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### Dear BPLA Members:

For an association of patent attorneys and other IP professionals who represent clients on the cutting edge of technology, and for an association that should itself be in the vanguard of technological advances, the BPLA has been slow to adopt the latest content distribution technology. To wit, we still print our newsletters on paper. In an attempt to catch up with the rest of the 21st Century, and to do our share for the environment, the BPLA will distribute the newsletter electronically starting with the next issue. This issue is our last printed on paper. So save it. It may become a collector's item some day.

## President's Message

By Donna Meuth, Eisai Inc.

It has been a cold and snowy winter for New England and feels like spring will never come. The Annual Meeting in December seems like it was a long time ago. A little snow, however, will not stop the BPLA. We've had a busy and productive winter.

Thanks to everyone who attended the Annual Meeting. It was a great program, with Judge Smith's wonderful speech. In these changing times with implementation of the AIA now in full swing, it is helpful and interesting to hear the viewpoint of the USPTO and in particular the PTAB. Judge Smith's speech was very creative and entertaining, describing his journey to the North Pole for advice. It was a very enjoyable afternoon and great to have such a wonderful turnout. Thanks to Past President Joe Maraia for planning the day and also thanks to Joe for a wonderful and successful BPLA year.

I am very excited about the year ahead and look forward to working with the membership. It should be another very busy year. The



*President Donna Meuth*

Supreme Court has been extremely active in shaping our patent law over the past couple of years, and we will see if they continue that trend in 2014. Even after passage of the most significant patent reform legislation in over 50 years, Congress is still interested in additional patent legislation. We will experience changes in our practices as the effects of the America Invents Act continue to be seen, with cases filed after March 2013 progressing through prosecution and allowance, and IPRs and PGRs moving forward.

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# Boston Patent Law Association Minutes of The Annual Meeting

Intercontinental Boston • Wednesday, December 11, 2013

## I. Call to Order, Welcoming Remarks, Introductions, and Moment of Silence

### **President Maraia**

President Joseph Maraia called the meeting to order at approximately 12:25 PM. He then welcomed the audience and made a number of introductions. President Maraia introduced each of the individuals seated at the head table, which included the BPLA Officers and Board of Governors, and the keynote speaker, the Honorable James Donald Smith, Chief Administrative Patent Judge of the Patent Trial and Appeal Board (PTAB) at the United States Patent and Trademark Office (USPTO). The BPLA Officers and Board of Governors in attendance included President Maraia, President-Elect Donna Meuth, Vice President Gregory Siczekiewicz, Treasurer Erik Belt, Secretary Monica Grewal, Immediate Past President Neil Ferraro, and Board of Governors Members Rory Pheiffer, Deirdre Sanders, and Michael Bergman. President Maraia also introduced the past presidents of the BPLA in attendance, and recognized the new members of the BPLA in attendance. President Maraia then held a moment of silence for those impacted by the Boston Marathon bombings earlier in the year.

## II. Writing Competition Awards

### **Ms. Sanders**

President Maraia introduced Ms. Sanders, who served as chair of the BPLA Writing Competition Committee, a committee which also included Immediate Past President Ferraro and Mr. Bergman. Ms. Sanders announced the winners of the annual BPLA writing competition as follows:

- Rajarshi Banerjee was awarded 1<sup>st</sup> Place, and with it \$1,000, for his article entitled, *The Success of, and Response to, India's Law against Patent Layering*;
- Booyong S. Lim tied for 2<sup>nd</sup> Place, and was awarded \$500, for her article entitled, *The U.S. Court of Appeals for the Federal Circuit's Recent Expanded View of Liability for Induced Infringement under Section 271(b)*; and
- Elliott Williams tied for 2<sup>nd</sup> Place, and was awarded \$500, for his article entitled, *Equitable Discretion and the Patent Owner's Delay*.

## III. Secretary Report

### **Secretary Grewal**

Secretary Grewal requested motions to waive the reading of the minutes, which were both published in the Fall 2013 BPLA newsletter and distributed to the membership via



*Incoming President Donna Meuth congratulates outgoing President Maraia on a job well done*

e-mail, and to move the minutes into the record. Both motions were made, seconded, and passed unanimously.

## IV. Treasurer's Report

### **Treasurer Belt**

Treasurer Belt reported a net income for the fiscal year ending November 30, 2013. Treasurer Belt then requested a motion to enter the Treasurer's Report into the records. The motion was made, seconded, and passed unanimously. Treasurer Belt concluded by reminding members to renew their memberships and pay their dues.

## V. President's Report

### **President Maraia**

President Maraia presented his remarks on BPLA accomplishments and developments over the past year. He made mention of some of the events and seminars held over

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the past year, such as the Annual Judges Dinner and the Patent Cooperation Treaty Seminar, and also reported back to the membership on the three initiatives he set out during his incoming remarks at the BPLA Annual Meeting in 2012.

One initiative President Maraia focused on was implementing participation of the BPLA membership in the USPTO Pro Bono Initiative. President Maraia noted the hard work of Pro Bono Committee Chairs Chelsea Loughran and Rex Huang in these efforts, and thanked them for their continued contributions. The BPLA membership is now participating in the USPTO Pro Bono Initiative, as candidates for representation are currently being screened and interviewed by employees of the Volunteer Lawyers for the Arts (VLA) and members of the BPLA. Additionally, Ms. Loughran and Mr. Huang recently signed the American Invents Act Pro Bono Advisory Council Charter, becoming founding members of the Advisory Council. In that capacity, they will have an impact on the future of all regional pro bono programs, which are increasingly important to the inventor and small business communities. Further, the BPLA donated \$5000 toward the implementation of the Pro Bono Initiative by the BPLA and VLA.

Another initiative that President Maraia announced last year was the "Bring 'Em Back" campaign, which was an effort to replenish the num-



*The 2014 BPLA Board of Governors poses with Chief Judge Smith*

ber of BPLA members, as well as the participation of those members in BPLA events and seminars. Last year President Maraia noted a decline in BPLA membership over the course of two years. As a result of the campaign, in 2013 BPLA membership numbers rose from approximately 600 members to over 900 members. President Maraia thanked the BPLA membership for their help in "bringing 'em back."

A third initiative of President Maraia's was to host events and seminars directed to helping BPLA members effectively practice in light of the changes in the law resulting from enacting the America Invents Act. President Maraia noted that, in this regard, over 28 BPLA seminars and luncheons were held over the course of the past year. President Maraia thanked the committee chairs for their efforts in organizing these events and seminars.

President Maraia concluded his remarks by acknowledging, with

gratitude, the efforts of Activities and Public Relations Committee Chair Nikhil Patel, as well as Emily Marshall, Office Coordinator at President Maraia's law firm Pierce Atwood, for their efforts in helping him fulfill his presidential duties.

