



BOSTON PATENT LAW ASSOCIATION NEWSLETTER

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PRESIDENT'S MESSAGE



Doreen M. Hogle

It's hard to believe that I am almost at the end of my term as President of the BPLA. We've had many terrific events this year and this is the p e r f e c t

opportunity for me to thank all of you who helped to make this year a great success. I would first like to thank my Activities Chair, Joe Maraia, who contributed with unique ideas, exceptional communications to our membership, and was always willing to help out whenever necessary. I would like to thank my assistant, Katie Norris, who was instrumental in planning and coordinating the year's events, and for keeping me organized as well. I would also like to thank my colleagues and the staff at Hamilton, Brook, Smith & Reynolds for encouraging and supporting me throughout the year.

I thank the BPLA Officers and Board Members for their innumerable contributions and hard work during the year. I'd like to give special thanks to our treasurer, Leslie Meyer-Leon, for her huge effort in working with our accountant to

upgrade our accounting practices for both the BPLA and BPLF, and to update our membership list. I also thank our Committee Chairs for the wonderful seminars this year--yes, it is a lot of hard work to put on a seminar, yet the Chairs step up to the plate every year and do a spectacular job. No, it doesn't quite take a village to run the BPLA, just very many highly motivated, selfless people, both "on stage" and "behind the scenes", who are willing to make the effort. Thank you all.

As mentioned above, we've had many memorable events this year. I particularly enjoyed the Judges Dinner, and to relive those wonderful memories we now have the photos available on the BPLA website. Although the "wrong-colored" Sox were in the World Series this year, we still had a great time at the Red Sox game in July for the Summer Outing. Since the last Newsletter we've had more seminars (write-ups inside) and we will have held the Advanced PCT Practice Seminar. I'm now looking forward to the Annual Meeting on December 7 at the Boston World Trade Center (across from the Seaport Hotel). The Commissioner of Patents, John Doll is our guest speaker. I'd like to remind you that we will be voting on the BPLA by-law amendment on the process for selecting

committee chairs as was discussed in September's Newsletter. Please take a moment to review the proposal before the meeting.

As a final reminder, BPLA membership dues must be paid by February 1, 2006. Only paid-up members are eligible for member privileges, such as discounted rates for seminars. Our membership list has been updated on the website and now currently lists only active members. Please take a moment to check the website to ensure that your address information is correct, or you'll miss out on future notices. Members can update their own address information by logging into the "members only" section of the website. Membership renewal forms will be available for download from the website. Even if you are an emeritus member (over 70 years of age) we still require that you submit a renewal form, however membership dues are waived.

This year was great fun for me. Thank you all again for making the Boston Patent Law Association the premier organization that it is. I look forward to seeing you at the Annual Meeting and hope you will be there to join me in welcoming Ingrid Beattie as our new President.

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THE BOSTON PATENT LAW ASSOCIATION AND THE BOSTON PATENT LAW FOUNDATION
2005 ANNUAL MEETING

The 2005 BPLA/BPLF Annual meeting will be held at the World Trade Center (across from the Seaport Hotel) on Wednesday, December 7, 2005, from 11:00 AM – 2:00 PM. The Annual Meeting is a time to reflect on the events of the past year and preview the upcoming activities for 2006. Please join us at the annual gathering where we mingle with old friends and make new ones.

We remind you that the membership will also be voting on the proposed BPLA By-Law amendment to Article X on Standing Committees, as described in the September BPLA Newsletter. Please take a moment to review the proposed amendment prior to the meeting.

This year we are particularly honored to have the new Commissioner of Patents, Mr. John Doll join us as our Keynote

Speaker. Prior to becoming Commissioner for Patents, John Doll was Deputy Commissioner for Patent Resources and Planning. Prior to serving as Deputy Commissioner, Mr. Doll was on detail for 10 months as the Special Assistant to Jon Dudas, Under Secretary of Commerce for Intellectual Property, Director of the USPTO. Before his detail, John was a Group Director in Tech Center 1600, responsible for Art Units 1610 and 1630, the areas that examine organic chemistry, pharmaceuticals and biotechnology.

John received his Bachelor of Science degree from Bowling Green State University in chemistry and physics and his Master of Science degree from The Pennsylvania State University in physical chemistry.

John joined the Patent and Trademark Office in 1974 as a patent examiner and

was promoted to Primary Examiner in 1979 examining patent applications encompassing pharmaceuticals, herbicides, pesticides and dyestuffs. As a Supervisory Patent Examiner in Groups 1100 and 1800, he was responsible for the examination of applications drawn to a variety of arts including inorganic chemistry, hydrometallurgy, zeolite catalysts, buckminsterfullerenes, proteins and peptides. In 1992, he was promoted to be the Deputy Director of Group 1100/2900 that examined chemical, chemical engineering and design patent applications. In 1995, he became the Director of Group 1800 which examined biotechnology patent applications. He was then one of the Directors of the Chemical Matrix that transitioned into Technology Center 1600. Mr. Doll will update us on the latest USPTO plans and procedures.

AMICUS BRIEFS

By Erik Paul Belt, Esq., Bromberg & Sunstein LLP

The Boston Patent Law Association has appeared in the national spotlight twice this past year to contribute ideas and scholarship on important issues of patent law. In particular, the BPLA *Amicus* Committee, co-chaired by Erik Paul Belt of Bromberg & Sunstein LLP and Peter F. Corless of Edwards & Angell, LLP, has filed two *amicus* briefs on claim construction. These *amicus* briefs have furthered the BPLA's reputation as a thought leader in the intellectual property law community.

