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Upcoming Events

November 9th
 November Monthly Meeting of the Biotech Case Law Club
 Biogen Idec Inc.
 8:15 AM - 9:30 AM

December 12th
 Annual Meeting of the BPLA
 InterContinental Boston
 11:00 AM - 2:00 PM

December 14th
 December Monthly Meeting of the Biotech Case Law Club
 Biogen Idec Inc.
 8:15 AM - 9:30 AM

President's Message

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

As this is my final message as President, I want to take this opportunity to thank all members, Committee Chairs, and the BPLA Board of Governors for their active and tireless efforts this past year. We have accomplished much. In addition to our recurring programs – including the Judges Dinner, numerous Amicus filings, the *Invented Here!* Competition, the BPLA Writing Competition, the TTAB comes to New England, the PCT Seminar, networking events, and the many other Committee-hosted programs – we kicked off several new initiatives.

As I mentioned during last year's Annual Meeting, I set out three initiatives for this year: creating relationships with colleagues and entrepreneurs in South America; working with the US District Court for the District of Massachusetts to present on topics relating to the AIA; and rallying support for a Boston-area PTO Satellite Office. Each of these initiatives required the time and talent of our dedicated membership.

We have made significant inroads to the Chilean entrepreneurial com-



President Neil Ferraro

munity and recently met with Governor Patrick and his Latin American Task Force along with Chilean Ambassador to the United States, Felipe Bulnes, and his foreign services corps. We presented the BPLA as a resource for the Chilean-based audience of entrepreneurs, businesses, start-ups, students, and universities as they conduct business in Massachusetts. We are also delighted to be a part of next year's Encuentros Conference to be held in Boston. Encuentros is the largest meeting of Chilean students, researchers,

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and entrepreneurs abroad, and we look forward to continuing to develop closer ties with Chile through this and other programs.

In October, Board members Erik Belt and Monica Grewal conducted a seminar at the Federal Court's Bench & Bar Conference. Erik and Monica spoke on a panel along with Judge Saris to an audience of lawyers and judges on the intricacies of the AIA.

While we were not successful in convincing the USPTO to select our region for a Satellite Office, the work by the BPLA Satellite Office Task Force truly exhibited the efforts and dedication of its members. We rallied universities, industry, and associations to submit letters and petitions, gathered over 250 signatures from our own membership, and submitted a 50-page presentation demonstrating our region's deep technical and intellectual property resources.

The BPLA is also exploring patent pro bono opportunities through a joint effort with the Volunteer Lawyers for the Arts (see "Pro Bono Corner" in this newsletter for more information.) The American Invents Act directs the USPTO to work with and support intellectual property law associations across the country to establish pro bono patent programs designed to assist financially under-resourced independent inventors and small businesses. We hope to work closely with the VLA in fostering a spirit of volunteerism for our members to give of

their talents in patent law in support of this USPTO initiative.

On August 15, 2012, the Patent Agents and Technical Specialists Committee held a panel discussion titled "Balancing Law School and Patent Law Careers." This free event was hosted by Choate, Hall & Stewart and included panelists who all have attended or are attending law school while working as a patent agent or technical specialist. The panelists were: Charles Lyon, JD, PhD, Partner, Choate; Daniel Young, JD, PhD, Patent Agent, Wolf Greenfield; and Jessica Colantonio, PhD, Patent Agent, Choate.

The Boston Patent Law Association's New Lawyers and Law Students Committee and the Boston subcommittee of the American Intellectual Property Law Association's New Lawyer Committee co-hosted an informal summer social on Thursday, August 23 at The Terrace at Avenue One at the Hyatt Regency in Boston. The event provided a great opportunity to wind down while catching up with old friends and making some new ones. The event was co-sponsored by the BPLA and Fish & Richardson. Thanks go to Committee Co-Chairs Reza Sadr and Mike Carbonello for organizing the evening's event.

The Computer Law Committee held a "Brownbag Lunch" on September 12 to discuss recent Federal Circuit decisions finding computer-related inventions to be eligible or ineligible subject matter under Section 101. The roundtable discussion included summaries of recent cases and fac-

tors that may have driven results in seemingly irreconcilable decisions. The group also discussed strategies for drafting new applications and for prosecuting existing applications, as well as ideas on the test(s) for patent eligibility that the CAFC may be developing. Co-Chairs Edmund J. Walsh, Wolf Greenfield, and Weber Hsiao, Pierce Atwood, organized the event.

