

BOSTON PATENT LAW ASSOCIATION NEWSLETTER



Serving the
New England
Intellectual
Property Bar
Since 1924

March 2003

Volume 34, Issue 1

President's Message

I hope this note finds you all enjoying the new year. I am honored to assume the presidency of the Boston Patent Law Association this year. On behalf of the entire organization, I would like to thank last year's president, Bill Gosz, for his extraordinary efforts on behalf of the organization over the years. I would also like to personally thank Bill for his generous support and friendship – as well as his help in making this transition a smooth one.

Now, just over a month into the new year, we have all read much about structural changes in our local and national legal communities, and, of course, the world of intellectual property continues to introduce change. The consultants and legal industry observers have tried to explain the recent consolidations, and the economic downturn of recent years appears to be at the center of these shifts. As we all know, however, throughout both strong and lagging economies, we can count on our intellectual property laws continuing to evolve.

These changes in IP law, brought on by continuing moves toward global harmonization, improvements in government

efficiency, growth in new technologies, court decisions, or changes in other legislation, challenge us to maintain our currency and to develop new skills. Several of these recent changes include the USPTO's recent Fee Modernization Act (which includes several procedural and fee modifications), the new European design



law, the US adoption of the Madrid Protocol, the tough new corporate disclosure standards and related standards, issues surrounding the Internet, and confusion from the CAFC in some key areas.

This year, the BPLA will continue our traditional focus on education to maintain and improve the skills of our members by offering many opportunities to stay current with these changes. Second, and with an eye towards those less fortunate, we are also introducing opportunities to get involved and assist those in need of legal assistance. Last, we will be providing a wide variety of opportunities to socialize and get to know others who work within our IP and legal communities.

EDUCATION, SERVICE AND COMMUNITY

A wide variety of educational events are sure to provide something for everyone. We kicked off our busy schedule with a luncheon seminar on European Patent Prosecution and Litigation on January 27, hosted by our International and Foreign Practice Committee (a report on that event is provided by Deirdre Sanders, chair of the Committee, in this Newsletter). Upcoming events include: a presentation on valuation of IP assets and new Financial Accounting Standards 141/142 on March 7; a presentation on the
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THE 78TH ANNUAL MEETING OF THE BOSTON PATENT LAW ASSOCIATION

The 78th annual meeting of the Boston Patent Law Association was held on December 4, 2002 at the Seaport Hotel. At the meeting, new BPLA officers and board members were introduced. Past-president William Gosz was honored for his year of excellent service to the organization, and new president Peter Lando addressed the group, emphasizing that the theme for 2003 would be education, service and community. Neil Ferraro of Wolf, Greenfield & Sacks was introduced as the Activities Chair for 2003. Also recognized for their service were the 2002 Boston Patent Law Association committee chairs.

Lee Bromberg, as chair of the BPLA

Writing Competition, awarded the first place prize to Stephen R. Wilson. Second place was awarded to Shannon M. Sidie.

The guest speaker was James E. Rogan, the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office. His Honorable James Rogan was sworn in as Under Secretary of Commerce for Intellectual Property on December 7, 2001 and became the 55th head of the United States Patent and Trademark Office. Judge Rogan manages the USPTO's operations and is a policy advisor to the Bush administration on all domestic and international intellectual mat-

ters. He also co-chairs the National Intellectual Property Law Enforcement Coordination Council, which oversees domestic and international property law enforcement issues among federal entities.

Judge Rogan addressed issues concerning modernizing the USPTO, alleviating the backlog of patent applications awaiting examination, harmonization with foreign patent office procedures and the proposed new fee structure for patent application examination. In particular, Judge Rogan described his efforts to avoid redirection of USPTO fees to other federal agencies.

THE BOSTON PATENT LAW ASSOCIATION ELECTS NEW OFFICERS

At the Boston Patent Law Association Annual Meeting, held December 4, 2002, new Officers and a Board of Governors were elected. The President is Peter Lando of Wolf, Greenfield & Sacks; President-elect is Peter Corless of Edwards & Angell; Vice-President is Doreen Hogle of Hamilton, Brook, Smith & Reynolds; Treasurer is Ingrid Beattie of Mintz, Levin, Cohn, Ferris, Glovsky & Popeo; and the Secretary is Lee Bromberg of Bromberg & Sunstein. The Board members are: William Gosz of Ropes & Gray; Leslie Meyer-Leon of IP Legal Strategies; Mark Solomon of Hamilton, Brook, Smith & Reynolds and Lisa Michaud of Nutter, McClennen & Fish.

Please feel free to contact them with suggestions and comments on BPLA activities.

