



BOSTON PATENT LAW ASSOCIATION NEWSLETTER

Serving the
New England
Intellectual
Property Bar
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April 2008

EDUCATION, SERVICE, COMMUNITY

Volume 39, Issue 2

PRESIDENT'S MESSAGE

By Leslie Meyer-Leon, Esq., IP Legal Strategies Group

If in New England you don't like the weather, just wait a while; so it would seem with intellectual property these days. The Patent Reform Act of 2007 (H.R. 1908 and S. 1145) proceeds rapidly toward resolution. Numerous PTO rule changes are at various stages of implementation, and courts continue to adjust to the changed winds of the U.S. Supreme Court. Similar to Mark Twain's take on New England weather, "the [denizens of intellectual property] are always doing something there; always attending strictly to business; always getting up new designs and trying them on people to see how they will go. But it gets through more business in Spring than in any other season."

This spring, the BPLA is an active and respected voice in the debate on patent law reform. We rank among the country's largest, most influential intellectual property associations, and count amongst our members a solid cadre of bright, influential, experienced IP attorneys. It is fitting that the BPLA be active in the direction of patent law reform, and the participation of each one of our members counts. Fortunately we have a vehicle for collective member input, which is through our committee structure.

On the legislative front, the Contested Matters Committee held a working

session on January 31, 2008, to formulate a position on the Post-Grant Review sections of S.1145. The position was drafted by co-chairs Mike McGurk and Susan Glovsky, and sent to committee members for further comments before its February 13th submission to the Senate Judiciary Committee. (See letter at page 9) Other aspects of the proposed legislation await comment from the BPLA, such as first inventor-to-file, assignee filing, apportionment of damages, willful infringement, prior user rights, third party prior art submissions, venue, interlocutory appeals, inequitable conduct, and mandatory search. Many consider this legislation to be on fast track for an April/May Senate vote, so I encourage you to act soon. Please contact one of your committee chairs to participate.

On the regulatory front, a joint meeting of the Patent Office Practice and Biotechnology Committees was held March 24th to work on comments in response to two recent proposed sets of PTO rule changes. Comments on new rules concerning biological deposits are due April 21st. Comments on a second

set of rules, regarding examining claims containing alternative language, are due April 9th. My thanks go to Donna Meuth of the Patent Office Practice Committee, and to Shann Kerner and Christine Wise of the Biotechnology Committee, for their initiative and leadership. Please contact them to participate in formulating responses to these or other PTO requests for comments on proposed rule changes.



President Leslie Meyer-Leon

On the judicial front, a joint meeting of the Computer Law and Amicus Committees was held March 20th to prepare an outline and strategy for an amicus brief in response to the Federal Circuit's February 15th en banc order requesting amicus briefs in *In re Bilski*. *In re Bilski* involves the question of whether pure business methods, or even computer

implemented methods, are statutory subject matter under section 101. Kudos for taking this initiative go to John Stickevers and Steve Henry of the Computer Law Committee, and to Erik Belt and Robert Abrahamson of the Amicus Committee. <>

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CALENDAR OF EVENTS



Tuesday, April 1, 2008

5:00-7:00 pm

Careers in Intellectual Property

Presented by the New Lawyers and Law Students Committee

Friday, April 4, 2008

12:00-3:00 pm

The Law of Software Contracts Restated by the American Law Institute – and Other Current IP-Contract Issues

Presented by the Copyright Law
Committee

Friday, May 2, 2008

Annual Dinner in Honor of the Federal Judiciary

Monday, July 7, 2008

Annual Summer Outing - Boston Red Sox v. Minnesota Twins

Wednesday, December 3, 2008

2008 Annual Meeting

For further information, go to www.bpla.org

MEMBERS ON THE MOVE

- **Gregory Sieczkiewicz** recently joined Foley Hoag as an associate.
- **Jennifer A. Zarutskie** recently joined Dyax Corporation as the Director of Intellectual Property.
- **Louis Myers, Laurie Lawrence,** and **Diana Collazo** joined Lowrie, Lando & Anastasi LLP as partners. **Cathy McCarty** and **Natalie A. Lissy**, who are associates, and **Allyson R. Hatton**, a patent agent, also joined Lowrie, Lando & Anastasi LLP.
- **Kaplesh Kumar** has recently taken an early retirement from his 33-year engineering career at the Charles Stark Draper Laboratory to start up an independent IP law practice.
- **Monica Grewal** has been elevated to partner in the Intellectual Property Department at WilmerHale.
- **Joyce Hersh** became in-house counsel for Metabolix, Inc. this past July.
- **Victor H. Polk, Jr.** moved to Greenberg Traurig LLP, where he continues his Intellectual Property litigation practice.
- **Joseph Maraia** has accepted a Senior Counsel position at Foley Lardner.

SAVE THE DATE

The Boston Patent Law Association
announces the date for our

**Annual Dinner
in Honor of the Federal Judiciary**

Friday, May 2, 2008

John Joseph Moakley United States Courthouse
Boston, Massachusetts

Our Entertainment will be
COMEDIAN JIMMY TINGLE

Recipient of the BPLA Distinguished Public Service
Award

THE HONORABLE PATTI B. SARIS

Cocktails begin at 6:00 p.m.

Program and Dinner begin at 7:15 p.m.
Black Tie Optional

Please mark your calendar

\$210 per member or guest of member
\$260 for non-members
\$2100 per table of 10

RSVP

Janice Roussel at 617.526.6804
Janice.Roussel@wilmerhale.com

Leslie Meyer-Leon
President, Boston Patent Law Association

**Jimmy Tingle for President
The Funniest Campaign in History**

Drawing on 25 years of comedic insight, outrage and commentary, nationally known Comedian and commentator for 60 Minutes II Jimmy Tingle has constructed another hilarious, thought provoking and politically charged one man show based on his 2008 run for the Whitehouse.

In lieu of consultants, volunteers or campaign contributions Tingle employs "the gift of laughter" for 90 minutes each night campaigning with passion, intellect and creativity on every issue from Immigration and education to Global warming and national healthcare.

Running as the nominee of "The American Peace Party" which he founded in 2000 it is Jimmy Tingle's hope to use his campaign and the party to create a vehicle to raise the consciences of the American people and help move this great nation out of the wilderness of partisan politics and despair and into the "promised land" of hope, laughter, optimism, progress, prosperity and peace with humor. Despite the seriousness of the issues, don't worry it's funny.

The show will run at least through election day 2008. In the unlikely event Jimmy Tingle is actually elected president he will have no choice but to continue the show through Inauguration day 2012.