On September 25, the Co-Chairs of the BPLA Biotechnology Committee, Leslie Meyer-Leon, IP Legal Strategies Group; Jen Siczekiewicz, Biogen Idec; Konstantin Linnik, Nutter McClennen & Fish; and Bo Han, WilmerHale, organized a lunchtime seminar titled "Creating and Living with a Foreign Filing Strategy." The event featured keynote addresses by Harvey Adams, Owner, Mathys and Squire, discussing updates on European IP and Exclusivity Laws, and Henry Gu, Counsel, WilmerHale, speaking on China IP and Exclusivity Laws. Panelists Harvey Adams; Henry Gu; Gabriel Kleiman, Assistant General Counsel, Pfizer Inc.; Christopher H. Chung, Associate Vice President, IP, Sanofi Pasteur; Joseph Kenny, Chief Patent Counsel, ImmunoGen, Inc.; Nicholas M. Boivin, Director, IP Counsel, Cubist Pharmaceuticals, Inc.; Lisa Geller, Senior Patent Counsel, Eleven Biotherapeutics; Dan Darnley, VP & Chief Intellectual Property Counsel, Millennium Pharmaceuticals; and Jen Siczekiewicz, Associate General Counsel, IP, Biogen Idec (Moderator) spoke on best practices and key considerations in

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creating a foreign filing strategy.

The Trade Secret Committee, co-chaired by Heidi Harvey, Fish & Richardson, and Russell Beck, Russell Beck LLP, and the International Practice Committee, co-chaired by Sarah Gates, Lando & Anastasi, and Elias Domingo, Covidien, hosted a luncheon seminar on International Trade Secret Protection on October 22. Panelists Jeffrey Hsu, Supervisory Attorney at the ITC, and David Reibel, General Counsel, Aspect Software, discussed ITC jurisdiction for trade secret matters and best practices for management of trade secret and confidential information in OUS operations. The event took place via videoconference with Mr. Hsu in Washington DC and Mr. Reibel in Boston.

We once again welcomed Carol Bidwell, PCT Consultant on PCT Matters for WIPO and former Supervisor of the USPTO's Office of PCT Legal Administration, and Matthias Reischle, Deputy Director, PCT Legal Division-Innovation and Technology Sector, for the annual 2-day PCT Seminar held on Thursday, November 1 and Friday, November 2, at the InterContinental Hotel. 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.

The BPLA's busy fall schedule culminates in this year's Annual Meeting to be held on December 12 at the InterContinental Hotel. Along with our traditional business including changing of the guard, bidding farewell to Immediate Past-President Grant Houston and passing the gavel to our new President, Joseph Maraia, we are delighted to host David Kappos, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, as our keynote speaker. We hope to see you there.

I want to take a moment for a special thanks to Dan Young, this year's Activities Chair. Not only was Dan instrumental in helping me plan, organize, and run a variety of events such as the Judges Dinner, the Red Sox Outing, the PCT Seminar, and the Annual Meeting, he aided Committee Chairs with their own event planning. Dan has also been a terrific advisor to me regarding the many on-going administrative activities and 2012 initiatives. Thank you Dan!

I also want to thank the members of my firm Wolf, Greenfield. I could not have even come close to running the BPLA and all its programming without my firm's support – I am deeply grateful.

Thank you all for allowing me the honor to serve as your President this past year. It has been a rewarding experience in innumerable ways, and I am especially grateful for having worked with many of you.

BPLA Annual Meeting for 2011

The Boston Patent Law Association's Annual Meeting for 2011 was held on December 9, 2011, at the Seaport Hotel in Boston.

Outgoing President Grant Houston called the meeting to order, welcomed the audience and guests, and recognized the past presidents. Board member Monica Grewal announced the winners of the writing competition: first place to Daniel Klein and second place to Briana Erickson. The winning entries can be found on the BPLA website. A moment of silence was then observed for BPLA members who had passed in the previous year. The late Bob O'Connell, a past president, was remembered fondly. Secretary Gregory Sieczkiewicz presented the Secretary's report, which was approved unanimously by voice vote.

Vice President Joseph Maraia, standing in for Treasurer Donna Meuth, presented the Treasurer's Report, which also was approved unanimously by voice vote. Mr. Houston then spoke on the BPLA's mission and accomplishments during the past year, noting that patent reform will present new challenges for the membership over the coming years. Past President Lisa Adams, Chair of the Nominating Committee, then presented the slate of Officers and Board Members for 2012. The nominees were Neil Ferraro, President

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The SHIELD Act Takes Aim at Non-Practicing Entities

Proposed legislation aims to combat strategic litigation by non-practicing entities

By Matthew B. Pinckney, Hoffman Warnick, LLC

A new round of intellectual property (IP) legislation aimed at helping corporations ward off patent infringement lawsuits was introduced in Congress this past month. Titled the "Saving High-Tech Innovators from Egregious Legal Disputes Act of 2012" (SHIELD) Act, its goal is to protect software and computer hardware innovators from the tactics of non-practicing entities, also referred to by some as "patent trolls." The provisions of the SHIELD Act are intended to dramatically change patent litigation practices in the United States for companies and individuals involved in intellectual property development and enforcement. At the heart of the SHIELD Act is a provision which would require patent owners who lose an infringement dispute to pay the legal fees of the defendant.

