BOSTON PATENT LAW ASSOCIATION NEWSLETTER

Serving the New England Intellectual Property bar Since 1924

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PRESIDENT'S MESSAGE

Doreen M. Hogle

We are already a quarter of the way through 2005 and plans are in full swing for the Annual Judges Dinner. The Dinner will be held on Friday, May 13 at the World Trade Center, Seaport Boulevard, in Boston. Cocktails begin at 6:00 p.m., with the program and dinner starting at 7:15 p.m. We are very excited to have as our guest speaker Mr. Peter Gammons, noted baseball journalist. More information about Mr. Gammons can be found in a separate article in this Newsletter. As always, we also look forward to honoring the members of the judiciary and having the opportunity to interact with them in a more relaxed, social environment. We will also be hosting our second annual Silent Auction to benefit local charities. Items to be auctioned off include concert tickets, Red Sox tickets and ski lift tickets. So bring your checkbook and be prepared to be generous.

We have held some exciting events in March and April. The BPLA was active in the Giles S. Rich Memorial Moot Court Competition sponsored by the AIPLA in March. BPLA Seminars included "Unlocking the Mysteries of Interference Law and Practice: Part II---Declaration of Interference to Decision" and "IP Due Diligence". The Licensing Committee also hosted a seminar by Ms. Patricia A. Martone. Articles covering these events in more detail are in this Newsletter.

The Boston Patent Law Foundation has now completed its registration process and has been officially recognized as a public charity in the Commonwealth of Massachusetts. Registration as a charitable foundation allows us to continue our mission of education and public service to the community by hosting programs with speakers from the Federal Courts, the Patent and Trademark Office and the Copyright Office.

One example of our commitment to these goals is the sponsorship of a grant awarded to a student at the Massachusetts State Science Fair. This year the Fair is being held at MIT on May 6-7. Hundreds of high school students from around Massachusetts participate in this Fair, and the projects are truly outstanding. BPLA members are invited to visit this year's exhibition and support our future scientists. More information can be found at www.scifair.com.

This year the BPLA Board has also undertaken an initiative to review our website, and entertain suggestions for updating and improvement in its design and function. This will be a long term project, which will take many months to accomplish. At this time we have begun to review the websites of other similar organizations and consider which features that we would like to incorporate into our new design.

I am excited that we still attract members who are willing to participate at a high level in our organization. The BPLA officers and Board members are prime examples of those committed to keep our organization great. But I am also looking for ways to allow more members to get involved. Members have been contacting me to find out how they can be more active in the organization. Ideas that have been discussed include adding additional seats on the Board of Governors, new committees, limiting the term of committee chairs, and staggering the terms of committee co-chairs. The Board has been considering all of these options, but I'm sure that there are many other ideas out there and we welcome your suggestions.

IN THIS ISSUE

ANNUAL DINNER FOR FEDERAL JUDICIARY - FRIDAY, MAY 13, 2005

By Joseph M. Maraia, Esq.
Hamilton, Brook, Smith & Reynolds, P.C.

The Boston Patent Law Association (BPLA) is proud to announce its Annual Dinner for the Federal Judiciary. This year's dinner will take place at the World Trade Center, Boston, MA on Friday, May 13, 2003 from 6:00 PM to 10:00 PM.

Peter Gammons will be the Keynote Speaker for the Annual Dinner. Mr. Gammons is a highly respected Major League Baseball journalist and serves as a studio analyst on ESPN's Baseball Tonight.

Mr. Gammons has been a Major League Baseball correspondent on ESPN since 1988. Besides working for ESPN, Mr. Gammons contributes to the Boston Globe and to Baseball America.

Mr. Gammons was voted the National Sportswriter of the Year for 1989, 1990 and 1993 by the National Sportscasters and Sportswriters Association and was awarded an honorary Pointer Fellow from Yale University.

Mr. Gammons began his career as a reporter for the Boston Globe in 1969. He has also worked for Sports Illustrated covering the National Hockey League, college basketball and Major League Baseball (1976-78, 1986-90).

