



THE BOSTON PATENT LAW ASSOCIATION NEWSLETTER

*Serving the
New England
Intellectual
Property Bar
Since 1924*

March 31, 1999

Volume 30, Issue 1

U.S. PATENT ISSUANCES INCREASE 31 PERCENT IN 1998 NEW ENGLAND LAW FIRMS RIDE THE WAVE

The U.S. Patent Office reported a record number of patent issuances in 1998. According to the PTO, 163,209 patents were granted in 1998, an increase of 31.5 percent over 1997. Only slightly more than one-half of the new U.S. patents, however issued to U.S. residents.

U.S. residents received 55.6% of all U.S. patents issued last year. Nearly twenty percent of the new U.S. patents granted to U.S. inventors were awarded to California residents. Massachusetts ranked seventh among the states with five percent of the patents, while New England, as a whole, garnered about ten percent of the patents awarded to U.S. residents in 1998.

According to the PTO records, virtually all of New England's law firms with intellectual property departments as well as those firms that specialized exclusively in patent law secured more patents for their clients in 1998 than they did in previous years.

IP practice groups and departments within general practice law firms continued to grow, according to statistics compiled by *Intellectual Property Today*. The IP Group of Nutter, McClennen and Fish posted the greatest growth with a 175% increase in issued patents. Testa Hurwitz & Thibault also recorded a strong showing with a 56% increase in patent issuances.

In terms of the total number of patents awarded, the Wolf, Greenfield and Sacks law firm continued its dominance among local firms with a 892 patents awarded to its clients (both foreign and domestic). Dike, Bronstein, Roberts and Cushman held second place with 327 total patents issued to its clients.

Notably absent from the listings compiled by *Intellectual Property Today* was the Fish and Richardson firm which continued its practice of not identifying itself as the patentee's counsel on any patents that issue to its clients.

For the sixth year in a row IBM received the most new patents (1,724). Canon was second (1,381).

BPLA Enters Its 75th Year of Service to New England Patent Bar Jubilee Celebration at Annual Judges' Dinner on May 7th

"Seventy five years old and going strong" is how to describe the Boston Patent Law Association, according to President Walter Dawson.

Dawson also announced that David Fink will be the speaker at the Jubilee Judges' Dinner on May 7th at the Westin Hotel in Waltham.

David Fink is the new President and CEO of Inventure Place, which houses the National Inventors Hall of Fame. Inventure Place is dedicated to inspiring creativity and invention throughout the nation. Inventure Place has welcomed over a half million visitors since opening to the public five years ago. Fink will speak on fostering innovation.

Prior to heading Inventure Place, Fink spent eight years with Walt Disney Imagineering where he supervised Disney's research and development ac-

tivities, including developing the technology behind Walt Disney World's Tower of Terror and Indiana Jones attractions.

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By Walter Dawson
Pearson & Pearson, LLP

We are rapidly moving along the last year of this century, and now that you all have your Y2K problems resolved, you should resolve to attend one of our upcoming functions.

Membership attendance at our Annual Meeting last December at the Meridian Hotel in Boston was excellent, and I hope everyone let their opinions be known to our guest speaker, Q. Todd Dickinson, Acting Commissioner Designate of the Patent and Trademark Office.

Already we have had two successful events in 1999. The Corporate Practice Committee held an association-wide morning meeting on February 3, 1999 at Arthur D. Little Enterprises on Managing and Licensing the Corporate IP Portfolio. The speakers were Edward Kahn of EKMS, Inc. and Joseph J. Coté, Jr., Vice President of

Message from President Dawson

Arthur D. Little Enterprises. The speakers discussed the general state of the art in IP licensing and the shift in IP activities from "tactical" to "strategic".

On February 9, 1999, the Computer Law Committee, chaired by Ed Porter and Lee Bromberg, hosted a seminar on Software Patent Prosecution featuring five outstanding practitioners as speakers and panelists, with Ed Porter serving as the lead panelist. The seminar was held at the MBA in Boston to a standing room only crowd.

BPLA Board Member Doreen Hogle is heading up the 1999 BPLA Writing Competition. She is contacting law schools in the First Circuit, and papers written by a student or students relating to the protection of intellectual property must be submitted by July 31, 1999. Further details are described elsewhere in this Newsletter.

