Sacks, PC, 600 Atlantic Ave, Boston, MA, ph (617) 720-3500, fax: (617) 720-2441, plando@wgslaw.com

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Board

Thomas J. Engellenner, Nutter, McClennen & Fish, LLP, One International Place, Boston, MA, ph (617) 439-2000, fax (617) 973-9748, tje@nutttter.com

Mark Solomon, Hamilton, Brook, Smith & Reynolds, PC, PO Box 9133, Concord, MA, ph (978) 341-0036, fax: (978) 341-0136, mark.solomon@hbsr.com

Lee Carl Bromberg, Bromberg & Sunstein, LLP, 125 Summer Street, Boston, MA, ph (617) 443-9292, fax (617) 973-9748, lbromberg@bromsun.com

Leslie Meyer-Leon, IP Legal Strategies Group, PC, PO Box 1210, 1480 Falmouth Road, Centerville, MA, ph (508) 790-9299, fax (508) 428-1900,

LMeyer-leon@iplegalstrategies.com

BPLA COMMITTEES

ACTIVITIES AND PUBLIC RELATIONS

activities@bpla.org
Martina Rozumbervoka (617) 951-7000

AIPLA MOOT COURT

mootcourt@bpla.org
Christopher Centurelli (617) 542-5070
Merton E. Thompson (617) 542-5070

ANTITRUST LAW

antitrust@bpla.org
Ernie Linek (617) 227-7111
Mark Patterson (508) 457-5050

BIOTECHNOLOGY

biotechnology@bpla.org
Kerry A. Flynn (617) 679-3583
Doreen M. Hogle (978) 341-0036

CAREERS IN IP LAW

careers@bpla.org

CHEMICAL PRACTICE

chemical@bpla.org
Peter F. Corless (617) 439-4444
Maggie Kanter (617) 252-7500

COMMUNITY SERVICE

community@bpla.org
James Cullem (978) 867-2311

COMPUTER LAW

computer@bpla.org
Edward W. Porter (617) 494-1722
Karen A. Buchanan (617) 443-9292

COPYRIGHT LAW

copyright@bpla.org
Charles Gagnebin (617) 542-2290
Thomas M. Saunders (617) 227-0700

CORPORATE PRACTICE

corporate@bpla.org
Walter F. Dawson (978) 452-1971
Faith Driscoll (781) 326-6645

ETHICS AND GRIEVANCES

ethics@bpla.org
Timothy French (617) 542-5070

INTERNATIONAL AND FOREIGN PRACTICE

international@bpla.org
Maria M. Eliseeva (617) 856-8340
Thomas A. Turano (617) 248-7378

LAW STUDENTS

students@bpla.org

LICENSING

licensing@bpla.org
William G. Gosz (617) 951-7000
Karl F. Jorda (603) 228-1541

LITIGATION

litigation@bpla.org
Ronald E. Cahill (617) 439-2782
Matthew Lowrie (617) 720-3500

PATENT LAW

patents@bpla.org
Leslie Meyer-Leon (508) 790-9299
John Prince (617) 535-4000

PATENT OFFICE PRACTICE

patentpractice@bpla.org
Grant Houston (978) 262-0049
David Conlin (617) 439-4444

TRADE SECRETS

tradesecrets@bpla.org
Stephen Y. Chow (617) 854-4000
Richard M. Gelb (617) 345-0010

TRADEMARKS & UNFAIR COMPETITION

trademarks@bpla.org
Cindy Johnson (617) 573-7840
Andrea Jacobs (617) 439-4444

YOUNG LAWYERS & LAW STUDENTS

younglawyers@bpla.org
Lisa Michaud (617) 439-2550
Lesley Hamlin (978) 657-1168

The **Boston Patent Law Association** (BPLA) is an association of intellectual property professionals, providing educational programs and a forum for the interchange of ideas and information concerning patent, trademark, and copyright laws. Through a volunteer Board of Governors and committees, it organizes and hosts educational seminars, social events, and conventions, and comments on rules and legislation impacting the profession. Visit the BPLA at www.bpla.org.

Membership in the BPLA is available to attorneys and other professionals practicing intellectual property law within the Federal First Judicial Circuit (Maine, New Hampshire, Vermont, Massachusetts, Rhode Island, and Connecticut). Applications for membership can be obtained from our web site at www.bpla.org. Full membership for 2001 (available only for attorneys practicing within the First Circuit) costs \$55.00. Associate membership (available to non-attorney intellectual property professionals) costs \$45.00. Mailing list-only affiliation costs \$25.00.

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Editor: Peter Corless

Graphics: Kristen Weller

Contributors: Andrea A. Jacobs,
Art Morgenstern

Letters to the editors and articles are encouraged. Mail all correspondence to:

BPLA Newsletter
c/o Peter Corless
Edwards & Angell, LLP
101 Federal Street, Boston, MA 02110 or
via e-mail at pcorless@ealaw.com

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Boston Patent Law Association
8 Faneuil Hall
Boston MA 02109
Telephone: (617) 973-5021
www.bpla.org

Interested in joining a committee?

Please contact the committee chair if you are interested in joining or switching a committee.