Non-practicing entities are companies, collectives, and individuals whom acquire any number of broad patents, and then rather than using or practicing the patented technology, seek merely to enforce these patents on other companies in an attempt to generate revenue. Corporate counsel and inventors claim that these non-practicing entities drain and strain their budgets by asserting minimally supported infringement claims based on these patents in an effort to leverage a quick settlement and thus generate income. The length

of litigation proceedings, risk of an unfavorable judgment, and expense of patent litigation serve as a tacit threat to technology companies, who often choose to settle for a comparatively small financial payment to the non-practicing entity rather than seek vindication through litigation. These non-practicing entities have become a serious concern in intellectual property portfolio development for innovators and corporate counsel working on the cutting edge of technology, forcing investors and inventors to be ever cognizant of a lurking non-practicing entity and subsequent litigation or settlement.

Under the SHIELD Act, at the conclusion of an action disputing the validity or alleging the infringement of a computer hardware or software patent, the court would make a determination as to whether or not the party who brought the action had a reasonable likelihood of success at the outset of the action. If the court determines that the party who brought the action did not have a reasonable likelihood of success, in essence determining that the suit was frivolous, then the defendant may recoup their full costs, including reasonable attorney's fees from the party who brought the action.

Proponents of the SHIELD Act laud its departure from traditional US judicial litigation standards (where each party in a dispute bears the cost of litigation). These proponents claim

that by requiring patent owners to pay defendants' legal costs when an infringement suit is unsuccessful, the SHIELD Act will significantly deter strategic litigation. Through this distribution of legal fee liability to patent owners whom bring unsuccessful claims, the SHIELD Act indirectly targets non-practicing entities, forcing them to consider the merits and probability of a successful outcome in litigation before beginning proceedings.

Critics of the SHIELD Act warn that the legislation will still lead to a great deal of frivolous litigation and settlements, as both parties in a dispute are required to pay their own legal fees until the action has been decided -- a process which may take years -- and cost millions. These upfront costs of litigation and the prolonged process driving technology companies to settle, rather than take the risk of incurring significant legal bills in the hopes they will prevail in the action. Thus, in large part for budgetary reasons, critics claim that technology companies will still be forced to settle disputes prior to the conclusion of infringement proceedings, and will also be more reticent to assert their own patent rights against infringers. However, the SHIELD Act would provide defendants with additional leverage in settlement negotiations, providing financial incentive for non-practicing entities to discontinue frivolous actions for fear of being burdened with double the litigation expense.

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Invented Here! Program 2012

By BPLA Invented Here! Committee Chairs Mark Solomon, Esq., Hamilton, Brook Smith & Reynolds, P.C.; Rory Pheiffer, Esq., Nutter McClennen & Fish LLP; and Aaron Connor, Esq., BTS

The Boston Patent Law Association (“BPLA”) and Museum of Science (“Museum”) once again collaborated on the *Invented Here!* program to honor inventors from the New England region for their achievements. Three inventors with patented technology and one inventor with patent-pending technology were recognized by an audience of hundreds at an event held Thursday, September 20, 2012 at the Museum. The event began with cocktails and light dinner, followed by the program. Robin Young of WBUR emceed a “Conversation with the Inventors” and asked the Top Three Honorees questions about their “aha” moment and journey that led them to their patented invention.

At the event, the BPLA Invented Here! Committee Chairs, Mark Solomon, Rory Pheiffer, and Aaron Connor, thanked the Museum for another year of a terrific partnership and described the process the BPLA used in its selecting noted honorees (from among dozens of nominees), from which the Museum’s Selection Committee selected the Top Three Honorees. The BPLA Committee Chairs also made a special announcement that September 20, 2012 was proclaimed “Massachusetts Inventors Day” by Governor Deval Patrick. Special thanks to Jesse Erlich, BPLA Past President, for working through political channels to bring a Proclamation, which was drafted by Jesse, Mark Solomon,



Aaron Connor; Mark Solomon; Jesse Erlich; Rory Pheiffer with the Proclamation



Aaron Connor and Rory Pheiffer

Photos © Pat Piasecki 2012



Ioannis Miaoulis, Daniel Wyner (Top Fan Favorite), Robin Young

Invented Here!
September 20, 2012
Museum of Science



Ioannis Miaoulis; Hugh Herr; Bien Chann; Robert Rabiner (Top Three Honorees); Robin Young

Top Three Honorees

- “External cavity one dimensional (1-D) wavelength-beam-combining (WBC) of 2-D diode” - Bien Chann
- “Active Ankle Foot Orthosis” - Hugh Herr et al.
- “Systems and Methods for Internal Bone Fixation” – Robert A. Rabiner

The Fan Favorite Published Patent Application is

- “Flexible Cushion Pads” (US20 12/0084896) - Daniel Wyner et al.

and Deirdre Sanders, to the attention of Governor Patrick, who signed the Proclamation.

This year's program also included a Fan Favorites category for pending patent applications for which the public voted on-line to select a Top Fan Favorite.

