

# Boston Patent Law Association Newsletter

*Serving the New England  
Intellectual Property Bar  
Since 1924*



December 2004

## **The BPLA Board Members:**

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## **Special Interest Articles:**

- 2004 Caselaw Roundup
- BPLA Submits Amicus Curiae Brief In Phillips

## **Individual Highlights:**

Annual Meeting	1
President's Message	2
BPLA Submits Amicus Curiae Brief In Phillip	5
2004 Caselaw Roundup	6
Practice Before the Court of Appeals for the Federal Circuit	11
BPLA Information	13

## **80<sup>th</sup> Annual Meeting of the Boston Patent Law Association - Tuesday, December 14**

The 80<sup>th</sup> Annual Meeting of the Boston Patent Law Association will be held at a luncheon at the Seaport Hotel on Tuesday, December 14, 2004. Registration begins at 11:00 a.m.

The Annual Meeting is a time to reflect on the events of the past year and see a preview of the upcoming activities for 2005, so please join us as we gather and meet with old friends and make new ones.

This year, we are particularly honored to have the Honorable Alan D. Lourie, Circuit Judge, United States Court of Appeals for the Federal Circuit, us as our Keynote Speaker.

Judge Lourie has been Circuit Judge for the U.S. Court of Appeals since his appointment by

President George Bush in 1990. He was born in Boston and educated at Harvard University (A.B.), University of Wisconsin (M.S.), University of Pennsylvania (Ph.D.) and received his J.D. from Temple University.



His early career was spent working as a chemist for Monsanto Company and Wyeth Laboratories. After graduation from Temple, he became the associate director of Corporate

Patents and rose to Vice President, Corporate Patents and Trademarks and Associate General Counsel at SmithKline Beecham Corporation -- a position he held until his appointment to the U.S. Court of Appeals.

During his tenure at SmithKline Beecham, Judge Lourie also served and held positions on patent advisory committees and associations including the Presidency of the Philadelphia Patent Law Association from 1984 to 1985.

## President's Message



Peter Corless, President

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*"As the year draws to a close, I wish to sincerely thank the membership for the opportunity to serve as President of the Boston Patent Law Association."*

I look forward to our final event of this year: the Boston Patent Law Association Annual Meeting and Luncheon on December 14 at the Seaport Hotel. I am extremely pleased that Judge Alan Lourie of the Federal Circuit will join us and provide his thoughts on current intellectual property issues.

One of the first events of this year – the USPTO Boston Road Show on Chemical and Biotechnology Patent Practice – was considerably more challenging organizationally than our upcoming Annual Meeting and Luncheon.

Although we had initially received a commitment from five PTO Technology Center 1600 officials to present the Road Show, we were later advised by the Patent Office that, as a condition for the PTO officials to travel to Boston, the BPLA had to be certified by the Internal Revenue Service as tax exempt under section 501(c)(3) of the Internal Revenue Code.

Apparently, certain Congressional officials believed that Patent Office employees were embarking on too many speaking engagements.

To thus limit trips away from the Patent Office, a rule was imposed that Patent Office representatives could only receive reimbursement for travel expenses from organizations that have 501(c)(3) tax exempt status. The Boston Patent Law Association however cannot qualify for 501(c)(3) status due to some necessary operations of the organization (the BPLA is a 501(c)(6) entity). As a consequence of the lack of any funding in the PTO budget for travel costs, reimbursement of PTO officials' travel expenses is an effective requirement for PTO participation in Boston area events.

To make the Road Show happen, Suffolk University Law School (a 501(c)(3) group) graciously agreed to co-sponsor the event. The joint sponsorship was acceptable to the Patent Office for that one event. As many of you know, the Technology Center 1600 officials did travel to Boston and presented an outstanding full-day program last February.

At that time, we canvassed national and regional intellectual property bar associations such as the AIPLA, the New York Law Intellectual

Property Law Association and the Connecticut Intellectual Property Law Association to inquire how they were responding to the new restrictions placed on travel for PTO representatives. Each of those groups was seriously considering or actively proceeding to establish a subsidiary organization that could receive 501(c)(3) status and operate events with PTO participation. Also at that time, our Activities Chair Christine O'Day was organizing the Advanced PCT Practice Seminar scheduled for November, and Christine was informed that the Patent Office speakers could present the seminar only if the event was hosted by a 501(c)(3) organization.