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ANNUAL MEETING - DECEMBER, 2002



Bill Gosz opens the annual BPLA meeting



The BPLA Officers and Board Members



Lee Bromberg and the winner of the Writing Competition, Stephen Wilson



New BPLA President Peter Lando



His Honorable James E. Rogan



Bill Gosz presents the Patriot's Plate to Mr. Rogan

THE BPLA AND THE VLA JOIN EFFORTS: A NEW PRO BONO COMMITTEE

By Lisa J. Michaud
Nutter, McClennen & Fish, LLP

The Boston Patent Law Association (BPLA) is pleased to announce that we are joining forces with the Volunteer Lawyers for the Arts of Massachusetts, Inc. (VLA) to establish a new BPLA Pro Bono Committee. Lisa Michaud of Nutter, McClennen & Fish is the co-chair of the new committee. While we are still in the early stages of developing the committee, the general purpose of the committee will be to provide members with more information relating to pro bono opportunities in the community. The committee will also address the BPLA's community involvement in civic, charitable and educational events.

The VLA is the only non-profit organization in Massachusetts established to meet the legal needs of the state's artistic and cultural communities. The current VLA was incorporated in September 1989 through the joint efforts of the Boston Bar Association, the Artists Foundation, and the City of Boston's Office of Cultural Affairs. Since the VLA's formal creation thirteen years ago, the organization has assisted over 3,000 artists from all creative disciplines including visual arts, music, literary arts, performing arts, and film and video. The VLA has organized speakers for over one hundred seminars on arts-related legal issues. The VLA has also increased volunteerism in the Bar by outreaching to and training a panel of over 350 attorneys that may not have otherwise regularly volunteered their services through traditional legal services organizations because of the more transactional nature of their practice.

The VLA created four referral options for the attorneys on its panel in order to meet its goals. They are as follows:

The VLA's Direct Legal Services:

The goal of the VLA Direct Legal Services is to provide *pro bono* legal assistance through the use of a volunteer attorney panel to qualifying artists and cultural organizations on arts-related legal issues. The panel's range of expertise includes, but is not limited to, copyright, trademark, patent,

non-profit incorporation, alternative dispute resolution, real estate, and all areas of litigation. Artists are qualified for pro bono service based on their family income. Currently, an artist with a family income of less than \$25,000 would qualify for pro bono service. Arts organizations are qualified for pro bono service based on their operating budget. Currently, an organization with an operating budget of less than \$250,000 would qualify for pro bono service. The VLA's objective is to provide a minimum of 150 pro-bono legal referrals annually. The VLA also offers those clients that do not qualify for pro bono services a reduced fee option. Lawyers interested in assisting the reduced fee clients agree to charge no more than \$30 for the first half hour of service. The lawyer and the clients would then be free to negotiate a fee for any additional services.

The VLA's Educational Services:

The goal of the VLA's Educational Services is to educate lawyers, individual artists and arts organizations on arts-related legal matters. For attorneys, the VLA offers a seminar every two years through Massachusetts Continuing Legal Education (MCLE). For artists and arts organizations, the VLA offers seminars throughout the year called "*The Artist Survival Series*". Examples of previous seminar topics include estate planning for visual artists, non-profit incorporation, copyright, trademark, and immigration. VLA panel attorneys volunteer as lecturers. The VLA's objective is to provide a minimum of six arts-related legal seminars annually in Massachusetts.

The VLA Board Bank:

The goal of the VLA Board Bank is to refer VLA panel attorneys to small and mid-size arts organizations as pro-bono general counsels or board members. This service offers a valuable long-term resource to organizations that would otherwise be unable to access the ongoing support of dedicated legal counsel. The long-term goal of this new option is to assist the organization in building the professional

infrastructure needed for long-term success. The VLA's objective is to provide a minimum of five referrals annually to arts organizations looking for long-term legal support.

The VLA Speakers Bureau:

The goal of the Speakers Bureau is to create a resource of knowledgeable attorneys that are interested in addressing audiences on a wide range of arts-related legal matters. This is a popular referral option for both the arts organizations and the panel attorneys. Many arts schools and arts organizations use the Speakers Bureau to widen the breadth of education courses they can offer their constituents. Program topics cover a variety of areas, including copyright, moral rights, artist live/workspace issues, contract issues, libel, slander, and privacy, non-profit incorporation, issues for independent filmmakers, dance community issues, arts in the electronic age, multimedia contracts, taxes for artists, and estate planning for artists. The VLA's objective is to refer a minimum of six lawyers from the VLA panel annually as speakers.