Special thanks to the BPLA Selection Committee members:

- **Reza Sadr**, Co-Chair – Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
- **Michael Carbonello**, Co-Chair – Houston & Associates, LLP
- **Chris Albert** – Hamilton Brook Smith & Reynolds, PC
- **Joshua Brandt** –Partners HealthCare Research Ventures & Licensing
- **Roy Isaac** – Elmore Patent Law Group, PC
- **Rebecca Menapace** – Partners HealthCare Research Ventures & Licensing
- **Andrea Daley Merin** – Wolf, Greenfield & Sacks, P.C.

- **Seth Milman** – Daly, Crowley, Mofford & Durkee, LLP
- **Kahlil Mitchell** – GTC Law Group
- **Matthew Pinckney** – Hoffman Warnick, LLC
- **Brian Reese** - Choate, Hall & Stewart LLP
- **John Rooney** – Franklin Pierce University
- **Robert Sahr** – Choate, Hall & Stewart LLP
- **Andrew Schultz** – Nutter McClennen & Fish LLP
- **Janet Smart** – Proteostasis Therapeutics, Inc.
- **Andrina Zink** – Alkermes, Inc.

The enthusiasm brought again to the *Invented Here!* program is a credit to the BPLA membership and the team of dedicated program leaders at the Museum. The Chairs of the BPLA *Invented Here!* Committee thank all BPLA members who submitted nominations or participated in the program in other invaluable ways.

We look forward to next year's program!

The SHIELD Act

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Both critics and proponents of the SHIELD Act agree that non-practicing entities are a legitimate concern for innovators and technology companies large and small, draining budgets and resources, and hindering product development and technological advancement. This legislation at the very least is an indication that some members of Congress have

acknowledged the issue and are attempting to provide a financial shield to innovators in the form of a looming fine directed at non-practicing entities. While the success and impact of the SHIELD Act is yet to be seen, overall, the SHIELD Act could limit patent litigation and allow innovators and corporations to restructure their budgets, redistributing man hours and funds from litigation to innovation.

BPLA 2011 Annual Report

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(automatic elevation); Joseph Maralia, President-Elect; Donna Meuth, Vice President; Gregory Sieczkiewicz, Treasurer; Erik Belt, Secretary; Monica Grewal, Patrick Quinlan, and Rory Pheiffer, Board Members. Upon voice vote, the slate was unanimously approved, and the nominees were installed. Mr. Houston then turned the meeting over to incoming President Ferraro. Mr. Ferraro presented Mr. Houston with a gift and thanked him for his service and leadership. Mr. Ferraro then outlined his platform for the coming year, including initiatives to further bench/bar relations and to lobby for a USPTO satellite office in Boston.

Mr. Houston then introduced the keynote speaker, The Honorable Paul R. Michel (ret.), former Chief Judge of the United States Court of Appeals for the Federal Circuit. Judge Michel spoke about the American Invents Act and the positive and negative effects it may have on the patent system. To Judge Michel, the patent system is the single best engine for a stable economy and positive welfare of the country. He thus encouraged the BPLA and its members to help improve the patent system by submitting amicus briefs to help guide the courts on important patent law issues and to lobby Congress on important issues. Mr. Ferraro then adjourned the meeting.

Membership Renewal

This is a reminder that renewal fees for the 2013 BPLA membership will soon be due. To avoid a lapse in membership, membership should be renewed between December 1, 2012 and February 1, 2013.

Renewal fees remain at the 2012 rates of:

- Attorney Member \$115
- Non-Attorney Member \$105

Members wishing to renew their membership for 2013 can do so on-line beginning December 1, 2012, at www.bpla.org and following the link under "Current Members" on the homepage. The on-line payment option allows for credit card payment. Once your payment is received, your membership status will be automatically updated for the membership year. You will also receive a statement itemizing your transaction. It is also possible to pay by mail. A renewal form can be printed from the website. Please mail the completed form along with a check made payable to the Boston Patent Law Association to the following address:

BPLA Treasurer

One Batterymarch Park
Suite101
Quincy, MA 02169 - 7454

Firms and companies also have the ability to renew members in bulk. For bulk renewals, please send an email to treasurer@bpla.org.

If you have any questions regarding renewals, please contact treasurer@bpla.org for assistance.

Nominating Committee Recommendations

The Nominating Committee of Grant Houston, Lisa Adams and Mark Solomon recommends the following members to serve as the Officers and Board of Governors of the Boston Patent Law Association for the upcoming year:

President-Elect:	Donna Meuth
Vice President:	Greg Sieczkiewicz
Treasurer:	Erik Belt
Secretary:	Monica Grewal
Board Member:	Neil Ferraro (Immediate Past President)
Board Member:	Rory Pheiffer
Board Member:	Deirdre Sanders
Board Member:	Michael Bergman

As President-Elect, Joseph Maraia will take the office of President at the Annual Meeting. The vote will take place at the Annual Meeting on December 12, 2012.

MEMBERS ON THE MOVE

Richard E. Gamache is now a Partner at Chapin Intellectual Property Law, LLC, in Southborough, MA

Lin J. Hymel recently joined McLane, Graf, Raulerson & Middleton, PA as Of Counsel.