Accordingly, to ensure that the BPLA membership can continue to enjoy programs that include Patent Office participation, the BPLA Board of Governors proceeded to establish an independent 501(c)(3) subsidiary organization of the Boston Patent Law Association. That subsidiary – the Boston Patent Law Foundation (BPLF) – was formed last spring, and we received formal recognition of the entity's 501(c)(3) status from the Internal Revenue Service

## President's Message *(continued)*

in late June. Once we received that formal recognition, the speakers for the PCT seminar were able to confirm their participation.

To preserve the BPLF's 501(c)(3) status, the entity must be operated separately from the Boston Patent Law Association, including a separate director and accounting operations. The BPLF director will be the person who served the prior year as the "Past President" of the BPLA Board of Governors. Thus, since the BPLF's inception last spring, Bill Gosz has served as the BPLF director and Peter Lando will hold that position in 2005. Additionally, to assist with

the accounting duties of both the BPLA and BPLF, the BPLA Board decided to engage a part-time bookkeeper. The accounting duties for the BPLA alone represent a significant volume of work and the further responsibilities necessitated by the BPLF clearly warrants engaging such professional assistance.

In connection with the bookkeeper hiring, the BPLA Board also decided to increase the active members' annual dues for 2005 by ten dollars to \$65.00. This is the first dues increase in six years.

As the year draws to a close, I wish to sincerely thank the membership for the opportunity to serve as President of the Boston Patent Law Association. In

the position, I have enjoyed many great events and meeting numerous interesting people. Some highlights certainly include spending time with the membership and New England Patriots Head Coach Bill Belichick at the Judges Dinner in May, bidding successfully for a beautiful painting at the Pro Bono Committee's first ever Charity Silent Auction held in conjunction with the Judges Dinner, being depicted on the Fenway Park scoreboard with Wally the Green Monster during the Summer Outing to the Red Sox/Rangers game in July, and attending the many outstanding seminars hosted by our committees.

We all look forward to a great year in 2005 with Doreen Hogle serving as our next President.

## POSITION AVAILABLE

Company **EMC Corporation**  
Position **Intellectual Property Counsel**  
Location Hopkinton, MA

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EMC Corporation of Hopkinton, MA, has an immediate need for an Intellectual Property Counsel to work with its engineering organizations to protect its industry leading technology. Emphasis will be on IP licensing and transaction work and include all aspects of Intellectual Property law practice, including patent prosecution. Must have Juris Doctorate from an accredited law school and BSEE or BSCS along with Admission to U.S. Patent Office. At least 3-5 years experience preferable. Mass Bar a plus. For further information, please contact: Krish Gupta at EMC Corporation, (508)-435-1000, Ext. 76654.

**JULY BPLA SUMMER OUTING A SUCCESS**



*Wally The Green Monster*



***WE BELIEVED!***

## BPLA Submits Amicus Curiae Brief In Phillips Case

This past summer, the United States Court of Appeals for the Federal Circuit invited bar associations, trade organizations, and others to submit *amicus curiae* briefs to help it settle vexing issues of claim construction that have led to uncertainty and inconsistency in patent infringement cases. The Boston Patent Law Association answered the call and submitted an *amicus* brief to address these important claim construction issues. Erik Belt, a partner at Bromberg & Sunstein LLP and Co-Chair of the BPLA Amicus Brief Committee, wrote the brief, which you can read on the BPLA website at [http://www.bpla.org/documents/BPLA\\_amicus\\_Phillips.pdf](http://www.bpla.org/documents/BPLA_amicus_Phillips.pdf) Peter Corless, the BPLA's president and Erik's co-chair on the Amicus Brief Committee, also contributed.

In *Phillips v. AWH Corp. et al*, the Federal Circuit asked for guidance on seven questions about the role of various sources of meaning in interpreting disputed patent claims and which sources should be preferred over others.

One such question is whether dictionary definitions should be given prominence over the patent documents themselves and over expert testimony on the patented technology. In past cases, the Federal Circuit has suggested that courts are free to consult dictionaries first, before other evidence of a disputed claim term's meaning.