**VI. Report of Nomination Committee and Installation of New Officers and Board of Governors**  
***Immediate Past President Ferraro***

Immediate Past President Ferraro, who served as chair of the BPLA Nominating Committee, a committee which also included Past Presidents Grant Houston and Lisa Adams, presented the report of the Nominating Committee for its recommendation of 2014 BPLA Officers and Board of Governors Members. The following BPLA members were nominated:

1. Donna Meuth, President (automatic elevation)
2. Gregory Siczekiewicz, President-Elect

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**President's Message***Continues from Page 1*

As I stated at the Annual Meeting, as my initiative for the coming year, I'd like to focus on education. This would include education of our membership as well as collaborations with the law schools in the area. I'd like to build on the success we had last year with a number of great educational programs. Regarding member education, last year, we had 30 educational programs. Attendance has been high and the content diverse and focused on important current issues facing the bar. Our Committee Chairs have worked very hard to provide high quality programs of interest, and many firms and companies have been gracious in allowing BPLA to use their facilities and sponsoring programs to provide programs at a lower cost and thus a real advantage to our membership. With the help of my Activities Chair, Mike McGurk, I'd like

to continue with this emphasis on education for the coming year.

In addition, as part of my focus on education, I'd like to start an Ad Hoc committee directed to University Relations, and work with the great law schools that we are fortunate to have in our area. I'd like to partner with the law schools and work with them to provide additional educational opportunities for our members as well as for the law students. As we've all seen, it is a difficult time to be graduating from law school. Through a partnership between BPLA and the schools and their students, I hope that we can work together to provide opportunities for the students to enhance what they are learning in the IP classes and also provide benefits to our members in working with talented students. If anyone is interested in working on this committee, please contact me by email at [President@bpla.org](mailto:President@bpla.org).

As announced at the Annual Meeting, and as part of our collaboration with the local academic institutions, we will have an event early this spring, "Hot Topics In European and US Patent Law," that will be a great opportunity for our members. This program will compare, contrast and look at ways to harmonize European and US patent practice, focusing on post-grant proceedings, the unitary patent system, biosimilars and patent trolls. Rebecca McNeil from VIVICAR Law and Amelia Baur from Finnegan, are co-chairs for the program which is a joint effort of the BPLA and The Broad Institute in Cambridge, MA. They have put together a great program, which includes many experts from Europe as well as our members. This program will be held the afternoon of April 1<sup>st</sup> and registration is now open. Thanks to our generous sponsors, Edwards Wildman, Finnegan and Foley Hoag, this program is free to our members. I hope that you will be able to attend and look forward to seeing you there.

Announcement for  
***Invented Here! 2014***  
A Collaboration between the Museum of Science and the BPLA



**New!** Rolling Nomination Window between now and Monday, June 2, 2014

**Qualifications for Nomination**

- Inventions created in New England and one of the below:
  - Patents that issued within the last 5 years, or
  - Patents that received U.S. Regulatory Approval within the last 3 years, or
  - Published Patent Applications within the last 3 years (Fan Favorite)

2013 Invented Here! Honorees  
© Pat Piasecki



**For more information**  
Go to [www.bpla.org](http://www.bpla.org) > Meetings & Events > Invented Here!



Please also save the date for our Annual Dinner in Honor of the Federal Judiciary, on Friday, June 20, 2014. This year the dinner will take place aboard the ODYSSEY Harbor Cruise, sailing out of Boston Harbor. The ODYSSEY will be docked during a cocktail hour from 6:00 p.m. - 7:00 p.m., before departing on a cruise around the Boston waterfront from 7:00 pm - 10:00 p.m. We hope this will be an enjoyable event for everyone.

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**President's Message***Continues from Page 4*

Our Committee Chairs have been very busy with planning programs for this year. We have already held several events and many more are being planned. The Biotech IP Case Law Club continues to have its monthly meetings, with lively discussions of recent cases in the biotech field. President-Elect Greg Sieczkiewicz is working with Committee Chairs to launch a high tech case law monthly meeting for members practicing in that area; please watch for future announcements in this regard. In January, the Business and Marketplace Committee held its inaugural event, a program entitled "Trading Innovation: A Market Alternative to Bilateral Licensing, Litigation, and Legislative Reform." Unfortunately, the January weather interfered with a program that was being jointly hosted by the Corporate (In-House) Practice Committee and the International and Foreign Practice Committee, entitled "Efforts on International Harmonization of Patent Laws." This program has been rescheduled for April 30. Hopefully, by then the snow will be long gone and will not interfere with the program. The Patent Office Practice Committee scheduled a roundtable luncheon to discuss the recent *Notice of Proposed Rulemaking on Changes to Require Identification of Attributable Owner*, issued by the USPTO on January 24, 2014. The Notice contains proposals to require more disclosure of ownership information during the

application process and at certain times post-issuance, as well as proposals regarding what types of ownership information would need to be disclosed. The Committee will consider preparing formal comments for BPLA submission to the USPTO based on the member feedback gathered at this event. The *Amicus* Committee has also been busy, preparing and filing an amicus brief in *Highmark Inc. v. Allcare Management Systems*. Thank you to the Committee Chairs as well as to the members participating in these programs for your time and efforts.

In an effort to seek input for the members, we will be conducting

a brief survey regarding ideas for additional events. Please watch for this survey in the spring and we hope you will take the time to complete it and provide us with your feedback and ideas.

I am very much looking forward to working with all of you over the coming year. If you have additional ideas that you would like to see, please feel free to let me know by email to [President@bpla.org](mailto:President@bpla.org). I encourage everyone to become actively involved with the BPLA and invite you to reach out to me or any Officer, Board Member or Committee Chair with any comments or suggestions.

## Save the Date

### THE ANNUAL DINNER IN HONOR OF THE FEDERAL JUDICIARY

*Friday, June 20, 2014*

Aboard the ODYSSEY Harbor Cruise  
Boston, Massachusetts

The ODYSSEY will be docked during cocktail hour from 6:00 p.m. - 7:00 p.m.  
before departing on a cruise around the Boston waterfront.

Program and Dinner — 7:15 p.m.  
Docking — 10:00 p.m.

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3. Erik Belt, Vice President
4. Monica Grewal, Treasurer
5. Rory Pheiffer, Secretary
6. Deirdre Sanders, Board Member
7. Michael Bergman, Board Member
- 8 Daniel Young, Board Member

A motion was made and seconded to vote in and install the nominated Officers and Board of Governors members. The motion passed unanimously.

Outgoing President Maraia passed the BPLA presidential gavel to incoming President Meuth. Outgoing President Maraia will continue on the BPLA Board of Governors as Immediate Past President.

**VII. Keynote Speech – Remarks on the Patent Trial and Appeal Board**

***Honorable Chief Administrative Judge Smith***

Immediate Past President Maraia introduced the keynote speaker, the Honorable James Donald Smith, Chief Administrative Patent Judge of the PTAB at the USPTO.

Chief Judge Smith began by commending the outgoing Board of Governors, and wishing the incoming Board of Governors well in their duties over the course of 2014. Chief Judge Smith then presented to the BPLA membership five lessons he learned from Santa Claus and Mrs. Claus, whom he



***Chief Administrative Patent Judge Smith relates five lessons for running the PTAB that he learned from Santa Clause***

indicated he met and visited with in Lapland, Finland when he was employed by the Nokia Corporation (emphasis on the “ki”), which is headquartered in Finland. Chief Judge Smith said that the Clauses keep a summer home in Lapland, and that the reindeer reserve is also located there.