Jimmy Tingle was born and raised in Cambridge, Massachusetts. The social, political and economic diversity of that city laid the groundwork for his development as a performer and satirist. He started performing in 1980

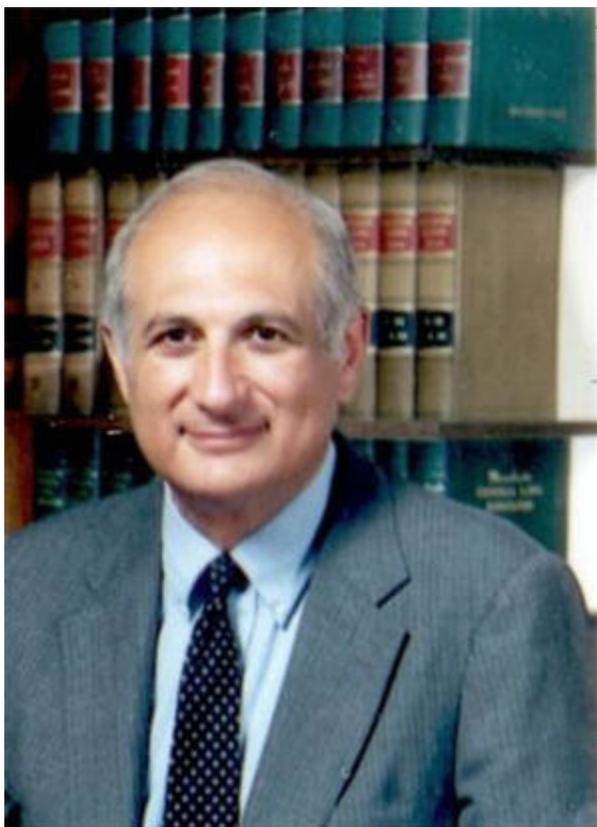
during the early stand up comedy scene in Boston and quickly rose through the ranks from open-mike performer to paid engagements, headlining at comedy clubs, theaters and colleges nationwide. He is now regarded as one of the top social commentators and humorists in the country.

Jimmy Tingle completed two seasons with 60 Minutes II on CBS as the humorist / commentator in the Andy Rooney spot, worked as a contributor and satirist for MSNBC and has appeared on Comedy Central's Tough Crowd with Colin Quinn, was the American correspondent for Sir David Frost's show for PBS and the BBC, The Strategic Humor Initiative. Tingle appeared as a television talk show host in Chris Rock's film, Head Of State. Tingle has also appeared on ABC-TV's The American Comedy Awards, The Tonight Show, CNN's Larry King Live, Late Night with Conan O'Brien, as well as his own HBO comedy special.

www.jimmytingle.com



Robert Cesari
(1928-2007)



The Boston Patent Law Association extends its sympathies to the family, friends, and associates of Robert A. Cesari, an eminent intellectual property lawyer, founding partner of Cesari & McKenna, LLP in Boston, and past president of the BPLA. Mr. Cesari died January 8, 2008 in Boston at the age of 79 after a valiant, 4 ½ year struggle against acute lymphocytic leukemia (A.L.L.).

"Our founder, colleague, mentor and friend, Bob, was unique among all men," said Martin O'Donnell, a partner speaking for the firm, Cesari & McKenna."

As an intellectual property attorney and a founder of the firm, Cesari & McKenna, Mr. Cesari helped to shape the landscape of the technology industry in Massachusetts. As a result of his outstanding activities in the fields of patent law practice, Mr. Cesari was voted by his peers as one of the top civil litigators in Boston and one of the top intellectual property lawyers in the United States. He was a past president of the Boston Patent Law Association and a member of the Massachusetts Bar Association, American Bar Association, and the American Intellectual Property Law Association.

Jean Montagu, currently Chairman of Decision Biomarkers Inc. and a client of Mr. Cesari's since 1959, remembers that Bob Cesari was an incredibly generous person and a rare judge of character: "He always added to each application he prepared. He had imagination and backed his feelings with action. He was generous not only with his time but also his advice, encouragements and moral support. Bob took me in as a client in 1959 when I had no job and no money. The technology became a business and a success and we became great friends and [he was a] supporter to the time he died."

Mr. Cesari was raised in Elmira, New York. In 1950, he graduated from the Massachusetts Institute of Technology with a degree in electrical engineering. Upon graduation, he entered Harvard Law School where his studies were interrupted by two years of active service in the U.S. Army ordnance corps in which he served as a Lieutenant. Mr. Cesari was deeply involved in community activities within the Boston area. Among them, he served on the Board of Directors of the Boston Heart Foundation starting in 1980 and served as class agent for his M.I.T. class of 1950.

His leisure time was devoted to his family and outdoor activities. Mr. Cesari's children remember him as "a compassionate man with a brilliant mind who dearly loved his family and always enjoyed a good joke."

Mr. Cesari leaves his wife of 54 years, Lucille, his three children, Robert, Jr. of Cambridge, Mass., Carol Tourgee of Morristown, N.J., and Richard of Dallas, Texas, and his brother, Gene and sister-in-law Judith, of South Ryegate, Vermont and three grandchildren.

**Citation of References in Light of
McKesson Information Solutions, Inc. v. Bridge Medical, Inc.**

By Rory P. Pfeiffer, Esq. and Christina Sperry, Esq., Nutter, McClennen & Fish LLP

While the patent law community was busy trying to figure out exactly what was obvious following *KSR v. Teleflex*, 550 U.S. ___, 127 S. Ct. 1727 (2007), the Federal Circuit ruled on a case involving the citation of references during the prosecution of a patent and its impact on potential allegations of inequitable conduct. The reasoning in *McKesson Information Solutions, Inc. v. Bridge Medical, Inc.*, 487 F.3d 897 (Fed. Cir. 2007), should cause many practitioners to reconsider the amount and types of references they cite in Information Disclosure Statements ("IDS"). This article discusses the *McKesson* case and the implications that this ruling has on prosecution practices going forward.

