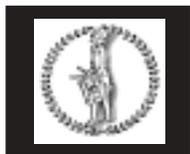


BOSTON PATENT LAW ASSOCIATION NEWSLETTER



Serving the
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Since 1924

August 2003

EDUCATION, SERVICE, COMMUNITY

Volume 34, Issue 3

President's Message

I hope this note finds you all enjoying summer, taking some time to rest, enjoying friends and family, and perhaps reading a good book.

Although the organization has taken a short break from its seminar schedule this summer, we have remained busy scheduling several informative events beginning next month through the end of the year. In addition, we have planned an enjoyable social event for late September. We have continued to establish ties to the Volunteer Lawyers for the Arts, channeling VLA case summaries and opportunities to get involved to members of our Pro Bono Committee. Finally, we have also improved the organization's website (www.bpla.org) to be more useful and easier to navigate (please remember the username and password: attorney/minuteman). Among other things, from the website, you can review and edit your personal information, or view your current BPLA committee memberships.

Before I describe what's been planned, I would like to briefly summarize the events that have taken place since our last Newsletter. At the top of the list is this year's Judges' Dinner. The truly special evening was held on May 16 at the Boston Harbor Hotel's Wharf Room. Ben-

jamin Zander, conductor of the Boston Philharmonic Orchestra, was our guest speaker. He presented (with stories, music, and leading us all in song) for over two hours on the very positive message outlined in the book "The Art of Possibility," which he co-authored with his wife Roz Zander (who also joined us later in the evening). Our honored guests from the Federal Judiciary included Judges Harrington, Zobel, Gorton, Saris, and Niemann from the Massachusetts District



Court. Also present was our special guest James Grace, Director of the Volunteer Lawyers for the Arts. I would like to once again thank my friends and (former) col-

leagues Meghan Haggerty, Audra Callanan, Sara Crocker, and Neil Ferraro for their tireless effort in making this year's Dinner a memorable one.

This past spring we also continued to offer a variety of educational events. On May 7, the BPLA sponsored a program on Alternative Dispute Resolution with Maria Walsh and Jerry Cohen from JAMS. The speakers provided strategies and experienced insight into the benefits of mediation to resolve intellectual property disputes. The upcoming implementation of the Madrid Protocol was the topic of a well-attended breakfast program held on June 5. USPTO Deputy Commissioner, Lynne Beresford presented the latest updates on the Madrid Protocol rules, and offered practice tips as we all await this new international trademark filing regime. Finally, on June 17, there was an interesting presentation on a new intellectual property right -- the new European design law. The presentation by Roy Marsh and Peter Wiedemann, from the Munich based firm Hoffmann-Eitle, was very informative and provided filing details and strategies. (in-depth reports, and details on getting more information, about each of these events are provided in this Newsletter.)

Now for what's planned. On September
continued on p. 4

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79TH ANNUAL JUDGES DINNER

By Neil Ferraro

Mark Winsor started that day like any other. Like some of us, he sent his children off to school, went to work and looked forward to an evening out with his wife and friends at the Boston Harbor Hotel. Mark, whose birthday was May 18, thought little about the connection between attending the BPLA's Annual Judges Dinner and his Birthday. Yet Benjamin Zander, our guest speaker and world-renowned conductor of the Boston Philharmonic Orchestra, led nearly 180 people in song wishing Mark a passionate and heartfelt Happy Birthday.

Benjamin's message: anything is possible.

This year, the BPLA held its 79th Annual Judges Dinner at the Wharf Room of the Boston Harbor Hotel. The evening was well attended by the judges of the

Federal Court, honored guests, members, spouses and friends. The Honorables Edward Harrington, Rya Zobel, Patti Sarris, Nathaniel Gorton and Kenneth Niemann attended. Special guest Jim Grace, director of the Volunteer Lawyers for the Arts was also present. Benjamin's wife and co-author, Rosamund Stone Zander, joined us for dinner.

Despite having flown in from Minnesota that afternoon, suffering from an agonizing shoulder injury, through his boundless energy, Ben Zander delivered a truly inspirational talk. For nearly two hours, he mesmerized the audience, speaking of the power of possibility, playing selected pieces of classical music and delivering provocative messages through stories. At one point, Mr. Zander looked over at Peter Lando and asked whether he had

a few more "moments" for just one more story. I happened to look at my watch and noticed it was 8PM. When he was finished speaking, he taught us all to sing (and appreciate) "Ode to Joy" - in German! By now it was 8:30, but it was as though time stood still.

After the program, the attendees enjoyed a wonderful dinner filled with enthusiasm and chatter undoubtedly reflecting on the messages delivered. A copy of the Zander's co-authored book, "The Art of Possibility" or Mr. Zander's CD, "Mahler's Symphony No. 5" was placed at each table setting. Guests took advantage of the authors' willingness to speak to them individually during dinner and to autograph their books and CD's.