Chief Judge Smith’s first lesson learned from the Clauses is that “elf selection is job one.” Chief Judge Smith indicated that since October 2011, approximately 2000 applicants

have been reviewed for positions as administrative judges at the PTAB. This has resulted in approximately 350 applicant interviews and 112 new hires. The number of judges at the PTAB has nearly doubled, with there now being 185 administrative judges. It is Chief Judge Smith’s opinion that there is no one thing more important than selecting great judges, and that one of the criteria in doing so is making sure that each judge cares about the enterprise.

Chief Judge Smith’s second lesson learned from the Clauses is that “the North Pole is not the universe.” Chief Judge Smith intimated that it was advantageous to have more judges in more locations. There is now a second USPTO office in the Washington D.C. area, a permanent office in Detroit, and temporary offices in Denver, Dallas, and Menlo Park. Each of these offices has administrative patent judges. The Denver office currently has 10 judges, and the Dallas office is currently only being used for PTAB purposes. The Menlo Park office will eventually move to city hall in San Jose, while permanent

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***Davies & Monahan, P.C.***  
Certified Public Accountants

<p>Suzanne M. Monahan, CPA Kelly A. McLaughlin, CPA David M. Walsh, CPA</p>	<p>1 Batterymarch Park, Suite 101 Quincy, MA 02169 617-769-9600 <a href="http://www.daviesmonahan.com">www.daviesmonahan.com</a></p>
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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.

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sites for the Denver and Dallas offices are pending. Additionally, many proceedings are conducted having one or more judges in another city through the use of videoconferencing.

Chief Judge Smith's third lesson learned from the Clauses is that "classic toys have value, just as new toys." Chief Judge Smith noted that the PTAB has not forgotten *ex parte* matters despite having to work under particular time constraints in handling other matters (*e.g.*, *inter partes* reviews, supplemental examinations, and challenges under the transitional post-grant review for business method patents program). He indicated that it is the goal of the PTAB to issue decisions in *ex parte* matters within three years of their initial filing. Chief Judge Smith also noted that the backlog of cases is nearly 1800 cases lower than it was at its peak two years ago, and there has been a significant decline in the pendency of appeals, from about 24 months to about 18 months on average.

Chief Judge Smith's fourth lesson learned from the Clauses is that "an efficient elf enables more joy." Chief Judge Smith knows that parties at the PTAB want to make business decisions without uncertainty. As a result, the PTAB strives to be efficient as possible. One tool utilized to increase efficiency has been an increase in the number of

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# IP FORUM

## Faster, Smarter, and Leaner

### How Can You Achieve More With Less?

**When:** Thursday, March 27, 2014

**Where:** Westin Copley Place

*Innovative Technology. IP Thought Leaders. Collaborative Solutions.*

### Register Today

You are cordially invited to join CPA Global and intellectual property thought leaders at the Westin Copley Place to discuss your current IP management challenges and best practices in increasing efficiency, reducing risk, and lowering costs.

In the face of daily pressures on budgets and limited resources, the need for efficiency has never been greater. These challenges can impact your ability to build an effective IP management strategy and respond to higher value tasks while making agile decisions.

#### Peer-driven discussions will include:

- Reducing and containing IP department costs
- Data management and automation
- Achieving more with administrative IP Support Services
- The Paper Light Office Myth

#### Agenda at a Glance

12:00 to 1:00 pm – Registration, Lunch, & Welcome  
 1:00 to 2:00 pm – Guest Speakers: Aligning IP to the Business Objectives  
 2:15 to 3:00 pm – Break-Out Session: Law Firm and Corporate  
 3:15 to 4:00 pm – Collaborative Solution Development  
 4:00 to 4:30 pm – First To File™ Demo and Q&A  
 4:30 to 5:00 pm – Networking Reception

Join intellectual property thought leaders and CPA Global to learn how to gain a competitive advantage towards a leaner, more efficient IP strategy.

### Register Here

**Please contact Anna O'Leary with any questions:**  
 Email: AO'leary@cpaglobal.com / Phone: (571)-239-6819

## Scope of Estoppel in Inter-Partes Review

Harry K. Ahn, Partner  
Lisa D. Tyner, Special Counsel  
McCarter English, LLP

As a tool for a third party post-issuance patent challenge, *inter partes* review (IPR), which was introduced on September 16, 2012, as part of the America Invents Act (AIA), has gained widespread acceptance. From September 16, 2012, to December 31, 2013, 766 IPR petitions have been filed, which is an average of 47 petitions per month.<sup>1</sup> Moreover, the rate of filings continues to increase. Just in the month of January, 2014 alone, 57 IPR petitions were filed.

The popularity of IPRs as a tool to resolve patent validity disputes has stemmed, at least in part, from several advantages over district court litigation, including much lower cost and quicker resolution.



Harry K. Ahn

Lisa D. Tyner

For example, IPRs cost a fraction of patent litigation and, barring an exceptional case, are concluded within 18 months from filing the petition, compared with the 30

months median time to trial for district court litigation.

Another advantage of an IPR is that it provides a litigation-like procedure involving discovery (including witness depositions and document discovery related to conception and reduction to practice) and oral arguments in front of patent- and technology-savvy administrative patent judges (APJs), who deal exclusively with patent law, rather than lay juries or to generalist judges in a district court litigation. Moreover, during IPR, claims are potentially more broadly construed because the broadest reasonable interpretation standard is used, in which claims are given their ordinary meaning in light of the specification, as opposed to the traditional *Markman*-based claim construction utilized in district courts.<sup>2</sup> The broader construction can make it easier to invalidate the patent claims.

### IPRs and Petitioner Estoppel

Despite these distinct advantages, the estoppel provisions of IPR proceedings have raised some concern among potential third party challengers. In particular, the IPR estoppel provision prohibits an IPR petitioner from asserting any ground of invalidity the petitioner “raised or *reasonably could have raised*” during the IPR, in a subsequent civil action (or ITC proceeding).<sup>3</sup> Notably, IPR estoppel attaches only when the PTAB issues a final

written decision (which issues within 12-18 months from filing of the petition). This is a significant change as compared to the pre-AIA *inter partes* reexamination procedures, where estoppel attached only after all appeals were exhausted (three years on average). Thus, estoppel is in effect much more quickly for IPR than for *inter partes* reexamination.

### What Does “Reasonably Could Have Raised” Mean?

Because IPRs are relatively new, it is not entirely clear how the estoppel provision will be construed by the courts. The IPR’s “*reasonably could have raised*” provision is less strict than the “raised or could have raised” estoppel standard from the pre-AIA *inter partes* reexamination statute. Thus, it may be construed by a court to provide some leeway in introducing art that was discovered after the conclusion on an IPR. Indeed, the legislative history of the AIA supports the interpretation that the standard “reasonably could have raised” means that IPR petitioners are estopped from raising the prior art that a skilled searcher conducting a diligent search reasonably could have been expected to discover, as opposed to the “could have raised” estoppel, which has been interpreted to mean that petitioners are estopped from raising all prior art that would have been uncovered by a scorched-earth search around the world.

