



THE BOSTON PATENT LAW ASSOCIATION NEWSLETTER

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JUDGE GILES S. RICH SUCCUMBS TO ILLNESS OLDEST ACTIVE FEDERAL JUDGE DIES AT 95 YEARS OLD

Judge Giles Sutherland Rich of the Court of Appeals for the Federal Circuit died of lymphoma on June 9, 1999 in Washington following a brief illness. Appointed to the Court of Customs and Patent Appeals in 1956 by President Eisenhower, Judge Rich was one of the twelve original members of the reorganized CAFC in 1982 and, until his illness, was said to have never missed a session of the court.

Judge Rich was born on May 30, 1904 in Rochester, New York and, following education at Harvard College and Columbia Law School, joined his father's private practice in New York City in 1929. In 1940 he began lecturing on patent law at Columbia Law School and was the president of the New York Patent Law Association during 1950 and 1951.

Before his appointment to the bench, Attorney Rich was a member of the national drafting committee that assisted Congress in the recodification of the U.S. patent laws that was enacted as the 1952 Patent Act. He has been widely credited as the author of those sections that addressed the standards of nonobviousness, contributory infringement and the doctrine of equivalents.

Two years ago, Chief Justice Rehnquist of the Supreme Court quipped in a letter to Judge Rich. "Every day, you, like Cal Ripken Jr., extend your record. Judge Rich never took senior status or a reduced case load and continued working full time until shortly before his hospitalization at Sibley Memorial Hospital.

Judge Rich's decisions helped shape every facet of patent law from software protection

to biotechnology, and from the standards for inventiveness to claims interpretation. Among the decisions that he authored are *In re Chakrabarty*, 197 USPQ 72 (CCPA 1978, affirmed by the Supreme Court, 1979) which held that genetically engineered microorganisms are not outside the scope of patents merely because they are living organisms, *Hybritech v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1987), which set the standard for enablement in biotech cases, *In re Donaldson Co. Inc.*, 29 USPQ 2d 1845 (Fed. Cir. 1994), which set the standard for interpreting "means-plus-function" claims, and most recently, *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 47 USPQ 2d 1596 (Fed. Cir. 1998) which held that methods of doing business can indeed be patented.

SUPREME COURT RULES FOR THE PATENT OFFICE CAFC MUST GIVE GREATER WEIGHT TO PTO APPELATE DECISIONS

By a 6-3 vote the U.S. Supreme Court held on June 10, 1999 in *Dickerson v. Zurko* (No. 98-377) that the Court of Appeals for the Federal Circuit must apply a more deferential standard of review than the "clearly erroneous" standard that it purportedly had been applying since 1982.

Under the ruling the CAFC can overturn PTO denials of patents only if the decisions are "arbitrary, caparicious or unsupported by substantial evidence" - the basic guidelines codified in section 706 of the Administrative Procedures Act (APA) which is presently used in the appellate review of virtually every other review of federal administrative decisions.

Proponents of broader review power for the Federal Circuit asserted an exception

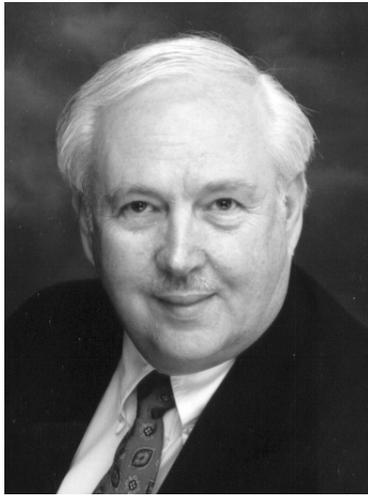
based on 5 U.S.C. 559, which provides that the APA did not limit or repeal additional requirements recognized by law, and argued that, at the time the APA was enacted in 1946, the predecessor of the the CAFC, the Court

of Custom and Patent Appeals (CCPA) had applied a "clearly erroneous" standard that was stricter than the APA standard. This more stringent review, they argued, was an

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Walter Dawson
Pearson & Pearson

Message from President Dawson

establish as a "brand name" the National Inventors Hall of Fame. He encouraged the BPLA members to visit the Hall of Fame and to support it and its programs with contributions, such as Camp Invention for children entering grades 2 through 6.