In 1986, upon his return to Sports Illustrated as a senior writer following a second stay at the Boston Globe, Mr. Gammons wrote numerous stories covering some of baseball's most important news events and authored "Inside Baseball," *Sports Illustrated*'s weekly baseball notebook.

Mr. Gammons is also the author of "Beyond the Sixth Game," a look at free agency.

The BPLA will also hold its second annual silent auction to benefit local charities. Last years auction was a tremendous success raising over $6,000 for local area charities.

We hope to see you all in attendance.

IP DUE DILIGENCE

by Susan C. Kelly, Ph.D.
Hamilton, Brook, Smith & Reynolds, P.C.

On Wednesday April 6, 2005 the Boston Patent Bar Association held one of its highest attended seminars ever. The seminar was entitled "IP Due Diligence", and the guest speakers were Mr. John L. Brooks III of Prism Ventures, Mr. Michael Feinstein of Venrock Ventures, Mr. Michael Lytton Esq. of Oxford Bioscience Partners, Dr. Ed Mascioli of MPM Capital, and Dr. Christopher Mirabelli of Healthcare Ventures. The event moderator was Mr. David E. Brook Esq. of Hamilton, Brook, Smith and Reynolds.

The first speaker was Mr. Michael Lytton Esq. Mr. Lytton is a General Partner at Oxford Bioscience Partners (OBP) (http://www.oxbio.com/) and serves on the Board of Directors for various companies and non-profit organizations.

Mr. Lytton spoke on the topic of "evaluating the risk of infringement of patents (freedom to operate (FTO))".

According to Mr. Lytton one of the key factors in an FTO study is matching the Intellectual Property (IP) to the business strategy of a company, in particular, whether FTO in a specific area will facilitate the business strategy. Mr. Lytton believes that patentability of the core technology, likelihood of pending claims issuing, agreements already in place, or any competitive intellectual property (IP) along with freedom-to-operate should be considered when looking at a potential investment.

The intellectual property analysis generally is the final part of OBP's investigation into any potential client, and OBP generally hires outside counsel to carry out any FTO study or patentability study. Mr. Lytton expressed a preference for a written FTO opinion rather than a verbal FTO opinion. Mr. Lytton values outside counsel who evaluate the relative risk, i.e., who will focus on the key issues or problems. Mr. Lytton, stated that venture capitalists (VCs) need to understand the written opinion from a business point of view, for example, they will want to fully understand the "power to exclude" as well as the "freedom-to-operate".

The second speaker was Ed Mascioli, M.D. Dr. Mascioli is a Principal of MPM Group (http://www.mpmcapital.com/). Prior to joining MPM, Dr. Mascioli was a Senior Medical Director at Parexel, an international clinical research organization. Prior to that, he was on the faculty of Harvard Medical School and on the staff of the Deaconess Hospital in Boston.

Dr. Mascioli spoke on "valuation of IP during the due diligence process from a venture capitalist perspective".

Dr. Mascioli believes that patent applications and issued patents are a priority in terms of IP. Trademarks and copyright are not as important as most of the drugs they invest in are not yet named. MPM does not in general invest in big pharmaceutical companies and, therefore, does not always expect, or look for, broad blocking patents. Instead, they have found that in most cases they will find "picket fence" patents and patent applications covering the core technology. Dr. Mascioli said that due to the time it takes to get a drug on the market, patent term is also of high importance to MPM when they are looking to invest.

The third speaker was Mr. John L. Brooks, III. Mr. Brooks is a Co-Founder and General Partner of Prism Ventures (http://www.prismventure.com/) who actively works with Prism's life sciences

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IP Due Diligence (con't)

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companies evaluating the issues facing early- and growth-stage companies.

Mr. Brooks spoke on the topic of IP agreements.

According to Mr. Brooks, Prism Ventures looks at agreements from the point of view of reselling the company. They look in particular at criteria such as, geography, restrictions, full license protection, royalties, that the definitions are clear e.g., "gross sales" versus "net sales", "equity component" versus "royalty component", and, for example, if the royalty component will be paid on a sliding scale, or if sales outside the US are included in the agreement.