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### Scope of Estoppel in Inter-Partes Review

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During congressional debate on the Patent Reform Act of 2011, Senator Kyl commented on the modifier “reasonably,” stating that it “softens the could-have-raised estoppel that is applied by *inter partes* review against subsequent civil litigation” and “ensures that could-have-raised estoppel extends only to that prior art which a skilled searcher conducting a diligent search reasonably could have been expected to discover” as opposed to requiring “a scorched-earth search around the world.”<sup>4</sup> It is likely that the courts will adopt the interpretation as expressed by Senator Kyl, while weighing each parties’ arguments as to whether the art reasonably would have, or should have been, discovered in a diligent search. If so, it would seem reasonable to expect that an estoppel may not attach to prior art that was discovered, for

example, after the IPR proceeding in an obscure library of a foreign country.

### Refusal of the PTO to Institute an IPR Will Likely Not Give Rise to Formal Estoppel

The IPR estoppel provision states that estoppel will attach when a final written decision is made.<sup>5</sup> In an IPR petition, the petitioner sets forth the grounds for invalidating a patent. The PTAB reviews the petition and issues a decision as to whether each ground meets the threshold standard that there is “reasonable likelihood that petitioner would prevail.” If the standard is met, the IPR is instituted. However, the PTAB may move forward with only certain grounds of invalidity, while denying others for such reasons as the ground being cumulative or redundant, and failing to meet the threshold standard.

The question remains as to whether the petitioner would be estopped in subsequent litigation from raising grounds that were denied by the PTAB. Given that denied grounds cannot be raised during the proceeding<sup>6</sup>, nor will they be part of the final written decision, it seems likely that the denied grounds will not be estopped. Furthermore, the estoppel provision states that the grounds must have been raised. It is arguable that grounds that were denied should not be considered to have been “raised,” and thus no statutory estoppel attaches. While there is no definitive answer regarding estoppel pending a decision by the courts, it may be useful to file an IPR petition with

multiple grounds, rather than with only what the petitioner considers the best prior art. If prior art is available, and it is not included in the petition, estoppel will certainly apply.

### Availability of other defenses

When determining a strategy regarding whether or not to proceed with an IPR, the potential challenger should also consider the types of invalidity defenses that are available. If only patents and printed publications are available (no other types of prior art), an unsuccessful IPR could potentially leave no invalidity defense in litigation due to estoppel. However, if there are other defenses available, including other types of prior art (e.g., public prior use), lack of written description and/or enablement, or lack of patentable subject matter, estoppel based on prior art would not completely hinder successful litigation.

Clearly, the decision to file an IPR is complex and case-specific and it is uncertain how the courts will interpret the IPR estoppel provisions. Because they can potentially prevent the petitioner, real party in interest and the petitioner’s privies from bringing subsequent challenges, the risks to these parties should be carefully considered. However, given the overall benefits, IPR provides a compelling cost- and time-efficient option.

1 IPR filing data, available at [www.uspto.gov/aia\\_implementation/statistics.jsp](http://www.uspto.gov/aia_implementation/statistics.jsp)

2 The IPR claim construction standard may soon be changed by Congress. The Innovation Act of 2013 (HR 3309), which was passed by the House of Representatives on December 5, 2013, would eliminate the “broadest reasonable interpretation” standard for claim construction in IPR, and instead require the USPTO to follow district court claim-construction methodology.

3 35 U.S.C. §315(e)(2)

4 157 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl)

5 35 U.S.C. §315(e)(2)

6 “Denial of a ground is a Board decision not to institute inter partes review on that ground.” (37 C.F.R. §42.108(b))

## Why Patent Monetizers Are Coming to Biotech and Pharmaceuticals

By W. Nicholson Price II, Academic Fellow, Petrie-Flom Center for Health Law Policy, Biotechnology, and Bioethics at Harvard Law School

*Note: this article is a summary of a larger article co-authored with Robin Feldman at UC Hastings College of the Law. The original article may be found at [http://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=2395987](http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2395987).*

Patent monetizers, by whichever name you prefer—patent trolls, nonpracticing entities, patent assertion entities, or something else—are receiving a lot of attention in the legal and policy worlds. Monetizers are entities primarily in the business of making money

from patents without practicing the inventions covered in those patents; those entities that rely on low-quality patents and abusive litigation practices to do this are frequently referred to as patent trolls. On the subject of patent trolls, the past year has seen a White House statement, numerous proposed acts of Congress (and one bill that passed the house), state legislation, scholarly attention, and lots of coverage in the media. In all the activity, however, the life sciences are conspicuous by their absence. Even though patents are absolutely central to the biotech and pharmaceutical industries (collectively, “biopharma”), they are assumed to be insulated from patent monetizers. In a recent study, Robin Feldman and I set out to test this assumption, combining theoretical analysis with a novel study of the patent holdings of five majority university systems. We conclude that the assumption is unwarranted: biotech and pharma should be ready for the coming attention of monetizers.

Conventional wisdom holds that biopharma has little to worry about from monetizers, for three primary reasons. First, the story goes, there are likely very few extant relevant patents about which to worry. Firms patent drugs—biopharma is often described as a “one-product, one-patent” industry—early in development, and thus have years to find whether any other relevant patents exist. Second, the high costs of development and entry keep out of the industry players who are not deep-pocketed and serious about drug development, such that other players are not developing patentable ideas to increase that potential patent inventory. Third and finally, the assumption has largely been, based on experience, that patent monetizers stick mostly to high-tech targets, because they are relatively easy and fruitful.

The conventional wisdom, however, misses three aspects about monetizers and biopharma. First,

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**HOT TOPICS IN EUROPEAN  
AND  
US PATENT LAW**

Comparing, contrasting, and harmonizing strategies  
with focus on post-grant proceedings,  
unitary patent system, biosimilars, and trolls

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APRIL 1, 2014**

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Rebecca McNeill - [rebecca.mcneill@vivicar.com](mailto:rebecca.mcneill@vivicar.com)




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*per curium* decisions, *i.e.*, a decision that includes no written formal opinion. Additionally, Chief Judge Smith indicated that efficiency is encouraged by way of the judges trying hard to get it right the first time. He presented data indicating that the number of cases affirmed is substantially higher than the number of cases reversed. In fact, the data showed that there were only four reversals in fiscal year 2012, and only four reversals in fiscal year 2013.

Chief Judge Smith's fifth and final lesson learned from the Clauses is that "December 2014 is a December 2013 activity." Chief Judge Smith anticipates 1300 to 1400 new cases will be filed with the PTAB per year. Based on that estimate, even if 2/3 of those cases go to trial, that will likely result in the PTAB being one of the busiest, if not the busiest, federal court in the country. Even today the statistics show that the PTAB is the third busiest patent court in the country, trailing only the Eastern District of Texas and Delaware. Presently, Delaware is the busiest federal patent court in the country.

Chief Judge Smith then accepted questions from the audience. In response to the first question, Chief Judge Smith indicated that he believes the *pro hac vice* system seems to be working, but encourages people to contact him if they are aware of any issues. The second question indicated some trepidation regarding the increase

in the use of *per curium* decisions because it can make it difficult for the losing party to appeal the decision on a scant record. Chief Judge Smith understands this concern, and indicated that typically a *per curium* decision issues only in instances where the examiner's answer is sufficient for the Federal Circuit if there was an appeal. In response to the third question, Chief Judge Smith indicated that the USPTO is currently working to improve the administrative staff of the PTAB, and, as a result, attorneys may see more delays than normal in the short term, but that such delays should lead to improved efficiency in the



*The Honorable Past Presidents of the Boston Patent Law Associations*

long term. The final question related to the amount of communication and collaboration that occurs between the USPTO administrative office and the PTAB regarding the impact of changes in the law from Congress or the judiciary. Chief Judge Smith indicated that the PTAB is in contact with the USPTO administrative offices, it does not receive directives to guide its decisions. The PTAB is guided by the case law. However, the goal is for there to be continuity between the examination side of the USPTO and the PTAB.