As most of you know, our Annual Dinner is often referred to as the "Judges Dinner" because the Honored Guests are members of the First Circuit Federal Judiciary. This year we were honored to have with us The Honorable Marianne B. Bowler, The Honorable Nathaniel M. Gorton and his wife Jodi, the Honorable A. David Mazzone and his wife Eleanor, The Honorable George A. O'Toole, Jr. and his wife Lucy, and The Honorable Patti B. Saris, all from the United States District of Massachusetts.

Each of the Judges was escorted by an Officer or Board Member and seated at their law firm's table which included Fish & Richardson, P.C., Hamilton, Brook, Smith & Reynolds, P.C., Pearson & Pearson, LLP, and Wolf Greenfield & Sacks, P.C. I want to thank those law firms for their support and also Dike, Bronstein, Roberts & Cushman, LLP, and Testa, Herwitz & Thibeault, LLP for their support. However, many other law firms were represented at the Annual Dinner which contributed to its success.

Everyone enjoyed socializing at the Reception prior to the dinner, where five types of Hors D'Oeuvres and various cheeses and fruits and vegetables were served with background music provided by the Lisa Calvo Harp and Flute Duo. The dinner included roasted halibut filet or black angus prime

ribeye, and California merlot and white wines were served during dinner. Cappuccino mousse cake with shaved chocolate completed the dinner.

The 75th Anniversary Dinner and Reception was enjoyed by all and if more members had decided to attend we might have had a space problem (but we had a moveable wall). We estimated an attendance eight months before the dinner of 150 and we had 153. However, I was disappointed with the poor attendance of our corporate members. We called most of our corporate members in an effort to get more to come, but to no avail. However, we were pleased to see at the dinner Nancy Hough of GTE, Tom Tuytschaevers of Analog Devices, Faith Driscoll of Bull, Leslie Levine of Transkaryotic Therapies, Inc., and Martha Finnegan of Cabot Corporation.

Last but certainly not least I want to thank Activities Co-Chair, Mary Dawson, for her many hours of planning and arranging this Annual Dinner and Reception which she started planning immediately after the 1998 Annual Dinner.

Each year the President of the BPLA is invited to the New York Intellectual Property Law Association Annual Dinner in honor of the Federal Judiciary. This year I had the pleasure and opportunity to attend it at the Waldorf-Astoria Hotel. I was welcomed by the IP Law Firm of Frommer, Lawrence & Haug, LLP, attended their reception prior to the Annual Dinner and was seated at their

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The Boston Patent Law Association
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Board of Governors:

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PTO TO MOVE TO ALEXANDRIA VIRGINIA IN 2002

The U.S. General Services Administration (GSA) announced on June 14, 1999 that LCOR Alexandria, L.L.C., has been chosen to provide approximately 2 million square feet of office and related leased space for the United States Patent & Trademark Office as part of the PTO's consolidation project.

The new home for the PTO will be built by the year 2002 on undeveloped land at Dulaney Street and Eisenhower Avenue between Elizabeth Lane and Carlyle Street in Alexandria, Virginia. A Record of Decision was signed on June 14th that identified LCOR and the Carlyle site as meeting PTO's long-term housing needs. The ROD stated that LCOR's proposal was rated the highest

technically and offered the lowest price.

"This decision paves the way for awarding a lease in the near future." "It is the largest single lease the Federal Government has ever initiated, and we look forward to an expeditious conclusion of the final phase of this project," stated Nelson B. Alcalde, Regional Administrator for GSA's National Capital Region.

The LCOR design proposes a "U" shaped complex with two adjacent, and connected, above-ground parking structures capable of housing 3,500 vehicles. The "U" includes an 18-story tower at the center of the facility and four office buildings of ten floors on either side. The complex will be within walking

distance of the Eisenhower Avenue and King Street Metro stations as well as the King Street VRE station.