Since 1995, when the Court of Appeals for the Federal Circuit held in *Markman v. Westview Instruments* that patent claim construction is an issue of law for the courts, the Federal Circuit's reversal rate on district court claim construction has hovered between 30-40%. In contrast, only about 8% of all civil appeals are reversed. Reacting to this unusually high rate of reversals on claim construction decisions, the BPLA advocated procedures for claim construction designed to lower the reversal rate and add more certainty to patent litigation.

In its first venture, the BPLA *Amicus* Committee filed a brief supporting the plaintiff-appellant in *Phillips v. AWH Corporation*, a case that attracted much interest in the patent bar and legal community generally. In *Phillips*, the

Court of Appeals for the Federal Circuit decided to rehear an otherwise obscure case en banc and invited bar and trade organizations, legal scholars, and others to weigh in on seven questions relating to the canons of claim construction. Chief among these questions was the role of dictionaries in defining disputed claim terms. Although that question alone was important, it was not the real reason the case generated so much buzz. Rather, the legal community and IP scholars anticipated that the Federal Circuit would use the occasion to simplify claim construction, to provide more bright-line rules or to otherwise decrease the high reversal rates.

By way of background, in *Texas Digital Sys. Inc. v. Telegenix Inc.*, 308 F.3d 1193 (Fed. Cir. 2002), a panel of the Federal Circuit had elevated dictionaries over patent specifications in defining claim terms. The *Texas Digital* ruling, however, led to dictionary wars, with litigants trotting out competing dictionaries supporting their definitions. These dictionary wars departed from the main objective of claim construction, which is to get at what the inventors invented, and instead led to sometimes absurd battles of semantics. The *Texas Digital* ruling fueled some of the confusion and high reversal rates in patent litigation.

In its brief, the BPLA *Amicus* Committee argued that (1) dictionaries and other extrinsic evidence should not take precedence over the claim wording and patent specification (i.e., the intrinsic evidence); (2) the Federal Circuit should reaffirm its guidelines for claim construction set forth in the 1996 *Vitronics* decision, and (3) courts should construe claims without regard to their validity. The Federal Circuit essentially adopted the BPLA's positions. See *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). In particular, the *Phillips* court overruled the *Texas Digital* decision, relegating dictionaries and other extrinsic evidence of meaning to a subservient role in defining the scope of claims. The Court also reaffirmed the canons of construction set forth in *Vitronics*.

The past September, the BPLA *Amicus* Committee filed a brief urging the United States Supreme Court to grant *certiorari* in a patent battle between Merck & Co. and Teva Pharmaceuticals over the drug Fosamax. One of the pressing issues in that case was the standard of review that the Federal Circuit should apply to a trial court's claim construction. Again, by way of background, in 1998, the Federal Circuit, sitting *en banc*, held that a trial court's claim construction ruling should be

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MINUTES OF THE 2004 BPLA ANNUAL MEETING

By Mark B. Solomon, Esq., Hamilton, Brook, Smith & Reynolds P.C.

Peter Corless, BPLA President, called the 2004 BPLA Annual Meeting to order and welcomed the membership in attendance.

Mr. Corless introduced the head table, including Honorable Judge Lourie (keynote speaker), Doreen Hogle (President-Elect), Ingrid Beattie (Vice President), Leslie Meyer-Leon (Secretary), Mark Solomon (Board Member), Grant Houston (Board Member), and Peter Lando (Board Member and Immediate Past President). Lee Bromberg (Treasurer) and Lisa Michaud (Board Member) were not in attendance.

Mr. Corless introduced BPLA Past Presidents, including George Neuner, Jerry Cohen, Richard Wise, Jesse Erlich, Faith Driscoll, John Skenyon, Martin O'Donnell, Steve Henry, John DuPré, Greg Williams, Susan Glovsky, Tim French, Walter Dawson, David Thibodeau, Bill Gosz, and Peter Lando.

Mr. Corless recognized new members in attendance and asked them to stand to be recognized by the membership in attendance.

Moment of Silence: Tim French addressed the membership to recognize deceased members. In particular, Mr. French presented a moving discussion of Bill Booth, recently deceased, and his contribution to the intellectual property community in Boston and to the community in general. Mr. French also recognized the passing of Judge Mazzone and noted his lifelong service to the community. A moment of silence was taken by the membership.

BPLA Writing Competition Awards: Mr. Solomon presented the 2004 BPLA Writing Competition awards on behalf of the Lead Judge, Ms. Michaud. Mr.

Solomon read a list of titles of all papers entered in the competition. Mr. Solomon announced the first place winner, Nathan Greene, who received a \$750 award, and the second place winner, Joy Simeone, who received a \$250 award. Both award recipients were in attendance and were called up to the podium to receive their awards. Both awards recipients authorized placement of their respective papers on the BPLA website for the membership to read.

Report of the President: Mr. Corless presented the President's report. Mr. Corless recapped this year's thirteen seminars and discussed the Judge's dinner and honored guest speaker, Bill Belichick, coach of the New England Patriots. Mr. Corless went on to discuss the BPLA's amicus brief that the BPLA filed with the Federal Circuit on September 20, 2004 in *Phillips v. AWH Corp.* The amicus brief was drafted by Eric Belt of Bromberg & Sunstein under the auspices of the new BPLA Amicus Committee.