Other types of documents which are also of importance according to Mr. Brooks include:

Research collaborations: it is often not clear who actually owns the IP, VCs need to make sure this is properly defined.

Confidentiality disclosures: VCs need to see if the company takes these seriously, if the company has an environment of appreciation for non-disclosure or confidentially agreements.

Employment contracts and non-compete agreements, including, for example, the contract and agreements which employees may have had from previous employers.

The fourth speaker was Dr. Christopher Mirabelli. Dr. Mirabelli is a General Partner at Healthcare Ventures (http://www.hcven.com/) with more than twenty years of experience in the pharmaceutical and bio-technology industry, and in biomedical research as both a senior executive and scientist.

Dr. Mirabelli spoke on ownership of IP.

Dr. Mirabelli stated that Healthcare Ventures investigates assignments very thoroughly. A lot of their investments are owned by universities, and it is often not clear who holds the rights to the IP. Dr. Mirabelli has found that it is common for work to take place between two different institutions and thus the inventions are multi-institutional in terms of ownership. Dr. Mirabelli has also found that there are similar issues with consultants, therefore, when work is outsourced VCs need to make sure ownership issues are taken care of before, rather than after the work takes place.

Michael Feinstein http://www.venrock.com/) was the final speaker. Mr. Feinstein is a General Partner of Venrock Associates and focuses on investments in information technology, specifically networking, components, and software infrastructure. Mr. Feinstein was most recently a General Partner at Atlas Venture and led their US Communications investment team.

Mr. Feinstein spoke on "global investment strategy and venture management of venture capital through due diligence – how do you find new technology to invest in and what is the criteria for choosing the technology?"

Mr. Feinstein stated that there are two main strategies when deciding where to invest:

1) Proactive, focusing on particular technology areas, VCs will, for example, stay close to particular universities, go to key labs, and keep an eye on research projects.
2) Reactive, for example, through a network of contacts.

Aside from these two strategies, plans are also submitted to VCs for review and VCs will also look at journals, search the internet and attend conferences.

When investing, VCs look at the technology, the team and the market place. According to Mr. Feinstein the team is of high importance when Venrock is looking to invest.

REASONABLE ROYALTY DAMAGES AFTER PUBLICATION AND BEFORE THE PATENT ISSUES: INTERPRETATION OF PROVISIONAL RIGHTS PROVISIONS

By Judith R.S. Stern,, Esq.
Bromberg & Sunstein LLP

Since November 29, 2000, U.S. patent laws, as amended by Congress, have required that the United States Patent and Trademark Office publish patent applications no later than 18 months after their earliest claimed filing date (with certain exceptions). Before the amendment, publication did not occur until the patent issued. Pre-grant publication poses obvious drawbacks to inventors, including the loss of any trade secret protection, and the risk of copying by competitors. As compensation for the negative impact of this earlier disclosure, Congress added a "provisional rights" provision (35 U.S.C. § 154(d)). This provision gives the patentee a "provisional" right to obtain reasonable royalty damages from an infringer for the time from publication of the application through the issuance of the patent.

This provisional right comes with two caveats, both of which are somewhat ambiguous. As the statutory amendment is relatively new and has not yet developed a body of case law, the practitioner must rely on legislative history and analogy to other statutes. One caveat concerns changes made in the application between publication and issuance. The invention as claimed in the patent must be "substantially identical" to the patent as claimed in the published patent application. 35 U.S.C. § 154(d)(2). The legislative history indicates that the standard for "substantially identical" (not defined in the statute) is based on the standard used in case law deciding intervening rights under the reissue statute. *See* House of Representative Report 105-39 accompanying H.R. 400, the "21st Century Patent System Improvement Act," March 20, 1997 (containing a provisional rights provision, at Section 204, identical in substance to the amended 35 U.S.C. § 154(d)), available

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Reasonable Royalty

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at http://thomas.loc.gov [hereinafter HR Report 105-39]; Philippe Signore, Ph.D., *The New Provisional Rights Provision*, 82 J. Pat. & Trademark Off. Soc'y 742, 752-53 & n. 27 (2000) [hereinafter 82 JPTOS]. If a claim is amended, the applicant should consider requesting that the amended claim be published, which presumably would permit the applicant to send a new Section 154(d) notice based on the amended, published claim.