### **VIII. Thank You**

#### ***Immediate Past President Maraia***

Immediate Past President Maria presented Chief Judge Smith with a gift, the traditional Patriot's Plate, and thanked Chief Judge Smith for his attendance, remarks, and continued service.

### **IX. Incoming President's Remarks**

#### ***Incoming President Meuth***

Immediate Past President Maraia introduced President Meuth, and she provided some incoming remarks related to her upcoming presidency. President Meuth thanked the last

Board of Governors, as well as previous Boards of Governors on which she served. She also thanked Michael McGurk and Susan Glovsky for starting her involvement with the BPLA through the Contested Matters Committee. Mr. McGurk will work with President Meuth in the upcoming year as the Chair of the Activities and Public Relations Committee.

President Meuth noted that she anticipates that over the course of the next year, the Supreme Court

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### ***Why Patent Monetizers Are Coming to Biotech and Pharmaceuticals***

*Continues from Page 10*

assuming that patents are available to be asserted against the industry, the tightly-regulated nature of the industry means that inventing around any asserted patents is much more costly. If, for example, an electronics manufacturer were faced with a patent on some aspect of a product, above a certain settlement cost, the manufacturer would rather just change the product than settle. In biopharma, tight regulatory oversight means that changing a product, or a manufacturing method, will frequently be very costly or effectively impossible, thereby increasing potential settlement costs.

Second, conventional wisdom assumes prevalence of the classical model of patent bargaining and litigation, where patent strength and applicability are assessed, weak claims are dropped, and strong claims proceed to litigation and settlement. But modern monetizers exploit the tremendous cost leverage of patent litigation, where patent suits are extremely expensive to defend and weigh against comparatively low licensing or settlement demands. Firms are also asymmetrically vulnerable: monetizers frequently have few assets, where targets often have much at risk; this may be especially true for biopharma firms.

Third and finally, conventional wisdom assumes that monetizers will stick to their best-case scenario, the easily-targeted high-tech industry. But the high-tech industry

is merely low-hanging fruit; as the number and sophistication of monetizers continue to increase, they are very likely to branch out into other industries. Indeed, reports are beginning of pressure for biopharma counsel to increase monetization of firms' IP by licensing to patent monetizers and, on the other side, of biotech firms starting to hear from monetizers.

Underlying these theoretical issues is the central assumption that there simply is not an inventory of patents which could be asserted by monetizers against biopharma firms. We suspected that the patent holdings of universities would provide a rich source of potentially assertable patents for monetizers to mine, particularly in light of a recent decision by the Association of University Technology Managers to reexamine a 2007 pledge not to sell patents to monetizers. CalTech and Duke have already sold some patent rights to Intellectual Ventures, a well-known monetizer.

To test whether university patent holdings were likely to provide relevant patents, we performed a deliberately light search of the holdings of five major research university systems: the University of California system, the University of Texas system, MIT, CalTech, and the University of South Florida. We looked for patents in classes likely to be relevant to biopharma, such as drugs, chemical reactions, and methods of manufacture, selected patents with promising titles, and skimmed patents to find those which seemed likely to be relevant. We

easily found several dozen potential patent targets in several categories. These included active ingredient patents (rare and hard to find, but potentially very valuable), methods of treatment (easy to find and assertable against end-users as well as firms), manufacturing methods, dosage forms, research screening methods, and what we call "plausibly related patents," which are least likely to be valid but pass the risibility test well enough to be asserted as a basket of patents in a demand letter.

That we found these patents easily may suggest that biopharma has already found and dealt with them, either by finding patents irrelevant or by licensing them. It seems likelier that the conventional wisdom described above has kept these patents off the radar of biopharma, especially since universities have until recently stayed out of the patent litigation and monetization game. The industry itself also likely holds large stocks of relevant patents; while monetization has remained a distant issue, those patents were relatively quiescent, but now that monetizers are approaching, biopharma firms may supply patents to be used against their competitors through monetizer intermediaries.

Overall, the long-held wisdom that biopharma is immune to threat from patent monetizers appears to be untrue. When determining what, if anything, is the appropriate policy response to the growing question of monetizers, the biotech and pharmaceutical industries should be taken into account.

## Intellectual Property in Distressed Circumstances -- Challenges and Opportunities

by John G. Loughnane  
Nutter McClennen & Fish LLP, Boston

A bankruptcy filing creates a host of challenging issues. Licensors and licensees, for example, need to understand the implications of the bankruptcy process in order to protect themselves from a counterparty's filing.

A bankruptcy filing can also create opportunities. The best source of recovery for creditors of the failed firm, for example, may be through a sale of all or a portion of the intellectual property portfolio of the troubled company. An opportunistic firm may



John G. Loughnane

see value in acquiring a trouble company's owned or licensed technology for a variety of reasons: (i) to further develop its own technology by means of the acquisition;

(ii) to keep the assets from a competitor; or (iii) to assert rights affirmatively against others through infringement actions.

In any distressed situation, it is critical for licensors and licensees of the troubled company as well as potential buyers to understand how intellectual property issues are treated in the context of a federal bankruptcy proceeding. A detailed examination

of all issues relevant to intellectual property and distressed companies is beyond the scope of this article. The objective of this article is to assist nondebtor licensors and licensees in responding to the challenges of a counterparty's bankruptcy filing. In so doing, the article should also be of use to potential buyers wading into the market for distressed intellectual property.

### Recent Transactions

There are many alternative options for a financially distressed company to consider when responding to its crisis. The federal Bankruptcy Code governs federal bankruptcy cases (including chapter 11 reorganizations and chapter 7 liquidations) and the sales that often occur in such proceedings pursuant to Section 363 of the Bankruptcy Code. Troubled companies can also seek relief pursuant to various out of court liquidation or restructuring options available under state law.

Some examples of recent bankruptcy matters involving valuable intellectual property have attracted much attention. For example, in 2011 Nortel Networks Inc. conducted a bankruptcy auction involving approximately 6,000 wireless patents. The assets sold for approximately \$4.5 billion. In 2013, Eastman Kodak Company conducted a bankruptcy

auction of its digital imaging patent portfolio which yielded \$525 million. Within the past few years, numerous intellectual property assets in the life sciences industry in Massachusetts have been marketed and sold in bankruptcy cases. In 2013, chapter 11 debtor Inspiration Biopharmaceuticals, Inc. completed two section 363 sales: (i) a sale to Baxter International for a purchase price that could exceed \$700 million; and (ii) a separate sale to Cangene Corporation for a purchase price that could exceed \$300 million. Distressed intellectual property deals also commonly occur in chapter 7 liquidation scenarios such as the chapter 7 trustee's sale of the intellectual property assets of debtor Peptimmune to Merck Serono and another chapter 7 trustee's sale of the intellectual property assets of debtor Innovative Spinal Technologies, Inc. to Integra Life Sciences.