Scott E Kamholz has moved to VA and joined the USPTO in Alexandria, VA, as an Administrative Patent Judge.

Dan Holmänder is now a Partner at Barlow, Josephs & Holmes Ltd., in Providence, RI.

BPLA Pro Bono Corner

By Chelsea Loughran, Esq., BPLA ProBono Co-Chair, WolfGreenfield

The America Invents Act directs the USPTO to work with intellectual property law associations across the country to establish *pro bono* patent programs for financially under-resourced inventors and small businesses. This directive is aimed not only at providing legal counseling to inventors who would otherwise navigate the application process *pro se*, but to assist the USPTO itself in reducing the *pro se* application pool and increasing the quality and merit of patent applications on the whole. In response to this directive, the Pro Bono Committee of the Boston Patent Law Association is looking to develop a patent *pro bono* program to work with low-income clients in the Greater Boston area. This issue of the Pro Bono Corner highlights the current proposal for establishing that program. The Pro Bono Committee will soon be circulating a brief survey to BPLA members to assess our members' support for this type of initiative and, separately, our members' interest in participating in the program either financially or through provision of volunteer services.

Our current vision for the development of a patent *pro bono* program focuses upon a collaboration between the BPLA and the Volunteers Lawyers for the Arts of Massachusetts (VLA), a program of the Arts & Business Council of Greater Boston. The VLA is an established organization that assists artists and cultural

organizations in need of legal services in a variety of arts-related matters by connecting qualified clients with members of a panel of over 400 volunteer attorneys. The existing program and operational model of VLA provides a strong foundation for this new patent *pro bono* project and will help the BPLA establish a sustainable patent *pro bono* program in Boston.

***Pro Bono Committee
looking to develop a patent
pro bono program in the
Greater Boston area***

The VLA already receives a small number of requests for patent application assistance and refers these out to local patent practitioners. Our proposal, therefore, seeks to build upon this existing model, utilizing the USPTO's guidance, referral coordination program and training and certification requirements, in conjunction with financial and volunteer resources provided by the BPLA membership.

This joint program between the VLA and BPLA would connect member attorneys to under-resourced inventors and entrepreneurs in need of patent legal support. The VLA would be responsible for client intake, *pro bono* qualification determination and oversight of client training and certification. Because of the specific technical aspects of the case assessment process we are proposing formation of a small committee, including BPLA patent attorneys, to handle the initial

evaluation of the merits of each incoming case. Once an individual has been qualified and his or her case has been vetted, the VLA could seek and obtain a volunteer attorney from a panel that would include interested BPLA members willing to donate their time to advise the client within a defined scope of representation (determined on a case by case basis). The hope is that local law schools would also encourage interested students to work on cases under the guidance and mentorship of local patent attorneys. Northeastern University School of Law has already voiced an interest in participation in such a program.

Ultimately, the goal of this program is to increase the infrastructure, resources and available volunteer panel for patent *pro bono* services in the Boston area. Provision of such services would not only support the large and dynamic population of innovators and entrepreneurs in the community who would otherwise navigate the USPTO alone, but would support the USPTO in its efforts to reduce the *pro se* pool and serve as a valuable educational opportunity for young patent attorneys and law students.

Please keep an eye out for our survey, and assist the Pro Bono Committee by letting us have your thoughts. Additional information regarding the USPTO *pro bono* initiative may be found on the USPTO Website at <http://www.uspto.gov/news/pr/2012/12-66.jsp>.

Balancing Law School and Patent Law Careers

By Cristin D. Berkey and Natalie Grace, Choate, Hall & Stewart LLP

On August 15, 2012, the Patent Agent and Technical Specialist Committee sponsored an event on Balancing Law School and Patent Law Careers. The event featured a discussion, including panelists Charles Lyon, Partner at Choate, Hall & Stewart LLP, Dan Young, Patent Agent at Wolf, Greenfield & Sacks, P.C., and Jessica Colantonio, Patent Agent at Choate, Hall & Stewart LLP. This event was specifically geared towards technology specialists/patent agents to address the process of applying to and attending law school while working in the patent field. The main topics of discussion were the basics of getting into law school, how to succeed in law school with very limited time due to work, how to maintain a presence at work despite being in school, and how to achieve work-school-life-balance.

The panel discussion was attended by approximately 30 patent agents/technical specialists. Most attendees were working at firms with law school programs and were either beginning to contemplate law school or in the process of applying. The panelists did a fantastic job addressing the main topics and answering the numerous questions from the audience. This event provided a great deal of information to technology specialists /patent agents about law school that was unique to their situation.

The Patent Agent and Technical Specialist Committee is a new committee that aims to address the unique needs of an important subset of the Boston Patent Law Association mem-

bership. Committee members range from technical specialists entering the field of patent law to career patent agents.

BPLA ANNUAL MEETING

Wednesday, December 12, 2012

InterContinental Hotel Boston

The Keynote Speaker is:

David J. Kappos, *Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office*

Registration and Cocktail Reception begins at 11:00 a.m.