We have scheduled a Luncheon/Speaker meeting for Tuesday, March 23, 1999 at Anthony's Pier IV Restaurant. Networking will start at 11:30 am with lunch at 12:15 PM. Such luncheons were popular with the membership several years ago, so we have scheduled this one, and if there is a good attendance we will schedule another one.

The speaker at the Luncheon will be Jesse Feder, Esq., Policy Planning Advisor to the Register of Copyrights. Mr. Feder will discuss the Digital Millennium Copyright Act of 1998 including the section on the copyright infringement liability of online service providers.

The Annual Judges Dinner will be held at the Westin Hotel in Waltham on Friday, May 7, 1999. The guest speaker will be David G. Fink, the new President and CEO of Inventure Place which houses the National Inventors Hall of Fame in Akron,

Ohio. Mr. Fink has combined technology, art and entertainment throughout his career. Before taking the helm at Inventure Place, he was CEO of Sony Development, a division of Sony Corporation and prior to that, he was Vice President of Walt Disney Imagineering, where he revitalized Disney's Intellectual Property Program. A reception prior to the dinner at the Westin Hotel will feature a harp and flute duo. Please plan to join us, and black tie is optional as always. If you haven't attended a Judges Dinner, invite your spouse or a guest, wear a business suit, enjoy the evening and meet our Federal Judges.

The Trade Secret Seminar originally announced for April will be held in late May. Panelists and speakers have been selected and the Trade Secret committee co-chairs, Richard Gelb and Stephen Chow, are making final arrangements. This will be a sellout, so make your reservations early.

This takes us through the first half of 1999, and we already have plans for the second half. We are considering a Boston Harbor Cruise for our annual Summer Outing and another Luncheon/Speaker meeting for September. Also, an Advanced PCT Seminar will be held in Boston in October in cooperation with the World Intellectual Property Organization (WIPO).

If you have any comments or suggestions regarding your BPLA, please call me at (978) 452-1971 or send an E-mail to wfd@pearson-pearson.com.

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Board of Governors:

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1998 LOCAL LITIGATION HIGHLIGHTS

by Scott Rothenberger
Nutter McClennen & Fish LLP

This article is part of a continuing series of reports summarizing IP case decisions by the Federal district courts of the First Circuit.

Amgen, Inc. v. Hoechst Marion Roussel, Inc. 3 F. Supp. 2d 104, 46 U.S.P.Q.2d 1906 (D. Mass. 1998)

Michael Gottfried, Dennis Allegretti, of Burns & Levinson, Boston, MA, and Douglas Hochstetler, Edward O'Toole, Jane Choi, Michael Borun, of Marshall, O'Toole, Gerstin, Murray & Borun, Chicago, IL, for Plaintiff.

Robert Frank, Jr., Mark Michelson, of Choate, Hall & Stewart, Boston, MA, Peter McCabe, III, of Raymond Perkins, Winston & Strawn, New York City, Steven Molo, of Winston & Strawn, Chicago, IL, and Kenneth Herman, Herbert Schwartz, James Haley, Jr., Russell W. Faegenburg, of Fish & Neave, New York City, NY for Defendants.

Plaintiff, Amgen, Inc. brought this action for infringement in the District Court of Massachusetts against Hoechst Marion Roussel, Inc. and Transkaryotic Therapies, Inc. (Defendants) for manufacturing recombinant forms of erythropoietin (EPO). Plaintiff also sought relief from Defendants future plans for producing EPO. EPO is a genetically engineered compound used for treatment of anemia. Defendants moved for summary judgment, arguing that their activities were exempt under 35 U.S.C. 271 (e)(1).

The issue before the Court was whether the allegedly infringing activities by Defendants fell under the section 271(e)(1) exemption which permits research and development activities that otherwise would constitute infringement so long as they are reasonably related to development and submission of information for FDA approval.

Plaintiff asserted six potentially infringing activities by Defendants, the undertaking of which were not disputed by Defendants. The allegedly infringing activities centered on the manufacture of EPO by Defendants by an alternative process and the exportation of this EPO to Japan, where it is used in rabbit pyrogen studies. The compound was

then reproduced in three commercial scale production batches and shipped to Japan, where the product underwent further characterization studies, viral clearance tests and radiolabel studies.