The PTO has been located in leased space in the Crystal City area of Northern Virginia for over 20 years and currently occupies 18 separate office buildings over a one mile area.

An increase in patent and trademark applications, up nearly 50% percent since 1994, has strained the resources and space of the current facilities. In 1995, Congress authorized the GSA to lease approximately 2 million square feet of office and related space for the PTO in Northern Virginia, for a 20-year term.

CAFC Review

APPEALS COURT GIVES PUMPKIN BAG INVENTORS A TREAT JUDGES REVISIT DECISIONS BASED ON PFAFF STANDARDS

The Court of Appeals for Federal Circuit has reiterated the requirement that the Patent Office show a motivation to combine prior art when it rejects patent claims based on combinations of two or more references.

In re Dembiczak (Fed. Cir. No. 98-1498, April 28, 1999) involved a patent application for a general round bag premanufactured in orange, with facial indicia, and an opening suitable for filling with trash. In 1992, co-inventors Dembiczak and Zinbarg had invented these trash bags that, when filled with trash, resembled Halloween pumpkins. The application was rejected and the PTO Board of Appeals sustained a rejection of the claims based the combination of two classes of references: conventional trash bag designs and a children's art designs of pumpkins.

The CAFC found that the Board's decision failed to cite any information from either reference that would justify their combination. "Nowhere does the Board particularly identify any suggestion, teaching or motivation to combine the children's art references with the conventional trash or lawn bag references, nor does the Board make any specific - or inferential - findings concerning

the identification of the relevant art, the level of skill in the art, the nature of the problem to be solved or any other factual findings that would support a proper obviousness analysis."

The new standard for determining when an invention is "on sale" set out in the Supreme Court's recent decision in the *Pfaff v. Wells Elect. Inc.* case last year has prompted the CAFC to revise at least one of its recent decisions much to the patentee's disappointment.

In *Scaltech, Inc. v. Retec/Tetra LLC* (Fed. Cir. No. 97-1365, June 4, 1999), The Appeals Court granted a rehearing to apply the *Pfaff* on-sale requirement that the invention be "ready for patenting" at the time an offer for sale is made (to start the one-year clock running on patent filings).

Scaltech, a petroleum waste processor had developed a method of de-oiling waste sediments in a centrifuge. Between 1988 and 1991, the company proposed using this processing at a number of potential client refineries. At least some of the proposals were not identified as experimental. A patent ap-

plication on some of the specific steps in the process was filed in 1993. Scaltech sued the defendant shortly after the patent issued in 1995.

In an initial judgment last year the CAFC reversed the District Court's summary judgment of invalidity and remanded the case for trial. However, Retec petitioned the Federal Circuit for rehearing shortly after the Supreme Court decision in *Pfaff* was rendered last November.

On June 4, 1999, the CAFC granted Retec's petition and issued a revised opinion. The revision, one of the last opinions authored by Judge Rich before his death, noted that the record failed to show whether any of the processes offered by Scaltech fell within the claims of the patent as ultimately issued.

"There is no requirement that the offer specifically identify these limitations....Nor is there a requirement that Scaltech must have recognized these limitations at the time of the offer....If the process that was offered for sale inherently possessed each of the claim limitations, then the process was on sale, whether or not the seller recognized that his process possessed the claimed characteristics."

1999 JUDGES' DINNER CELEBRATES BPLA'S 75th YEAR DAVID FINK REPORTS ON INVENTURE PLACE

By David Thibideau
Hamilton, Brook, Smith and Reynolds

The Association's annual reception and dinner honoring members of the Federal Judiciary was held on Friday, May 7, 1999 at the Westin Hotel in Waltham. The guests included the Hon. Marianne B. Bowler, Hon. Nathaniel M. Gorton, Hon. A. David Mazzone, Hon. George A. O'Toole, Jr., and Hon. Patti B. Saris of the U.S. District Court for the District of Massachusetts.