Mr. Corless also discussed his experience of being on the infield in Fenway Park at the beginning of the Red Sox game that the BPLA attended for its summer outing. Mr. Corless also thanked Regina Edwards and Christine O'Day and presented gifts to each for their contribution to organizing and running BPLA events this year.

Following Mr. Corless' discussion of events conducted over this past year, he introduced to the membership the Boston Patent Law Foundation (BPLF) under 501 (c)(3) tax laws. Mr. Corless presented reasons why the BPLF was formed, raising such issues as reimbursing PTO personnel for travel expenses. The BPLF was formed during the spring of 2004 and operates as a separate entity from the BPLA. Mr.

Corless also indicated that due to increased complexity and because of overall growth throughout recent years, the BPLF and BPLA will be hiring an accountant to assist in keeping the financial records for both organizations. As a result, Mr. Corless announced that the BPLA annual dues will be increased across the board by \$10 to \$65 for active members and \$55 for associate members, which is the first increase in six years. Persons who only receive mailings continue to pay only \$35.

Report of the Secretary: Ms. Meyer-Leon entertained a motion for waiver of reading of the Minutes of the December 4, 2003 Annual Meeting since it was distributed to the membership prior to the meeting. A member moved for a motion; a second was heard; and approval was granted by the membership.

Ms. Meyer-Leon requested a motion for acceptance of the Minutes as printed. The membership approved of the motion. Ms. Meyer-Leon also indicated that the BPLA membership has welcomed 119 new members during 2004.

Report of the Treasurer: Mr. Corless read a report of the Treasurer on behalf of Lee Bromberg, who was unable to attend the annual meeting. Mr. Corless announced that a (\$393) net loss was incurred by the BPLA. Total income was \$188,487, and total expenses were \$188,880. Mr. Corless announced that dues for 2005 are due February 1, 2005.

Report of the Nominating Committee: Mr. Corless recognized Mr. Lando as the Chair of the Nominating Committee and invited Mr. Lando to read the Nominating Committee Report.

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Amicus Briefs (con't)

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reviewed *de novo*. *Cybor Corp. v. FAS Techs. Inc.*, 138 F.3d 1448 (Fed. Cir. 1998). In the BPLA brief, the BPLA Amicus Committee argued that the Supreme Court should set a more deferential standard of review.

In the underlying case, the trial judge defined the disputed claim term according to a definition found in a certain passage in the specification. The defendant's

technical expert admitted on cross-examination that, to one of ordinary skill in the art, the definition was to be found in that very passage. On appeal, however, a 2-1 majority ignored the expert's testimony and, reading the same passage, held that the specification did not define the term. So now two judges (the trial judge and the dissenting Federal Circuit judge) read the specification one way while the other two judges (the appeals panel majority) read it the other. While reasonable lay people might differ on how to read the passage, those of ordinary skill in the art apparently

did not. Accordingly, the BPLA Amicus Committee argued that, had the Federal Circuit granted some deference to the trial court, it would have necessarily considered the expert's reading of the patent and thus would have adhered more closely to its own guidelines of reading patents as inventors' fellow engineers, scientists, or mechanics would read them. Moreover, a more deferential standard of review will eventually lower the reversal rate and bring it closer to the national average for all civil appeals.

2004 Annual Meeting (con't)

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Mr. Lando read the report of the Nominating Committee, which stated the following nominations: Doreen Hogle, President; Ingrid Beattie, President-Elect; Lee Bromberg, Vice-President; Leslie Meyer-Leon, Treasurer; Mark Solomon, Secretary; Peter Corless, Board Member/Immediate Past President; Lisa Michaud, Board Member; Grant Houston, Board Member; and Neil Ferraro, Board Member.

Mr. Corless entertained a motion to accept the Nominating Committee's recommendation. The BPLA membership accepted the Nominating Committee's recommendation.

Installation of New President: Pursuant to Article 7, Section 3 of the By-laws, Mr. Corless announced that President-Elect, Doreen Hogle, now takes

office as President. Mr. Corless presented the BPLA gavel to Ms. Hogle.

Presentation of Gifts to New Immediate Past President: Ms. Hogle presented Mr. Corless with a beautiful Faneuil Hall clock and a BPLA Minuteman pewter plate. Mr. Corless graciously accepted the gifts.

Welcome New Officers: Ms. Hogle introduced the BPLA Officers for 2005: Ingrid Beattie, President Elect; Lee Carl Bromberg, Vice-President; Leslie Meyer-Leon, Treasurer; Mark Solomon, Secretary; Peter Corless, Board Member/Immediate Past President; Lisa Michaud, Board Member; Grant Houston, Board Member; and Neil Ferraro, new Board Member. Ms. Hogle also introduced Joseph Maraia, who will be serving as the BPLA Activities Chair for 2005.

Introduction of the Guest Speaker: Mr. Corless introduced Honorable Judge

Lourie to present the keynote speech to the BPLA membership. Prior to the speech, Mr. Corless presented a Fenway Park clock to Judge Lourie who, in response, mentioned that he had been to a game of the 1946 World Series with his father. Judge Lourie proceeded to speak about the activities that have taken place in the last eight years since he previously spoke to the BPLA membership. Included in the discussion were topics, such as claim construction and Hilton-Davis, Doctrine of Equivalents, Pennsylvania Avenue's resurfacing, and the CAFC courtroom's renovation to double capacity and to add a balcony. The renovations are scheduled for completion in April 2005. Judge Lourie mentioned that (i) Chief Judge Mayer is to be succeeded by Judge Michel, (ii) the Court mourns the passing of Judge Rich, and (iii) three Judges are available for senior status, including himself, but he has no plans at present to accept this status.