By collaborating with the VLA, the new BPLA Pro Bono Committee members will become VLA panel attorneys and thus be able to participate in all four referral programs. Once on the panel, the BPLA will receive a bimonthly email that lists all pro bono opportunities. The Pro Bono Committee will also work in conjunction with the VLA to provide training in a variety of arts-related legal issues to attorneys who wish to handle cases outside of their areas of expertise.

Please check the VLA's website in the upcoming months for more information relating to the new Pro Bono Committee, and the BPLA's collaboration with the VLA. Also please see the VLA website at www.vlama.org for more information about the VLA and its programs.

SEMINAR ON “EUROPEAN PATENT PROSECUTION & LITIGATION PRACTICE TIPS”

By Deirdre E. Sanders, Hamilton, Brook, Smith & Reynolds, P.C.

On Monday, January 27, 2003, the International Law Committee of the Boston Patent Law Association held a lunchtime seminar on “European Patent Prosecution & Litigation Practice Tips” at the Hampshire House in Boston. The seminar featured European prosecution and litigation practitioners David Barron and Patrick Lloyd.

The first speaker was Mr. Barron, who is a partner at the U.K. law firm Wragge & Co. His practice area is patent and trademark litigation, and he is experienced at coordination of litigation strategies around Europe, with direct litigation experience in the United States, Canada and a number of countries throughout Europe. Mr. Barron spoke regarding strategies and tactics for patent litigation in Europe. He began the presentation with a general discussion of European harmonized law and the different procedures, approaches, weapons, timing and costs among countries in Europe. He then provided a country-by-country analysis of the most important features of litigating in the United Kingdom, Germany, France, Italy and the

Netherlands, including ways to obtain discovery for use in European litigation.

Mr. Barron also discussed strategies to obtain stays, “torpedoes” and other procedural devices to stall litigation, and strategies to avoid them. He also gave advice regarding European oppositions and pan-European injunctions. He ended his talk with a discussion of potential changes in European litigation systems.

The second speaker, Patrick Lloyd, is a Chartered Patent Agent and European Patent Attorney and partner at the U.K. patent and trademark firm Reddie & Grose. His practice area is patent prosecution in the electrical and electronic arts, including communications, broadcasting, software and business methods. Mr. Lloyd spoke about a number of aspects of EPO patent practice, including avoiding prosecution pitfalls, and patenting software and business methods. With regard to priority claims from provisional patent applications, Mr. Lloyd emphasized the need to provide an enabling disclosure, and he cautioned that anything less than a full patent specification may not be safe to rely upon

for a valid priority claim. He then discussed considerations for avoiding added matter objections when making broadening and narrowing amendments under European practice. Mr. Lloyd also gave advice for EPO claim drafting, including ways to reduce costs and increase speed of prosecution in the EPO by reducing translation costs and avoiding excessive claim fees. He also discussed important considerations specific to software and business method prosecution, including patentability of software and business method inventions in Europe and claim drafting tips and techniques.

Jonathan M. Davies was also available to answer questions. Mr. Davies, a Chartered Patent Agent and European Patent attorney in the Chemistry and Chemical Pharmacology field, is also a partner at Reddie & Grose.

Copies of materials from this seminar are available by contacting Deirdre Sanders at deirdre.sanders@hbssr.com, or by contacting any member of the BPLA board.

UPDATE TO 2002 AUSTRALIAN PATENT LAW CHANGES

By Doreen M. Hogle, Hamilton, Brook, Smith & Reynolds, P.C.

The Australian Patents Act was amended effective April 1, 2002. The new provisions significantly affected the scope of the duty to disclose prior art, and the novelty and inventive step requirements.

An expanded duty of disclosure requires an applicant to disclose to the Australian Patent Office (APO) the results of any documentary searches conducted for the purposes of assessing the patentability of an invention disclosed in the Australian application, or in a corresponding application filed outside Australia. This includes, for example, the results of searches conducted by foreign patent offices, the applicant, or the applicant’s counsel. The requirement relates to searches conducted to determine the patentability of an invention *disclosed*, not necessarily claimed, in the application. Moreover, this

expanded duty of disclosure is ongoing until the grant of the patent.

For pending Australian applications (all cases not accepted prior to April 1, 2002), the search results must be disclosed to the APO: 1) at the time of requesting examination; 2) before January 1, 2003; or 3) within six months of the relevant search being completed (which date can be after the date of grant), whichever is the latest of these three dates.

Unlike the practice in the United States, copies of the documents listed in the search results are not required. In addition, the relevance of the documents is not the controlling factor; all results must be disclosed, even if the underlying documents are not particularly relevant to the invention.