In short, bankruptcy cases of all types increasingly involve IP intensive companies. Licensors and licensees need to understand the consequences of a bankruptcy filing by a counterparty. The best time to consider such consequences is at the outset of the relationship -- before the license agreement is drafted. Once notified that a counterparty has filed, licensors and licensees

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### **Intellectual Property in Distressed Circumstances**

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ees need to pay careful attention to ensure their rights are protected. Opportunistic parties will also be on the lookout for the chance to pick up distressed IP at bargain basement pricing.

### **Fundamental Issues**

Despite the prevalence of IP transactions occurring in distressed situations, bankruptcy law is unsettled on some critical topics involving licensed IP. Adding to the complexity, the application of the Bankruptcy Code can vary greatly from circuit to circuit. Furthermore, the intersection of bankruptcy law in the US can conflict with the insolvency laws of other countries. Harmonizing the laws in multinational insolvency proceedings can be difficult. Every licensor and licensee should understand at least the following:

- the basic framework of Section 365 of the Bankruptcy Code which gives a debtor or trustee the right to assume, assign or reject “executory contracts”;
- the restriction in Section 365 against assignment of executory contracts where prohibited by applicable nonbankruptcy law
- the Circuit split concerning a debtor’s ability to assume and the distinction between the “hypothetical” test and the “actual” test;
- the Fourth Circuit’s famous 1985 decision in *Lubrizol*, the ensuing

1988 Intellectual Property Amendment to the Bankruptcy Code and the Seventh Circuit’s recent decision in *Sunbeam* criticizing the *Lubrizol* decision; and

- the Fourth Circuit’s very recent decision in *Qimonda* dealing with intellectual property issues in a multinational insolvency proceeding.

Each of these issues is discussed below.

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***IP assets will continue to play a prominent role in distressed situations in the coming years. The tension between bankruptcy law which seeks to maximize value and intellectual property which seeks to protect patents, copyrights and trademarks will deepen. Nondebtor parties with IP licenses with a debtor will need to vigorously protect their rights and avoid harm from any distressed contract party’s efforts to maximize value.***

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### **1. Section 365 Basics**

In a chapter 11 proceeding, the debtor company will seek to use the time afforded by the automatic stay against creditor action during a case to reorganize around key assets. Frequently, when a stand-alone

reorganization is not possible, the company’s efforts will turn to selling assets to the highest bidder. A debtor (or chapter 11 trustee in the rare case where one is appointed to displace the debtor’s management) has the ability to assume and assign “executory contracts” unless prohibited by applicable non bankruptcy law. The key factor in evaluating whether a license agreement is “executory” is whether performance remains due on each side so that failure to complete performance by either party would be a material breach. In addition to the power to assume and assign, the debtor or trustee also has the power to reject burdensome executory contracts.

Thus, as part of a restructuring or a sale in chapter 11, the company will make a determination on each contract (including each license) as to whether it deems such contract “executory” and if so whether it desires to assume, assume and assign, or reject such contract. In a chapter 7 liquidation case, the chapter 7 trustee will make a similar determination on each contract. Once the debtor or trustee makes the assumption or rejection decision, the decision will be presented to the court for its review and approval in accordance with Section 365 of the Bankruptcy Code which contains various elements that much be satisfied before the decision can be approved and implemented.

The nondebtor party to each such contract will be affected significantly by the decision and must therefor (i)

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pay close attention to the proceedings, (ii) exercise its rights to try to reach its desired business result and (iii) be prepared to respond aggressively to any action by a debtor or trustee that might be beneficial to the debtor or creditors but disastrous for the affected nondebtor IP counterparty.

One initial issue that the nondebtor licensor or licensee should analyze is whether the license is in fact executory and therefore subject to an assumption or rejection in the first place. The Bankruptcy Code does not contain a definition of the term “executory contract.” Two recent cases help demonstrate that the decision about “executoriness” is not simple. Specifically, in *In re Exide Technologies*, 607 F.3d 957 (3d Cir. 2010) the Third Circuit determined that a perpetual, royalty-free trademark license was not an executory contract and thus not subject to assumption or rejection by the licensor debtor. In contrast, in *In re Interstate Bakeries Corporation*, 690 F.3d 1069 (8th Cir. 2012) the Eighth Circuit determined that a similar license was executory and thus could be assumed or rejected by the licensor debtor. However, the Eighth Circuit has since vacated its panel decision and reheard the matter en banc in September of 2013.

If executory, the debtor (or trustee) must comply with various requirements of Section 365 in order to assume including curing any existing

defaults, other than defaults relating to the insolvency or financial condition of the debtor, the commencement of a bankruptcy case, the appointment of a trustee, or the satisfaction of a penalty provision relating to non-monetary obligations.

### **2. Section 365’s Prohibition on Assignment when Prohibited by Applicable Law**

One critical exception to the general rule of Section 365 regarding assumption, assignment and rejection of executory contracts is that assignment is not permitted when applicable non-bankruptcy law excuses a non-debtor party from accepting or rendering performance from a third party. Thus, once the issue of “executoriness” is determined, a separate analysis is needed as to whether relevant applicable law operates to preclude a party from accepting performance from a third party over its objection -- an issue that will depend in part on the particular jurisdiction where the case is pending.

Specifically, Section 365(c) of the Bankruptcy Code provides in part that an executory contract may not be assigned when “applicable law excuses a party, other than the debtor, to such contract ... from accepting performance from or rendering performance to an entity” other than the debtor. The classic example of such a contract is a personal services contract: state laws prevent a party from forcing a counterparty to accept personal services from a third party not selected by the counterparty. Courts have determined that patent, copyright and trademark law also

constitute “applicable law” which preclude a debtor from attempting to force its counterparty from accepting performance from a third party. Cases reaching this conclusion include:

1. Patent cases such as *Gilson v. Republic of Ireland*, 787 F.2d 655, 658 (D.C. Cir. 1986 (“[i]t is well settled that a nonexclusive licensee of a patent has only a personal and not a property interest in the patent and that this personal right cannot be assigned unless the patent owner authorizes the assignment or the license itself permits assignment.”); See also *In re Catapult Entertainment*, 165 F.3d 747, 750 (9th Cir. 1999) (nonexclusive patent licenses cannot be assigned by a debtor licensee).
2. Trademark cases such as *In re N.C.P. Mktg. Group Inc.*, 337 B.R. 230, 237 (D. Nev. 2005), *aff’d*, 279 Fed. Appx. 561 (9th Cir. 2008); *In re XMH Corp.*, 647 F.3d 690, 695 (7th Cir. 2011) (holding that trademarks are personal and thus not assignable under trademark law without the consent of the trademark owner/licensor).
3. Copyright cases such as *In re Patient Educ. Media*, 210 B.R. 237, 240-43 (Bankr. S.D.N.Y. 1997); *In re Golden Books Family Ent. Inc.*, 269 B.R. 311, 314 (Bankr. D. Del. 2001); *ITOFCA Inc. v. MegaTrans Logistics Inc.*, 322 F.3d 928, 941 (7th Cir. 2003) (determining that nonexclusive copyright licenses are personal to transferees who

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### **Intellectual Property in Distressed Circumstances**

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cannot assign it to a third party absent the copyright owner's consent).