TRADEMARKS AND UNFAIR COMPETITION COMMITTEE: "TRADEMARK YEAR IN REVIEW: 2005"

*By Cynthia Johnson Walden, Esq., Fish & Richardson, P.C.
John L. Welch, Foley Hoag LLP*

On Wednesday, October 19, 2005, the Trademarks and Unfair Competition Committee held its "Trademark Year in Review: 2005" Seminar at the Seaport Hotel in Boston. Craig K. Morris, TEAS Project Manager at the USPTO, reviewed recent and upcoming developments concerning the PTO's Trademark Operation. His presentation followed those of Michael Boudett (Foley Hoag LLP) on federal litigation, Pamela S. Chestek (Reebok International Limited) on 1st Circuit litigation, Prof. Stacey L. Dogan (Northeastern University School of Law) on legislative developments, and Douglas R. Wolf (Wolf, Greenfield & Sacks, P.C.) on the TTAB.

Mr. Morris, with materials prepared by Sharon R. Marsh, Deputy Commissioner for Trademark Examination Policy, provided the latest statistics on PTO trademark filings, outlined recent and upcoming changes in PTO filing procedures, and commented on other administrative matters.

Filing statistics: In fiscal year 2005, a total of 258,527 applications were filed (an 8.4% increase over FY2004), representing 323,501 classes. The average time between filing and a first action was 6.3 months. For the year, 112,446 marks were registered (143,396 classes), bringing the

total number of active registrations to 1.2



Boudett, Chestek, Dogan, Morris, Wolf

million.

Staffing: In FY2005 the PTO employed 358 examining attorneys and it plans to hire 80 more in FY2006. It will also add two new law offices. Approximately 70% of examining attorneys work from home.

TEAS-Plus: Mr. Morris reviewed the requirements for a TEAS-Plus application, and noted that requests for additions to the USPTO "ID Manual" may be sent to Jesse Roberts at TMIDSuggest@uspto.gov. Requests should include the name and address of the sender, and should set forth the requested addition in 25 words or less. Additions to the ID Manual are made once per month. In response to an audience question, Mr. Morris indicated that TEAS-

Plus applications are not processed any more quickly than other applications.

Design Search Codes: The PTO is undertaking a project to improve the system for assigning design search codes to non-word marks. Postcards and/or e-mails will be sent to applicants and will indicate the proposed codes to be assigned to a particular mark; applicants will then have an opportunity to approve or correct the coding. Requests for correction may be sent to TMdatabasecorrect@uspto.gov.

Rule Changes?: The PTO is considering changes to the Trademark Rules in connection with extensions of time to file a statement of use, in order to allow an applicant to request more than a single 6-month extension at one time. The Office is also considering a change in the procedure for handling requests for reconsideration after final refusal, a cause of considerable delay in processing applications.

Assignment: Mr. Morris pointed out that requests to record assignment documents that are filed electronically via ETAS (Electronic Trademark Assignment System) are processed in one or two days, compared to the five months required to process assignment documents filed by mail. When an assignment document is

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Trademark Year (con't)

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filed electronically, the records in TRAM, X-Search, TARR, and TESS are automatically updated.

Pdf attachments: The PTO is planning to begin allowing the attachment of pdf files in addition to jpegs, but initially only with regard to TEAS responses to office actions. The target date for this change is December 17, 2005.

Michael Boudett reviewed federal case law developments in the areas of fair use, gripe sites, dilution, and famous foreign marks. He discussed the 9th Circuit's treatment of the *KP Permanent* case on remand from the Supreme Court, the *Bosley Medical* and *Lamparello* rulings that non-commercial gripe sites do not infringe under the Lanham Act, the 2nd Circuit's

Savin decision on proof of actual dilution, and the *Grupo Gigante* and *Almacenes* decisions on protection of famous foreign marks under U.S. law.

Pamela S. Chestek focused on litigation within the 1st Circuit, including the Court of Appeals decisions in *Cecil McBee* (extraterritorial reach of the Lanham Act) and *Dialogo* (affirming denial of a preliminary injunction because of failure to prove irreparable harm). The district court case of most interest was *Beacon Mutual*, in which the federal court in Rhode Island, on remand from the Court of Appeals, made several questionable rulings while finding trademark infringement.

Prof. Stacey L. Dogan discussed the proposed revisions to the Federal Trademark Dilution Act, including establishment of a "likelihood of dilution" standard, provision for dilution by

tarnishment, and clarification of the requirements for a finding that a mark is famous. She also noted proposed legislation on trafficking in labels that bear or comprise a counterfeit mark, and on modifying the Lanham Act with regard to treatment of certification marks in light of the 2nd Circuit's *Idaho Potato Commission* case.

Douglas R. Wolf reviewed the TTAB's citable decisions for 2005, as well as the CAFC's recent *Mayer/Berkshire* and *Steelbuilding.com* cases. He topped off his remarks with a comparison of the Board's recent rulings in *DC Comics* (finding likelihood of confusion between Opposer's mark KRYPTONITE and Applicant's mark KRIPTONITA for fruit cocktail) and *Blue Man Group* (dismissing an opposition to registration of BLUE MAN for cigarettes).

RECOMMENDATIONS OF MBA TASK FORCE ON LAWYER DISCIPLINE

By Timothy A. French, Esq., Fish & Richardson, P.C.