In the *amicus* brief, the BPLA argues that patent claims cannot be removed from their technological context and thus courts should not consult dictionaries, at least in the first instance. Dictionary definitions are typically abstractions divorced from the technological context. But artisans working in the field of invention each day--e.g., chemists, engineers, mechanics, etc.--inherently understand the technological context and are thus better positioned to understand the meaning of disputed words in the patent claims. Accordingly, the BPLA argues in the brief that courts should give more prominence to

testimony from these artisans. That testimony is more likely than a dictionary to reflect how the terms would be read and understood by the primary audience of patents. That audience is typically the inventor's fellow engineers and scientists, including those working for the inventor's commercial competitors. The BPLA thus argues that dictionary meanings should not control interpretation of disputed claim terms.

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*"In the amicus brief, the BPLA argues that patent claims cannot be removed from their technological context and thus courts should not consult dictionaries, at least in the first instance."*

## 2004 Caselaw Roundup

By: Nicholas P. Triano, III

Mintz Levin Cohn Ferris Glovsky & Popeo PC

As the year draws to a close, we review below some of the most notable developments in the law and on the Hill over the past twelve months. Our apologies if we've omitted some of your favorites.

### Prosecution History Estoppel

*Honeywell International Inc. v. Hamilton Sundstrand Corp.*, 71 USPQ2d 1065 (CA FC 2004). This is one of the more important cases of the past year. The Federal Circuit, ruling *en banc*, held that even rewriting dependent, allowable claims into independent form is a "narrowing amendment" resulting in the loss of equivalents for *all* claim elements. During prosecution of the patents in issue, the Examiner found that the claims in issue were allowable, but were rejected only due to their dependency on a rejected base claim. The Applicant rewrote the claims in independent form, and the patents proceeded to issue.

Central in the court's determination was its interpretation of the Supreme Court's *Festo* decision as "rewriting an independent claim in

independent form creates a presumptive surrender if the amendment is "made to secure the patent". Judge Newman filed a vigorous dissent, arguing that the decision will have a major impact on routine patent practice and noting that "(my) colleagues state that they are preventing subversion of the court's attempts to restrain access to equivalency, by preventing "astute practitioners, through clever claim, drafting, to treat most, if not all amendments by merely adding new claim limitations rather than narrowing existing ones"...Yet the writing of broader claims and their cancellation during prosecution is, or was, the common practice. Astute practitioners are indeed needed, for little is left of access to equivalency."

The case is presently on appeal to the Supreme Court.

### No Opinion of Counsel - No Adverse Inference

If *Honeywell* is the number one case, *Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 68 USPQ2d 1383 (CA FC 2003) is at least a close second. *Knorr* overrules prior precedent in the law

governing opinion of counsel, holding that "no adverse influence that an opinion of counsel was or would have been unfavorable flows from an alleged infringer's failure to obtain or produce an exculpatory opinion of counsel."

### Invalidity/Inequitable Conduct

*Purdue Pharma L.P. v. Endo Pharmaceuticals Inc.*, 70 USPQ2d 1185 (DC SNY 2004). While a lower court decision, this case is notable for not only its topical subject matter - invalidation of Purdue's lucrative OxyContin patents - but as a possible caution for practitioners when drafting applications. Purdue sued Endo, alleging that Endo's Abbreviated New Drug Application (ANDA) submission infringed three of Purdue's patents on OxyContin. The court found that Purdue's representations to the PTO during prosecution (as well as what appeared in the specifications of the patents) that they had "surprisingly discovered" that the invention reduced the dosage range and eased titration compared to other opioid formulations was a misrepresentation,

## 2004 Caselaw Roundup

By: Nicholas P. Triano, III  
(continued)

because Purdue had “no scientific proof” that the inventions exhibited such properties. Thus, the court found that Purdue should have informed the PTO that its ‘discovery’ “had not been proven, and was “inherently difficult to demonstrate.””

### License/Offer to Sell

In *Elan Corp. PLC v. Andrx Pharmaceuticals Inc.*, 70 USPQ2d 1722 (CA FC 2004), the Federal Circuit considered Elan’s appeal from the District Court’s decision on invalidity of its patent in issue by arguing that a letter to a possible partner was merely an initial inquiry into whether the partner would be interested in a potential licensing and development project for a product that had no yet been developed.