The second caveat concerns notice. The statute requires the infringer to have "actual notice" of the published application. 35 U.S.C. § 154(d)(1)(B). This requirement is wide open to interpretation. The statute does not indicate whether the applicant must put the accused on notice, or whether the notice requirement can be satisfied if the accused learns of the published claims through independent means or a third party. Nor does the statute indicate what information the notice must include. Finally, the statute does not indicate whether reasonable royalties begin to accrue only after the required notice has been given, or whether giving notice allows royalties to accrue from the date of publication.

The legislative history provides some guidance: "The requirement of actual notice is critical. The mere fact that the published application is included in a commercial database where it might be found is insufficient. The published applicant must give actual notice of the published application to the accused infringer and explain what acts are regarded as giving rise to provisional rights." Statements on Introduced Bills and Joint Resolution, Senate, S. 1948, Cong. Rec. S14719 (Nov. 17, 1999), available at http://thomas.loc.gov. Commentators agree that based on congressional intent, the courts will likely require notice from the applicant. *See, e.g.*, 82 JPTOS at 748; Patrick J. Birde, Nicholas J. Nowak, *Analyzing Provisional Rights for Patent Applicants*, 9 No. 12 Intell. Prop. Strategist 1 (2003); Terence P. Ross, *Intellectual Property Law: Damages and Remedies* § 3.08 (2004); Brian J. Massey, *Reasonable Royalties for 18-Month Patent Publication Infringement: An Unreasonable Remedy for Small Businesses*, 8 J. Small & Emerging Bus. L. 87, 103 (2004).

One Federal Circuit case provides limited, indirect support for this interpretation. *Stephens v. Tech Int'l, Inc.*, 393 F.3d 1269, 1276 (Fed. Cir. 2004) concerned an attorney fee award based on, *inter alia*, litigation misconduct consisting of the patentee's 35 U.S.C. § 154(d)(1) notification to the defendant concerning a separate patent application. The Federal Circuit held that the patentee, Spectrum, "operated within its rights under section 154 when it notified Tech [the defendant] of its potential infringement. The letter represented Spectrum's adherence to section 154's requirement that Tech be placed on notice of Spectrum's future right to obtain royalties if a patent issued in a form substantially identical to the published '222 application." This language, though dictum insofar as it relates to the requirements of Section 154(d), does suggest that the applicant must place the accused on notice.

As to the contents of the notice, the legislative history indicates that the notice should "explain what acts are regarded as giving rise to provisional rights." Commentators have speculated that the courts will analogize to the notice requirement of 35 U.S.C. § 287(a) in the context of limitation of damages in unmarked product cases for guidance in interpreting the requirements of § 154 (d). Based on § 287(a) cases, the actual notice must identify the patent application serial number and the activity that is within the scope of the claims, and should include a proposal to abate the activity. *See* 82 JPTOS at 749.

The analogy to cases interpreting the notice requirements of Section 287(a) also provides guidance in determining when royalties begin accruing. If courts interpret Section 154(d) in a similar manner, royalties will be calculated from the date notice is given, **not** from the date of publication. The legislative history indicates that notice must be given "during the period in which the provisional rights are available." HR Report 105-39. Thus, applicants who wish to take advantage of their provisional rights should be vigilant in their policing even during the pre-publication period and would be well advised to send Section 154(d) notice letters immediately upon publication.

ACHIEVING GLOBAL LEADERSHIP IN THE BIOTECHNOLOGY INDUSTRY

By Christine M. Doe, Esq.
Hamilton, Brook, Smith & Reynolds, P.C.

On February 7, 2005, the Boston Patent Law Association held a breakfast seminar entitled: "Achieving Global Leadership in the Biotechnology Industry" at the Omni Parker House. The guest speaker was Thomas M. Finneran, Esq., President of the Massachusetts Biotechnology Council.