The changes proposed by the Report of the MBA Task Force on Lawyer Discipline, summarized briefly below, in most respects would bring Massachusetts closer into line with the ABA Model Rules and/or with the practices followed in most other jurisdictions.

The Report makes a strong argument that attorney discipline processing in Massachusetts is subject to delays in the extreme, and that many of the practices presently followed in Massachusetts are not conducive to addressing or correcting the problem.

It is recommended that the BPLA strongly consider joining the MBA in this effort.

Here is a summary of the proposals:

1. Implement time standards of six months from complaint to decision to prosecute, from petition to hearing, and from hearing to decision [many cases now drag on for 10 years and more].
2. Adopt a statute of limitations of 5 years for lawyer discipline, with exceptions.
3. Require an annual (or more frequent) accounting of unresolved cases [presently only the number of resolved cases is reported].
4. Change the standard of proof from "preponderance of the evidence" to "clear

and convincing evidence" [as followed by an overwhelming number of jurisdictions].

5. Implement a Lawyer Practice Assistance Program for diversion of appropriate cases resulting from innocent error.
6. Implement a mediation program.
7. Permit bilateral discovery.
8. Allow Bar Counsel discretion to dismiss cases that are frivolous or outside the Board's jurisdiction.
9. Make proceedings following rejection of offer for a private admonition private.
10. Require disclosure and/or permit discovery of certain information obtained by the Board.
11. Require service on Respondent of a summary of charges, any investigative report, and all exculpatory material; permit motion to dismiss and motion for summary judgment.
12. Allow chair of local Hearing Panel and Special Hearing Officer to entertain motion to dismiss.
13. Ensure right to local hearing will not be lost without right to be heard.
14. Limit consideration of prior discipline as an aggravating factor.

15. Require certain disclosures at OBC website and in published literature.

16. Require all consumer complaints in writing.

17. Immediately eliminate all mention of "no discipline" and "private discipline" at BBO website.

18. Require all interviews and Board proceedings to be held in location of respondent.

19. Permit attorneys facing criminal convictions to confer with, and determine the position of, the OBC in advance.

20. Modify reinstatement rules to permit application six months in advance of expiration of term, eliminate hearings concerning moral qualifications, and require adherence to the term of the original suspension without re-litigation at reinstatement hearing.

21. Analyze apportionment of costs between OBC and respondents, and provide for costs to successful respondents.

22. Publish decisions where attorneys not disciplined [apparently only decisions for the OBC have been published since 1999].

BREAKING THE LOGJAM OF THE PATENT APPLICATION BACKLOG

By Neil P. Ferraro, Esq., Wolf, Greenfield & Sacks, P.C.

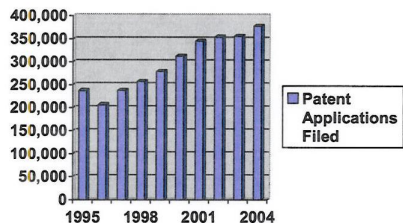
You have a brilliant idea and decide to engage a patent attorney to draft a patent application on it. In a matter of months, you will have an issued patent that you can take to the bank, license to others, or use to stop rival companies from competing with you. Right? Not so fast, says the United States Patent and Trademark Office.

On average, a patent application filed today will take two and a half years to be issued as a patent by the U.S. Patent Office – up from 19 months in 1995.

Companies large and small benefit when they have patents in hand. Start-ups often showcase their patents to potential investors; many venture capitalists and other investors balk at funding companies that lack intellectual property. The CEO of one start-up told me that while his investors may not necessarily know what exactly the patents cover, “they sure can count!” Both quality and quantity can be critical. More established companies want their patents to issue quickly to facilitate licensing (a profit center) and/or to stop infringement by the competition.

In short, delays in the Patent Office can be an impediment to implementing important business strategies. Companies want strong patents and they understandably want them “now.”

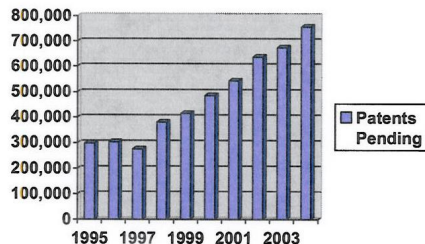
The increase in patent pendency over time appears directly correlated to the sheer volume of patent applications received by the Patent Office. Patent filings have grown from 236,679 in 1995 to 376,810 in 2004, for an average annual growth rate of about 6%.



* Source: USPTO 2004 Annual Report

Significantly, the growing backlog of applications waiting to be reviewed has far outstripped the increase in filings, suggesting that the Patent Office has passed a tipping point in its ability to handle more work. In 2004, more than

750,000 patents were waiting to be reviewed, a staggering 15% per year increase from just 300,000 in 1995.



* Source: USPTO 2004 Annual Report

On numerous occasions, the Patent Office has assured the patent bar and the public that pendency would not be adversely affected by the volume of applications filed. The growing backlog, however, has led to a significant increase in average pendency of applications.

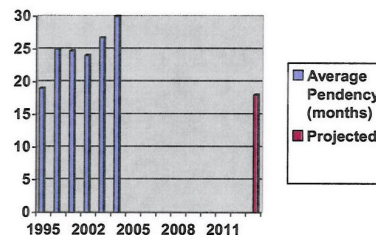
By 2002, the average wait had grown to 25 months. In 2003, the Patent Office responded with its 21st Century Strategic Plan initiative, which included several suggestions on how to improve the situation. One suggested approach was to implement market-driven examination options, whereby prior art searching typically performed by the patent examiners would instead be performed by outside contractors. In some circumstances, a new search would not be performed, with the U.S. Patent Office instead relying on search results from a foreign patent office for a corresponding foreign patent application.