Plaintiff asserted that these activities bore no reasonable relationship to FDA approval because no approval had been sought for the alternative process; that the rabbit pyrogen tests were actually carried out in order to satisfy European regulatory requirements and were not submitted to the FDA; that the Defendants abandoned their process because of their commercial disappointment with the quality of the product; that the characterization studies were conducted to solely to determine whether Defendants product infringed Plaintiff's patents; that the viral clearance tests were designed to meet European regulatory standards; and that the Defendants planned to conduct radiolabeling studies unique to Japanese regulatory requirements.

Defendants countered that the export of EPO to Japan was done in an effort to improve manufacturing processes and deferred action on the process until after FDA approval of the EPO produced by the new process; that although the rabbit pyrogen tests were not reported to the FDA, the tests were conducted to confirm the purity and safety of the EPO for use in clinical trials, which data would be submitted to the FDA; that the three commercial batches were produced to meet FDA requirements that three consecutive batches could be produced within certain tolerances of a reference material; that FDA guidelines require characterization as part of the approval process; that regardless of the stringency of European standards, the viral clearance tests were also reasonably related to obtaining FDA approval; and that no radiolabeling studies were ever performed.

Plaintiff's position centered on a "dual purpose" theory, that being, that Defendants were attempting to piggyback regulatory approval from various foreign regulatory agencies and from the FDA from the same package of data and clinical studies which should not be afforded protection under section 271.

Judge Young found this position untenable, finding that all the activities fell within the protection afforded by section 271 because they were solely for uses reasonably related to the production of information for submission to the FDA for regulatory approval and, therefore, were not infringing activities.

Judge Young then considered whether the Court had jurisdiction to determine future infringement and whether or not to exercise that jurisdiction. In order to meet the controversy requirement in a declaratory judgment suit by a patentee against an alleged future infringer, two elements must be present: (1) the defendant must be engaged in an activity directed toward making, selling, or using the patented product in a manner subject to an infringement charge under 35 U.S.C. §271(a), or be making meaningful preparation for such activity; and (2) acts of the defendant must indicate a refusal to change the course of its actions in the face of acts by the patentee sufficient to create a reasonable apprehension that a suit will be forthcoming.

Judge Young concluded that the Defendants in this case would only violate the law if they stepped outside the protective safe harbor that Congress created and that the declaratory judgment claim was administratively closed, to be reopened upon motion of either party for good cause shown.

Nova Biomedical Corp. v. Mallinckrodt Sensor Systems, Inc. 997 F. Supp. 187 (D. Mass. 1998)

John J. Regan, Hale & Dorr, Boston, MA, for Plaintiff, Nova Biomedical Corp.

Paul F. Ware, of Goodwin, Procter & Hoar, Boston, MA, and Richard E. Campbell, Raymond A. Kurz, George R. Repper, G. Franklin Rothwell, Steven Lieberman, of Rothwell, Figg, Ernst & Kurz, PC, Washington, DC, for Defendant, Mallinckrodt Sensor Systems, Inc.

Plaintiff, Nova Biomedical, alleged that two blood analyzers marketed by defendant Mallinckrodt, infringed, under the doctrine of equivalents, the claims of Nova's U.S. Patent 4,686,479, directed to methods and apparatus for analyzing hematocrit. Defendant counterclaimed,

CAFC CLARIFIES SMALL ENTITY RULES

A recent decision by the U.S. Court of Appeals for the Federal Circuit provides guidance for patent owners who have erroneously claimed "small entity" status while pursuing their patent rights before the U.S. Patent and Trademark Office (PTO). Although the decision provides a remedy that had previously been denied by at least one lower federal court, the Washington-based appeals court has also made it clear that "diligence" in correcting errors, once they are uncovered, is essential to invoking the remedy.

Since 1982, the U.S. patent laws have afforded a special status to small entities, such as individual inventors pursuing patents on their own, non-profit organizations and businesses with less than 500 employees. The official fees for almost every aspect of patent prosecution (e.g., government fees for filing an application, presenting extra claims, and requesting time extensions during examination, as well as the fees for issuance and maintenance of patents) are all reduced by 50 percent for those applicants that qualify for "small entity" status. For most applicants these savings can amount to several thousand dollars over the life of a patent.

If an application is filed on behalf of a small entity, the PTO does not expect to be notified immediately if the applicant's status changes. However, there are certain points in patent prosecution where small entity status must be reviewed and, if the status has changed, the regular fees must be paid from then onward. The most common of these verification points are whenever an application is re-filed, and prior to the payment of the issue fee or any maintenance fee.

