



BOSTON PATENT LAW ASSOCIATION NEWSLETTER

Serving the
New England
Intellectual
Property Bar
Since 1924

November 2008

EDUCATION, SERVICE, COMMUNITY

Volume 39, Issue 4

PRESIDENT'S MESSAGE

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



President Leslie Meyer-Leon

In case you woke up this morning wondering *Why have a BPLA?*, or *Is the BPLA doing what it should be doing?*, I will tell you. The BPLA has a mission to keep, and collectively you have kept it alive and kicking.

The charter of the BPLA is articulated in its bylaws (see insert). Our mission is to stimulate the interchange of thought by providing educational programs and forums for the exchange of information and ideas, to buttress high standards of professional quality and integrity, to foster fellowship and social relations among members of the intellectual property bar, to act on proposals affecting intellectual property laws and their administration, and of course to provide the framework to carry all of this forth. But

bylaws and mission statements are prone to lip service; in reality, a professional association has only as much life as its members breath into it.

So I will tell you how alive you have been this year. For starters, the quality of the BPLA's educational programming has never been higher. This community has benefited from no less than seventeen excellent educational seminars, showing a level of dedication, hard work, and thoughtfulness that was distributed across almost every committee of the BPLA:

- The Litigation Committee, under the leadership of David Daskocil, Matt

Lowrie, and Martin O'Donnell, gave us two programs, "*Litigating Patent Cases in the Eastern District of Texas*" and "*Recent Developments in Patent Damages Litigation*";

- Michael Bergman and Paul Burgess of the Licensing Committee provided the impetus in March for a program titled "*Managing IP in the Face of Secrecy and Export Controls*", and for its upcoming November program on international licensing transactions;
- The Computer Committee, under John Stickever's and Steve Henry's stewardship, organized a program on *In re Bilski*, as well as an April

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ARTICLE II: Objects

The objects of this Association shall be:

- * to provide an organization capable of acting in concert in connection with matters relating to laws and practices in the fields of patents, trademarks, copyrights and other intellectual property matters; to concern itself with other matters such as the welfare, honor and dignity of the legal profession and to act in the best interest of the public it serves;
- * to promote the development of industry and the useful arts by the establishment and maintenance of intellectual property rights; to disseminate information of interest to authors, to inventors, and others concerned with the laws of intellectual property;
- * to stimulate interchange of thought along all lines of common interest;
- * to maintain high professional standards;
- * to foster good fellowship and promote good social relations among its members;
- * to take action concerning proposals affecting the patent, trademark, copyright and other intellectual property laws as well as the administration thereof;
- * to protect the administration of such laws against practices tending to impose upon the public or to bring into disrepute the American System of patents, trademarks, copyrights and other intellectual property; and generally to consider and act upon other related matters as may be of common interest.

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CALENDAR OF EVENTS



Wednesday, November 5, 2008

VIEWPOINTS ON THE INTERPLAY BETWEEN TRADE SECRET AND PATENT PROTECTION FOR INTELLECTUAL PROPERTY
Presented by the Trade Secrets Committee

Wednesday, November 12, 2008

INTERNATIONAL LICENSING TRANSACTIONS
Presented by the Licensing Committee

Thursday, November 20 - Friday, November 21, 2008

ANNUAL PCT SEMINAR
Presented by the BPLA

Wednesday, December 3, 2008

BPLA 2008 ANNUAL MEETING

For further information,
go to www.bpla.org

MEMBERS ON THE MOVE

»**Daniel J. Holmander** was recently admitted to the Rhode Island Bar and Massachusetts Federal Bar

»**Robert H. Underwood** has moved as a partner to the Intellectual Property Group of McDermott Will & Emery's Boston office.

»**Kristin A. Connarn** has moved as an associate to the Intellectual Property Group of McDermott Will & Emery's Boston office.

Members on the Move

Do you have a new job?
Made a lateral move lately?
Been promoted?

We want to hear about your news. Please send your job-related news to:

vice-president@bpla.org

so that we can include an announcement in our next newsletter.

BPLA ADVANCED PCT SEMINAR

November 20 & 21, 2008 from 8:00 A.M. – 4:30 P.M.

Doubletree Guest Suites, 550 Winter Street, Waltham

This educational seminar is designed for patent attorneys, patent administrators, patent agents, patent paralegals, and others seeking an in-depth understanding of the Patent Cooperation Treaty (PCT).

SPEAKERS

Matthias Reischle
Deputy Director
PCT Legal Division, WIPO
Carol Bidwell, Consultant on the PCT
(Previously Supervisor for the Office of PCT Legal Administration of the U.S. Patent & Trademark Office)

SCHEDULE OF ACTIVITIES November 20 & 21, 2008

Registration & Breakfast 8 a.m. – 8:45 a.m.
Presentation 8:45 a.m.- 10:15 a.m.
Break 10:15 a.m. – 10:30 a.m.
Presentation 10:30 a.m.-12:00 p.m.
Lunch 12:00 p.m. – 1:15 p.m.
Presentation 1:15 p.m. – 3:00 p.m.
Break 3:00 p.m.-3:15 p.m.
Presentation 3:35 p.m.– 4:30 p.m.