Other options for speedy examination put some of the responsibility back on the applicant. In one suggested approach, a “rocket-docket” option would give the patent applicant the opportunity to have his or her application reviewed and issued within 12 months, provided that the applicant files electronically, performs a prior art search, and includes no more than 20 “claims” (the numbered paragraphs at the end of the patent that define the metes and bounds of the patentee’s property right). Any further correspondence between the Patent Office and the applicant would have to take place via e-mail or facsimile, and the Patent Examiner would be required to respond to the applicant within two weeks.

Yet other ideas included fee discounts or refunds for patent examination processes that reduce the burden on the PTO – for example, refunding part of the filing fee if an applicant decides to expressly abandon an application during certain time periods in the examination process.

Since recognizing the problem and offering some solutions (none of which have been fully adopted), the Patent Office has continued to report growth in patent pendency. For an average application filed today, we can expect an average of 30 months before that application will issue as a patent.

The goal articulated by the Patent Office in its Plan is to reduce this backlog and drive overall patent pendency down to 27 months by 2008 and to 18 months within 10 years of the Plan. Only time will tell whether the Patent Office will be successful in this regard.



*Source: USPTO Annual Reports and 21st Strategic Plan

In the meantime, while many of the Plan’s suggestions have yet to take hold, there are processes in place today that your patent attorney can utilize to move your application along.

The Patent Office’s default rule is that new applications are taken up for examination in the order of their effective United States filing dates. Not all patent applications must be treated alike, however. Exceptions are made for applications falling within certain categories. For example, one rule aims to stimulate the economy: if the applicant shows that it has the ability to make the product it seeks to patent, but will not do so unless a patent is granted, this is a valid ground on which to request expedited examination.

Another rule aims to permit patentees to protect their rights against infringers. If an infringing device or product is actually on the market, the applicant can use this as

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SUFFOLK LAW AND BPLA TO CO-SPONSOR SYMPOSIUM ON RECENT ISSUES IN BIOTECHNOLOGY PATENT LAW

On Friday, November 18, 2005, the Center for Advanced Legal Studies at Suffolk University Law School, in conjunction with the Boston Patent Law Association, will present an all-day symposium directed to current patent issues facing the biotechnology community. "Resolving Uncertainty in Biotechnology Patent Law: Safe Harbor/Experimental Use, Inherency, Obviousness and Utility," will feature panels addressing the meaning and impact of several recent decisions, including the Supreme Court's holding in *Merck KGaA v. Integra Lifesciences*, and the Federal Circuit decisions of *University of Rochester v. G. D. Searle & Co.*, *KSR International v. Teleflex Co.*, *Purdue Pharma v. Endo Pharmaceuticals* and *In re Fisher*. Morning and afternoon four-member panels will include representatives from academia, private practice, industry and the United States Patent and Trademark Office.

The morning panel will be devoted to *Merck v. Integra*, and will include presentations by Kenneth J. Burchfiel of Sughrue Mion, PLLC in Washington, D.C., Kristina L. Burgard, Chief Intellectual Property Counsel of Sepracor Inc, Denise DeFranco of Foley Hoag, LLP and John M. Whealan, Deputy General Counsel for

Intellectual Property and Solicitor of the U.S. Patent and Trademark Office, all of whom were authors or coauthors of amicus curiae briefs filed in this case. The discussion will focus on the scope of the exemption under 35 U.S.C. 271(e)(1), as well as the possible relation of the exemption to the legal doctrine of experimental use and to the likelihood of its effect on research tools.

In the afternoon, the subject will turn to the notion of "invention." Michael Dzwonczyk, also of Sughrue Mion, PLLC, and John F. Duffy, of the George Washington University Law School, will discuss the *Rochester* and *KSR* decisions, respectively. John Duffy was the author of the petition for writ of certiorari to the Supreme Court for *KSR*, which directly challenges the Federal Circuit's long-standing "suggestion-teaching-motivation" test for obviousness under 35 U.S.C. 103. Also, Janice Klunder, Patent Counsel for Millenium Pharmaceuticals, will address the extent to which researchers can patent their early "hunches" in light of the Federal Circuit's recent holding in *Purdue v. Endo*, and Stephen G. Walsh, Associate Solicitor for the U.S. Patent and Trademark Office, will talk about *In re Fisher*, which held that

expressed sequence tags (ESTs) are not patentable subject matter under 35 U.S.C. 101, at least when individually claimed and where there is no known relation of the sequences to specific proteins or their functions.

John Duffy and Michael Dzwonczyk in the morning will also present an update of new and impending relevant decisions, covering issues such as inherency, at the Supreme Court and the Federal Circuit. During lunch, Kenneth Burchfiel, who is the author of "Biotechnology and the Federal Circuit," a text widely used in advanced legal course work, will speak on pertinent aspects of the Patent Reform Act of 2005, now before Congress. Finally, in the afternoon, Solicitor John Whealan and Associate Solicitor Stephen Walsh are going to provide an "inside peek" at developments in the Patent Office, some of which they have suggested will be news.

Scott Pierce and Mary Murray, of Hamilton, Brook, Smith & Reynolds, P.C., in Concord, MA, will be moderators for the event.

Please visit www.law.suffolk.edu to register on-line.