Program and Lunch begin at Noon.

Members \$125

Non-members \$150

Interested in sponsoring this event?

Contact activities@bpla.org for details

Sponsorship includes advertisement in meeting announcements and publications, and table of 10 for \$1750

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With approximately 20 years in providing accounting, auditing, tax, and consulting services, we attribute our long-term success to understanding our clients' needs and providing high-quality, timely service. If you would like to discuss how we can assist your business please contact David M. Walsh, CPA for a free consultation.

Job Opportunities

FISH & RICHARDSON P.C.

Boston, MA

Patent Litigation Associate

Fish & Richardson P.C. is a leading global law firm practicing in the areas of intellectual property, litigation and technology law. We are seeking a patent litigation associate with two to four years of experience to join our Boston office. A technical background is preferred. Excellent writing and academic credentials required. For additional information on Fish & Richardson P.C., please visit us at www.fr.com.

To apply, please submit cover letter, resume, transcripts and writing sample to Recruiting@fr.com.

DOWNS RACHLIN MARTIN PLLC

Burlington, Vermont

Patent Attorney

DOWNS RACHLIN MARTIN PLLC, Vermont's largest law 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. We are seeking candidates with EE, ME, CE, physics, chemistry or computer science background and 2-4 years relevant experience. 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, and intellectual property litigation. Please send resume in confidence to: Hiring Coordinator, Downs Rachlin Martin PLLC, P.O. Box 190, Burlington, VT 05402-0190 or online to iweisburgh@drm.com.



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LANDO & ANASTASI, LLP

Cambridge, MA

Litigation Associate

Lando & Anastasi, LLP is a Cambridge, MA based intellectual property law firm seeking a litigation associate with 2 to 5 years of experience to join our busy litigation team. This is an exciting opportunity for a bright and dedicated individual to work directly with our senior litigators and broad range of high-tech clients, and to gain hands-on experience and training in all aspects of IP litigation.

Candidates should have outstanding academic credentials, and preferably a technical degree. Candidates must be creative, detail-oriented, have excellent writing, communication and organizational skills, and enjoy working both independently and as a member of a team.

The firm has received national recognition for its practice, aggressive approach to serving clients' needs, and for its firm culture. Our work environment includes an emphasis on life balance, which is reflected in L&A's 1600 hour billable minimum – well below that of other firms – coupled with a generous bonus program for hours billed in excess of the target.

L&A is an equal opportunity employer, and we offer a competitive salary and benefits package. Interested candidates are encouraged to explore our website at: www.LALAW.com

Resumes and further inquiries should be directed to: Hiring@LALAW.com

DUANE MORRIS LLP

Boston, MA

Patent Attorney and/or Patent Agent

Duane Morris LLP has an opening for a patent attorney and/or patent agent with pharmaceutical/biopharmaceutical experience to join the Hatch-Waxman and Biosimilars practice in its growing Boston office. Candidates should have familiarity in patent estate and lifecycle management strategies in protecting FDA-approved drug products for both pre-litigation analysis and active litigation. Our ideal candidate will have 1-5 years' patent-related experience and hold a Ph.D. or equivalent in a relevant life science discipline, be well-versed in pharmaceutical patent analysis and possess litigation skills, and who will thrive in our creative, entrepreneurial and collegial environment. Admission

to the Massachusetts Bar or USPTO preferred.

Interested applicants please contact Vincent L. Capuano, Ph.D. at vcapuano@duanemorris.com.

COVIDIEN

Mansfield, MA

IP Docketing Clerk (Legal Assistant, Intellectual Property)

MEDICAL SUPPLIES/VASCULAR THERAPIES

This position will provide docketing services to Intellectual Property Attorneys and Sr. Paralegals

RESPONSIBILITIES INCLUDE:

- Docket all IP deadlines into CPI database
- Open new records (Invention Disclosures) in CPI system, along with new US and/or foreign filings, make new files, and send Office Actions and correspondence to Outside Counsel.
- Electronically maintain and manage IP documents and correspondences
- Generate regular docket reports for and participate in docket meetings with Attorneys and Sr. Paralegals
- Generate reports using CPI; prepare reports in Word, Excel, and Access
- Create and maintain general IP correspondence (i.e. letters, memos, charts, reports, graphs, etc.)
- Provide general administrative support to attorneys and paralegals

BACKGROUND PREFERRED:

- 3 yrs. Docketing Experience providing support to Management Level or in a legal office

- Knowledge of patent docketing system (preferably CPI)
- At least one year experience with USPTO-EFS-WEB
- Detail oriented
- Ability to be a team player and take initiative
- Proficient in Microsoft Office, including Outlook, Word, Excel and Access
- Ability to coordinate/manage multiple attorneys
- Ability to effectively communicate with people at all levels of the organization
- Experience with using any of the following IP service providers and acquiring patents and patent file histories from: US Patent & Trademark Office, EPO, WIPO, Delphion, Patent Fetcher, Lexis, etc.