Other special guests included Mr. Nicholas Godici, the Acting Assistant Commissioner of Patents and Mr. Richard Maulsby, Director of Public Affairs at the PTO.

The guest speaker was David Fink, the recently appointed President and CEO of Inventure Place in Akron Ohio. Mr. Fink was formerly senior vice president and chief operating officer of Sony Development, a division of Sony Corporation,

established to design and build entertainment centers. Before that, he spent eight years with Walt Disney Imagineering, where he built the research-and-development function into a \$25 million operation and developed the technologies behind Walt Disney World's Tower of Terror and Indiana Jones attractions.

Inventure Place, which houses the National Inventors Hall of Fame and other innovation-related exhibits, is considered to be the premiere public exhibit in the country dedicated to

inspiring creativity and invention. Its mission is to promote research and development, artistic expression, and entrepreneurship in an effort to keep our nation at the forefront of technological leadership. Inventure Place has welcomed more than a half million guests since opening in July 1995. A primary focus has been on children and school field trips, which together total approximately 40% of the attendance. Present activities include hosting a hands-on exhibit version of the Beakman's World innovative children's show, and the "Camp Invention" day camp program with structured activities for children in grades 2-6 held in schools throughout the country each summer.

The National Inventors Hall of Fame was founded to celebrate the creativity and entrepreneurial spirit of inventors. The Hall is dedicated to the individuals who have brought about technological advances, fostered by the U.S. Patent System.



l. to r. BPLA President Walter Dawson, Mary Dawson, PTO Public Affairs Director Richard Maulsby, Assistant Commissioner for Patents Nicholas Godici, and guest speaker David Fink

AIPLA RELEASES ECONOMIC SURVEY

The American Intellectual Property Law Association released its latest survey this month, revealing the continued economic importance of intellectual property law practice and the success of IP practitioners. The survey, which was based on almost 1900 AIPLA member responses to a two-page questionnaire, reveals that the incomes of both private practice and corporate practitioners continue to rise. For private practice in Boston the survey reported a 1998 median associate income of about \$100,000 and a median partner income over \$200,000. The 75th percentile incomes for Boston IP associates and partners were about \$125,000 and \$350,000, respectively. Among local corpo-

rate IP counsel, the survey reports median incomes for in-house staff attorneys to be slightly more than \$100,000 and for heads of IP departments in Boston area corporations, the median income was reported to be about \$150,000.

The numbers for the Boston area were based on returns from 64 practitioners.

The survey also reported typical charges for commonly provided IP services. The Boston median services charges (excluding official filing fees and other disbursements) did not reveal any surprises.

Patentability evaluation were reported to cost about \$1,000. The median cost of simple patent applications was about \$5,000 while complex patents (either biotech or elec-

trical) on average cost twice as much. The median cost of trademark evaluations and trademark application filings were about \$500 each.

The full report contains almost a hundred pages of data including the exact numbers for the income and typical charges described above, as well as hourly billing rates and income graphs versus years of IP experience, characteristics of law firms and costs of litigation through various phase of a case.

All members of the AIPLA receive free copies of the report. Extra copies are available to members for \$35. Non-members can order copies for \$300. Contact the AIPLA at www.aipla.org or by phone: (703) 415-0780.

PRESIDENT'S REPORT

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table in the Grand Ballroom. Every IP law firm in New York held a "private" reception within the hotel before and after dinner. This event was attended by several thousand and not only were the ballroom and its tier boxes filled, but also the proceedings in the ballroom were televised into 6 other function rooms or areas of the hotel.

The guest speaker was the Honorable Joseph M. McLaughlin, Senior Circuit Judge for the United States Court of Appeals for the Second Circuit. Judge McLaughlin gave sort of a "Candid Camera" view of his experiences as a teacher, lawyer and judge over the years and the laughter was continuous from start to finish. The next morning the presidents of various IP Law Associations were invited to a breakfast hosted by Don Martens, Chair of the NCIPLA and, coincidentally, President of the National Inventors Hall of Fame. At the breakfast we had an opportunity to chat with USPTO Commissioner Dickinson and Assistant Commissioner Godici.