The seminar will focus on the PCT, including the following:

- Filing of an International Application
- Correction of Defects
- Recording of changes relating to the applicant, the agent or the inventor
- International search and written opinion by the International Searching Authority
- Filing of Amendments
- The International Bureau
- International publication of the international application
- International Preliminary Examination and the International Preliminary Examination Report (IPER)
- National phase requirements
- Withdrawals
- Summary of the latest Rule changes and future developments

For additional information, please go to www.bpla.org or contact Janice Roussel at (617) 526-6804 or janice.roussel@wilmerhale.com.

President's Message

(Continued from page 1)

- program on the law of software contracts, co-sponsored with Copyright Committee co-chairs Steve Chow and Anne Marie Longobucco;
- We have Shann Kerner and Christine Wise of the Biotechnology Committee to thank for a program on patent protection in the biotechnology industry after *KSR Int'l Co. v. Teleflex, Inc.*;
 - Eric Raciti and Neil Ferraro of the Medical Devices Committee organized a program on functional claim drafting;
 - Deirdre Sanders and John Anastasi of the International and Foreign Practice Committee for a program on international obviousness standards;
 - James Olesen and Peter Lando of the Chemical Practice Committee contributed a program on written description guidelines;
 - Donna Meuth of the Patent Office Practice Committee was the leadership behind an October program on prosecuting patents for future enforceability;
 - John Welch and Mark Robins of the Trademark Committee brought the TTAB to Boston;
 - Walter Dawson, William DeVaul, and David Cerveny of the Corporate Committee are on track for an October program on recent developments in corporate practice;
 - The Trade Secrets Committee, led by Claire LaPorte and Vickie Henry, is putting forth a November program titled "*Viewpoints On The Interplay Between Trade Secret And Patent Protection For Intellectual Property*"; and
 - Monica Grewal of the Activities Committee has worked hard with WIPO to organize a seminar on advanced PCT practice.

But before you settle into the idea that all the BPLA does is CLE, read on. The writing competition is also alive and well, and this year's submissions are currently entertaining judges Donna Meuth, Lee Bromberg, and Joe Maraia. The challenges posed by PTO's use of 37 CFR 10 et seq., as well as judicial findings of attorney malpractice, have not gone unnoticed. The Ethics Committee, led by Greg Sieczkiewicz and Tim French, jumped into gear by holding a meeting for our members on professional responsibility and risk management. In fact, numerous committees have met in small working sessions, not only to exchange ideas on seminar topics but especially to draft comments on legislative proposals and administrative rule packages. April's newsletter provides details of work done by the Contested Matters Committee, under the leadership of Michael McGurk and Susan Glovsky, on Senate Bill S.1145, and of comments

submitted to the PTO by the Patent Practice Committee and the Biotechnology Committee.

Under the stewardship of Erik Belt and Robert Abrahamsen, our Amicus Committee busied itself this year on two fronts. First came an amicus brief in *In Re Bilski*, produced after a working session held along with the Computer Law Committee. Then came an amicus brief successfully submitted in the District Court for the District of Massachusetts in *In Re Engage*, concerning the issue of whether attorney liens can be applied in a bankruptcy proceeding to secure payment of legal fees for patent prosecution services. The IP Task Force, under the direction of Lee Bromberg, succeeded in gaining acceptance by the judiciary of its proposals to revise certain local rules relating to patent litigation in the District Court for the District of Massachusetts, a tremendous success which you can read more about on page 6 of this newsletter. Finally, Karen Buchanon, Tim Murphy, David Boundy, and David Conlin worked hard with me over the summer toward forming a task force on patent reform.

Many of you attend BPLA events because you wish to keep in touch with your colleagues, an opportunity that breathes community into the word 'association'. Approximately 250 of you gathered together for a few laughs, toasts, and guffaws at the Annual Judges Dinner. And no fewer than 300 BPLA Red Sox fans joined the Fenway Park gathering. That these events happened are thanks to the hard work and superb organizational skills of Activities Committee chair Monica Grewal and her assistant Janice Roussel.

The framework behind all this is due to the energies of the officers and members of the board of governors, who have been busy keeping this organization alive and ready for what is to come. I particularly wish to thank Mark Solomon and his assistant Kristine Ferrigno for their oversight of committee affairs and for implementing a new system for managing the event calendar. Lisa Adams has produced a polished newsletter each quarter, Grant Houston kept our finances in the black, Neil Ferraro worked hard as board secretary, and to board members Lee Bromberg, Joe Maraia, Donna Meuth, and Greg Sieczkiewicz we owe our web site and a million other thanks.