EDUCATION REQUIRED:

- High School diploma
- Advanced Training in IP or Paralegal Studies

Interested applicants please contact Arielle DeLorie at 508-452-4519

PATENTBAR INTERNATIONAL P.C.

Patent Prosecution Agent/Attorney

Our small IP firm in Newton has an immediate opening for a patent associate -- a patent agent or a patent attorney with at least 3 years of hands-on patent prosecution experience. A degree in science or engineering is required. Experience in industry or academia is a plus. We offer a collegial work environment of a small firm. Working from home a day or two per week would be fine. Compensation will be commensurate with experience and skills. Please email your resume and cover letter to maria@patentbar.com. Principals only, no recruiters. Interested applications may also contact Maria Eliseev at 617-332-5800.



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What Every General Counsel Needs to Know About the America Invents Act

By Michael G. Biro, Lathrop & Gage LLP, Brian C. Trinqué, Lathrop & Gage LLP, and Aaron L. Schwartz, Eisai Inc.

On Sept. 16, 2011, President Obama signed into law the Leahy-Smith America Invents Act (the AIA), P.L. 112-29, which makes the most significant changes to our existing patent laws (Title 35 of the United States Code) since the 1952 Patent Act. The most publicized amendment concerns the change from a “first to invent” patent system to a “first inventor to file” patent system, along with accompanying changes to Section 102, which requires that an invention be new (novel).

The AIA also makes a number of additional changes to our patent laws, which will affect the way companies think about their patent strategy. This article will address some of the provisions that will come into effect on March 16, 2013, as well as some that came into effect on September 16, 2012.

“First Inventor to File” Patent System (Section 3 of the AIA)

Novelty

Section 102 of Title 35 of the United States Code describes the “novelty provisions” of the US patent laws, which require that any patented invention be new (novel). One of the most significant changes under the AIA is the amendment to Section 102 that will change the United States patent system from a “first to invent”

system to a “first inventor to file” system. Traditionally, the United States has been one of the few countries to concern itself with the date that an invention was invented, and not the date the invention was described in a patent application and filed with the United States Patent & Trademark Office (USPTO). As a result, when an invention was rejected in view of a third party’s earlier disclosure of that same invention, inventors could rely on the date of their invention (e.g., signed and dated pages from a lab notebook) — distinguished from the date of their patent application filing — in order to demonstrate that their invention was invented prior to the third party’s disclosure. A successful showing of prior invention by “swearing behind” the third-party disclosure resulted in a US patent protecting that invention.

Under the new law, however, the first person to invent subject matter may not always be entitled to a patent. This is because the new law rewards the first inventor to file a patent application, as opposed to making an invention. In making this change, Congress was clearly not interested in preserving our “first to invent” uniqueness. Section 3 of the AIA explains that converting the US patent system to a “first inventor to file” system will “promote harmonization of the United States patent system with the patent

systems in the rest of the world.”

In general, the changes to the novelty provisions will also expand the field of “prior art” (printed publications, verbal presentations and other events) that could be used to demonstrate a lack of novelty, which may make it more difficult to obtain a patent. As such, companies should be aware of the following issues:

- Prior to the AIA, an inventor’s own prior art (e.g., a publication in a scientific journal) may not have deleteriously affected the inventor’s efforts to obtain a patent on an invention compared to the prior art of a third party. With certain exceptions (see below), the AIA does not make a distinction between prior art of the inventor and that of third parties.
- The AIA removes the territorial limits of the current law such that it does not make a distinction between US and foreign prior art publications or events.
- The AIA has eliminated the Hilmer Doctrine. As a result, US patents and applications with foreign priority claims will be citable as prior art as of their foreign priority dates.
- The AIA retains a one-year grace period for disclosures made by or on behalf of the inventor that occur

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one year or less before the effective filing date of the patent application. This one-year grace period could be a trap for the unwary, though, if a company plans to file internationally, as many countries have an absolute novelty standard and do not have a one-year grace period.

Overall, these changes to our novelty provisions should cause companies to seriously consider filing a patent application earlier in the research and development phase than they may have under the current law, especially in situations where they are creating innovations in a crowded field (i.e., technological areas where many people and/or companies are creating innovations).

Non-obviousness

Section 103 of Title 35 of the United States Code currently states that a novel invention may still not be patentable “if the differences between the [invention] sought to be patented and the prior art are such that the [invention] as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.” Stated alternatively, if an invention’s novelty is achieved by simply modifying a prior invention in a way that could be deemed “obvious” to the skilled artisan, then a patent will not be awarded. The obviousness provisions of Section 103 will change under the AIA in order to conform to the novelty provisions of Section 102. This means that, under the new law, obviousness will also be

determined as of the effective filing date of the patent application, rather than at the time the invention was made. This change will also expand the field of prior art and may make it more difficult to obtain a patent.