Background of the McKesson Case

The patent at issue in *McKesson*, U.S. Patent No. 4,857,716 to Gombrich et al. ("the '716 patent"), is directed to a patient identification and verification system and method that can be used to electronically link items, such as prescriptions, to patients so that such items could be accurately distributed to patients. More specifically, the claim at issue was directed to a three node system including a system computer means for processing and storing patient data, a portable handheld patient terminal means for scanning bar codes, and a base station means having a programmable unique identifier ("PUI") to facilitate communication between the system computer means and the portable handheld patient terminal means based on a patient's PUI. The prosecution of the '716 patent occurred in front of Examiner Trafton ("Trafton"). While the '716 patent was being prosecuted, a continuation-in-part (the "CIP application") claiming priority to the application of the '716 patent was filed, examined by Trafton, and issued prior to issuance of the '716 patent. Also during the prosecution of the '716 patent, a second application, which eventually issued as U.S. Patent No. 4,850,009 ("the '009 patent"), was being prosecuted in front of a different examiner, Examiner Lev ("Lev"). The '009 patent was directed to subject matter similar enough to the '716 patent that the attorney disclosed the same body of prior art with

both applications.

During prosecution of the patent at issue, Trafton rejected all of the claims, however the attorney eventually convinced Trafton that the claimed three node system and a PUI was novel. Following the receipt of a first rejection during prosecution of the related application that eventually issued as the '009 patent, the attorney added claims directed to a three node system and a three node system having a PUI. Just seventeen days after submitting arguments to Trafton that the claims that eventually issued in the '716 patent were novel, the attorney discovered a new reference that disclosed a form of a three node system and PUI with respect to a cordless telephone system, the Baker reference, and called Lev to tell him about the new reference. After the conversation with Lev, an office action issued rejecting each of the pending claims, and following the office action the attorney narrowed the initial claims and canceled the previously added claims, which in turn resulted in issuance of the '009 patent.

Although the attorney initially disclosed to Trafton the existence of the application in front of Lev, the attorney never disclosed the Baker reference or the office action from Lev rejecting the claims directed to a three node system having a PUI. Further, the attorney never cited the Notice of Allowance issued in the '716 patent by Trafton in the CIP application which was also being examined by Trafton. In *McKesson*, the court found that each of these three omitted citations constituted inequitable conduct, and further, that the pattern created by each of these three acts of inequitable conduct constituted a fourth act of inequitable conduct, which justified invalidation of the '716 patent.

Reasoning Behind the McKesson Decision

Only when there is both a failure to cite information material to patentability and an intent to deceive can inequitable conduct exist. In determining whether the three references (Baker, the office action, and the Notice of Allowance) in question

were material to patentability, the court evaluated whether a reasonable examiner "would substantially likely consider important [the information] in deciding whether to allow an application to issue as a patent."

With respect to the Baker reference, the patentee argued that the Baker reference was not material and to the extent that it could be considered material, it was cumulative of the other references of record. The court did not agree. The court found that the Baker reference made disclosures not already included in the prior art and also found that to the extent it was related to other disclosures, it provided the Examiner a more in-depth analysis than any other information of record.

With respect to Lev's rejection, the court determined that the rejection was material because the '009 patent was "substantially similar" to the claimed invention of the '716 patent at least because the claims added (and later canceled) during the prosecution of the '009 patent substantially overlapped with the claims of the '716 patent. The court in particular explained that Lev's rejection would be of additional importance to Trafton because it contradicted the attorney's arguments for patentability previously made to the Examiner, and that the cancellation of the claims following the rejection further evidenced the materiality of the rejection.

With respect to the Notice of Allowance issued by Trafton in the CIP application (i.e., the Notice of Allowance issued by the *same* Examiner), the court held it was material because it was also directed to a three-node communication system and thus at least material with respect to a conceivable double patenting rejection. Relying on the Manual of Patent Examining Procedure ("MPEP"), the court stated that a prosecuting attorney should not assume that an examiner retains information from one file while working on another file, and thus the burden is on the prosecuting attorney to bring possibly material and non-cumulative references to

(Continued on Page 6)

McKesson Information Solutions
(Continued from Page 5)

the attention of the examiner to give the examiner the opportunity to decide whether the information is material to patentability.

Deceptive intent, which is typically found through circumstantial evidence, was found in the nondisclosure of each of the three references. With respect to the Baker reference, the court particularly noted that, only seventeen days after the attorney argued to Trafton that the three node system of the patent at issue was novel, the attorney notified Lev of the Baker reference and discussed the same in an interview with Lev but did not do the same with Trafton. The court further reasoned with respect to both the Baker reference and Lev's rejection that deceptive intent could be inferred because the attorney's decision to cancel the claims without argument gives rise to an inference of materiality of both, this being especially true when the references contradicted the attorney's position with respect to novelty of the three node system. While the patentee argued that cross citing the '716 patent and the '009 patent at the outset of prosecution demonstrated an intent not to deceive, the court found that the lower court weighed this fact against all of the other circumstantial evidence supporting a finding of deceptive intent and without any credible explanation for not disclosing any of the three references, the court upheld the finding that the attorney committed inequitable conduct by failing to disclose each of the Baker reference, Lev's rejection, and the Notice of Allowance.

Concluding the case, the Federal Circuit engaged in an equitable balancing of materiality and intent in light of "the pattern of material nondisclosures" and determined that it weighed firmly in favor of unenforceability because the showings of materiality and intent were high with respect to each identified nondisclosure. The court failed to address whether one nondisclosure, standing alone, would likewise justify a judgment of unenforceability of the patent.

Prosecution in Light of McKesson

How does the decision in *McKesson* affect practitioners? The practical prosecution tips provided here should prove helpful, at

least until Congress or the Patent and Trademark Office ("PTO") adopts new rules. At least at the time of writing this article, law relating to inequitable conduct is likely to be considered in patent reform legislation in Congress and new IDS rules are in the approval process in the PTO, although a final version of their content has not been released. As every practitioner knows, it is always prudent to check the current rules for current requirements.

The citation of prior art is governed by 35 U.S.C. § 301 and more particularly is guided by the regulations of 37 C.F.R. § 1.56 ("Rule 56") and chapter 2000 of the MPEP. Rule 56 states that each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith to the PTO with respect to all information material to patentability. This duty persists throughout prosecution.

Despite bringing the specter of inequitable conduct more into the light, the *McKesson* decision should not markedly change a patent prosecutor's general good practices when it comes to citing art in related cases. It is still best practice to disclose all art cited in all related cases, whether those cases have a familial relationship or are related only by subject matter. Prosecutors should also still bring prosecution of related cases to an Examiner's attention, whether in the text of an application, in an IDS, or in a response to a PTO action. Even if the same Examiner is examining related cases, *McKesson* and the MPEP indicate that wise practice would include explicitly informing the Examiner of such relationships.

As a potential variation to an individual's typical IDS recitations, *McKesson* highlights that Applicants should not merely bring the existence of related cases to an Examiner's attention but bring prosecution documents in related cases to an Examiner's attention. *McKesson* indicates that prosecution documents such as Office Actions and Notices of Allowance can be material to patentability if they could conceivably raise patentability issues, such as double patenting. *McKesson* in particular highlights the importance of bringing to an Examiner's attention documents that contradict positions taken during the prosecution of the application at hand.