So, I hope that you will join with me on December 3, 2008, at the BPLA's 84th Annual Meeting, a chance to greet each other and to extend your appreciation to all those who like yourselves are the spirit and soul of this association. Our founding members may have articulated the reason for forming the BPLA in the first place; so many of you contribute to its vitality. ♦

In Memory of Donal Tobin (1941-2008)

By Chet Cekala, Esq., Teradyne, Inc

Donal Brendan Tobin, the former vice president of intellectual property at the Gillette Company and chief architect of the IP strategies for numerous block-buster consumer products like the Mach3 & Fusion razors, Oral-B Cross-Action toothbrushes and Duracell batteries died on August 1st of pulmonary fibrosis. He was 67.

Donal, a graduate of Boston Latin School and Tufts University began his career working for a defense contractor in the aerospace industry. He would proudly speak of his engineering efforts developing heat shields used in the Apollo space missions.

Mr. Tobin later graduated from Georgetown University Law Center in 1969. After working as a patent attorney in private practice for several years, he began working in-house. Don, as most of his colleagues called him, had a successful 11 year career at Johnson & Johnson before returning to the Boston area to head the Gillette Patent Department in 1990.

One of Donal's greatest strengths was his ability to see the big picture. He was always plugged into the Gillette management team's decision making process, resulting in IP strategies which fit product launches like a glove. Mr. Tobin was well known for his ability to think on his feet. "I've seen [Gillette] engineers stop Don in the hallway to asked complicated legal questions. Don's answers were always crisp, on-point and engaging. Don wasn't just a great lawyer, he was a valued business partner and a pleasure to watch in action." said Chet Cekala former Senior Group Patent Counsel under Mr. Tobin.

The Gillette business model which concentrates on selling high-volume disposable razor cartridges instead of razor handles is well known in MBA circles. Don understood that this model falls apart if competitors or counterfeiters can copy Gillette's proprietary razor features. Don aggressively enforced the company's intellectual property rights and made great progress combating counterfeiters around the world.

After retiring from Gillette in 2006, Mr. Tobin taught courses in intellectual property law at Northeastern University.

Many of Donal's friends and colleagues have commented that he epitomized the Gillette slogan "The best a man can get". He was a valued member of our legal community, a wonderful mentor, a true gentleman and a great friend. He will be greatly missed.

In addition to his wife Elaine, Mr. Tobin leaves his daughter Katherine, his daughter Leah and her husband Chris Shumans of Roswell, GA, his son Joshua and his wife Nicole (House) Tobin of Los Gatos, CA and his grandchildren David Brendan, Noelle and Michael Howard Tobin.◊



In Memory of Cynthia M. Soroos (1974-2008)



The Boston Patent Law Association extends its sympathies to the family, friends, and colleagues of Cynthia M. Soroos, a respected intellectual property lawyer and Of Counsel at Lahive & Cockfield, LLP in Boston.

Cynthia came to Massachusetts to attend Wellesley College, from which she received her undergraduate degree in chemistry. She continued her studies at Harvard University, earning an A.M. degree in organic chemistry. After Harvard, Cynthia decided to pursue a career in patent law joining Lahive & Cockfield in 1998. She worked full time while attending law school in the evenings to earn her J.D. from Suffolk University Law School. Cynthia is remembered as an exceptional scientist, accomplished lawyer, devoted mentor, respected colleague, avid cello player, brave adventurer, truly giving person, and loyal friend. She was a member of the Boston Patent Law Association, active in the Women's Bar Association and recently named to the *Super Lawyers* Rising Star list.

Outside the legal profession, Cynthia shared her generosity, enthusiasm, leadership and many gifts with all of her friends and communities. She maintained her connection to Wellesley College through mentoring and networking groups. Cynthia also actively mentored and volunteered within Harvard-Epworth United Methodist Church. Always looking for new challenges, Cynthia took up cello after finishing law school and performed with the Cambridge Symphony Orchestra. Cynthia also loved to share her tales and pictures of international adventures with her sister Sarah. The pair recently returned from a bike riding trip in Croatia, and their 2007 horseback riding trip through the Yukon Territory was featured in the *Boston Globe* travel section.

Cynthia leaves her parents, Margaret and Howard Soroos of Alexandria, VA, sister Sarah Soroos of Seattle, WA, brother Eric Soroos of Langley, WA, grandmother Margaret Watson of Indianola, IA and countless relatives, friends and colleagues who will remember her devotion, smile and brilliance. ♦

IP Cases Task Force Proposed Local Rule For Patent Cases Gains Traction

By Lee Carl Bromberg, Esq., Bromberg & Sunstein LLP

The proposed local rule for patent cases submitted to the Judges of the United States District Court for the District of Massachusetts by the IP Cases Task Force of the Boston Patent Law Association has been favorably received and published for comment by the Court. We are hopeful that it will become part of the Local Rules soon.

The IP Cases Task Force of the Boston Patent Law Association was established by the BPLA in 2007 to address issues involved in the handling of patent and other intellectual property lawsuits in the courts in our area. The Task Force set as its first objective the development of a proposed local rule for the District of Massachusetts on scheduling and procedures for patent cases. A draft was prepared and after much revision and debate, was submitted to Judge Stearns and Chief Judge Wolf. Task Force members then met with Judge Stearns and Judge Saris to receive comments from the judges generated at a discussion of the proposed rule during a monthly judges meeting.