Changes to take effect on March 16, 2013

The changes regarding first inventor to file, novelty, and non-obviousness will take effect on March 16, 2013, and will apply to all applications and patents issued thereon, that contain or contained at any time an invention specified (claimed) in a patent application filed on or after this date. (Note, however, that the introduction of a new invention into a patent application filed prior to the March 16, 2013 date could act as a “one way ticket” that irrevocably brings the application, and all applications claiming priority to it, under the provisions of the AIA.) Companies should determine how these new laws will affect their patent applications and develop patent filing and prosecution strategies that maximize the value of their intellectual property.

Post-Issuance Mechanisms For Challenging Issued Patents (Section 6 Of The Aia)

The AIA also adds three new mechanisms for challenging issued patents within the USPTO (Post-Grant Review, Inter Partes Review, and Citation of Prior Art and Written Statements), while deleting two current mechanisms (optional inter partes re-examination and citation of prior art).

Post-grant review

Chapter 32, Post-Grant Review (Sections 321-329), has been added to Title 35 of the United States Code. Under the new law, a person who is not the owner of a patent may file a petition with the USPTO to institute a post-grant review of a patent. This review may be based upon almost any requirement of patentability, including Section 112, which requires that an invention be adequately described, and enable one of skill in the art to make and use the invention. A petition for post-grant review may only be filed within nine months of the issuance of a patent. In addition, the petition must identify the grounds upon which the challenge to the patent is based, and the evidence that supports the grounds for challenge. Post-grant review is barred if the petitioner filed a civil action challenging the validity of a claim of the patent.

The end result of a post-grant review could be settlement, cancellation of a claim or amendment of the patent. A noteworthy disadvantage of post-grant review is the estoppel provisions, which state that after a final written decision, the petitioner may not assert in a proceeding before the USPTO, International Trade Commission (ITC), or in a civil action, any argument that the petitioner raised or reasonably could have raised during post-grant review.

Inter partes review

After the nine-month window for post-grant review has closed, a person who is not the owner of a patent may file, under the new law (Chapter

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31; Sections 311-319), a petition with the USPTO to institute an inter partes review of the patent. However, a petitioner's arguments are limited to issues under Section 102 (novelty) or Section 103 (obviousness), and only on the basis of prior art consisting of patents or printed publications. Like post-grant review, the petition must identify in writing each claim challenged, the grounds upon which the challenge to each claim is based and the evidence that supports the grounds for challenge to each claim. Inter partes review is barred if the petitioner filed a civil action challenging the validity of a claim of the patent.

The end result of inter partes review could be settlement, cancellation of a claim or amendment of the patent. As with post-grant review, a disadvantage of inter partes review is the estoppel provisions, which state that after a final written decision, the petitioner may not assert in a proceeding before the USPTO, ITC, or in a civil action, any arguments that could have been raised during inter partes review. These changes took effect on Sept. 16, 2012, and will apply to any patent issued before, on or after that date.

Citation of prior art and written statements

Section 301, Citation of Prior Art, of Chapter 30 of Title 35 of the United States Code has been replaced with

Section 301, Citation of Prior Art and Written Statements. The new law provides that any person at any time may cite to the USPTO, in writing, any patents or printed publications that are believed to have a bearing on the patentability of an invention described in a patent, and "statements of the patent owner filed in a proceeding before a Federal court or the Office in which the patent owner took a position on the scope of any claim of a particular patent."

Strategy

Companies should consider monitoring issued patents of third parties and/or competitors in their field in order to take advantage of post-grant review, which can only be instituted within nine months of patent issuance. Although inter partes review, and citation of prior art and written statements are not time barred, the scope of the challenge is limited to prior art patents and printed publications. The decision to use post-grant review or inter partes review should be carefully evaluated in light of the estoppel provisions. It is also important to note that Ex Parte Reexamination of Patents (Sections 302-309) of Title 35 of the United States Code remains unchanged by the AIA, and is still a viable alternative to challenge an issued patent.

Correcting Information In Issued Patents (Section 12 of The Aia)

The AIA has added a new procedure called Supplemental Examination to

Section 257 of Title 35 of the United States Code for correcting information in issued patents. Under the new law, a patent owner may request supplemental examination of its patent in the USPTO to consider, reconsider or correct information believed to be relevant to the patent. Reexamination of the patent will be ordered if the information in the request raises a substantial new question of patentability. Importantly, a patent will not be held unenforceable on the basis of conduct relating to information that was not considered, was inadequately considered or was incorrect in a prior examination of the patent if the information was considered, reconsidered or corrected during a supplemental examination of the patent.

This procedure is an opportunity to further strengthen an important patent prior to possible litigation, such as by clarifying the record to mitigate or avoid third-party allegations of inequitable conduct. In addition, requesting supplemental examination will not destroy the presumption of validity of the patent or be relevant to enforceability of the patent. These changes took effect on Sept. 16, 2012, and will apply to any patent issued before, on or after that date.

It is important to note that other means of correcting patents, such as reissue, disclaimer, certificates of correction and correction of inventorship, remain available and are unchanged by the AIA.

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