In the 1996 case of *DH Technology, Inc. v. Synergystex International, Inc.*, the Federal District Court for the Northern District of California was faced with a situation where the plaintiff-patent holder had failed to review its entitlement to small entity status before paying the issue fee for a patent that was later asserted in infringement litigation. A

patent application (on laser jet printing techniques) had been filed in 1990 by a small start-up company. A year later, the business (and the patent rights) were sold to DH Technology, Inc. (DHT), a for-profit corporation with more than 500 employees. In 1992 a notice of allowance from the PTO was received and the issue fee promptly paid without consideration of the new owner's size. A week after the patent issued in August 1992, the new owner, DHT, brought suit against a competitor. DHT's error in claiming "small entity status" surfaced during discovery about two years after the suit was filed.

At trial, Judge Orrick of the Federal District Court for Northern California was persuaded by the defendant that DHT's patent had gone abandoned and could not be revived. He reasoned that Section 151 of the Patent Laws sets a limited time period for payment of deficiencies in the payment of the issue fee, and that this time period had expired. As a consequence, DHT would have to show that the delay in payment was "unavoidable." Although the error may have been "unintentional," the Court concluded that it was not "unavoidable" because DHL did not have any procedures in place at the time to ensure that patent rights acquired from others were converted in due course from small entity to regular status.

This California federal court decision sent a cold chill through many corporate patent owners, particularly in those companies where employment fluctuated, and in companies that had licensed their patent rights to large entities without thinking of the impact that such a license could have on the patentee's small entity status.

In contrast to Judge Orrick's decision, at least one other federal district court had come to the opposite conclusion in 1996. In *Jewish Hospital of St. Louis v. Idexx Laboratories*, a federal district court judge in Maine decided that another provision of the Patent Laws controlled the resolution of errors in claiming small entity status. Judge Hornby of the Federal District Court for Maine reasoned that a provision in

the patent regulations (37 C.F.R. 1.28) applied in such instances. This section permits a patent holder to correct the erroneous payment of a small entity fee at any time provided the mistake occurred in good faith, and it was promptly corrected (by the payment of the proper fee and a surcharge) following discovery of the error.

The situation became even muddier when another California federal judge invalidated a second patent in an infringement suit following the reasoning of Judge Orrick. Next, the Patent Office suspended its processing of issue fee corrections. The confusion quickly reached a point where not only litigants but also federal judges began to voice concern that the different decisions would lead to "forum shopping."

Fortunately, the dispute between the different districts was taken up by the Court of Appeals for the Federal Circuit (CAFC). This special appeals court was established in 1982 and given exclusive jurisdiction over appeals from district court decisions on patent law issues. The purposes behind the creation of the CAFC included the desire to ensure greater uniformity in the interpretation of the patent laws and the need to relieve the burden on the Supreme Court that was increasingly unable to resolve such matters.

The opportunity to address the disparate decisions on small entity errors arose when DH Technology appealed Judge Orrick's decision to the CAFC. A three judge panel of the CAFC heard the appeal and unanimously ruled that Maine's Judge Hornby's ruling was the proper one. Judge Schall, writing for the panel of Judges Newman, Plager and himself, explained that section 151, relied upon by Judge Orrick, was merely a vestige of long-since discontinued practice of the PTO, under which the issue fee had been collected in two parts, a base fee payable before the patent issued and a subsequent fee based on the actual printing costs, three months after issuance. The penalty of patent revocation under the prior scheme was a means to ensure that government re-

(Continued on page 5)

SMALL ENTITY ERRORS NOT FATAL SO LONG AS CLAIM WAS MADE IN GOOD FAITH

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couped its printing expenses. Judge Schall also noted that section 151 did not mention small entity status at all.

On the other hand, the CAFC found 37 C.F.R. 1.28 was specifically directed to erroneous claims of small entity status. The Court further noted that this interpretation was consistent with current PTO practices.

Following the Court's ruling, the PTO has further relaxed the requirements for correcting errors in small entity status. Under the present regulations, the PTO does not require a statement explaining how the error in good faith occurred. The submission of a petition to correct a fee deficiency is

treated as a representation that a party's small entity status was claimed in good faith and the original payment of small entity fees was made in good faith.