Attendees had a good evening - no, a perfect evening!



Jim Grace (VLA Director) Michelle Lando Benjamin Zander



Benjamin Zander Jim Grace Michelle Lando Renee and Neil Ferraro Kenneth and Jan Niemann (l-r)



Leslie Meyer-Leon, Hon. Nathaniel Gorton, Hon. Edward Harrington, Hon. Kenneth Niemann, Jan Dummond Niemann, Hon. Rya Zobel (l-r)



Benjamin Zander

79TH ANNUAL JUDGES DINNER



Lisa Michaud, Kevin Cronin, Jennifer Karnakis, Christina Karnakis, Kristin Konzak (l-r)



Tim Murphy, Pam Bromberg, Lee Carl Bromberg, Steve Henry, Carol Henry (l-r)



Ellen Harrington and Hon. Edward Harrington



Michelle Lando, Neil and Renee Ferraro



Audra Callanan (L) and Sara Crocker (R), whose tireless help made the event an evening to remember, with BPLA President, Peter Lando, and guest speaker, Benjamin Zander



Hon. Patti Saris (center) with Hon. Kenneth Niemann (R) and Jan Dummond Niemann (L)

79TH ANNUAL JUDGES DINNER



BPLA President, Peter Lando



Donna Hieken and Benjamin Zander

PRESIDENT'S MESSAGE

(cont. from p. 1)

ber 3, the BPLA will host a presentation on electronic patent filings (you should have received an announcement by now) at the Seaport Hotel. Our speaker is Maria Eliseeva, who serves as the Chair of the AIPLA Committee on Electronic Business, Automation and Harmonization of Standards.

The annual BPLA Advanced PCT Practice Seminar is scheduled for October 16-17 at the Omni Parker House. We are fortunate to have Louis Maassel from WIPO, Carol Bidwell from the USPTO,

and David Reed from Procter & Gamble, offer their perspectives on new rules and forms required in PCT practice.

Our organization's committees will be offering other programs this year covering the latest happenings from the USPTO in chemical and biotech matters, licensing and litigation topics. Keep an eye out for these and other events on our website, mail, and e-mail announcements.

Finally, I would like to make you all aware about our next BPLA social event for members and their families. The

BPLA Fall Festival will be held on Saturday, September 27, 12:00-3:00 at the Nashoba Valley Winery and Orchard, in Bolton, MA for picnicking, apple picking and wine tasting. Details to be announced soon! In the meantime, to learn more about the Winery and Orchard, visit their website at: www.nashobawinery.com.

Thanks - I look forward to seeing and meeting you soon at an upcoming event!

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MADRID PROTOCOL

By Cynthia Johnson Walden

Lynne Beresford, Deputy Commissioner for Trademark Examination Policy at the United States Patent and Trademark Office, spoke to the BPLA Trademarks and Unfair Competition Committee on June 5, 2003 at the World Trade Center/Seaport Hotel. Ms. Beresford spoke about implementing the Madrid Protocol in the United States, including a survey of the basics of the Madrid Protocol, changes in registration practice, and an evalua-

tion of some of the risks and benefits under the Madrid Protocol. Ms. Beresford highlighted that while the Madrid Protocol is not a one-stop international registration system, it does offer one-stop filing, in English, and it is ultimately cheaper and easier to maintain foreign registrations through the centralized WIPO system. She pointed out that an important consideration to remember is that the rights stemming from a Madrid Protocol filing are dependent of the country-of-origin basis

application for five years, although transformation to a national application is possible. Ms. Beresford also discussed some of the proposed implementation rules, including the filing requirements, priority claims, electronic application form, and fees. Ms. Beresford urged those who will be making Madrid Protocol filings to obtain the "Guide to International Registration of Marks" by WIPO (see www.wipo.int/madrid/en/).

TRADEMARK NEWS POTENTIAL BAN ON GEOGRAPHIC NAMES TO DESCRIBE FOOD AND WINE

By Doreen M. Hogle

The European Union is expected to call for a ban on the use of certain generic terms to describe food and wine when members of the World Trade Organization (WTO) meet in September. The EU first raised this proposal in 1999, but has stepped up its efforts to gain acceptance of such a ban. At the recent World Intellectual Property Organization meeting held in San Francisco, the EU (representing 15 European countries) indicated that they have now compiled an initial list of 40 names to be included on a proposed worldwide register. Terms such as "burgundy", "Chablis", "champagne", "feta", "parmesan", "tequila", "Dijon" and "Darjeeling, known as geographic indications or GIs, could be affected. The EU believes that these geographical indications are not sufficiently protected. If the EU's proposal were ap-

proved, only food and drink products that are produced in that specific region would be entitled to use the name.