Thereafter, the Task Force revised its proposed rule and resubmitted it to Judge Stearns. In substance, the pro-

posed rule sets forth issues that must be addressed by the parties in a patent infringement case in their joint statement under Local Rule 16.1. The proposed rule then provides a suggested scheduling order setting time lines for the parties to address infringement contentions, validity contentions, and claim construction in an orderly fashion parallel to the conduct of discovery in the case, to present claim construction positions to the Court in a "Markman Hearing," and following the Court's ruling on claim construction, to do supplemental discovery and expert discovery, if necessary, within the Court's discretion. The proposed rule puts the onus on the parties to propose a schedule for the Court's consideration consistent with the rule. Following the Scheduling Conference, the Court will enter a Scheduling Order for the case which includes the time lines unique to patent cases.

At the invitation of the court, on August 5, 2008, Lee Bromberg, Sarah Columbia and Don Ware, representing the Task Force, met with the judges of the United States District Court for the District of Massachusetts for a lively discussion about our proposed local rule and the issues involved. The Judges present

included Chief Judge Wolf, Judge Stearns, Judge Saris, Judge Zobel, Judge Tauro, Judge Gorton, Judge Woodlock, Judge O'Toole, Judge Lasker and Magistrate Judge Bowler. Judge Ponsor participated in the meeting by telephone from Springfield. Task Force representatives stressed that the provisions of the proposed rule had been developed to help provide certainty and order to patent litigation and that they were intended to be neutral as between patentee and accused infringer.

Shortly thereafter, the judges voted to publish the proposed local rule, formatted to conform to the local rule format, for comment. Notice was published on August 14, 2008, and copies of the proposed rule have been available from the offices of the clerk in courthouses in Boston, Worcester and Springfield, and on the court's website at www.mad.uscourts.gov. The comment period is scheduled to close October 17, 2008.

We are hopeful that the published rule will soon be officially adopted into the Local Rules for the District of Massachusetts and that it will thereafter facilitate the handling of patent infringement cases in the District of Massachusetts. ◊

MEMBERSHIP RENEWAL AVAILABLE NOW ON-LINE AT WWW.BPLA.ORG FOR THE MEMBERSHIP YEAR BEGINNING DECEMBER 1, 2008

Members wishing to renew their membership for association year 2009 can now do so on-line at www.bpla.org. The on-line payment option is made available through PayPal. You do not need a PayPal account - payment is made by entering your credit card information, but billing and payment are facilitated by PayPal. Once your payment is entered, your membership status will be automatically updated for the membership year. You will also receive a statement from PayPal itemizing your transaction. New member applications continue to be handled through a paper application.

Firms and companies also have the ability to renew members in bulk. Any member can renew members of his or her firm or company. After you log in, click on the Firm login tab and a website-generated list of your firm's/company's members up for renewal will appear. You can then click on those members you wish to renew or select "all". Payment is made by entering your credit card information, as above. Once payment is entered, the membership status of each selected firm/

company member will be automatically updated for the current year, and an itemized transaction statement listing all those members renewed at this transaction will be sent to your e-mail address. Attempts to renew a member where the renewal is already in process are prevented.

If you have not already personalized your BPLA on-line password, please visit our website and simply click on the Member Login tab in the upper right corner of your screen. You will be prompted to enter your e-mail address and password. Your e-mail address is not case sensitive and your password has temporarily been set to the old, generic password. At your initial login, you will be asked to change your password. If you have already changed your password and forgotten it, simply enter your e-mail address, and your password will be sent to you via e-mail.

Members wishing to renew using the paper renewal form can download and print the form located at http://www.bpla.org/documents/BPLA_Renewal_Form.pdf. ◊

PTO Lobs National Security Salvo At Outsourcing The Preparation Of US Patent Applications

By Bruce Sunstein, Esq., Bromberg & Sunstein LLP

In a notice published July 23, 2008 in the Federal Register, the U.S. Patent and Trademark Office (PTO) fired a warning shot towards those who are considering outsourcing to a foreign country the preparation of a U.S. patent application: such a practice may be restricted by Export Administration Regulations.

In the interest of national security, the Export Administration Regulations (EAR), 15 C.F.R. §§ 730-774, regulate the export (among other things) of technical information. Enforcement of these regulations is handled by the US Bureau of Industry and Security (BIS) in the Department of Commerce. These regulations apply, among other things, to "dual use" technology, that is, technology which may have both military and civilian uses.

To proceed in accordance with the rules, one must follow the procedures laid out in 15 CFR §732 by, among other things,

considering the type of technology, the country of ultimate destination for export, who will receive it, the use to which the information will be put, determining whether the export is controlled, determining how it is classified, whether it is subject to a general prohibition, whether there is a license exception, and finally, if called for, applying for a license.

Although the PTO notice does not mention it, outsourcing of patent applications related to military technology may require a State Department license under the International Traffic in Arms Regulations (ITAR).

The PTO's warning is not simply a shot in the dark. For decades, the PTO has been administering the Invention Secrecy Act (35 U.S.C. §§ 181-188), which permits the Atomic Energy Commission and the Secretary of Defense to keep a patent application secret if required in

the interest of national security.