Courts have also analyzed the issue of whether an exclusive IP license similarly restricts an assignment by a debtor licensee without the nondebtor licensor's consent. On this issue, the courts have reached differing results. Some courts have ruled that exclusive patent licenses (like non exclusive patent licenses) are nonassignable without the patent owner's consent. See, e.g., *In re Hernandez*, 285 B.R. 435, 440 (Bankr. D. Ariz. 2002) (to hold otherwise would render an exclusive license the equivalent of an outright assignment which would contravene well established federal law); see also *Proteo Tech Inc. v. Unicity Intern. Inc.*, 542 F. Supp. 2d 1216, 1219 (W.D. Wash. 2008). With respect to assignments of exclusive copyright licenses, some courts have determined to allow assignment reasoning that under applicable copyright law, an exclusive copyright license conveys an "ownership" interest. See, e.g., *In re Golden Books Family Ent. Inc.*, 269 B.R. at 319. Other courts such as *Gardner v. Nike Inc.*, 110 F. Supp. 2d 1282, 1287 (C.D. Cal. 2000) have concluded that exclusive copyright licensees do not have the right to assign absent the copyright owner's consent.

### **3. Current Circuit Split Regarding Assumption**

The specific language of Section 365 contains a drafting ambiguity that has injected an additional level of complexity into the analysis of assumption and assignment issues – and the rights of nondebtor licensees facing a counterparty's bankruptcy case. Specifically, Section 365(c) provides that a debtor or trustee cannot "assume or assign" an executory contract when applicable law would prevent assignment.

Some courts have opted to read the three words "assume or assign" literally. That is, such courts have refused to allow even the mere assumption of a nonexclusive intellectual property license on the grounds that such a license is non assignable under applicable nonbankruptcy law. Four Circuit Courts of Appeal ( the Third, Fourth, Ninth and Eleventh) have adopted the hypothetical test and ruled that if a contract cannot be assigned under applicable non-bankruptcy law, then it can not be assumed or assigned by the trustee of the debtor-licensee. See *In re West Elecs., Inc.*, 852 F.2d 79, (3d Cir. 1988); *RCI Tech. Corp. v. Sunterra Corp.* (In re Sunterra Corp.), 361 F.3d 257 (4th Cir. 2004); *Perlman v. Catapult Entm't, Inc.* 165 F.3d 747 (9th Cir. 1999); *City of Jamestown v. James Cable Partners, L.P.* (In re James Cable Partners, L.P.) 27 F.3d 534 (11th Cir. 1994).

Two other Circuit Courts of Appeal (the First and Fifth) have rejected that view. See *Institut Pasteur v. Cambridge Biotech Corp.*, 104 F.3d 489 (1st Cir. 1997); *Bonneville*

*Power Admin. v. Mirant Corp.* (In re Mirant Corp.), 440 F.3d 238 (5th Cir. 2006). Instead, these two Circuits have adopted an alternative test known as the actual test. Under the actual test, a debtor licensee is prevented from assuming a license only if it intends to assign it without the consent of the licensor. If the debtor merely plans to assume the license without attempting to assign, then the debtor is authorized to do so.

The implication of this Circuit split is monumental. In "hypothetical test" jurisdictions, debtor licensees confront the reality of not only being precluded from assigning their IP licenses, they are also precluded from merely attempting to assume such licenses. In contrast, in "actual test" jurisdictions (such as the First Circuit), debtor licensees who do not intend to assign are free to at least assume their IP licenses. The Circuit split is likely to be resolved by the Supreme Court at some point. In 2009, Justice Kennedy was joined by Justice Breyer in issuing a statement on the denial of a petition for writ of certiorari in the case of *N.C.P. Marketing Group, Inc. v. BG Star Productions, Inc.*, 556 U.S. \_\_\_\_ (2009). In the statement, Justice Kennedy described the division in the courts as "an important one to resolve for Bankruptcy Courts and for businesses that seek reorganization" and that in a different case "the Court should consider granting certiorari on this significant question."

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### **Intellectual Property in Distressed Circumstances**

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#### **4. Lubrizol, the 1988 IP Amendments and Sunbeam**

The power granted to a debtor to assume, assume and assign or reject is fundamental to the bankruptcy process. The impact of the power on the rights of intellectual property licensees was highlighted in the 1985 Fourth Circuit decision in *Lubrizol Enterprises, Inc. v. Richmond Metal Finishers, Inc.*, 756 F.2d 1043 (4th Cir. 1985). In that case, pre bankruptcy, Richmond granted Lubrizol a nonexclusive license of certain patents. After filing for bankruptcy, Richmond rejected the license agreement. The Fourth Circuit held that under the Bankruptcy Code as it then existed, when Richmond rejected the license, Lubrizol, as the patent licensee, lost its rights under the license.

In response to this decision, in 1988 Congress enacted Section 365(n) to the Bankruptcy Code expressly granting licensees of «intellectual property» an option to elect to either (i) treat a rejected IP agreement as terminated or (ii) retain all rights, including rights to enforce any exclusivity provisions in the license and related or ancillary agreements, for the duration of the license and any extensions. At the same time, Congress amended the Bankruptcy Code to define the term «intellectual property» — a definition that included patents and copyrights but specifically did not include trademarks.

Thus, as a result of Section 365(n), now when a debtor is a licensor and seeks to reject a license of “intellectual property” as defined by the Bankruptcy Code, the nondebtor licensee has the statutory right to continue to retain its rights if it so elects. Specifically, Section 365(n) provides the nondebtor licensee with the right to continued usage as long as the licensee continues to pay royalties that are due and waives any right to setoff. However, the licensee making the election will not obtain any future updates, support or protection from infringement from the licensor. Upon the rejection, in other words, the debtor licensor is relieved of its obligations to perform. Nondebtor licensees of rejected contracts should pay careful attention to the language of any proposed sale order to ensure that the Section 363(n) rights are preserved and not subject to any argument that such rights are waived by the typical “free and clear” language in a typical sale order.

As noted above, the defined term «intellectual property» in the Bankruptcy Code does not include trademarks. Accordingly, the 1988 IP Amendments enacted in response to Lubrizol did not specifically grant a nondebtor trademark licensee the right to elect to retain its rights in the event of an executory license rejection by a debtor trademark licensor.

Recently, courts have begun to analyze further the rights of nondebtor trademark licensees when a debtor licensor rejects despite the lack of explicit protection in Section 365(n).

For example, in *Sunbeam Products v. American Manufacturing*, 686 F.3d 372 (7<sup>th</sup> Cir. 2012) the Seventh Circuit held that the rejection of a trademark license does not constitute a termination of the nondebtor licensee’s rights under the rejected contract. This result, of course, contrasts with the analysis of Lubrizol and has given trademark licensees of debtor licensors newfound support for retention of their licensee rights in the event of a rejection by a licensor – despite the omission of trademarks from the definition of “intellectual property” added to the Bankruptcy Code by the 1988 IP Amendments. As helpful as the Sunbeam opinion is to nondebtor trademark licensees, the decision leaves open several points about the scope of the licensee’s rights which will be resolved only through further litigation or legislation.

#### **5. The Fourth Circuit’s decision in *Qimonda* issued in December 2013**

The United States Court of Appeals for the Fourth Circuit recently issued an opinion that is comforting to nondebtor licensees confronting a foreign debtor’s attempts to terminate (under foreign law) patent licensing agreements governed by United States law.