We held a special meeting of the Association on May 26, 1999 prior to the Trade Secret Seminar at the Sonesta Hotel in Cambridge. The Board of Governors recommended that the By-Law for setting the amount of the dues by Association members be changed to have the Board of Governors set the dues. This amendment passed unanimously and we thank you for your support.

There has not been a dues increase in many years and the current Board is trying to develop structure within the Association to more effectively handle the work required to arrange seminars and other BPLA functions. There is a growing need for our seminars to be certified for CLE credits which are required by our New Hampshire Bar members. If your Board of Governors determine that a dues increase is required in the future, I expect that we will all benefit as members of our Professional Association, instead of continuing to maintain the status quo of the Association which has grown significantly in membership the last 10 years.

We are planning to have the 1999 Summer Social on the Spirit of Boston on Sunday afternoon, August 8, 1999, from 11:00 am to 2:30 pm. Friends and children are welcome but advanced registration is critical for space on the boat. Watch for the announcement flyer and make your reservations immediately.

There are many new seminars or functions now being planned for the fall by the following Committees: Corporate, International, Biotech, Chemical, Litigation, Patent Practice and Young Lawyers. For example, an Advanced PCT Seminar is scheduled for October 15 and 16, 1999 in Boston. You will see more details within this Newsletter, in coming announcements, or check the BPLA Web Site (www.bpla.org).

AMAL DORAI WINS BPLA SCIENCE FAIR AWARD

16 Year Old Lexington High Student's topic was pollution

The BPLA has again had the honor of presenting an award in connection with the Massachusetts State Science Fair, held on Saturday, May 1, on the MIT campus in Cambridge. A number of organizations and local companies handed out more than \$400,000 in scholarships and prizes to the best and brightest high school students in the Commonwealth. David Thibodeau, President-Elect, presented a \$500 award on behalf of the BPLA.

"We should be especially proud that the Association in some small way helps to encourage students to seek a career in science and engineering," said David. "I hope the BPLA will consider increasing its support for this worthwhile cause next year." The winner of the BPLA award, chosen by the staff judges of the Science Fair, was Amal K. Dorai, 16 years old from Lexington High School. The title of his project was "Pollution of Mystic River Phase III -- Quantifying Fecal Coliforms."

PTO WINS ON STANDARD OF REVIEW

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"additional requirement" that exempts CFAC review of PTO actions from the APA. However, the Supreme Court considered the CCPA's cases reviewing PTO decisions and found that the decisions did not reflect an established "clearly erroneous" standard. In fact, no CCPA's opinion actually used the words "clear error" or "clearly erroneous," the terms of art signaling the more wide-ranging analysis typically found in appellate court review of trial court decisions. Most of the CCPA cases in which PTO decisions were reversed used the phrase "manifest error." Furthermore, the Supreme Court found that the CCPA cases revealed that the terms "clearly wrong" and "manifest error" had explanations which indicated that court considered court/agency, not court/court review in mind.

The Supreme Court was not persuaded by the policy reasons asserted by those supporting broader review powers for Federal Circuit in lieu of the APA standard. Disruption to the bench and bar, creation of an anomaly between the standards applied during a direct appeal from the PTO rather than first seeking review in a district court, and the promotion of better agency fact finding, were all rejected by the Court.

The effect of the ruling may be less significant than it might seem, based on the Justices' comments during oral arguments this spring. At least two Justices (Scalia and Ginsberg) saw little difference in the two review standards. Justice O'Connor questioned whether the APA standard of review might, in fact, be less deferential than the "clearly erroneous" standard, and Justice Breyer remarked that in his experience the difference in standards has never been "outcome determinative."

Justices Rehnquist, Kennedy and Ginsburg dissented, noting that the majority's opinion turns on whether 89 or so cases identified by the Court can be read to establish a different standard. Rehnquist wrote: "I would defer, not to agencies in general as the Court does today, but to the Court of Appeals for the Federal Circuit, the specialized Article III court charged with review of patent decisions."