Breaking the Logjam (con't)

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another ground to move the application along.

Likewise, inventions generally recognized as benefiting society, such as those relating to environmental quality, energy, DNA research, HIV/AIDS and cancer research, superconductivity, or countering terrorism also qualify for expedited examination.

In addition, the application can be expedited if the applicant is of ill health or advanced age, or if the invention is biotechnology-related and the owner is a small company.

Each of these special situations requires the applicant to file additional papers with the Patent Office justifying the request.

I recently filed a request for expedited examination for a client and was told by the Patent Office that it should shave 6-9 months off the time it takes for the application to get in front of the examiner in the first place. It took the Patent Office

one month to grant the request, and the application should be in front of the Examiner within three months from the request date.

If your application doesn't qualify for special handling, you can't get to the top of the heap any sooner, but there are strategies that enable your patent attorney to ensure that the process moves along once the patent application is in the examiner's hands.

I favor conducting interviews with the patent examiner, which can be done in-person or over the telephone. Explaining the importance of the invention and how it works to the examiner in "real time" is valuable to avoid misunderstandings, as well as to demonstrate commitment to the process, and to suggest to the examiner that this is no ordinary application. When they understand the importance of the application to the inventor, examiners are more likely to help move the process forward.

While telephone interviews can be effective, it is preferable to visit the examiner in person at the Patent Office in

Alexandria, Virginia. In conducting such interviews, I often bring with me prototypes of the invention (if available) and, if possible, a sample device of any prior art that the examiner has raised. For very important applications, you may even want to make a prototype of the prior art if one is not available on the market, to show the examiner how your invention differs.

Expectations must be managed, however. While the examiners appreciate and often better understand the invention and its importance after an interview, they are often reluctant to commit to a position at the interview itself. The interview should be used as a means to expose the examiner to the invention, build rapport and show your commitment to the invention. It is a mistake to expect that you will walk out of the interview with a final decision from the examiner.

I recently had an in-person interview with an examiner and the engineer/inventor in charge of the product line. Together, we explained the invention and its benefits and how it differed from the prior art. In

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YOUNG LAWYER'S COMMITTEE HOLDS IP PRIMER

by Michelle Z. Bielunis, Esq., Nutter McClennen & Fish, LLP
Gregory J. Siczekwicz, Esq., Mintz, Levin, Cohn, Ferris, Glovsky & Popeo, P.C.

On October 14, 2005, the Young Lawyers and Law Students Committee held an IP Primer seminar relating to Patent Application Drafting at the Federal Reserve Bank in Boston. The seminar featured presentations from the perspective of a prosecutor, and a litigator, and provided practical tips, techniques, anecdotes, and things to consider when drafting a patent application. Steve Saunders, a partner at Bromberg and Sunstein LLP discussed the basics of drafting a patent application from a prosecutor's perspective while Matt Lowrie, a partner at Lowrie, Lando, and Anastasi, LLP, discussed recent case law developments and how those impact drafting patent applications from a

litigator's perspective.

About 55 people attended, including law students, technical specialists, patent agents, and patent attorneys of all levels. Jaime Burke, a technical specialist at Nutter McClennen & Fish LLP, said, "I found it interesting to see similar issues discussed from the perspectives of both a prosecutor as well as a litigator." "The seminar was informative for both law students and young lawyers in aiding their development towards a comprehensive approach to patent drafting," stated Doris Fournier, an IP litigation associate at Mintz Levin. Added Greg Len, a technology specialist at Mintz Levin, "The seminar was informative for both law students and

young lawyers in aiding their development towards a comprehensive approach to patent drafting."

The seminar concluded with most participants enjoying a great networking opportunity at a local bar.

The Young Lawyers and Law Students Committee plans to hold another IP Primer seminar in Spring 2006 relating to drafting responses to office actions. For more information about the Young Lawyers and Law Students Committee, please contact co-chairs Michelle Bielunis at mbielunis@nutter.com or Greg Siczekwicz at GJSiczekwicz@mintz.com.

Breaking the Logjam (con't)

(Continued from page 7)

the end, the examiner appreciated our visit, kept samples of the device for reference, and appeared to be more genuinely interested in light of our explanation. I expect that building this kind of rapport will help with this application and future ones with this examiner.

It can also be important to keep the pressure on. After the interview, you or your attorney should prepare a written response summarizing the interview and addressing the points raised. Deliver it to the examiner within a short period of time. I often prepare the response on my plane

ride home so that it can be filed the next day. Call the examiner to tell him or her that the response is on the way. Follow up in a week or two and invite the examiner to call you with any issues or concerns they may have.

In one matter I was handling, after having established a connection with the examiner, she called to inform me that she was working on the application and, while updating her prior art search, found what initially appeared to be a close prior art reference. She asked that I take a look at it and call her back to discuss it. That afternoon, I was on the phone and by the end of the conversation, we concluded that the prior art was not a concern. The benefit of this relationship is that it avoided

the unnecessary delay of a written office action and response.

Although it appears many of these suggestions may be more costly and timely in the short run, they will prove worthwhile in the long run by producing a patent much more quickly.

Neil P. Ferraro is a shareholder in the intellectual property law firm of Wolf, Greenfield & Sacks in Boston.

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Positions Available (con't)

(Continued from page 8)

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Technology Specialist

(Intellectual Property)

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The Technology Specialist will assist in patent preparation and prosecution of U.S.