Mr. Finneran began his presentation with a brief overview of the Massachusetts Biotechnology Council and its vision for the biotech industry and science education in Massachusetts. Then Mr. Finneran discussed the strengths and weaknesses of the Commonwealth of Massachusetts as a leader in the biotechnology industry. In regard to strengths, Mr. Finneran noted that Massachusetts has numerous colleges and universities of great prominence. These educational institutions attract intellectual talent to Massachusetts and provide the Commonwealth with a highly educated workforce. In addition, Mr. Finneran noted that Massachusetts is the home of world-renown hospitals which attract medical professionals of great intellect and reputation. He also noted that the strength of Massachusetts as a biotechnology leader is bolstered by the substantial allocation of federal research funding to the Commonwealth's universities and hospitals from agencies such as the National Institutes of Health and the Centers for Disease Control. Such significant funding is looked upon with great envy by politicians in other states. Lastly, Mr. Finneran noted that Massachusetts is an incredible source of venture capital funding, attracting new

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INTERFERENCE LAW AND PRACTICE EXPLAINED AT SEMINAR

By Joseph M. Maraia, Esq.
Hamilton, Brook, Smith & Reynolds, P.C.

The mysteries of interference practice were at least unlocked, if not yet completely solved, at the seminar presented March 30, 2005 at the Hyatt Regency, Boston. Michael R. McGurk, Donna M. Meuth and Susan G. L. Glovsky divided up duties in preparing the seminar "Unlocking the Mysteries of Interference Law and Practice, Part II: Declaration to Decision. The seminar nearly became a standing room only event, with about 50 patent professionals attending.

All of the presenting attorneys have extensive experience in interferences. Mr. McGurk relies on more that 14 years of experience in interference proceedings, and currently serves as the head of Finnegan Henderson's interference practice section. Donna Meuth of Wilmer Cutler Pickering Hale and Dorr LLP is the author of publications concerning interference practice, and is a member of the Interference Committee of the Intellectual Property Owners Association and the Interference Committee of the AIPLA. Susan Glovsky of Hamilton Brook Smith and Reynolds P.C. has served as lead counsel on a number of interferences, and has spoken previously on interferences.

Although no one can boast of going through an interference governed by the new rules that went into effect on September 13, 2004, it was evident that Mr. McGurk, Ms. Meuth and Ms. Glovsky are thoroughly prepared to do so. The new rules at 37 CFR §§ 41.100 to 41.208 were translated into an explanation of procedures and given with practice tips that carry over from the old rules. Interference proceedings are still complex, with strict time periods set for completion of various stages, all scheduled according to a goal of completion within two years.

An interference is in many ways a front-loaded process. If you receive notice that an interference has been declared, or if you yourself are contemplating suggesting an interference, stock up on the pink paper required for cover sheets of papers to the Board of Patent Appeals and Interferences, and think carefully about the initial concerns. A paramount initial concern is often the cost of an interference (quoted by the panelists as an average of $500,000 for going through the entire proceeding, and even occasionally going in excess of $1,000,000). The costs must be weighed against, among other things, the value of the patent at stake, the strength of your proof of an earlier invention date, potential weaknesses in the claims, and the likelihood of successful negotiations with the other party to the interference. It is also to your advantage to carefully consider strategy as soon as an interference is declared, or even before, if an interference can be anticipated. Motions can be filed to determine issues in the interference, for example, to challenge a priority benefit, to challenge the patentability of the other party's patent or application, to amend or add claims, to amend inventorship, or to allow for additional discovery.

The panelists recommended that the Standing Order should be read early and often, and that the procedures described in it be followed religiously. Motions are to be clear in their statements of the relief requested, the evidence, the facts, and the arguments, using specific references to other documents, and are to cover only one issue. Replies are to address arguments in the motion point by point, with similar clarity and specificity. More narrow and detailed provisions of the order can include specifying page limits, the hole punching method for papers, the color of the first page of papers to be submitted (pink), and methods of service. A typical motion period will last 8 to 9 months, and is followed by the priority phase.