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

Committee e-mail - activities@bpla.org

*Mary J. Dawson - (978) 452-1971

Mark Solomon - (781) 861-6240

We are planning a summer outing on the Spirit of Boston for Sunday, August 8, 1999 for members as well as their family and guests. The outing will include a New Englander Buffet Lunch, a two-and-a-half hour cruise of Boston Harbor with an accompanying narrated tour, as well as a festive floor show performed by the waitstaff of the Spirit of Boston. A 6x8 color photograph of attendees boarding the Spirit of Boston will be available for individual purchase. Parking will be available free of charge at a designated World Trade Center parking lot. Watch for a notice regarding this event, and be prepared to make immediate reservations as space will be limited. Please call Mary Dawson for further information.

AIPLA Moot Court

Committee e-mail - mootcourt@bpla.org

*Merton E. Thomson (617) 542-5070

John M. Berns (617) 542-5070

Antitrust Law

Committee e-mail - antitrust@bpla.org

*Paul R. Gupta - (617) 338-2482

Martin O'Donnell - (617) 951-2500

Biotechnology

Committee e-mail - biotechnology@bpla.org

*Patricia A. McDaniels - (603) 437-8790

Doreen M. Hogle - (781) 861-6240

The Biotechnology Committee hosted a well-attended luncheon talk by John Doll, Director of Groups 1630 and 1650 on April 29, 1999. The Committee was represented at the PTO Biotechnology Customer Partnership Meeting on May 25, 1999, which featured a talk by Chief Administrative Patent Judge Bruce Stoner. During Fiscal Year 1998 the Board of Patent Appeals and Interferences disposed of 4091 ex parte appeals, received 3779 new appeals, and ended the year with an inventory of 8889 pending ex parte appeals.

The Board declared 189 interferences, terminated 204 interferences, and had an end-of-year inventory of 433 pending interferences. In March 1999 there were 1454 pending appeals from TC 1600. The PTO has asked the Biotechnology Committee to help arrange a Customer Partnership meeting in Boston—more to come on this. At the PTO's request, the Committee is helping to organize an examiner field trip to several Boston area biotechnology companies at some point during this summer.

Careers in IP Law

Committee e-mail - careers@bpla.org

The BPLA is currently seeking volunteers to chair or co-chair this committee.

Chemical Practice

Committee e-mail - chemical@bpla.org

*Peter F. Corless - (617) 523-3400

Maggie Kanter - (508) 872-8400

A breakfast seminar on technology and legal issues relating to Computational Chemistry will be held on September 23, 1999. Featured speakers will include IP counsel and scientists of SmithKline Beecham currently working in this area.

Community Service

Committee e-mail - community@bpla.org

David J. Powsner - (617) 248-5000

Computer Law

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*Edward W. Porter - (617) 494-1722

Lee Carl Bromberg - (617) 443-9292

Copyright Law

Committee e-mail - copyright@bpla.org

*Charles ("Buzg") Gagnebin - (617) 542-2290

Thomas M. Saunders - (617) 227-0700

This Spring saw two noteworthy events in the Copyright area put on by the BPLA. The first was a BPLA Copyright luncheon organized by Walter F. Dawson at Anthony's Pier 4 restaurant that featured an accompanying address on the Digital Millennium Copyright Act of 1998 by the Library of Congress representative Jesse Feder, Esq. A group of close to fifty members and guests were treated to a well-polished presentation on the diverse facts of the new legislation and were given written summary materials. In May, the Committee members, together with members of the Boston Bar Association as their guests, listened to Richard Stallman, President of the Free Software Foundation (located in Boston), give a provocative discussion of why Linux is a better approach to an operating system because of the free updating and input from users worldwide.

Linux is not only free, but is now being shipped as the optional operating system by a number of desktop manufacturers. We look forward both to continued excitement in the Copyright area in the coming year and to the chance to present views of the movers and shakers in this area.