Under this law, a counterpart patent application cannot be filed outside the United States within six months after filing of a United States application unless a foreign filing license has been granted. Although unintentional violations of this provision can often be cured after the fact, a violation of the foreign filing license requirement can lead to invalidation of the United States patent. The PTO notice takes pains to point out that the foreign filing licenses it issues have nothing to do with outsourcing of preparation of US patent applications. For that activity, it is back to the EAR, and the BIS. While outsourcing patent portfolio development—like medical tourism (which involves outsourcing our medical care) — promises savings, if not quality, even the savings can be illusory.

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Multi District Litigation Challenges In The Patent Context

By Doris Fournier, Esq., Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.

On September 24, 2008, the Patent Law Committee hosted a luncheon seminar entitled "Multi District Litigation Challenges in the Patent Context." Multi district litigation ("MDL") is a procedure available in the federal court system to transfer civil cases pending in different districts to one district court judge for pretrial purposes.

This seminar focused on how and what to do if your patent case gets transferred into an MDL. The speakers for the event were Donald Ware of Foley Hoag, and filling in for Steven Bauer was Ben Stern from Proskauer Rose. Around 20 attorneys spanning from various firms turned out for the event. The seminar focused on, among other things, how an MDL works and is formed; what to expect and the unique challenges from a patent MDL; the pros and cons of litigating a patent matter in an MDL setting; effective communication techniques with both clients and counsel; and effective advocacy for your client in an MDL proceeding.

For his segment, Ben Stern offered various insights into both the nuts and bolts of MDL formation, as well as the overall nature and purpose of patent MDLs. He also provided the group with the latest statistics on MDL formation through the Judicial Panel on Multi district Litigation, and offered valuable information on the benefits and burdens of patent MDLs.

Don Ware shared his experiences from the *In re Columbia University Patent Litigation* where he served as liaison counsel for the group in that case. *In re Columbia University Patent Litigation* took place in the District of Massachusetts and involved Columbia's Axel patent which claimed cotransformation of CHO cells to produce glycoproteins. Don was able to offer a unique first hand look into how a patent MDL works, the pros and cons associated with his MDL, and the outcome and aftermath of the MDL.

The seminar was a great success overall, thanks to the informative and seamless presentations of attorneys Ware and Stern, and due to enthusiastic audience participation and discussion. For more information on the seminar, including materials, please contact Doris Fournier at dfournier@mintz.com or Joseph Capraro, Jr. at JCapraro@proskauer.com. ◇

PROPOSED AMENDMENT TO THE BPLA BY-LAWS

By Neil P. Ferraro, Esq., BPLA Secretary

The Board is proposing amendments to the BPLA By-Laws to reflect changes regarding the various Committees. The amendments are being requested because the By-Laws do not reflect the current standing Committees of the Association nor do they reflect the names currently adopted by the Association.

A vote on the proposed amendment will be conducted at the Annual Meeting.

The following is the proposed amendment.

ARTICLE X: Standing Committees

The Chairpersons of the standing committees of the Association shall be appointed by the President-Elect subject to approval of the Board of Governors no later than the meeting of the Board immediately preceding the Annual Meeting. Each standing committee shall have one or more Chairpersons. Appointments of the Chairpersons will be announced at the Annual Meeting, at which time their terms shall commence. The Chairpersons shall serve (1) for not more than three years or (2) until their successors shall have been appointed by the President .

The standing committees of the Association shall be as follows:

1. Committee on Activities and Public Relations
2. Committee on AIPLA Moot Court
3. Committee on Amicus ~~Briefs~~ Activities
4. Committee on Antitrust
5. Committee on Biotechnology
6. Committee on Chemical Patent Practice
7. Committee on Computer Law
8. Committee on Contested Matters ~~before USPTO~~
9. Committee on Copyright Law
10. Committee on Corporate Practice
11. Committee on Ethics and Grievances
12. Committee on International and Foreign Practice
13. Committee on Licensing
14. Committee on Litigation
15. Committee on Medical Devices
16. Committee on New Lawyers and Law Students
- ~~17.~~ Committee on Patent Law
- ~~16~~18. Committee on Patent Office Practice
- ~~17~~19. Committee on Pro Bono
- ~~18~~20. Committee on Trademark and Unfair Competition
- ~~19~~21. Committee on Trade Secrets Law
- ~~20. Committee on Young Lawyers and Law Students~~

Special committees may be appointed from time to time by the President.

BPLA ANNUAL MEETING

Wednesday, December 3, 2008
11:00 A.M. - 2:00 P.M.

Boston Harbor Hotel
Wharf Room
70 Rowes Wharf
Boston, MA 02110

KEYNOTE SPEAKER

Q. Todd Dickinson
Executive Director, AIPLA
Former Undersecretary of Commerce and Director of U.S. Patent and
Trademark Office

Q. TODD DICKINSON



Q. Todd Dickinson is the new Executive Director of the American Intellectual Property Law Association, succeeding Michael K. Kirk who is retiring after more than 13 years of service to the Association. Mr. Dickerson was formerly the Vice President and Chief Intellectual Property Counsel for General Electric Company, where he had corporate-wide responsibility for all intellectual property and technology licensing matters.