A major pitfall for patent holders still exists, however, if diligent steps are not taken to correct errors in small entity status. For this reason, patentees and their counsel should review the applicant's or patent holder's entitlement to small entity status periodically (and especially at the stages mandated by the PTO). Should an innocent error be discovered, prompt action will permit a patentee to preserve its patent rights.



Members of BPLA Board and Acting Commissioner Q. Todd Dickinson
(left to right) Peter Lando, Tom Engellenner, Walter Dawson, Commissioner Dickinson, Tim French, David Thibodeau and William Gosz
(missing from photo: Peter Corless and Doreen Hogle)

SUPREME COURT REDEFINES THE MEANING OF THE ON-SALE BAR

In a decision that adopted neither the reasoning of the CAFC nor the appellant, the Supreme Court ruled that an invention can be "on-sale" within the meaning of 35 USC 102(b) even if the invention has never been reduced to practice, so long as it is "ready for patenting."

In *Pfaff v. Wells Electronics*, the appellant, Pfaff, had been asked to develop a socket for semiconductor chip carriers. Pfaff sent detailed engineering drawings out for tooling and production on April 8, 1981 after receiving a purchase order. The sockets were not tested and shipped until July, 1981. Pfaff's patent application was filed on April 19, 1982.

The district court found that the invention had not been reduced to practice at the time of sale because it had not been built more than a year prior to his filing date. The CAFC reversed, ruling that there was no need for a physical embodiment of the invention to exist at the time of an offer for sale, rather the invention need only be "substantially complete". The CAFC found Pfaff's invention to be substantially complete since the customized tooling, manufacturing and fatigue testing steps that were performed after the sale were routine.

The Supreme Court upheld the CAFC finding but ruled that the "on-sale" bar exists if two conditions occur more than a year prior to filing: the invention must be the subject of a commercial sale and the invention must be "ready for patenting." The second condition is easily met if the invention was actually reduced to practice at the time, but can be also met by the existence of detailed drawings or other enabling descriptions.

1998 LITIGATION HIGHLIGHTS

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asserting inequitable conduct. Defendant sought to invalidate the patent by showing that Plaintiff intentionally withheld material information from the United States PTO during the prosecution.

Prior to applying for the '479 patent, Plaintiff had filed a 510k application for the Nova Stat Profile™, the commercial embodiment the patent. During FDA review, Plaintiff acknowledged that its device was substantially equivalent to U.S. Surgical's STAT-CRIT Instrument but included an improvement that corrected electrolyte background.

Nova had previously filed a Freedom of Information Act (FOIA) request seeking disclosure of a 510k application for STAT-CRIT, the hematocrit device manufactured by U.S. Surgical Corporation. Plaintiff received the information, which included an informational brochure on the STAT-CRIT, three months prior to the filing of the '479 application. During prosecution, Plaintiff disclosed, as prior art, an article by Okada et al., entitled, "An Electrical Method to Determine Hematocrit," and a patent on a hematocrit measuring device, issued to Ishihara. Nova did not identify the STAT-CRIT brochure as prior art and the defendant asserted that Plaintiff failed to disclose material information with intent to deceive the PTO.

Based upon expert testimony that the

brochure was cumulative of known information, Judge Stearns did not find any inequitable conduct. One basis for Judge Stearns' holding was that the Plaintiff had cited the Okada paper and the Ishihara patent during prosecution and that these references disclosed more material information than the STAT-CRIT brochure. According to the Court, deceptive intent could not be found on a mere inference or even on gross negligence; there must be conduct, viewed in light of all evidence, including evidence of good faith, that indicates sufficient culpability to require a finding of intent to deceive. In this instance, Judge Stearns held the Defendant failed to come forward with any clear and convincing evidence that the brochure was material prior art that should have been disclosed to the PTO. The Defendant also failed to produce any evidence that Plaintiff intentionally and deceptively withheld the brochure.

POSITIONS AVAILABLE

Please note that the BPLA Board has approved a change in policy and, starting with this issue, members will be charged a fee for the placement of Positions Available ads. Henceforth, the placement of such ads will cost \$100.00 per issue for approximately one hundred words of space in the newsletter.