Part I of this series, presented on November 10, 2004, gave the basics of interference practice. Part III is planned for the fall of 2005, and will go into post-decision practice, including post-decision ex parte prosecution.

NEITHER HERE NOR THERE: LIABILITY FOR EXTERRITORIAL OFFERS TO SELL

by Peter J. Karol, Esq.
Bromberg & Sunstein LLP

In this age of outsourcing, it has become common practice for United States companies wholly to manufacture and sell goods in foreign markets, often with no intention that the product will reenter the United States. The company will do little more than keep the books and take orders at the home office. Suppose that the product is accused of infringing a United States patent. Can the company continue this often lucrative practice without any fear of direct liability attaching? Not exactly.

There can be no direct infringement liability under the usual snags of 35 U.S.C. §271(a) because the product is not made, used or sold in, or even imported into, the United States. And liability cannot be predicated under §271 (f) because no component of the product is made domestically. Thanks to Congress' Patent Act amendments of 1994, however, there still lurks the disembodied specter of "offers to sell." Unfortunately, Congress never specified whether this language was meant to include offers to sell where the contemplated sale itself would not occur in the United States. And this has led to a mixed message from the federal courts.

The lead case regarding extraterritorial reach of offers to sell under the Patent Act is *Rotec Industries v. Mitsubishi Corp.*, 215 F.3d 1246, 1252 (Fed. Cir. 2000). Though the Federal Circuit ultimately held on the facts before it that there was no evidence of an actionable "offer to sell" in the United States, dicta, in particular Judge Newman's disapproving concurrence, suggests that "the majority opinion necessarily accepts

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LICENSING SEMINAR

by William G. Gosz, Esq.
Ropes & Gray LLP

On April 20th, Bill Gosz of the Licensing Committee hosted a seminar featuring Patricia A. Martone, of the Fish & Neave IP Group of Ropes & Gray whose topic was "Generating Revenue Through Patent Licensing". The seminar covered the criteria for an effective revenue generating licensing program, historical examples of successful programs, the coordination of patent and business strategies, and negotiation and litigation strategies. A question and answer period followed the seminar.

Global Leadership

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businesses and cutting edge industries to Massachusetts.

Mr. Finneran then discussed the weaknesses of the Commonwealth as a leader in the biotechnology industry. The first and most prominent issue outlined was the Commonwealth's convoluted business permitting system. In its current state, Mr. Finneran believed that the permitting process of Massachusetts could be qualified as a disaster, and in order to attract businesses, the permitting process needs to be simplified and streamlined, requiring public policy changes at both the state and local level. Mr. Finneran declared that another major issue facing the Commonwealth is the exorbitant cost of housing which prevents many highly educated individuals - such as graduate students and medical professionals - from moving to the area, or maintaining residence here. Lastly, Mr. Finneran noted that the unpredictability of the political climate is a weakness for Massachusetts.

Mr. Finneran concluded his presentation by taking questions from the audience. The majority of the questions focused on addressing the steps that are being taken to market towns in Massachusetts, outside of Boston and Cambridge, as sites for manufacturing plants for the biotechnology industry. Mr. Finneran acknowledged that there is a great need to attract manufacturing plants to Massachusetts, as biotechnology companies prefer to have their manufacturing plants close to their research and development centers. Mr. Finneran noted that towns such as Fall River, Springfield and Pittsfield offer affordable housing and good transportation which are attractive to businesses to set up manufacturing plants. In order to encourage investment, it was noted that the Chambers of Commerce for these towns need to address marketing their towns as sites for manufacturing plants. In addition, Mr. Finneran suggested that the growth of the biotechnology industry in Massachusetts could also benefit from an economic stimulus bill that the Governor is filing. If enacted, this bill would hopefully put us on equal footing with the growth of the biotechnology industry in other states, such as North Carolina. Mr. Finneran concluded by stating that he is optimistic that Massachusetts will succeed in its continued efforts to attract biotechnology firms to set up research facilities and manufacturing plants in the Commonwealth and maintain its position as a leader in the biotech industry.

Liability for Exterritorial Offers to Sell

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the critical premise that an 'offer to sell' made in the United States can constitute patent infringement even when the contemplated sale could not infringe the patent." *Id.* at 1258.