There are adverse consequences for

non-compliance with the duty of disclosure. Specifically, an applicant will not be able to amend a claim post-grant to overcome a reference if the reference was not properly disclosed to the APO. Thus, failure to comply with the disclosure provisions may bar a post-grant amendment to remove a ground of objection based on lack of novelty and/or lack of inventive step.

The new duty of disclosure does not apply to cases in which modified examination is, or has been, requested. If a request for modified examination is made, the Australian application must be amended into conformity with a corresponding patent granted in the U.S. or other major jurisdiction, and a certified copy of the granted patent must be submitted to the APO. Under the modified examina-

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PRESIDENT'S MESSAGE

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New England economy on March 28, featuring Cathy Minehan, President of the Boston Federal Reserve Bank; a presentation on IP strategies on April 11 with Kevin Revette (co-author of "Rembrandts in the Attic") of the Boston Consulting Group, and Harry Gwinnell, Vice-President, Chief Intellectual Property Counsel, Cargill, Inc.; and a seminar on ADR procedures with Maria Walsh and others from JAMS on May 7. Also, among other events already planned this year, is the annual PCT seminar presented by WIPO representatives. This year, an advanced program will be held on October 16 – 17 (and we understand that there will be new forms and procedures discussed). These, and other events, are described in this Newsletter's Calendar of Events. Keep an eye out for more details and more events.

In addition to traditional efforts to keep our members informed of IP happenings, this year, the BPLA has adopted a plan to reach out and serve those with needs for our skills within our community. Our Pro Bono Committee is up and running – chaired by our newest Board member, Lisa Michaud. As the membership has been notified, the BPLA has established ties with the Volunteer Lawyers for the Arts (VLA). As many of you may know, the VLA offers legal assistance to artists, musicians, and others in the arts community in need of simple agreements and the like. Being IP attorneys, we are uniquely qualified to assist those in need, and it may provide a wonderful opportunity for some to get involved with copyright matters or to provide basic contract assistance. Our Pro Bono Committee will be responsible for channeling pro bono opportunities to our members through e-mail and postings on our website – www.bpla.org – on a periodic basis.

We also hope that the Pro Bono Committee will bring other, less typical "pro bono" opportunities to your attention, such as lecturing at local business or engineering schools, serving as a moot court judge, or providing career counseling. These and

other opportunities will make this an exciting new committee for the BPLA, and it is my hope that many of you will get involved. (You can learn much more about this effort in this Newsletter or by contacting Lisa Michaud directly.)

In addition to these efforts, the organization will be planning to have several "social" events – including a few surprises – taking advantage of our many cultural venues in the area to get to know one another better and share experiences as a community. A first such event is planned at the New England Aquarium on February 28.

The Annual Judges' Dinner is perhaps the grandest of the organization's social events. This year the Dinner will be held on Friday, May 16 at the Boston Harbor Hotel's Wharf Room overlooking the Harbor (and the Federal Courthouse). Of course, we will have our local federal judges join us. In addition, this year we are fortunate to have Benjamin Zander, Conductor of the Boston Philharmonic Orchestra and co-author of a wonderful book titled "The Art of Possibility" speak to us on just that . . . "possibilities"! Ben Zander will be entertaining us with his unique style (and, of course, a piano!) while speaking to us on personal and organizational leadership and management (for which he has been profiled throughout major media outlets, including the TV news show "60 Minutes," the BBC, and most recently in the *Washington Post*). As any of you who know Ben Zander will agree, this promises to be an exciting and fun event.

OK, that's it – **EDUCATION, SERVICE, COMMUNITY** – and an exciting year ahead. Now we need you all to get involved. As a first order of business of your own, please send in your annual membership dues at your earliest convenience. Remember that many of our events are heavily discounted for members – some discounts are even more than the annual dues! As the saying goes, "membership has its rewards"!

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UPDATE TO 2002 AUSTRALIAN PATENT LAW CHANGES

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tion procedure, grant of the Australian patent is virtually automatic.

Subsequent to implementation, the Australian Patent Office was overwhelmed with search report submissions, and quickly recognized that there were substantial practical problems associated with the new requirement. Amending legislation has now been introduced in the Australian Parliament that would limit the types of search reports that must be submitted. Unfortunately, as a result of Parliamentary delays, the new legislation has yet to be approved. Parliament has, however, extended the deadline for submission of search reports from January 1, 2003 to June 1, 2003. It is hoped that by the time this June deadline arrives the amending legislation will be approved, with the result that only submission of a list of documents from search reports for corresponding applications will be required.