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- Experience searching literature and IP databases;
- BA/BS in Biology, Chemistry, Molecular Biology, or Biochemistry;
- Ability to search, read, digest and analyze scientific material in a broad range of fields;
- Strong oral and written communication skills;
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Preferences:

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Send resume to careers@combinatorx.com

Cubist Pharmaceuticals, Inc.

Coordinator, Intellectual Property Team

Cubist Pharmaceuticals, Inc. (Nasdaq: CBST) is focused on becoming a global leader in the research, development and commercialization of novel antimicrobial drugs to combat serious and life-threatening bacterial and fungal infections. Founded in 1992, Cubist is headquartered in Lexington, MA. For more information about the company, please visit our website at www.cubist.com.

The IP Team Coordinator will support the Chief Intellectual Property Counsel, Intellectual Property Counsel, Patent Agent and Intellectual Property paralegal by performing administrative functions related to patent, trademark, trademark opposition, domain name, copyright,

litigation, licensing and other miscellaneous corporate matters.

Responsibilities:

- Provide general administrative support (word processing; photocopying; printing; filing; scheduling/rescheduling meetings; preparing PowerPoint presentations; creating and maintaining Excel spreadsheets; FedExing; mailing; faxing; making phone calls; call screening; message taking; ordering supplies; retrieving and delivering documents and other items; accompanying visitors; scanning; requesting checks/wires; creating and maintaining physical files, including patent and trademark prosecution files and general oversight of the patent file room; responding to general requests for information)
- Retrieve, open, date stamp, sort, review and forward incoming correspondence; monitor and forward faxes received in LegalFax inbox
- Manage calendars (schedule/reschedule meetings; monitor responses; respond to meeting requests; resolve conflicts; manage meeting materials; announce out of office time; make travel arrangements; arrange for conference calls, A/V equipment; plan Team events)
- Manage Outlook task lists (make edits as required)
- Maintain orderly IP Team folders on shared drive (ensure folders are organized, ensure files are correctly named and saved in proper folders; delete outdated files)
- Maintain orderly IP Team files (attend to loose filing; create file jackets, redwelds, hanging folders and manila folders; assign matter numbers; maintain adequate stocks of filing supplies)
- Maintain IP Team Library (maintain orderly shelves and materials; update resources; discard outdated materials)
- Maintain orderly IP Team file cabinets and Law Department File Room shelves and open spaces (move/arrange files; send materials to and retrieve materials from offsite storage)
- Function as Department Record Manager in accordance with Law Department RRIP
- Maintain IP Team prosecution templates library (maintain library of current forms used during US and foreign prosecution, maintain library of current standard response language)
- Process expense reports
- Process purchase requisitions

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Positions Available

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- Process invoices (review for accuracy, completeness and duplication; resolve issues; get approvals; photocopy; record; produce reports, answer questions)
- Attend to conference participation (register participants; make travel arrangements; manage materials)
- Manage memberships and subscriptions (discuss; renew/cancel; record; manage materials)
- Coordinate intern program (act as liaison to law school intern programs; collect resumes; schedule interviews; send offer/rejection letters; orient/train; attend to new hire and departure matters; schedule meetings; maintain intern personnel files and project list; provide administrative support)
- Coordinate IP Team weekly meetings (schedule/reschedule; manage agendas and materials; retrieve and return files)
- Assist with domestic and foreign IP prosecution (provide administrative support; prepare formal prosecution documents such as Information Disclosure Statements, assignments, transmittals, fax cover sheets, postcards, Express Mail labels, office action responses, formal papers)
- Support long term projects such as litigation and company-wide Record Retention effort
- Work with other departments to ensure smooth interaction with IP Team
- Work with other legal administrative assistants in overall management and operation of Company's Law Department and support other Law Department team members as required

Requirements:

- Minimum of 2 years experience in an administrative assistant role
- Effective communication skills and proficiency with Microsoft Office applications
- Superior attention to detail
- Ability to prioritize, handle multiple tasks and organize
- Ability to work both independently and as a member of a team, with close supervision and almost no supervision
- Poise and professionalism to interact frequently with the company's scientists and senior management
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- Willingness to learn and think creatively

Strongly preferred:

- Experience in an intellectual property law practice

Special skills:

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A background in optical, electro-optical technologies or materials science is preferred. Responsibilities include interviewing scientists and engineers about inventions, accurately documenting invention and writing claims as first step of patent process. Will work with Ph.D.s and physicists, inside General Counsel and outside patent counsel.

Significant experience with patent drafting and prosecution a must.

Full time assignment for first 3-6 months, then part-time. Contract or employment basis.

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Qualified candidates should have at least five years of experience as a patent and trademark paralegal in a law firm, excellent communication skills, excellent organizational skills and attention to detail. In addition, strong writing skills, technology skills and the ability to meet strict deadlines are required.

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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.

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2005

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UPCOMING EVENTS

Wednesday, November 16, 2005
4:00-6:00 pm The U.S. Patent System:
Working or Broken and Who Decides

Friday, November 18, 2005
9:00-4:00 pm Safe Harbor/Experimental
Use, Inherency, Obviousness and Utility

Wednesday, December 7, 2005
11:00-2:00 pm BPLA Annual Meeting

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.

ARTICLE SUBMISSION

If you would like to write an article for an upcoming issue of the Boston Patent Law Association's Newsletter please contact: Lee Carl Bromberg at Bromberg & Sunstein LLP, 125 Summer Street, Boston, MA 02110-1618, phone (617) 443-9292, fax (617) 443-0004, lbromberg@bromsun.com

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