The court agreed, finding that the product met neither prong of the two-part *Pfaff* test; citing *In re Kallan*, 1) an offer to license a patent claiming an invention *after* future research and development had occurred is not, in and of itself, an offer for sale, and (2) the patented product had not yet been developed, so even if there were an actual offer, whatever it was that was

purportedly offered, was not the patented product.

### Printed Publication/102(b)

*In re Klopfenstein*, 72 USPQ2d 1117 (CA FC 2004) holds that a scientific presentation was a “printed publication” under 35 U.S.C. 102(b) where it was displayed to the public two years prior to the patent filing date; shown (for three days at two different institutions) to a “wide variety of viewers”, many of whom were of ordinary skill in the relevant art, and without expectation of privacy or that the information would not be copied or reproduced by the viewers. The above factors outweighed the fact urged by the appellant that no copies were publicly distributed or indexed.

### Written Description/DNA sequence

*In re Wallach*, 71 USPQ2d 1939 (CA FC 2004). *Wallach* involved an appeal by the inventors from the Board of Patent Appeals and Interferences (BPAI) of a rejection of claims to DNA encoding a particular protein on written description grounds. The claim recited a DNA sequence encoding a protein called TBP-II. The Applicants

isolated the protein, but only disclosed a partial (ten amino acid) sequence in the patent specification. No DNA sequence was disclosed, either, in the patent specification.

The Court held that “Appellant did not claim the nucleic acids *that encode the simple protein sequence that they disclosed*. Rather, they claimed the nucleic acids encoding a protein *for which they provided only a partial sequence.*” (emphasis added) Just because Applicants isolated the protein and physically possessed the protein, did not mean they had knowledge of the protein’s sequence or any of its other descriptive properties. Thus, until they “obtained the complete sequence (of the protein), they had no more than a wish to know the identity of the DNA encoding it.”

### Unexpected Results/Post-Grant Evidence

*Knoll Pharmaceutical Co. v. Teva Pharmaceuticals USA Inc.*, 70 USPQ2d 1957 (CA FC 2004) *Knoll* holds that “(e)vidence developed after the patent grant is not excluded from consideration (for unexpected results), for

## 2004 Caselaw Roundup

By: Nicholas P. Triano, III  
(continued)

understanding of the full range of an invention is not always achieved at the time of filing the patent application. It is not improper to obtain additional support consistent with the patented invention, to respond to litigation attacks on validity.”

### **Dictionary Usage v. Usage of Term in Art**

*Vanderlande Industries Nederland BV v. International Trade Commission*, 70 USPQ2d 1696 (CA FC 2004). In considering a patent on a sortation system, the court rejected the alleged infringer’s argument that a general-usage-dictionary definition of “glide surface” should be applied to the word “glide” alone. The court found controlling the lack of evidence that those of ordinary skill in the art would consider the word “glide” to have a different meaning, and most notably, the presence of “detailed, art-specific examples of glide surfaces” in the written description of the patent at issue.

### **Claim Preamble Not Limiting**

*Intirtool Ltd. v. Texar Corp.*, 70 USPQ2d 1780 (CA FC 2004) found the

Federal Circuit considering the District Court’s finding that Intertool’s patent on a hand-held sheet metal punch pliers was invalid for failing to meet the written description requirement of 35 U.S.C. §112, paragraph 1. The preamble of the claim included the words “for simultaneously pending and connecting overlapping sheet metal...” The preamble was followed by an extensive recitation of the structure of the pliers.

The court, citing the holding in *Catalina Mktg.*, found that the preamble in this case was not limiting, in view of the “complete and exacting” structural detail in the claim of the description of the tool. Moreover, the lack of reliance on the preamble *e.g.*, to distinguish over prior art, further pointed to the non-limiting nature of the preamble.

### **Markush Group/Definition of Claim Terms**

In *Biovail Laboratories Inc. v. TorPharm Inc.*, E.D. Pa. No. 02-7119, 7/13/04, the court rejected Biovail’s assertion that the term “wetting agent” was defined to mean only the

components that followed the term in a Markush group. The court found that the specification did not specifically define the term, and the prosecution file histories did nothing to limit, disavow, or disclaim the commonly understood meaning of the term.