If you wish to submit an advertisement for publication in the next issue, please send a copy of the proposed ad by email and a check (made payable to Boston Patent Law Association, Taxpayer ID# 04-2667161) for \$100.00 by regular mail to Tom Engellenner [Email: tje@nutter.com; Mail: Thomas Engellenner, Nutter, McClennen & Fish, LLP, One International Place Boston, MA 02110-2699]

Phylos seeks Patent Attorney (Job Code 60-1) with a JD, and a BS in Biological Science. Responsibilities include obtaining IP protection by preparing and prosecuting worldwide patent applications and providing intellectual property review. Successful candidate will play significant role in defining and effecting corporate strategy, including drafting, reviewing and negotiating agreements with significant IP content. A minimum of five years experience in drafting patent applications and amendments in the biotechnology/pharmaceutical industry and experience in drafting agreements (in- and out-licensing) needed. Phylos offers a competitive compensation package, health benefits, 401K, and stock options. Send CV's to Phylos, Inc., 128 Spring Street, Lexington, MA, 02421 or via fax to 781-402-8800.

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Announcing the 1999 WRITING COMPETITION sponsored by the BPLA

1st Prize: \$300

2nd Prize: \$200

will be awarded to the author of the best article on a subject relating to the protection of intellectual property written or published between Aug. 1, 1998 and July 31, 1999

CONTEST RULES

To be eligible for consideration, the articles must have been written solely by a student or students either in full time attendance at a law school (day or evening) within the jurisdiction of the First Circuit, or prepared in connection with a course at a law school situated in the First Circuit. The article must be submitted to the Boston Patent Law Association on or before July 31, 1999. Papers should be no more than the equivalent of 10 law review pages including footnotes (30-40 pages typed copy). Submission of 5 copies is required. Submissions must include the submitter's name, current address, current telephone number, law school and employment, if applicable.

Judges will consider the merits of the article as a contribution to the knowledge respecting intellectual property.

Send papers to:
The BPLA Writing Competition
 c/o Attorney Doreen Hogle
 Hamilton, Brook, Smith & Reynolds
 One Militia Drive
 Lexington, MA 01776

Notice to All BPLA members who have not yet paid their 1999 dues:

The annual BPLA membership fee of \$40.00 was due by February 1, 1999. A \$10.00 late fee is also due for renewals after that date. Membership renewal forms can be obtained from BPLA Treasurer William G. Gosz at (617) 720-3500 or via the internet from our web site www.BPLA.org

BPLA Committees

To switch committees (or to join another committee), members are encouraged to contact the committee chairpersons listed below to have their names added to committee rosters. Most committee chairpersons can be contacted through the BPLA web site: www.bpla.org (For committees that have co-chairs, please contact the person marked by the asterisk.)

Activities and Public Relations

Mary J. Dawson (978) 452-1971
Mark Solomon (781) 861-6240

AIPLA Moot Court

*Merton E. Thomson (617) 542-5070
John M. Berns (617) 542-5070

Antitrust Law

*Paul R. Gupta (617) 338-2482
Martin O'Donnell (617) 951-2500

Litigation

Susan Glovsky (781) 861-6240
Steven M. Bauer (617) 248-7594

Biotechnology

*Patricia A. McDaniels (603) 437-8970
Doreen M. Hogle (781) 861-6240

The Biotechnology Committee co-chairs have represented the BPLA at several quarterly meetings of the PTO Biotechnology Customer Partnership, most recently on February 23. At the most recent meeting, the PTO informed us that a new Notice of Proposed Rulemaking is coming which will incorporate the comments received on the proposals in the Advance Notice of Proposed Rulemaking of September 28, 1998. Many of the proposals have been deleted or altered significantly in response to the comments.

The proposed Written Description Guidelines will be revised and may receive additional public comment. About 30 comments were received, half from individuals and half from organizations.

The meeting also highlighted several significant changes soon to occur, such as:

The revised guidelines will not be technology specific and will not be tailored for ESTs; there will be a presumption of support; the initial burden will be on the PTO to establish lack of written description by a preponderance of the evidence; and the PTO does not want to expand the Fiers and Lilly decisions.

Please send comments and suggestions to the co-chairs to deliver at the next PTO Biotechnology Customer Partnership quarterly meeting in May.

Chemical Practice

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Maggie Kanter (508) 872-8400

Computer Law

*Edward W. Porter (617) 494-1722
Lee Carl Bromberg (617) 443-9292

The BPLA Computer Law Committee sponsored a seminar on Software Patent Prosecution on February 9, which more than fifty-seven people paid to attend.