Although not discussed in *McKesson*, materiality of foreign office actions in the same or related cases should also be considered for the same reasons for possible PTO submission.

While information that is cumulative does not need to be submitted, *McKesson* indicates that Applicants should submit that art to the Examiner, particularly if another Examiner used that art in rejecting a related case. Keep in mind that if information provides more detail to an otherwise cumulative reference or provides related information that is not cumulative, that information should be disclosed. If a practitioner determines that information is truly cumulative of art already before an Examiner and thus decides not to submit it to the PTO, the MPEP suggests noting as much in the file to help guard against later accusations of inequitable conduct.

Prosecutors should remember not to exclude art from submission because it is not technically prior art. Patent regulations particularly require information, as opposed to references that qualify as prior art, because any information that could make grant improper should be disclosed to the Examiner. A piece of art not considered prior art under patent regulations, such as another Examiner's rejection and related analysis in a co-pending application's Office Action or a related application that could be material for double patenting purposes, can still be material to patentability and thus can advisably be submitted to the PTO. In attempting to adhere to the duty of candor and good faith, the MPEP assumes that a practitioner will err on the side of caution by submitting any information that could be material to patentability, allowing the Examiner to determine if the information is actually material to patentability.

Keeping track of what art has been cited in which cases and what cases are related in any way to other cases can be a challenge. Every practitioner should invest the time and energy in finding or developing such a relationship tracking system with their employer or for themselves if they have not done so already. <

Issue Preclusive Effect of *Markman* Claim Construction Rulings

By Keith J. Wood, Esq., Mark B. Solomon, Esq., Susan G. L. Glovsky, Esq. and John T. Hurley, Esq., Hamilton Brook Smith Reynolds

Suppose your client asks you to provide an opinion regarding non-infringement or invalidity of a United States patent owned by your client's competitor. You discover that the competitor's patent has been asserted against a third party in a patent infringement action in which there has been a *Markman* ruling construing the claims of the patent.

Do you have grounds for opining that, if the patent were to be asserted in a new patent infringement proceeding against your client, the interpretation of the competitor's claims could be constrained by the construction in the *Markman* ruling?

Existing case law does not provide a simple answer.

Issue preclusion, also known as collateral estoppel, bars re-litigation by a party to an earlier case of issues that were actually litigated and necessarily determined in the earlier proceeding. *Blonder-Tongue Labs v. University of Ill. Found.*, 402 U.S. 313, 329 (1971); Restatement of Judgments §§ 13, 27 (2003). Collateral estoppel may apply when, in the prior proceeding, the following requirements are met: (1) the issue is identical to one decided in the first action; (2) the issue was actually litigated; (3) the resolution of the issue was essential to a final judgment; and (4) the party against whom estoppel is invoked had a full and fair opportunity to litigate the issue. *A.B. Dick Co. v. Burroughs Corp.*, 713 F.2d 700, 702 (Fed. Cir. 1983). However, collateral estoppel will not apply if the party against whom estoppel is sought could not, as a matter of law, have obtained review of the judgment in the initial action. Restatement of Judgments § 28 (2003).

Of the four requirements for application of collateral estoppel, requirements (1), (2) and (4) can all be satisfied when there has been a *Markman* ruling in an earlier case: the issue of claim construction was decided in the earlier action and was actually litigated and, assuming that estoppel is invoked against one of the parties from the earlier litigation, the party against whom estoppel was invoked had a full and fair opportunity to litigate the issue.

But when is a *Markman* ruling considered

sufficiently essential to a final judgment (requirement (3)) to allow invocation of collateral estoppel?

There is a growing split among regional district courts when interpreting the finality requirement of the standard for collateral estoppel. In the Fifth Circuit, collateral estoppel requires an appealable judgment. *R.F. Del., Inc. v. Pac. Keystore Techs., Inc.*, 326 F.3d 1255, 1261 (Fed. Cir. 2003). The Second Circuit uses a more flexible finality standard, considering "the nature of the decision (*i.e.*, that it was not avowedly tentative), the adequacy of the hearing, and the opportunity for review." *Lummas Co. v. Commonwealth Oil Refining Co.*, 297 F.2d 80, 89 (2d Cir. 1961). The Seventh Circuit has held that, to be final for purposes of collateral estoppel, the decision need only be immune, as a practical matter, to reversal or amendment. *Miller Brewing Co. v. Jos. Schlitz Brewing Co.*, 605 F.2d 990 (7th Cir. 1979). The Eleventh Circuit, applying a different set of factors, noted that a prior proceeding was sufficiently final because "the district court considered a wide range of evidence from all concerned parties, notified the parties of possible preclusive effect, clearly considered the findings final, and entered a final order approving the proposed settlement." *Christo v. Padgett*, 223 F.3d 1324, 1339 (11th Cir. 2000).

For patent cases, the Federal Circuit applies regional circuit law to collateral estoppel issues. *Novartis Pharms. Corp. v. Abbott Labs.*, 375 F.3d 1328, 1334 (Fed. Cir. 2004) (citing a line of cases holding that the application of principles of claim preclusion and issue preclusion is not a matter committed to the exclusive jurisdiction of the Federal Circuit, so the court looks to the law of the circuit to which an appeal would lie in non-patent cases from the particular district court). Therefore, whether collateral estoppel applies may depend on the regional circuit law for the trial court in which a patent infringement case is being held.

Indeed, among the District Courts, two conflicting schools of thought are emerging on the question of whether there is an issue preclusive effect on claim construction from a *Markman* ruling. The first school of thought follows *TM Patents, L.P.*

v. IBM Corp., 72 F. Supp. 2d 370 (S.D.N.Y. 1999). In this Second Circuit case, there had been a *Markman* ruling in an earlier case, but the parties subsequently settled the earlier case during trial. The *TM Patents* court held that the earlier court's claim construction was nevertheless binding on the patent holder because the patent holder was afforded a full and fair opportunity to litigate the claim construction in the earlier case. Other courts have followed the reasoning of the *TM Patents* court, for example in *Louisville Bedding Co. v. Perfect Fit Industries*, 186 F. Supp. 2d 752, 755 (W.D. Ky. 2001) ("[I]t is not for this court to judge the correctness of a previous judge's claim interpretation in determining its preclusive effect").