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BPLA DUES REMINDER

This is a notification that dues for the 2003 calendar year were due February 1, 2003. If you have not already submitted your dues, you are now subject to the late fee. Please download the membership renewal form from the website, and remit with your dues payment and late fee to the BPLA Secretary, Lee Bromberg, no later than March 31, 2003 in order to remain an active BPLA member. Thank you for your cooperation.

UPCOMING EVENTS

Valuation of Intellectual Property Assets and New Financial Accounting Standards 141 & 142.

March 7, 2003. LeMéri-dien Hotel, 250 Franklin Street, Boston, MA 02110, 617.451.1900. Seminar Hours are 11:30 A.M. – 2:00 P.M. The Statement of Financial Accounting Standards 141 and 142 (SFAS 141/142) have been referred to as two of the most significant changes in accounting in the past 20 years. These new standards provide specific guidance on how intangible assets, including patents, copyrights, trademarks and trade secrets, should be accounted for in connection with corporate balance sheets, annual reports, and mergers and acquisitions. Valuation of these assets will become closely watched and conventional financial statements will take a back seat. Participants will learn: *The need to communicate IP value to shareholders.

* Strategic issues being addressed by legal and financial professionals in connection with the implementation of these new standards. * Business and financial documents frequently requested during the discovery process in intellectual property disputes. * How documents related to the implementation of these standards may be used in the quantification of damages and royalty rates. Please contact Neil Ferraro, Wolf, Greenfield & Sacks, 600 Atlantic Ave. Boston, MA 02210, Tel.: (617) 720-3500, Fax: (617) 720-2441, or Email: nferraro@wolfgreenfield.com. The cost is \$80.00 for Members, \$95.00 for Non-Members and \$65.00 for Students.

New England Economic Outlook.

March 28, 2003. Federal Reserve Building. Cathy Minehan, President of the Boston Federal Reserve Board will speak to the Boston Patent Law Association regarding her views of the economic landscape of New England. Details will follow.

Intellectual Property Strategies. April 11, 2003. Guest speakers Kevin Rivette (co-author of "Rembrandts in the Attic") and Harry Gwinnell (Vice President, In-

tellectual Property, Cargill) will present their views on maximizing value of intellectual property portfolios. Details will follow.

Chemical Practice Tips.

April 29, 2003. The Chemical Practice Committee of the Boston Patent Law Association will offer current views on chemical practice. Details will follow.

Alternative Dispute Resolution.

May 7, 2003. Maria Walsh of JAMS will host a panel discussion regarding the benefits and issues surrounding alternatives to litigation. Details will follow.

Judges Dinner.

May 16, 2003. The Boston Patent Law Association will honor the judges of the Federal Court. This year's event will take place at the Boston Harbor Hotel Wharf Room and will feature a unique guest speaker. Details will follow.

Computer Law.

May 28, 2003. The Computer Law Committee will host a presentation regarding hot issues surrounding the practice of computer law. Details will follow.

New European Design Law.

June 17, 2003. The International Practice Committee will host a presentation on the new European Design Law. Details will follow.

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 cost \$100.00 per issue.

If you wish to submit an advertisement for publication in the next issue, please forward ad copy to :

doreen.hogle@hbsr.com. Please send check (made payable to Boston Patent Law Association, Taxpayer ID #04-2667161) to Doreen M. Hogle, Hamilton, Brook, Smith & Reynolds, P.C., P.O. Box 9133, Concord, MA 01742.

WRITING COMPETITION

Sponsored by the
Boston Patent Law Association

1st Prize: \$750

2nd Prize: \$250

The BPLA is once again holding its annual Writing Competition. Law students are encouraged to submit papers on a subject relating to intellectual property law, written or published between August 1, 2002, and July 31, 2003.

CONTEST RULES:

• 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 Federal Judiciary Circuit or prepared in connection with a course at a law school situated in the First Circuit.

• Articles must be submitted to the Boston Patent Law Association on or before July 31, 2003.

• Papers should be no more than the equivalent of ten (10) law review pages including footnotes (30-40 pages typed copy).

• Submission of five (5) copies is required.

• Submissions must include the submitter's name, current address, current telephone number, law school and employment information, if applicable.

Judges will consider the merits of the article as a contribution to the knowledge respecting intellectual property law and the extent to which it displays original and creative thought or information not previously published or available.

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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 2003 (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.

The BPLA Newsletter is published four times a year by the Boston Patent Law Association. Articles appearing in the newsletter represent the views of the authors and do not necessarily carry the endorsement of the BPLA.

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Interested in joining a committee?

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