Peter Gordon of Wolf, Greenfield & Sacks, spoke on "The Courts' Trend Toward Narrower Claim Interpretation, And How Best To Avoid It," Paul E. Kudirka of Kudirka & Jobse spoke on "How To Best Claim Software Inventions," Thomas A. Turano of Testa, Hurwitz & Thibault, spoke on "The Courts' Trend Toward Strict Interpretation Of The Written Description Requirement, And What To Do About It," Bruce D. Sunstein of Bromberg & Sunstein, spoke on "What Software Is Patentable: §101 Subject Matter Issues, Including Methods of Doing Business," and Wayne L. Stoner, of Hale & Dorr, provided a "Litigator's Advice To Software Patent Prosecutors."

Computer Law Committee Co-Chair Ed Porter of Porter and Associates led panel discussions with the speakers on each of the topics, and on "The Specifications in Software Patent Applications."

Computer Law Committee Co-Chair Lee Bromberg, of Bromberg & Sunstein provided introductions and also partook in the panel discussions.

Copyright Law

*Charles L. Gagnebin (617) 542-2290
Thomas M. Saunders (617) 227-0700

Corporate Practice

*Walter Dawson (978) 452-1971
Faith F. Driscoll (978) 294-6165

On February 3, the Corporate Practice Committee held a seminar on the managing and licensing of the Corporate IP Portfolio at Arthur D. Little Enterprises.

The featured speakers were: Edward Kahn, Founder and President of Ekms, Inc. and Joseph J. Coté, Jr., Vice President of Arthur D. Little Enterprises, Inc.

The speakers presented material pertaining to: the state of the art in IP Licensing, the shift in IP activities from "tactical" to "strategic," the five levels of IP Awareness, and the attributes of a successful licensing department.

There will be another Committee meeting next month; however, we are always interested in hearing from members.

International Practice

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Thomas A. Turano (617) 248-7378

Law Students

*Janice M. Mueller (617) 573-8171
Tom Johnston (781) 769-9450

The Law Student Committee is planning three events for 1999: 1) An educational program for law students interested in patent litigation; 2) a social event for IP law student organization members at area law schools; and 3) a mentorship program to match volunteer IP practitioners with law student members to offer ideas and encouragement regarding the IP field.

Patent Law/Practice

*David S. Resnick (617) 545-6057
Grant Houston 781-861-6240

Young Lawyers

*Leslie Hamlin (617) 720-3500
Aaron Bullwinkel (617) 345-0010

This committee helps IP lawyers who have been practicing less than five years to network with each other. Among the committee's activities will be Brown Bag Lunch Meetings with speakers and an educational seminar. For further information or to join the committee, please e-mail Aaron Bullwinkel at: g&g@gelbgelb.com, or Lesley Hamlin at: lhamlin@wgsllaw.com

Trade Secrets

*Stephen Y. Chow (617) 854-4000
Richard M. Gelb (617) 345-0010

On May 26, from 8AM-1PM, Steven Chow of Perkins, Smith & Cohen, LLP and Richard Gelb of Gelb & Gelb, LLP will co-chair a seminar on Trade Secrets.

The panel will include: U.S. Magistrate Judge Marianne B. Bowler, Jerry Cohen of Perkins, Smith & Cohen, LLP, Corky Hoffman of Hoffman Alvery, Mark Seltzer of Goulston & Storrs, P.C., Robert Vitteretti of Kroll Associates, and William Wise of Analog Devices.

The Seminar will commence after breakfast and will address: an overview of trade secrets law (including the Uniform Act); trade secret protection; ethical issues of concern to counsel; investigations of trade secret misappropriation; civil litigation issued and tactics; criminal law issues; trade secret valuation; expert testimony presentation; and judicial commentary.

Trademarks & Unfair Competition

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Donna M. Weinstein (617) 542-5070

UPCOMING 1999 EDUCATIONAL EVENTS

April - Luncheon Seminar "Patenting Methods of Gene Therapy"

The BPLA Biotechnology Committee has **postponed** its meeting with representatives of PTO Group 1600, who will speak on the enablement and utility issues in patenting methods of gene therapy. Luncheon will be either April 21 or 22. Reception from 13:00 AM to noon; Luncheon and program from 12:00PM to 1:30PM; at the Regal Bostonian Hotel at Faneuil Hall Marketplace. Member will be notified of a definite date in the mail. Contact Doreen Hogel at 781-861-6240 for more details.