However, another school of thought follows a Third Circuit case, *Graco Children's Products, Inc. v. Regalo Int'l, LLC*, 77 F. Supp. 2d 660, 662 (E.D. Pa. 1999), in which issue preclusive effect was not given to a claim construction hearing where the claim construction was found not to be essential to the final judgment. In *Graco*, a settlement had been reached in an earlier patent infringement case before the possibility of appellate court review arose. The *Graco* court reasoned that the parties in the earlier case lacked an adequate incentive to fully litigate the claim construction because the settlement was reached.

Because the *Graco* decision does not give issue preclusive effect to a claim construction where a settlement was reached in an earlier case, it is directly opposite to the *TM Patents* decision in the Second Circuit, and illustrates the split of authority on the question. See *The Application of Collateral Estoppel to Markman Rulings: The Search for Logical and Effective Preclusion of Patent Claim Constructions*, 3 Minn. Intell. Prop. Rev. 297 (2002). An example of a case that has followed the *Graco* court's reasoning is *Kollmorgen Corp. v. Yaskawa Elec. Corp.*, 147 F. Supp. 2d 464, 470 (W.D. Va., 2001) ("[c]ourts need not blindly apply the doctrine of collateral estoppel to a prior *Markman* ruling that construes a patent's scope and claim").

From a policy point of view, the courts that agree with the *TM Patents* court

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Effect of *Markman* Claim Construction Rulings

(Continued from Page 7)

reason that collateral estoppel helps preserve judicial precedent and removes the ability of wealthy litigants to buy away unfavorable preclusive effects through settlement. On the other hand, the courts that agree with the *Graco* court reason that there is no opportunity for review by the Federal Circuit of claim constructions that are unattached to final judgments, and parties would lack an incentive to settle after receiving an adverse *Markman* ruling if the ruling would have issue preclusive effect in future cases. See *Manders v. McGhan Med. Corp.*, 2006 U.S. Dist. LEXIS 57467 at *6, n.1 (W.D. Pa. 2006); *Anthony M. Garza, Collateral Estoppel and Claim Construction Orders: Finality Problems and Vacatur Solutions*, 6 Colum. Sci. & Tech. L. Rev. 4 (2005).

Outside of the circumstances of the *TM Patents* and *Graco* cases, in each of which a settlement had been reached in an earlier case in which a *Markman* hearing had been held, courts have applied different reasoning on the preclusive effect of a *Markman* ruling. For example, in a more recent First Circuit case, the U.S. District Court for the District of Massachusetts gave issue preclusive effect to a *Markman* ruling, in *Amgen, Inc. v. F. Hoffmann-LaRoche Ltd.*, 494 F. Supp. 2d 54, 60 (D. Mass. 2007). In this case, a *Markman* hearing was held to construe disputed terms of a patent litigated in an earlier case. In addressing the precedential effect of the prior claim construction, the Court held that because the plaintiff was a party in the previous case, which construed many of the same claims at issue, and had a full and fair opportunity to litigate the issue, the plaintiff would be barred from re-litigating claim language previously construed by the Court.

In a Third Circuit case on a somewhat similar issue, the U.S. District Court for the Western District of Pennsylvania declined to reconsider its own *Markman* ruling from earlier in the same case, in *Manders v. McGhan Med. Corp.*, 2006 U.S. Dist. LEXIS 57467 (W.D. Pa. 2006). Here, the defendants filed a motion for reconsideration of a claim construction order, objecting to three of the court's constructions from earlier in the case. Because of the extensive record, the formal procedure with which the claim construction proceedings were conducted, and in the interest of judicial economy, the court applied a strict standard of review to the motion for reconsideration. The court reasoned that, under such circumstances, a motion for reconsideration is granted only upon: (1) an intervening change in controlling law; (2) the emergence of new evidence not previously available; or (3) the need to correct a clear error of law or to prevent a manifest injustice. Failing to satisfy any of these elements, the court denied the defendant's motion for reconsideration.

Other courts have given some deference to a prior court's claim construction without necessarily following the prior claim construction identically. See *Abbott Labs. v. Dey, L.P.*, 110 F. Supp. 2d 667, 671-672 (N.D. Ill. 2000) (applying issue preclusion, but engaging in its own claim construction to determine if previous construction was plainly wrong); *Nilssen v. Motorola, Inc.*, 80 F. Supp. 2d 921, 924 n.4 (N.D. Ill. 2000) (according

respect to prior construction but no preclusive effect); *Texas Instruments, Inc. v. Linear Techs. Corp.*, 182 F. Supp. 2d 580, 589 (E.D. Tex. 2002) (stating that a court may defer to a prior construction, but is not bound by it).

One commentator, cited by the *Manders* court, has suggested that the grant or denial of collateral estoppel effect for earlier *Markman* rulings depends in large part on the level of finality of the *Markman* hearings. See *Manders*, 2006 U.S. Dist. LEXIS 57467, at *6, citing *Anthony M. Garza, Collateral Estoppel and Claim Construction Orders: Finality Problems and Vacatur Solutions*, 6 Colum. Sci. & Tech. L. Rev. 4 (2005).

The Federal Circuit has addressed the issue preclusive effect of claim construction with regard to administrative bodies such as the International Trade Commission (ITC) and the Board of Patent Appeals and Interferences. In *Texas Instruments v. Cypress Semiconductor Corp.*, the Court stated that "Congress did not intend decisions of the ITC on patent issues to have preclusive effect" and that "the district court can attribute whatever persuasive value to the prior ITC decision that it considers justified." See *Texas Instruments v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1569 (Fed. Cir. 1996).

The Federal Circuit has also held that, in reexamination proceedings, the Board of Patent Appeals and Interferences is not bound by a district court's claim construction. In *In re Trans Tex. Holdings Corp.*, a district court conducted a *Markman* hearing construing various terms of two patents in suit. During the course of litigation, Trans Texas requested reexamination of the two patents based on a substantial new question of patentability. The examiner subsequently rejected all claims of both patents as obvious. On appeal, Trans Texas argued that the Board of Patent Appeals and Interferences should have given preclusive effect to the district court's *Markman* order. The Federal Circuit disagreed and affirmed the examiner's rejection, holding that issue preclusion was not warranted because the Patent and Trademark Office was not a party to the earlier litigation. See *In re Trans Tex. Holdings Corp.*, 498 F.3d 1290, 1297 (Fed. Cir. 2007).