The USPTO opposes the formation of a mandatory register. As reported at NEWS@USPTO:

"It is more than a culinary debate. Geographical indications are valuable intellectual property rights," said James E. Rogan, Under Secretary of Commerce for Intellectual Property, in his opening address to symposium participants. "There are two problems, really: Americans can't get their GIs protected overseas, and Europe is demanding that we stop using common terms like 'parmesan.' This really strikes us as unfair. Why shouldn't Americans be able to eat a bologna sandwich or have a glass of chablis? And why should U.S. Trademarks be jeopardized because some countries think they should have exclusive rights to use words like 'parmesan'

or 'feta'?"

It is still uncertain whether the EU would be able to muster support for the proposed register. US food and wine industry organizations are very much opposed to the register. They describe significant economical costs based on potential loss of valuable trademarks and brand recognition and the need to redesign packaging, and revise marketing strategies. Hearings were recently held before the House Agricultural Committee on Geographical Indications to report on the issues.

There is even some dissension among the 15 members EU. While in theory all of the members favor the initiation of a world register, there are reports of internal dissension over the rights to specific GIs. It is reported that Greece, Denmark and France all claim the rights to the "feta" name.



NOTICE TO ALL BPLA MEMBERS WHO HAVE NOT YET PAID THEIR 2003 DUES

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 Treasurer, Ingrid Beattie, in order to remain an active BPLA member. Thank you for your cooperation.

ALTERNATIVE DISPUTE RESOLUTION

By Neil Ferraro

Every day, more individuals and companies are realizing the benefits of alternative dispute resolution (ADR). It can save time, effort, aggravation, stress and money. This equitable process gives participants greater control over the case and how it will be resolved. It also provides a confidential forum for resolving disputes among a few parties, or among many.

These features are especially beneficial in the realm of intellectual property disputes. The parties efficiently come to agree on a baseline of relevant science and engineering and related commercial facts to isolate and efficiently resolve the intellectual property rights remaining in dispute.

Maria Walsh and Jerry Cohen were the guest speakers at a BPLA luncheon on May 7, 2003 at the Seaport Hotel and

gave their insights to the ADR and Mediation process.

Ms. Walsh and Mr. Cohen spoke of the advantages of ADR and Mediation, including reduced cost and time and most notably, increased control over your client's matter. Participants can choose the arbitrator or mediator, choose the rules of the process such as discovery, maintain confidentiality, set schedules, and design unique remedies. Ms. Walsh and Mr. Cohen stressed that the process and outcome are limited only to the participants' creativity.

The speakers also highlighted the role of the mediator. An effective mediator should not evaluate a case. Rather, she or he should winnow down the facts that are in dispute and identify weaknesses or risks in each party's case. The parties settle, not necessarily on the strengths of their case,

but on the potential downside of exposure.

To take advantage of ADR or Mediation in potential intellectual property disputes, such as disputes over a license, contracts should be written with well-defined arbitration or mediation clauses. Ms. Walsh invited the audience to visit the JAMS website at www.jamsadr.com for exemplary clauses.

Mr. Cohen ended the session with a discussion on becoming a mediator. He referenced several sources, including a highly recommended course offered each year by the AIPLA. See www.aipla.org.

A limited number of presentation materials are available from Neil Ferraro (nferraro@wolfgreenfield.com). Additional materials may be obtained from Ms. Walsh (mwalsh@jams.com)

EUROPEAN DESIGN LAW

By Neil Ferraro

This year, the European Union has brought into operation a designs registration regime to join the existing (and successful) pan-European patents and trademark registration regimes.

Roy Marsh and Peter Wiedemann from Hoffmann · Eitle (Munich) were the guest speakers at a BPLA luncheon on June 17, 2003 at the Hampshire House regarding this new regime.

By the passing of European Union Council Regulation 6/2002 (the "Designs Regulation" or "DR") the Office for Harmonisation in the Internal Market (OHIM) has the additional duty of receiving applications for design registrations and issuing Community-wide design registration certificates. The effect of these design registrations will extend automati-

cally to joining countries, as they enter the European Union, so the registrations will initially cover 15 countries but will cover from May 1, 2004 a total of 25 countries, and a community of more than 450 million people.

Under this new regime, designs are to be protected to the extent that they are "new" and have "individual character." A design is to be considered as new "if no identical design has been made available to the public" and, for infringement purposes, designs are to be deemed to be identical "if their features differ only in immaterial details." To discover whether a design has individual character one must investigate "if the overall impression it produces on the informed user differs from the overall impression produced on such

a user by any design which has been made available to the public".