May 7 - Annual Judges Dinner

The dinner in honor of the federal judiciary will be held at the Westin Hotel in Waltham. Guest Speaker will be David Fink of Inventure Place. Black tie optional.

May 26 - Trade Secrets Seminar

A full morning program from 8:00AM to 1:00 PM will feature speakers on trade secret law (the Uniform Act), investigations, civil and criminal litigation and ethics.

September - PCT EASY™ Seminar

A 3 hour seminar to demonstrate use of the World Intellectual Property Organization's new software designed to make PCT filings "easy." Look for details in the mail.

October 8-9 - PCT Advanced Practice Seminar

Representatives of WIPO will present a two day training seminar on PCT practice for attorneys and legal staff who are familiar with the basic features of international applications. Program will cover both Chapter I Searches and Chapter II Examination.

December 1 - BPLA Annual Meeting

Mark your calendars now. The BPLA Annual Meeting will be held December 1st.

POSITIONS AVAILABLE

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Nutter, McClennen & Fish, LLP is seeking experienced patent attorneys for patent prosecution, litigation, technology licensing and client counseling. Persuasive advocacy skills and excellent writing ability essential. Particular needs include attorneys with medical device, chemistry, electronic instrumentation and biotechnology experience. Contact Patricia A. Naughton, Legal Hiring Manager at (617) 439-2351 or via email at pan@nutter.com.

Millenium Pharmaceuticals - Bright, innovative patent attorney sought by a leading edge company to be responsible for development of patent strategies and patent portfolios for Millenium and its subsidiaries. Responsibilities include working closely with research and business teams; advising, identifying and developing patent strategies for multiple new technologies; overseeing/managing the preparation and prosecution of patent applications, and providing creative approaches to broaden the Company's patent position with an understanding of competitors. Requires BS, JD and patent bar; 4-8 years law firm or corporate biotechnology patent experience; excellent science, communication and interpersonal skills; and the desire to be in leadership as an important part of a dynamic, progressive team. Contact: Jackie Hodge via (phone) 617-679-7192 (fax) 617-225-0884 or (email) jhodge@mpi.com

Wolf, Greenfield & Sacks, P.C. is seeking lawyers with degrees in any area of science or engineering. Candidates with industry experience and/or an advanced degree in science or engineering preferred. Specific needs exist for: a partner-level patent attorney in chemistry with at least 15 years' experience in prosecution and/or litigation and licensing, who is uniquely qualified to further successful existing practices and has both interest in and ability to train junior attorneys; a partner-level litigator with at least ten years' experience (preferably some IP litigation) and at least some technical background or demonstrated ability to understand and work with technical issues; an associate-level litigator with at least six years' experience including significant trial experience. For all candidates excellent interpersonal skills, writing skills, technical knowledge, academic records (both technical and legal), and references are required. The successful candidate will have impeccable integrity and team-oriented values. Please submit resume in confidence to: Timothy J. Oyer, Esq., Wolf, Greenfield & Sacks, P.C., 600 Atlantic Avenue, Boston, Massachusetts 02210. or via e-mail to www.wgslaw.com.

Weingarten, Schurigin, Gagnebin, & Hayes LLP seeks patent attys. with EE, Chemistry or Biochemistry degrees. Experience needed in electronics, polymer chemistry, catalysts, or pharmaceuticals. Responsibilities include preparation and prosecution of patent applns. and client counseling. Min. 2 yrs exp. required. Salary competitive. Send resume to Hiring Partner, WSGH, 10 Post Office Sq., Boston MA 02109

The Boston Patent Law Association (BPLA) is an association of intellectual property professionals, providing educational programs and a forum for the interchange of ideas and information concerning patent, trademark, and copyright laws. Through a volunteer Board of Governors and committees, it organizes and hosts educational seminars, social events, and conventions, and comments on rules and legislation impacting the profession. Visit the BPLA at www.bpla.org.

Membership in the BPLA is available to attorneys and other professionals practicing intellectual property law within the Federal First Judicial Circuit (Maine, New Hampshire, Vermont, Massachusetts, Rhode Island, and Connecticut). Applications for membership can be obtained from our web site at www.bpla.org. Full membership for 1999 (available only for attorneys practicing within the First Circuit) costs \$40.00 Associate membership (available to non-attorney intellectual property professionals) costs \$35.00. Mailing list-only affiliation costs \$15.00

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