The Federal Circuit has otherwise provided little guidance of its own on whether a *Markman* ruling has issue preclusive effect. In *R.F. Delaware Inc., v. Pacific Keystone Techs., Inc.*, 326 F.3d 1255 (Fed. Cir. 2003), the Federal Circuit did touch on the issue, but did not clearly state when collateral estoppel applies to an earlier court's claim interpretation, and did not reference the debate on the issue. See *RF Delaware Inc. v. Pacific Keystone Technologies, Inc.: The Federal Circuit has Finally Spoken on Collateral Estoppel of Claim Interpretation*, 20 Santa Clara Computer & High Tech. L.J. 293, 317 (2004).

Therefore, when evaluating the likelihood that a court will apply collateral estoppel to a prior proceeding's claim construction, we should consider as important factors (i) the finality of the prior proceeding, and (ii) the district court that is hearing a case. <

BPLA COMMENTS ON PATENT REFORM ACT

On February 13, 2008, the Committee on Contested Matters sent the following letter to Chairman Leahy providing comments on certain provisions of the Patent Reform Act of 2007:

Dear Chairman Leahy:

The Committee on Contested Matters (CCM) of the Boston Patent Law Association (BPLA), is writing to you to highlight its concerns with regard to certain Post Grant Review provisions in S.1145, the Patent Reform Act of 2007. For reasons discussed below, the CCM strongly urges:

a) the removal of Section 5(b), which would eliminate *inter partes* reexamination and leave much of the public with no relatively quick and inexpensive mechanism for challenging weak patent claims more than one year after a patent is granted,

b) the elimination or substantial restriction of the estoppel requirements under Section 5(c); as presently written, these provisions discourage interested parties and members of the public from challenging and removing weak patent claims during the life of a patent, in lieu of waiting for expensive, protracted district court litigation,

c) the elimination of the second window provisions for filing a petition for post grant review under Section 5(c), while retaining *inter partes* reexamination; the second window procedure is essentially unmanageable, unfair to the patentee, and would provide little public benefit,

d) providing greater flexibility for patent holders to amend claims under Section 5(c), and to encourage greater cooperation between the United States Patent and Trademark Office (USPTO) and opposing parties to formulate higher quality patents with valid and enforceable claims, and

e) the inclusion of an intervening rights provision under Section 5(c), to ensure that 3rd party rights are protected against charges of infringement where claims are amended during a post grant review process and the infringement would not exist for the amended claims.

The BPLA is an association of intellectual property professionals practicing within the Federal First Judicial Circuit. Its membership is comprised of approximately 900 professionals covering a diverse range of industries including; biotechnology, chemical, medical device, electronics, and finance. The CCM is one of the BPLA's 22 committees. Our focus is contested cases (i.e., multiparty adversarial proceedings) before the USPTO, including, if passed into law, the post grant review procedures of Section 5.

The CCM believes the patent system should strive to protect and foster innovation and investment in technology by permitting efficient and appropriate challenges to a patent grant. We believe any proposed changes to 35 USC should be business-model, industry and technology neutral so that the resulting legislation is party neutral. The CCM reviewed the post grant patent procedures in S.1145, Section 5, and considered the public policies for encouraging a strong patent system against those policies in favor of removing invalid or unenforceable patent claims improvidently granted or otherwise invalid in view of new evidence not previously considered by the USPTO. With these basic principles in mind, the CCM strongly encourages the following changes to S.1145:

1. Delete Section 5(b), entitled "Repeal of Optional *Inter Partes* Reexamination Procedures". The CCM supports the use of *inter partes* reexamination as an efficient and cost effective mechanism for 3rd parties to remove patent claims that seem clearly invalid in view of prior art printed publications and/or prior art patents. The CCM believes that the public interest in removing invalid patent claims from the system to encourage the free use of information by the public far outweighs any disadvantages to the patent owner, provided that the system is otherwise fair and objective. The CCM considers that more low cost alternatives for potential patent challengers, not less, are required and therefore is in favor of keeping *inter partes* reexamination. Subject to the estoppel issue discussed immediately below, the CCM believes that the present *inter partes* reexamination statute and implementing regulations are necessary.

The CCM believes that the true effect of a patent on 3rd parties is often not realized during the first year of its existence. For example, businesses frequently decide more than 12 months after grant of a patent to produce a new product, add a new process or improve an existing process covered by the patent that was of no interest before the decision was made. If *inter partes* reexamination is eliminated, such businesses would be effectively unable to test the validity of a patent claim before making substantial investments in a potentially infringing technology. Their only options for challenging the patent under these circumstances without litigation would be an *ex parte* reexamination (in which they have little opportunity to participate) or to infringe the patent and wait for a letter of infringement pursuant to a post grant review under the proposed second window of proposed Section 5 (C). Moreover, in the face of a patent barring entry to a field, many companies may chose not to enter rather than risk costly litigation that has the potential to jeopardize the investment in the technology. Such a negative economic effect on advancing technology and competition is clearly undesirable.

Inter partes reexamination provides a highly desirable alternative which permits a challenge of the patent, on the basis of public information, before investing in a new product or process (and waiting for a letter of infringement) and allows the requestor to participate throughout the reexamination procedure.

2. Eliminate or substantially restrict the estoppel and prohibited filings provisions of Section 5(c) and in *Inter Partes* Reexamination under 35 U.S.C. § 311 et. seq. See Section 5(c), Chapter 32, § § 325, 337 and 338; 35 U.S.C. § § 315(c), 317. The CCM wants to encourage, rather than discourage, the use of existing post grant review procedures such as *inter partes* reexamination and the newly proposed post grant procedures of Section 5(c), Chapter 32 § § 321-339. However, the CCM believes that the estoppel and/or prohibited filing provisions of § § 325, 337 and 338 of Chapter 32, and § § 315(c) and 317 of 35 U.S.C. will, and for the existing reexam statute

(Continued on Page 10)

BPLA Comments

(Continued from Page 9)

already do, act as a substantial deterrent to 3rd parties interested in quick and cost efficient mechanisms for challenging a patent claim's validity in a post grant procedure other than a district court litigation.

The estoppel/prohibited filings provisions should be eliminated completely or narrowly tailored so that only those patent claims targeted or challenged and only the specific prior art or basis for challenging validity (e.g., 35 U.S.C. §112) may be subject to the estoppel. In light of: (1) the differences between the existing and proposed presumptions and burdens of proof in a USPTO post grant procedure and in a district court; (2) the patentee's rights not to be harassed endlessly by repeated filings in USPTO post grant procedures; and (3) the rights of every plaintiff and defendant to have an opportunity to have their day in court, the CCM believes that the estoppel/prohibited filing restrictions should be limited only to those efforts by the same parties (and privies thereof) to raise the same arguments against the same patent claims in any other USPTO post grant procedure.