### **Claim Construction - “containing”, “ingredients” claim terms**

*Mars Inc. v. H.J. Heinz Co.*, 71 USPQ2d 1837 (CA FC 2004). In *Mars* the Federal Circuit vacated and remanded the District Court’s summary judgment ruling of non-infringement on Mars’ patent on pet food, featuring the language “containing a mixture of lipid and solid ingredients”. Following a Markman hearing, both parties moved for summary judgment on the infringement issue. Heinz argued that “ingredients” referred only to starting materials to make the product, while Mars countered that the term referred to the components in the final product. The lower court granted Heinz’s motion, finding that the disputed term referred to starting materials.

## 2004 Caselaw Roundup

By: Nicholas P. Triano, III  
(continued)

The Federal Circuit found to the contrary; the clear language of the claims “strongly suggested” that “ingredients” referred to the components of the mixture after having been combined, and that the specification provided no basis for deviation from the ordinary meaning of the term.

### Term Extension

In *Arnold Partnership v. Dudas*, 70 USPQ2d 1311 (CA FC 2004), the Federal Circuit considered the PTO’s rejection of term extension for a patent claiming compositions comprising hydrocodone and ibuprofen (or their salts); the commercial product is Vicoprofen<sup>®</sup>. Since the components of the combination had only previously been available separately, the FDA required a New Drug Application (NDA) prior to clearing Vicoprofen for the market. Arnold filed for patent term extension to recover the time the product had spent under FDA review.

The PTO rejected the application for term extension, reasoning that the product did not comply with the “first commercial marketing” requirement of

35 USC §156(a)(5)(A), since both components had been previously marketed. The District Court rejected Arnold’s argument that Vicoprofen (*i.e.*, the drug combination) was an “active ingredient” under the statute and not previously marketed. The Federal Circuit agreed, interpreting that the definition of “drug product” in § 156(f)(2)(A) was meant to refer to either a single active ingredient or an active ingredient in combination with another active ingredient. Thus, at least one active ingredient of a patented combination must be new to be eligible for patent term extension.

### Legislation

Lastly, the Cooperative Research and Technology Enhancement (CREATE) Act, eliminating certain secret information from qualifying as prior art is expected to be signed by President Bush. The purpose of the Act is to encourage collaborative research pursuant to a joint research agreement. The Act is intended to address the effect of the *OddzOn Products* case on collaborative research by creating new classes of subject matter under 35

U.S.C. 103(c), and will apply to patents granted on or after the date the legislation is enacted:

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## 2004 Caselaw Roundup

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The Act is intended to address the effect of the *OddzOn Products* case on collaborative research by creating new classes of subject matter under 35 U.S.C. 103(c), and will apply to patents granted on or after the date the legislation is enacted: "Section 103(c) of title 35, United States Code, is amended to read as follows:

"(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

"(2) For purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if--

"(A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made;

"(B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

"(C) the application for patent for the claimed invention discloses or is *amended to disclose the names of the parties to the joint research agreement.*

"(3) *For purposes of paragraph (2), the term 'joint research agreement' means a written contract, grant, or cooperative agreement entered into by two or more persons or entities for the performance of experimental, developmental, or research work in the field of the claimed invention.*"

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## Practice Before the Court of Appeals for the Federal Circuit

*Kathryn A. Piffat, Ph.D.*  
*Associate – Patent Attorney*  
*Edwards & Angell, LLP*

On Friday, September 24, 2004, Jan Horbaly, Circuit Executive and Clerk of Court for the United States Court of Appeals for the Federal Circuit (“CAFC”) addressed the Boston Patent Law Association on the subject of “Practice Before the Court of Appeals for the Federal Circuit.” His presentation focused on common pitfalls of practice before the Federal Circuit.

With respect to filing Notices of Appeal, Mr. Horbaly noted that it is important to provide all required information in the proper format during the initial filing, particularly with respect to spelling discrepancies, inconsistent party designations and docket entries, and changes in counsel. He cited particular problems with respect to lack of clarity with respect to parties dismissed or dropped and emphasized that disorganized submissions delay processing by the clerks. He recommended expediting the appeal by using the complete caption with correct and party designation, including the party name

with the appropriate attorney on the service list, and notifying the clerk of any Federal Rules of Appellate Procedure (“F.R.A.P.”) 4(a)(4) post-judgment motions pending in the trial court.