Corporate Practice

Committee e-mail - corporate@bpla.org

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Faith F. Driscoll - (978) 294-6165

International Practice

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*Timothy A. French - (617) 542-5070

Thomas A. Turano - (617) 248-7378

On June 17th, the International Law Committee hosted an educational seminar at the offices of Fish & Richardson. The speaker was Louis Maassel, formerly of the USPTO and now Consultant to the PCT Legal Division at WIPO. The seminar topic was the PCT-EASY software, available free of charge from WIPO, for creating the PCT Request for electronic transmission. Seventy attendees saw a demonstration of the new software package which, if used properly for submission of the Request and abstract with a new PCT application, results in a reduction of \$140 in the filing fee. Information relating to the PCT-EASY software, as well as the manual and software, can be accessed and downloaded at the WIPO website (www.wipo.int) or at the PCT-EASY webpage (<http://pcteasy.wipo.int>). UPDATE OF PCT PROCEDURES:

An informative and timely set of slides, also provided by Louis Maassel, is available on the International Law Committee webpage at the BPLA website (www.bpla.org). Included is an interesting analysis of the costs for pursuing an EP regional patent through PCT by the traditional route for a US applicant using the USPTO as Searching and Examination Authority versus the costs of using the EPO as Searching and Examination Authority. Surprisingly, at today's fees, the difference is only about \$130, since much of the greater initial expense for the EPO route is recoverable in credits when the EP regional application is filed.

EPO TO FURTHER REDUCE FEES:

It has been announced that effective July 1, 1999, the European Patent Office will reduce to seven the maximum number of designation fees required to be paid with an EP application. This means that 8+ countries can be designated at no additional cost. The available savings is likely to increase further in the Fall when it is expected that the present associate countries will be made full EPO members.

Licensing

Gregory B. Butler -
P.C. Lall - (401) 841-4736 (x24221)

Patent Law

Committee e-mail - patents @bpla.org
Leslie Meyer-Leon (617) 542-6000

The BPLA is seeking a co-chair for the patent law committee. This individual should be willing to lead the association's patent-law related activities including educating members and the public about patent law, and proposing positions for the BPLA to support or oppose legislative actions affecting the patent laws. This is one of the most important missions as an organization. Contact David Thibodeau, President-Elect at (781) 861-6240 or Leslie Meyer-Leon, if you are interested in serving in this capacity.

Patent Office Practice

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Grant Houston - (781) 861-6240
David Conlin - (617) 523-3400

Litigation

Committee e-mail - litigation@bpla.org
*Susan Glowsky - (781) 861-6240
Steven M. Bauer - (617) 248-7594

Law Students

Committee e-mail - students@bpla.org
Committee Co-Chairpersons:
Thomas M. Johnston - (781) 769-9450
Co-Chair Open - please contact David Thibodeau if you are interested in serving.

Trade Secrets

Committee e-mail - tradesecrets @bpla.org
* Stephen Y. Chow 617) 854-4000
Richard M. Gelb (617) 345-0010

On May 26, the Trade Secrets Committee presented a half-day seminar on developments in trade secret law. The seminar panelists included: 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 topics included: an overview of trade secrets law (including the Uniform Act); practical considerations in 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

Committee e-mail - trademarks@bpla.org
*Michael A. Albert - (617) 832-1175
Donna M. Weinstein - (617) 542-5070

We will be scheduling a lunch on the Trademark Law Treaty implementation legislation (which takes effect on October 31, 1999) for sometime in September, but the details have not been worked out yet.

Young Lawyers

Committee e-mail - younglawyers@bpla.org
Aaron Bulwinkle - (617) 345-0010
Co-Chair Open - please contact David Thibodeau if you are interested in serving.