Mr. Dickinson previously served as Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, having been nominated by President Clinton and confirmed by the U.S. Senate. Prior to assuming his present position, he was a partner in the law firm of Howrey Simon Arnold & White, where he was a leader of its intellectual property practice.

He has more than twenty-five years of experience in all aspects of intellectual property law and public policy, including patents, trademarks, copyrights, and trade secrets and has written and spoken extensively on intellectual property issues, and has testified before Congress, the Federal Trade Commission and the National Academy of Sciences on the impact of intellectual property policies.

Mr. Dickinson is a member of the Board of Directors of the Intellectual Property Owners Association and the Council of the American Bar Association Intellectual Property Law Section. He is also the ABA delegate to the World Intellectual Property Organization. In 2004 and 2005, he was named one of "The 50 Most Influential People in Intellectual Property" by Managing Intellectual Property magazine, and is one of the Lawdragon 500 Leading Lawyers in America.

He has also taught or lectured at various universities including Stanford, Yale, University of California (Berkeley), MIT, Georgetown, George Washington and Tokyo University, and is a member of the Editorial Advisory Boards of the BNA Patent, Trademark & Copyright Journal and Nanotechnology Law & Business.

He earned his J.D. in 1977 from University of Pittsburgh and his B.S. from Allegheny College in 1974. He is admitted to the bars of the District of Columbia, Pennsylvania, Illinois and California, United States Patent and Trademark Office, and the Court of Appeals for the Federal Circuit. ♦

REPORT OF THE BPLA NOMINATING COMMITTEE

Pursuant to BPLA By-Laws Article VII, immediate Past-President Lee Carl Bromberg and Past-Presidents Ingrid A. Beattie and Doreen M. Hogle, make the following nominations to the BPLA Board of Governors:

President	Mark B. Solomon
President-Elect	Lisa Adams
Vice President	J. Grant Houston
Treasurer	Neil P. Ferraro
Secretary	Joseph P. Maraia
Member (soon Past-President)	Leslie Meyer-Leon
Member	Donna M. Meuth
Member	Gregory J. Sieczkiewicz
Member	Erik Paul Belt

BPLA WRITING COMPETITION

Below is a listing of the entrants to this year's Writing Competition. The winners will be announced at the Annual Meeting.

Melissa Sikorski	<i>Is There a Meaningful Way to Improve Upon Current U.S. Regulations Addressing Product Placement Concerns?</i>
Melissa Sikorski	<i>Willy Wonka's Everlasting Gobstopper as a Never-Ending Trade Secret: The Importance of Cultivating an Effective Trade Secret Protection Program By Meeting a Client's Specific Needs</i>
Alexander Adam	<i>Technology Transfer to Combat Climate Change: Opportunities and Obligations Under Trips and Kyoto</i>
Lev Rosenblum	<i>The Name of the Game is the Claim – Please Roll the Dice</i>
Peter Flynn	<i>A Cursory Study of the Legal Issues Facing Wikipedia</i>
R. Neethu	<i>The Mysteries in Europe Over Software Patenting: The Reluctance Over Defining A Technical Approach</i>
Pia Amicone	<i>The Hatch Waxman Act: Is It In Need of Reform?</i>



MINUTES OF THE DECEMBER 5, 2007 BPLA ANNUAL MEETING

I. Call to Order

President Lee Bromberg called the 83rd Annual Meeting of the BPLA to order and welcomed all members in attendance. Mr. Bromberg introduced the head table including our guest speaker, Mark L. Wolf, Chief Justice of the United States District Court for the District of Massachusetts; Ingrid Beattie, Immediate Past-President; Leslie Meyer-Leon, President-Elect; Mark Solomon, Vice President; Lisa Adams, Treasurer; Grant Houston, Secretary; and Board Members, Neil Ferraro, Joe Maraia, and Donna Meuth.

Mr. Bromberg thanked our newest members and introduced our past BPLA presidents that were in attendance.

II. Moment of Silence

Mr. Bromberg asked for a moment of silence to recognize deceased member John F. Mizhir, an associate at Fish & Richardson P.C. and, prior to that, at Palmer & Dodge. John passed away in September.

III. Report of the Nominating Committee

Mr. Bromberg recognized Ms. Beattie as the Chair of the Nominating Committee and invited Ms. Beattie to read the report of the Nominating Committee:

Mark Solomon, President-Elect
Lisa Adams, Vice President
Grant Houston, Treasurer
Neil Ferraro, Secretary
Joe Maraia, Board Member
Donna Meuth, Board Member
John Sparks, Board Member

IV. Officer and Board Elections

Mr. Bromberg stated that a vote for the position of Board Member was to be conducted. Mr. Bromberg indicated that an election was to be conducted between John Sparks, who was recommended by the Nominating Committee, and Greg Sieczkiewicz, a member-nominated candidate. Only Active Members in good standing (or Life Members who were Active Members) may vote. Voting closed at 2PM, December 5, 2007.