Mr. Horbaly reiterated that, while the clerk’s office is willing to answer questions about the Rules, they do not give legal advice, such as how to file or for their recommendations on substantive issues.

Mr. Horbaly noted that 60-70% of the motion practice involves requests for extensions of time. He suggested that an attorney before the CAFC assess his or her work schedule as soon as the Notice of Docketing is received and, if necessary, apply for additional time well in advance of the deadline so that the court will have an adequate opportunity to decide the motion prior to the deadline. He cited the following problems with respect to motions:

1. The movant fails to comply with the conditions of Federal Circuit Rules (Fed. Cir. R.) 27(a)(5) by failing to state in the motion that the

movant has discussed the motion with the other parties, whether any party will object, and whether any party will file a response.

2. The attorney wrongfully assumes that three additional days are added to the prescribed period after a paper is served (F.R.A.P. 26(c)) when a court order requires action within a specific period.

3. Motions filed under Fed. Cir. R. 31(c), if granted, terminate the appeal, but the clerk’s office cannot advise the attorney whether to file a brief, because the clerk’s office does not provide legal advice.

4. The attorney files fewer copies of the motion than the original and three copies required by F.R.A.P. 27(d)(3).

5. The Certificate of Interest (Fed. Cir. R. 27(a)(7)) or the Entry of Appearance (Fed. Cir. R. 47.3) is often missing from the motion.

With respect to oral argument, Mr. Horbaly recommended early written notification of any potential conflicts, with a copy provided to the other counsel. Generally,

## Practice Before the Court of Appeals for the Federal Circuit

*Kathryn A. Piffat, Ph.D.*  
(Continued)

identified conflict dates will be protected unless there is an objection. Requests for postponement of oral arguments should be made as early as possible.

Mr. Horbaly emphasized the importance of the requirement that arguing counsel check in with the clerk in room 401 at least 30 minutes prior to the start of court.

Briefs are most frequently rejected for the following easily corrected reasons:

1. The caption on the brief is incorrect.
2. The brief has the wrong color cover or is received or served untimely.
3. A statement of related cases is missing.
4. The footnotes are not the same size or font as the text.
5. The initial brief is missing an addendum.
6. Counsel whose names appear on the cover of the brief do not have an entry of appearance on file with the court.

With respect to petitions for rehearing, he pointed out that counsel should always have a certificate of interest attached (Fed. Cir. R.

47.4(b)), type-volume limitations do not apply to petitions for rehearing or responses to rehearings (F.R.A.P. 32(c)(2)(b)), and the petition is timely filed and served (F.R.A.P. 40(a)(1)).

The Federal Circuit's docket is available on PACER through the Internet ([pacer.psc.uscourts.gov](http://pacer.psc.uscourts.gov)), including a listing of all parties and attorneys, a compilation of case-related information, and a chronology of dates of case events entered in the case record.

Mr. Horbaly discussed several issues addressed at the recent Federal Circuit Bar Association Bench & Bar Broadmoor Conference:

1. The increasing abuse of confidentiality notice in briefs has left the judges with difficulties writing opinions. A suggested solution was the use of a certification that items marked confidential in a brief are truly confidential.
2. There have been a growing number of frivolous or abusive cross-appeals.
3. Currently, the names of the judges on a panel are available with only one hour's notice. A

new proposal under consideration would extend the time to forty-eight hours.

4. The judges are considering the use of mediation on a limited bases.

5. Visual aids during oral argument are not favored by the judges. Mr. Horbaly pointed out that the judges have questions and want answers. Moreover, judges often complain that the aids are difficult to see or confusing. Rather than using visual aids during arguments, Mr. Horbaly suggested that they be put in the brief as figures and that counsel refer to them during argument.

6. Mr. Horbaly acknowledged that the clerk's office has had difficulties with judges posting opinions throughout the day, particularly late in the day just prior to a holiday or three-day weekend.

As he concluded his presentation, he reiterated that although the clerk's office cannot provide legal advice, they will endeavor to assist counsel whenever possible, and he encouraged practitioner's to contact his office.

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