POSITIONS AVAILABLE

Subject to the availability of space, the BPLA publishes advertisements by its members (and their firms or employers) for availability of employment positions. The placement of an ad costs \$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: Tom Engellenner, Nutter, McClennen & Fish, LLP, One International Place Boston, MA 02110-2699

HAYES SOLOWAY seeks highly qualified Applicants with strong EE or Physics background and 3 or more years patent prosecution experience for its Manchester, New Hampshire office. Experienced laterals and patent agents also considered. The firm has its headquarters in Manchester, New Hampshire with an additional office in Tucson, Arizona. If you are interested in a challenging position in a thriving and diverse national and international practice, with an opportunity for involvement in all phases of IP law practice, please send your resume in confidence to Hayes Soloway, 175 Canal Street, Manchester, New Hampshire 03101 emailiplaw@hsgh.com

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**JULY 31, 1999
IS THE FINAL DEADLINE
FOR 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 present 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 now due for renewals.

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

UPCOMING 1999 EDUCATIONAL EVENTS

August 8 - Summer Outing

This year's summer outing will be held aboard the Spirit of Boston on Sunday, August 8, 1999 from 11:00AM to 2:30PM. Look for further details in the mail.

September 23, 1999 - Computational Chemistry Seminar

The seminar will include breakfast and presentations by a panel of scientists and practitioners who will discuss patent issues relating to computational chemistry.

October 15-16 - 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. The 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

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 or biotechnology experience. Contact Patricia Porter, Legal Hiring Manager at (617) 439-2351 or via email at pap@nutter.com.

DOWNES RACHLIN & MARTIN PLLC, Burlington, Vermont, a mid-size general practice firm seeks a patent attorney to join its rapidly growing intellectual property practice. Enjoy challenging work, while living in an area endowed with natural beauty, superb recreational opportunities and a strong sense of community. Seeking candidates with 2-5 years patent prosecution experience, preferably with EE, physics or computer science background. Other technical backgrounds and experience levels considered. Work will include an initial emphasis on patent prosecution, with immediate and long-term opportunities for client counseling, intellectual property transactional work, trademark prosecution and intellectual property litigation. Please send resume in confidence to: Hiring Coordinator, Downes, Rachlin & Martin PLLC, 199 Main Street, P.O. Box 190, Burlington, VT 05402

WEINGARTEN, SCHURGIN, 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

INVENSYS, a \$15 billion industrial controls and automation company is expanding its Corporate Intellectual Property Department at its North American Headquarters in Foxboro, MA. *Division IP Counsel (2 POSITIONS)* - Successful candidates will review new product developments for patent protection, product clearance and selection of new trademarks for one of the four major Invensys divisions. Work will include novelty searches, evaluation of third party patents, preparation of new patent applications and supervision of outside counsel and IP costs. Candidates should have a BS Engineering (electrical, computer, or physics), a JD degree with state bar admittance and be admitted to practice before the United States Patent and Trademark Office or the European Patent Office. Must have 4 plus years of patent prosecution experience, as well as experience in developing patent protection strategies.

Corporate Trademark Counsel -

Will provide trademark support and strategy for Invensys, including preparing trademark searches, research reports and trademark registration applications for operating companies. Will also renew and supervise use of existing trademarks, prepare and administer trademark licenses and supervise the use of outside counsel and associated costs. Candidates should have JD degree with state bar admission and significant experience in trademark prosecution and licensing.

Patent Assistant- The successful applicant will be responsible for conducting patent research and preparing specific documents under the general direction of the patent attorney staff. Will also supervise and update patent docketing system for all Invensys group companies, prepare royalty reports and documents for licensed software and patents, and corresponding intercompany billing. Will be responsible for the quality of patent support work performed, including work processes, methodologies and output. Candidates should have an associates degree or equivalent and a minimum of 4 years patent experience.

Please respond by mailing or faxing your resume and salary requirements to Invensys Intelligent Automation, Staffing Department, 33 Commercial St., C41-1E, Foxboro, MA 02035. Fax: (508)549-2488,

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 with in 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

The BPLA Newsletter is published four times a year by the Boston Patent Law Association. Articles appearing in the newsletter represent the views of the authors and do not necessarily carry the endorsement of the BPLA.

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