Since *Rotec*, on the other hand, what appears to be a majority of the District Courts to look at the issue have held that "an 'offer to sell' made *within* the United States that contemplates a 'sale' of goods *outside* of the United States is not within the permissible scope of liability for 35 U.S.C. § 271(a)." *Cybiotronics, Ltd., v. Golden Source Elecs., Ltd.*, 130 F.Supp.2d 1152, 1171 (C.D.Cal.2001) (emphasis in original); *see also Quality Tubing, Inc., v. Precision Tube Holdings Corp.*, 75 F.Supp.2d 613, 624-25 (S.D. Texas 1999) (holding, prior to *Rotec*, that "contracting, in the United States, to manufacture, sell, and deliver a product in Scotland and Norway, for use in Norway" cannot amount to patent infringement; noting "the sale for which the offer is made must itself be an act of infringement.")

At least one District Court, however, has taken a harder line and adopted Judge Newman's argument about the majority opinion. *See Wesley Jessen Corp. v. Bausch & Lomb Inc.*, 256 F.Supp.2d 228, 234-35 (D.Del. 2003) ("In light of the foregoing, the Court rejects Bausch & Lomb's argument that an 'offer to sell' can only take place if there is also an unlawful sale within the United States. [. . .] The Court concludes that an unauthorized offer to sell a patented product, which offer is made in the United States, is a violation of 35 U.S.C. § 271(a)"); *and see Fieldturf, Inc. v. Southwest Recreational Industries*, 235 F.Supp.2d 708, 730-34 (E.D. Ken. 2002), *rev'd on other grounds*, 357 F.3d 1266 (Fed. Cir. 2004) (assuming offers to sell accomplished within the U.S. that contemplate sales outside the U.S. "fall under the blanket protection afforded by § 271(a);" finding no "offer to sell" on the facts before the court).

The Federal Circuit has returned to *Rotec* on occasion, but not definitively as regards this issue. *See Pelligrini v. Analog Devices, Inc.*, 375 F.3d 1113, 1119 (Fed. Cir. 2004) ("Pellegrini speculates that 'had there been admissible evidence to show an 'offer for sale' occurring in the United States [in Rotec], the Court would have judged otherwise.' Be that as it may, there is no evidence of record here that Analog has offered to sell the ADMC chips domestically.")

Thus, to play it safe, a company ought not to contract in the United States to sell and deliver accused products abroad. There is enough case law out there to at least argue (perhaps wrongly) that such an offer to sell is actionable direct infringement.

MEMBERS WHO HAVE NOT YET PAID 2005 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 2005 dues. Unless payments are received by the Treasurer before June 30, 2005, the following individuals will be removed from the membership roster. The dues payment form can be found on the BPLA web site, www.bpla.org.

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John B. Alexander
D. Dennis Allegretti
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John N. Anastasi
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Kathleen Chapman
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(Continued on page 10)

Positions Available

(Continued from page 9)

Skills:

- Proficient in word processing and spreadsheets (MS Word® and MS Excel® preferred)
- Excellent oral and written communication skills
- Meticulous documentation and record-keeping skills
- Ability to work well with others
- The background and skills to assist both the potential inventor and the attorney in the patent filing process

Supplemental Requirements:

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UPCOMING EVENTS

Friday, May 13, 2005
6:00 p.m. Annual Judges Dinner and Silent Auction

Tuesday, July 19, 2005
7:00 p.m. BPLA Summer Outing, Boston Red Sox v. Tampa Bay Devil Rays at Fenway

Friday & Saturday, September 16-17, 2005
Symposium on Life Science IP in Europe

Wednesday & Thursday, October 19-20, 2005
Advanced PCT Practice Seminar

Friday, November 18, 2005
Suffolk University Law School Symposium

NOTICE TO COMMITTEE CHAIRS

The newsletter would like to know of any upcoming events, whether cle or brown bag lunches, that the committees are planning. We are happy to promote your events in our newsletter listings and we welcome descriptions of your planned events for publication.

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