If, for example, a 3rd party has previously made an attempt in a USPTO post grant procedure to attack a claim's validity and fails, they should not be allowed to raise the same argument again in any USPTO post grant procedure. However, they should not be estopped or prohibited from raising that argument in a district court proceeding, if they choose to do so. In particular, the CCM believes that a party would only choose district court litigation if they had solid grounds for invalidation, given the higher "clear and convincing evidence" standard required to prove invalidity compared to the "preponderance" standard available in USPTO post grant procedures. Moreover, unlike USPTO proceedings where little or no discovery is permitted to obtain relevant evidence, evidence discovered in litigation through discovery may support a party's previously submitted and unsupported argument rejected by the USPTO. The CCM believes that narrowly defining estoppel/prohibited filings and providing the above limitations will enhance the existing and proposed post grant review procedures and, simultaneously, prevent the satellite litigation likely to ensue to interpret the existing estoppel provisions.

3. Eliminate the second window provisions for filing a petition for post grant review of Section 5(c). See Chapter 32, § 322 (2)(A)-(B). The CCM considers the second window provisions of § 322 (2)(A)-(B) to be unmanageable and ultimately unfair to the patentee who should be entitled at some point to the presumption of validity accorded under 35 U.S.C. § 282, subject to the existing burdens and presumptions provided during reexamination (both *ex parte* and *inter partes*) and as proposed in Section 5(c). In particular, the CCM believes that the language in § 322 (2)(A) "petitioner establishes in the petition a substantial reason to believe that the continued existence of the challenged claim in the petition causes or is likely to cause the petitioner significant economic harm" and in (2)(B) "receiving notice, explicitly or implicitly" is vague, indefinite and highly subjective. The CCM sees no reason for both *inter partes* reexamination and a second window, and strongly favors the former.

4. Revise Section 5(c) to provide for greater flexibility by the patent owner/patentee during a post grant review procedure to amend the claims throughout the proceeding, i.e., not limited to one opportunity to amend without a showing of good cause. See Chapter 32, § 332. The CCM considers the one shot claim amendment approach in Section 5(c) to be unworkable and tremendously unfair to the patentee. The patentee should have several opportunities to obtain patentable claims if it turns out that the existing claims are invalid or unpatentable. The patentee should have the ability to introduce successfully more narrow claims, in multiple filings if necessary, to have a reasonable opportunity to overcome patentability arguments asserted by a 3rd party or an administrative patent judge (APJ) against any claim. The patent owner should not be foreclosed from obtaining patentable claims merely because it presented in the first instance claims that it considers patentable even though the APJ ultimately does not agree. Such a process places an unfair burden on the patentee to "get it right" the first time around. The opportunity to amend should be more akin to that used in the European post grant opposition period, namely the ability to present claims of varying scope throughout the proceeding in response to arguments attacking the patentability of broader claims.

5. Add to Section 5(c) a provision that intervening rights under 35 U.S.C. § 252 apply to any new or amended claims added during post grant review that are deemed patentable. The CCM believes that the intervening rights (express and equitable) established in § 252 should apply to any proceeding where the claims are amended and a potential 3rd party who did not otherwise infringe a valid and enforceable claim before amendment, infringes after amendment. Otherwise, a patentee may knowingly or unknowingly receive a patent claim that can be asserted against a 3rd party who previously would not have been liable for infringement and proceeds forward with its business and activities. With the goal of an efficient, fair, cost effective patent system in mind, the CCM strongly urges the above recommended changes to S.1145, Section 5.

The CCM also believes that many of the problems facing the USPTO and perceived deficiencies in patent quality result from the USPTO's inability to adequately respond to its increased workload in recent years. Accordingly, the CCM would also like noted its belief that this bill would benefit from a provision that requires that "all USPTO user fees be designated only for use by the USPTO for its operations and improvement of the patent and trademark system." The CCM strongly believes the addition of a provision such as this will substantially strengthen the United States intellectual property system.

Finally, the CCM would welcome the opportunity to meet with you, or a designated member of your staff, to discuss its views.

Thank you for your consideration.

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Proposed Changes to Examination of Claims Containing Markush Language

By Hilary Dorr Lang, Ph.D., Esq., Foley Hoag, LLP

The Patent Office has proposed changes to the rules of examination of applications that include claims containing alternative (Markush) language. 72 FR 44992 (August 10, 2007). In proposing these changes, the Patent Office noted that claims containing Markush language typically arose in the chemical arts, but more recently, such claims have become common in most technology areas. According to the Patent Office, applicants often use alternative claim language to "claim multiple inventions and/or to recite hundreds, if not thousands, of alternative embodiments of a single invention in one claim," thereby burdening examiners with extensive searches and contributing to the backlog of pending applications. *Id.* Additionally, referring to the change to rule 1.75(b)(1) limiting the number of claims in an application, the Patent Office expressed concern that applicants would use Markush language "to circumvent the proposed claims rules by presenting a single claim that sets forth multiple independent and distinct inventions in the alternative." 72 FR at 44995. Thus, the Patent Office has proposed the changes to alternative claims practice, at least in part, to close a loophole in the proposed rule limiting the number of claims. Several key features of the proposed rules and comments on the changes follow.

The Patent Office has proposed amending rule 1.75(a) to add a requirement that "[a] claim must be limited to a single invention." Proposed new rule 1.140(a) provides that a claim reciting multiple species using alternative language is a "single invention" under rule 1.75(a) when "(1) The species share a substantial feature essential for a common utility, or (2) The species are *prima facie* obvious over one another. Rule 1.140(b) further allows an applicant to submit a statement explaining why a claim is limited to a single invention. Under proposed rule 1.75(j), a claim that reads on multiple species by using alternative language must also meet the following conditions:

- (1) The number and presentation of alternatives in the claim does not make the claim difficult to construe;
- (2) No alternative is defined as a set of further alternatives within the claim; and
- (3) No alternative is encompassed by any other alternative within a list of alternatives unless there is no other practical way to define the invention.

Rule 1.75(j)(4) further requires that "[e]ach alternative within a list of alternatives must be substitutable for one another."

The Patent Office received several comments on the proposed Markush rules, nearly all of which criticized the proposed changes. Many commentators expressed concern that the rules would make patent prosecution more difficult, time consuming and expensive for applicants, particularly small businesses. At the same time, the rules would limit applicant's ability to claim several species of a generic invention. Thus, the rules impose an artificial burden on applicants using Markush language to define an invention, while applicants using generic claim language face no such burden.