V. BPLA Writing Competition Awards

Joseph M. Maraia presented the 2007 BPLA/BPLF Writing Competition Awards. The First Place prize of \$1000 was awarded to Brendan Witherell for his article "The Extraterritorial Application of the Lanham Act: The First Circuit Cuts the Fat from the Vanity Fair Test".

VI. President's Report

Mr. Bromberg acknowledged the hard work of this year's Committees and Committee Chairs and gave special thanks to:

Joanne Creedon for her hard work during the year assisting Lee
Activities Chairs – Erik Paul Belt and Courtney Quish (Advanced PCT Seminar – Nov. 28-29, 2007)
AIPLA Moot Court Committee – Tom Johnston and Amy Brosius (34th Annual AIPLA Giles Rich Memorial Moot Court Competition – March 16-18, 2007)
Biotechnology Committee – Greg Sieczkiewicz and Christine Wise (Pharmaceutical Patents – Recent Trends in the Federal Circuit – April 23, 2007)
Computer Law Committee – John Stickevers and Steve Henry (Why Do Patent Examiners Do What They Do? – June 22, 2007)
Contested Matters Committee – Susan Glovsky, Michael McGurk and Donna Meuth (Section 135(b) Anxiety – Is Copying

(Continued on page 12)

Minutes from 2007 Annual Meeting

(Continued from page 11)

Claims Enough to Keep You Out of 135(b) Trouble? – Dec. 14, 2006)

International and Foreign Practice Committee – Deirdre Sanders and John Anastasi (Patent Enforcement and Prosecution in China – June 5, 2007)

Licensing Committee – Paul Burgess and Mike Bergman (Licensing after Medimmune: A Discussion of Pitfalls and Opportunities – April 25, 2007)

Litigation Committee – Matt Lowrie and Doug Doscocil (Litigating Patent Cases in the Eastern District of Texas – Dec. 11, 2007)

Patent Office Practice Committee – Grant Houston and Inna Landsman (Analysis of the USPTO Rule Changes and the Effects of These Changes on Patent Prosecution Practice – Sept. 25, 2007)

Trade Secrets Law Committee – Claire Laporte and Vickie Henry (Trade Secrets for Patent Lawyers – Oct. 22, 2007)

Trademarks and Unfair Competition Committee – John Welch and Mark Robbins (The TTAB Comes to Boston – Oct. 26, 2007)

Young Lawyers and Law Students Committee – Michelle Bielunis, Doris Fournier and Scott Gerwin (Event at Suffolk Law School – March 7, 2007)

Joint Programs with BBA – Steve Chow (Financing Technology Enterprises – Apr. 24, 2007; The Digital Campus: Ownership of Information on Institutional Networks – Dec. 20, 2006)

IP Task Force

Mr. Bromberg then requested a motion to accept an Amendment to the BPLA By-Laws relating to Associate Members. Specifically, after Board consideration, those having an interest in intellectual property law, and its practice, who are employed by, or provide services to, a firm or company engaged in the practice of patent, trademark, copyright or other intellectual property law and who reside or have a principle office in the First Judicial Circuit may become Associate members of the BPLA. The Amendment was passed.

VII. Secretary's Report

Mr. Houston presented the Secretary's report. Mr. Houston entertained a motion for the waiver of the reading of the Minutes of the 2006 Annual Meeting, which had been distributed to the membership prior to the meeting. The motion was approved by the membership.

VIII. Treasurer's Report

Ms. Adams presented the Treasurer's Report. A motion to accept the Report was entered, seconded and passed.

IX. Election of Officers and Board Members

A motion to accept the Nominating Committee's recommendations for the uncontested positions was entertained, seconded and carried.

Pursuant to Article 7, Section 3 of the By-Laws, the President-Elect, Leslie Meyer-Leon assumed the office of the President. Mr. Bromberg presented Ms. Meyer-Leon with the gavel.

X. Presentation to the Past-President

Ms. Meyer-Leon presented Mr. Bromberg with a gift in recognition of his service as the 2007 BPLA President.

XI. Speech by the Honorable Wolf

Mr. Bromberg introduced our guest speaker, the Honorable Mark L. Wolf. Chief Justice Wolf spoke of the ability of the United States District Court for the District of Massachusetts to handle complex patent matters and welcomed the BPLA's continued commitment to fostering expeditious, thorough and thoughtful consideration of patent infringement cases in the District.

XII. Final Announcements by Leslie Meyer-Leon

Ms. Meyer-Leon outlined the events and agenda for the BPLA in the upcoming year and entertained a motion to adjourn the Annual Meeting. The motion carried and the meeting adjourned. ♦

Career Opportunities

**PATENT ATTORNEY
Novartis, Greensboro, NC**

Job ID:	4761043	Posted:	September 15, 2008
Company Name:	Novartis	Job Function:	Professional Services
Position Title:	Patent Attorney	Job Type:	Full-Time
Min Experience:	3-5 Years	Entry Level:	No
Location(s):	Greensboro, North Carolina, United States	Apply URL:	http://www.jobtarget.com/c/jobclick.cfm?site=6148&job=4761043

Novartis Animal Health is a world leader in the development of animal health products that meet the needs of pet owners, farmers and veterinarians. Our products are brought to life by diverse, talented, high-performing employees who are committed to saving, prolonging and improving animal lives.