These registrations are powerful rights. With the payment of just four successive renewal fees, one every five years, the design registration can have a maximum term of protection of 25 years from filing date. They are true, patent-like monopolies, for which independent conception is no defense to infringement.

A limited number of presentation materials are available from Neil Ferraro (nferraro@wolfgreenfield.com). Additional materials may be obtained from Mr. Roy Marsh (rmarsh@hoffmanneitle.com) or Mr. Peter Weideman (pweidemann@hoffmanneitle.com).

UPCOMING EVENT

United States Patent and Trademark Office Boston Road Show

On Friday, November 21, 2003, the Chemical Practice and Biotechnology Committees are hosting a group of five senior Examiners from the United States

Patent and Trademark Office Group 1600 who will address selected patent prosecution topics. The seminar will be held at the Wharf Room of the Boston Harbor

Hotel and will include a buffet lunch. Further details will be provided to all members in October.

UPCOMING EVENTS

Conducting Business Electronically With the USPTO and WIPO

September 3, 2003, Seaport Hotel,
Boston, MA

The USPTO and WIPO now welcome and encourage conducting business electronically. Many transactions traditionally performed by mail can now be performed electronically and such transactions are not limited to e-filing of patent applications.

Join us for an informative session on electronic transactions now available at the USPTO and WIPO. Participants will learn how to file the following and other submissions:

- Utility and Provisional Applications
- Pre-Grant Publications
- Information Disclosure Statements
- Assignments

The session will also cover:

- The use of PAIR (Patent Application Information Retrieval) System Interchanges, Private and Public
- Rules for Mandatory Electronic Submissions to the USPTO
- Rule on e-IDS and Paper IDS Submitted on the Same Day
- Electronic Submission Procedures, Overview of Available Private Vendors' Authoring/Submission Tools
- Electronic Document Recordation
- Useful Tools and Tips

Maria Eliseeva of Houston Eliseeva, LLP will present this session on conducting business electronically with the USPTO and WIPO. Ms. Eliseeva is the Chairperson of the AIPLA Committee on Electronic Business, Automation and Harmonization of Standards and is one of the top e-filers in the US. Ms. Eliseeva, who is bilingual in English and Russian, holds graduate degrees in physics and materials science and serves clients in a wide variety of technology areas.

Price:

\$50.00 members

\$65.00 non-members

\$35.00 students

Please reserve early -- space is limited.

Please visit www.bpla.org for more details.

BPLA Fall Festival September 27, 2003 Nashoba Valley Winery Bolton, MA



The Officers and Board of Governors invites you and your family to join us at Nashoba Valley Winery and Orchard for picnicking, apple picking and wine tasting. Please mark your calendar! Details will follow.

Advanced PCT Practice Seminar October 16-17, 2003, Omni Parker House, Boston, MA

This 2-day educational seminar is designed for patent attorneys, patent administrators, patent agents, patent paralegals and others seeking an in-depth understanding of the Patent Cooperation Treaty (PCT). The seminar will focus on the PCT, including the rules of practice under Chapters I and II, and it will cover the material from the filing of the original PCT application, through International search, publication, preliminary examination and entry into the National/Regional stage.

Strategies for use of the PCT as part of a comprehensive program for protection of patent rights in the U.S. and foreign countries will also be addressed, with particular attention to issues of importance and concern to U.S. practitioners.

Speakers: Louis O. Maassel, consultant to the PCT Legal Division of the World Intellectual Property Organization; Carol Bidwell, supervisor for the Office of PCT Legal Administration of the U.S. Patent & Trademark Office; and David Reed, manager Global Patent Services, Procter & Gamble Corp.

Price \$395 members

\$495 non-members

Please visit www.bpla.org for more details.

POSITIONS AVAILABLE

CANTOR COLBURN LLP ATORNEYS WANTED

Cantor Colburn LLP seeks attorneys with 2-5 years experience in preparation and prosecution of patent applications for our Connecticut and Michigan Offices. Candidates must have a technical background, preferably in Chemistry, Chemical Engineering, Material Science, Mechanical Engineering or Electrical Engineering. Send resume in confidence to Judi Aidukonis, Cantor Colburn LLP, 55 Griffin Road South, Bloomfield, CT 06002, jaidukonis@cantorcolburn.com.

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Boston office of a large international law firm seeks IP attorney with Electrical Engineering background, strong academics and 2-6 years high-level experience in patent prosecution in the electrical/software/business methods arts. Position to include drafting, prosecuting, and managing U.S. and foreign patent applications, preparing opinions, and conducting IP due diligence for M&A and financing transactions. For more information, please contact: Joan Tagliareni at 617-535-4450 or jtagliareni@mwe.com and mention this posting

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