In particular, with regard to the requirement that a claim "must be limited to a single invention," several commentators argued that the rule requires a restriction requirement, while under 35 U.S.C. § 121 a restriction requirement is discretionary. Moreover, unlike current restriction practice, the rule appears to require, or at least permit, restriction even if there would be no undue search and examination burden. These additional restriction requirements would likely exacerbate, rather than reduce, the backlog of pending applications by dramatically increasing the number of divisional applications filed. The increased number of divisional applications would increase the applicant's costs, and particularly, would adversely affect

smaller businesses.

Many commentators stressed that in certain technologies, such as biotechnology and pharmaceuticals, it could be difficult or impossible to establish that the "species share a substantial feature essential for a common utility," as provided in proposed rule 1.140. The alternative means of establishing that a claim is a single invention, which requires applicants to state on the record that the species are obvious over one another, has also drawn objections. One commentator pointed out that such an admission would preclude an applicant from overcoming a prior art rejection by merely deleting an anticipated species from the claim.

Another widely raised concern is that proposed rule 1.75(j)(1) provides no guidance as to what is meant by "the number and presentation of alternatives . . . makes the claim difficult to construe." Several commentators suggested that the written description requirement 35 U.S.C. § 112, second paragraph, more than adequately addresses issues of clarity of claim language, and any further requirement violates this statute. The commentators also objected that the proposed rules do not explain what standard will be applied in determining that each alternative is "substitutable" with one another, as required by proposed rule §1.75(j)(4).

In response to concerns that the rules would negatively impact small business, the Patent Office conducted an initial regulatory flexibility analysis of the proposed rules. FR 73 12679 (March 10, 2008). The Deadline to submit further comments on these rules is now April 9, 2008.

As of this writing, rule 1.75(b)(1) is under a preliminary injunction, along with the rest of the Claims and Continuation Rules package.<

Proposed Rule Changes to Practice before the Board of Patent Appeals and Interferences

By Scott E. Kamholz, M.D., Ph.D., Esq., Foley Hoag LLP

The USPTO proposed changes to the rules of practice before the Board of Patent Appeals and Interferences (BPAI) on July 30, 2007. The proposed changes relate largely (but not entirely) to issues of procedure and form and were proposed, according to the Notice of Proposed Rulemaking, because they "are needed to permit the Board to handle an increasing number of *ex parte* appeals in a timely manner" (72 FR 41472). Notable among the proposed changes is the addition of several requirements for the content of appeal briefs, both formal and substantive. Some of the new requirements are:

- Several new sections that parallel court briefs, such as a jurisdictional statement, a table of contents, a table of authorities, and a statement of facts;
- Page limits and typeface size limits;
- An identification of any arguments first being made in the appeal brief or else a citation to the first occurrence of that argument in the prior record;
- An appendix that contains:
 - ◊ a claims support section that includes a copy of every claim argued separately with annotations for every claim limitation to support in the specification;
 - ◊ a drawing analysis section that includes a copy of every claim argued separately with annotations for every claim limitation indicating where the limitation is shown in the drawings or stating that the limitation is not shown; and

◊ an evidence section that includes "amendments, affidavits or declaration, non-patent literature, foreign patents and publications, published PCT documents, and any other material admitted into the record by the examiner;"

- A requirement to challenge every finding and conclusion made by the examiner to avoid a presumption that the examiner's position is correct on that issue;
- Waiver of all arguments which could have been but were not set out in the argument section of the appeal brief (even if earlier presented in the record); and
- A requirement to show that the claimed subject matter is patentable (as opposed merely to showing why the examiner's rejection is improper).

The proposed rules also permit the imposition of sanctions for misconduct, the definition of "misconduct" including failure to comply with an applicable rule.

The USPTO received about 45 formal public comments by the close of the comment period on September 28, 2007, most of which were overwhelmingly critical of the proposed regulations. Commentators derided the proposed rules, particularly those concerning the content of appeal briefs, as unfairly burdensome on applicants because they substantially increase the already significant complexity and expense of patent appeals. Commentators also criticized the rules as not being justified by any problem the BPAI has identified as especially troublesome. The USPTO has not, as of this writing, proposed revised or final rules. <

We would like to thank our accountants for providing the Boston Patent Law Association with outstanding service over the years

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Recently Published Proposed Rules Will Impact Biotech and Pharmaceutical Practice

By Donna M. Meuth, Esq., WilmerHale, LLP

The U.S. Patent and Trademark Office recently published a proposed rule change entitled "Revision to the Time for Filing of a Biological Deposit and the Date of Availability of a Biological Deposit," 73 *Federal Register* 9254 (February 20, 2008), which changes the timing requirement for deposits of biological material. Comments to these proposed rules must be filed by April 21, 2008.

Under the proposed rules regarding biological deposits, biological material would be required to be deposited before publication of a patent application. All restrictions on access to the deposited material would have to be removed upon publication. This would ensure that the application was enabled as of the publication date of the application. Currently, deposits must be made, and restrictions on the deposits removed, by the issue date of a patent. These changes are said to be in keeping with the requirement imposed by the American Inventors Protection Act of 1999 (AIPA) of publication of most applications at eighteen months from the filing date. Under the AIPA, any application publication providing an enabling disclosure would be entitled to provisional rights under 35 U.S.C. §154. Requiring the deposit prior to publication and removing restrictions on the deposit at the time of publication ensures that the application is enabled as of the publication date. Having the application enabled as of the publication date is also said to be important in terms of the published application being anticipatory prior art under 35 U.S.C. §§ 102(a), (b) and (e). According to the Notice, "Absent a requirement for deposit prior to publication coupled with release of the deposited material upon publication, an otherwise anticipatory patent application publication could fail to qualify as prior art. It is not in the public interest to allow arbitrariness in the date of deposit to disqualify a patent application publication as prior art, when the publication otherwise fully discloses an invention."

The Patent Office Practice and Biotechnology Committees are preparing comments on the proposed rules regarding biological deposits. Please contact the co-chairs of the Patent Office Practice Committee, Donna Meuth and Inna Landsman, at patentofficepractice@bpla.org or the co-chairs of the Biotechnology Committee, Shann Kerner and Christine Wise, at biotechnology@bpla.org for further information or to assist in preparing comments on these proposed rules. <

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bly a doctoral degree in biotechnology (e.g., molecular biology, immunology, genetics, or cell biology) or in organic chemistry. Technology specialists will work closely with one or more other members of the firm on a wide variety of intellectual property matters including patent prosecution, opinion work, due diligence and general intellectual property counseling. Law school attendance, although encouraged, is not mandatory.

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