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Think What's Possible.

Description:

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- Draft, file and prosecute patent applications and maintain, defend and extend term of patent rights
- Directing and advising client on patent and related IP issues for designated areas within BU
- Identifying inventions of designated area in BU and securing valid patent protection worldwide
- Assisting in formulation of patent strategies in research and development projects and providing patent situations
- Securing freedom from valid blocking 3rd party patent rights
- Give necessary and timely professional IP input for, and maintain full accountability to R&D/Licensing/M&A/Markets/Litigation activities
- Managing patents (incl. related IP aspects) for designated area in BU collaborative research and development activities
- Member of designated IPT and/or Research meetings
- Maintain and improve professional expertise
- Collaborate closely with Legal and BD&A on contracts and agreements especially with regard to the IP clauses
- Supervise US litigations and update superior and CIP on ongoing and potential US litigations
- Supervise IP-related issues in the course of collaborations with third parties
- Continuously inform supervisor about activities and seek support and approval by supervisor

Qualifications:

- Technical degree (B.Sc. or higher) in relevant subject (Chemistry, preferably Biochemistry or Biology) and familiar with European Patent prosecution is desirable
- USA: Law degree (J.D. or L.L.B.) and admission to practice as a US Registered Patent Attorney English (German desirable)
- Industry experience

Benefits:

Competitive benefits to include medical, dental, life, vision, 401K, LTD, STD and more.

Novartis is committed to embracing and leveraging diverse backgrounds. Novartis is an equal opportunity employer M/F/D/V.

Career Opportunities (Continued)

LITIGATION ASSOCIATE

Lowrie, Lando & Anastasi, LLP, Cambridge, MA

Litigation Associate with 1-3 years of experience. Technical degree or experience strongly preferred; strong writing and interpersonal skills required.

LL&A was founded on a work model that promotes legal professionalism over simply maximizing billable hours. We hail from across the U.S. and the globe and include graduates of the most renowned scientific and legal institutions in the country, and many have advanced technical degrees in a variety of disciplines ranging from electrical engineering to medical genetics to business and history. We require 1600 billable hours, leaving each individual time to meet other professional and personal goals. When our associates go above and beyond this requirement, we provide them with a generous bonus, competitive with the highest salaries in the region if similar hours are worked in a particular year.

We have a premier patent litigation practice, representing \$2 billion plus companies in high stakes patent litigation across the country, including our representation as lead counsel in patent litigation for Philips Electronics, Philips Solid State Lighting, Ledalite, PerkinElmer, Sun Life Assurance, Kenexa, BeldenCDT, Saint-Gobain and others. We have a national practice, with cases presently pending in Massachusetts, California, Missouri, Delaware, Texas, Florida, Wisconsin, Louisiana and Pennsylvania.

We are proud members of our profession and the work we do for our clients; we are appreciative of each other and encourage a fair and inclusive workplace for all to have fulfilling and enjoyable careers.

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 - substantially no client contact;
 - no interaction with co-workers;
 - repetitive work; and
 - learn on your own training.

Hoffman Warnick LLC is an IP boutique law firm in Albany, NY. We are currently seeking experienced patent lawyers and agents who are tired of the big law firm, big city life. Albany is an ideal family-oriented small city that has excellent schools, affordable housing and very little traffic, yet provides cultural offerings for everyone. The New York Capital Region enjoys beautiful summers that are perfect for golf, hiking, biking, etc., and winters perfect for world class skiing at the best ski areas on the East Coast. For those that need a big city experience on occasion, Boston and New York City are an easy three hour drive or train trip away.

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For more information, please see our website at

www.hoffmanwarnick.com.

JOB POSTINGS

To add a job posting to our on-line list of Career Opportunities for 3 full months, and to be listed in a BPLA Newsletter, please e-mail your job posting and contact information to:

vice-president@bpla.org

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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, legislation, and judicial decisions impacting the profession. Visit the BPLA at www.bpla.org.

Membership in the BPLA is available to attorneys and other professionals practicing intellectual property law within the Federal First Judicial Circuit (Maine, New Hampshire, Massachusetts, Rhode Island and Puerto Rico). Applications for membership can be obtained from our web site at www.bpla.org. Full membership for 2008 (available only for attorneys practicing within the First Circuit) costs \$115.00. Associate membership (available to non-attorney intellectual property professionals) costs \$105.00. Mailing list-only affiliation costs \$60.00. Members who renew before February 1st are eligible for \$25.00 early renewal discount.

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Please contact the committee chair if you are interested in joining, switching, or taking a more active participatory role in a committee.

Boston Patent Law Association Newsletter - November 2008

2007-2008

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