The insolvency proceeding of *Qimonda* involved a debtor which had filed a proceeding in Germany in January of 2009. The debtor was a manufacturer of semiconductor memory devices and the holder of approximately 10,000 patents,

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## BPLA Files *Amicus* Brief In *Highmark Inc. V. Allcare Health Mgmt. Sys., Inc.*

By Erik Paul Belt and  
Wyley S. Proctor, both of  
McCarter & English LLP

On January 24, 2014, the BPLA filed an *amicus* brief in the United States Supreme Court in *Highmark Inc. v. Allcare Health Mgmt. Sys., Inc.* The Court granted *certiorari* to decide whether a district court's objective baselessness ruling, made as part of a fee-shifting determination in a patent infringement case, should be reviewed on appeal *de novo* or with deference to the district court. The issue has implications for both plaintiffs and defendants in patent litigation. Many *amici*, including AIPLA, NYIPLA, and famous companies such as Apple and Google, filed briefs on both sides of the debate. In its *amicus* brief, the BPLA argues that such district court determinations should be reviewed *de novo*. A deferential standard could chill zealous advocacy in patent litigation, especially when novel or aggressive claims or defenses are required. Oral arguments will be heard on February 26, 2014.

### Case Background

The Patent Act provides that "[t]he court in exceptional cases may award reasonable attorney fees to the prevailing party." 35 U.S.C. § 285. Absent a showing of misconduct by the patentee during litigation or in procuring the patent, the Federal Circuit has held that

an accused infringer must meet a two-part test to show a case is exceptional and thus it is entitled to attorneys' fees: that (1) the patentee's suit was objectively baseless and (2) the patentee brought the suit in subject bad faith. *Brooks Furniture Mfg., Inc. v. Dutailier Int'l., Inc.*, 393 F.3d 1378, 1381 (Fed. Cir. 2005). In its 2012 decision in *Highmark Inc. v. Allcare Health Mgmt. Sys., Inc.*, the Federal Circuit, reviewing the district court's "objectively baseless" determination *de novo*, found that one of the patentee's claims was not objectively baseless and reversed the award of fees with respect to that claim. 687 F.3d 1300, 1313-15 (Fed. Cir. 2012). The accused infringer petitioned for writ of *certiorari*, and the Supreme Court granted review on the question "whether a district court's exceptional-case finding under 35 U.S.C. § 285, based on its judgment that a suit is objectively baseless, is entitled to deference." *Highmark Inc. v. Allcare Health Mgmt. Sys., Inc.*, No. 12-1163, *cert. granted* Oct. 1, 2013. On that same day, the Court will hear arguments in a separate appeal regarding Section 285, *Octane Fitness LLC v. Icon Health & Fitness, Inc.*, No. 12-1184, in which the Court will review the two-part *Brooks Furniture* test itself.

### The BPLA's Argument

Under § 285, attorneys' fees can be awarded only in "exceptional" cases.

A finding of exceptionality requires perspective. The Federal Circuit, which has reviewed thousands of patent cases, has the perspective to judge for itself whether a case is exceptional. If exceptionality is based on, say, litigation misconduct or subjective bad faith, then the district court is better positioned than the Federal Circuit to decide the issue, and thus that determination should receive deferential review. But when the exceptional case determination is based on objective baselessness, as was the case here, then the district court and Federal Circuit stand on at least the same footing. Indeed, if anything, the Federal Circuit is better positioned to determine objective baselessness because, as an institution created specifically to oversee patent litigation, it hears many more patent cases, and is exposed to many more issues and arguments, than an individual district court ever will. Thus, the district court's determination does not merit any deference.

*De novo* review of objective merit determinations by the Federal Circuit ensures that litigants are not punished for asserting legitimate, if aggressive or novel, positions. Over time, *de novo* review of the objective baselessness will create a body of precedent that will prove invaluable to litigants and district courts alike.

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### **Intellectual Property in Distressed Circumstances**

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including approximately 4,000 U.S. patents. The court-appointed Insolvency Administrator in the German proceeding, sought and obtained recognition of the German proceeding as a “foreign main proceeding” under Chapter 15 of the United States Bankruptcy Code. Thereafter, the US Bankruptcy Court issued an order that declared Section 365 to be applicable to the US proceeding. As the case proceeded, the Insolvency Administrator acted to exercise the debtor’s rights under German insolvency law to reject various patent agreements. When the US based licensees sought to

enforce their rights under Section 365(n), the Insolvency Administrator asked the US court to determine Section 365(n) not applicable to the proceeding.

After an extensive evidentiary hearing, the bankruptcy court held that the balancing of debtor and creditor interests mandated by relevant provisions of the Bankruptcy Code favored the application of section 365(n) with respect to the U.S. patent portfolio over application of German insolvency law which would have stripped the licensees of any rights. The Fourth Circuit, on direct appeal from the bankruptcy court, affirmed in a lengthy and well reasoned decision. *Jaffe v. Samsung*

*Electronics Co., Ltd.*, Case No. 12-1802. [As of the date of this writing it is not yet clear whether there will be a request for an en banc consideration or an appeal to the S. Ct]

### **Conclusion**

In addition to the above, other tricky issues lurk in the weeds for licensors and licensees of intellectual property. Specifically, Section 363 sale orders routinely include language that the sale is made “free and clear” of interests. Licensors and licensees need to be aware that failing to clarify the scope of such language could be construed as providing implied consent to a sale. Indeed, if there is any common theme to the general topic of intellectual property issues in distressed situations it is that non-debtor licensors and licensees must pay extremely close attention to any pending or threatened restructuring or liquidation proceeding.

### **BPLA Minutes of the Annual Meeting.**

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will continue to shape the patent laws, and the impact of the AIA will continue to result in changes in our practices. As a result, a hallmark of her presidency will be focusing on education, including embarking on more collaborative efforts with area law schools. President Meuth intends to form an ad hoc committee dedicated to working with law schools, members, and law students. Additionally, she is already working with the Broad Institute to put together an educational event in the spring focused on European patent examinations, an event that will include European patent examiners as panelists. The event is scheduled for April 1, 2014, and members are encouraged to mark their calendars accordingly. Members Rebecca Mc-

Neill and Amelia Baur are working with President Meuth and Mr. McGurk on this event.

President Meuth thanked her employer, Eisai Inc., the incoming Board of Governors, and the BPLA membership, for their continued support during her presidency. President Meuth then thanked Immediate Past President Maraia for his service and leadership of the BPLA, and presented him with both a Patriot’s Plate and an office chair engraved with the BPLA logo in recognition of his service and leadership.

### **X. Adjournment** **President Meuth**

President Meuth adjourned the meeting at approximately 1:35 PM.

IP assets will continue to play a prominent role in distressed situations in the coming years. The tension between bankruptcy law which seeks to maximize value and intellectual property which seeks to protect patents, copyrights and trademarks will deepen. Nondebtor parties with IP licenses with a debtor will need to vigorously protect their rights and avoid harm from any distressed contract party’s efforts to maximize value. Not only should such parties participate actively in any insolvency proceeding involving a counterparty, they should consider downside protections at the outset of the relationship when the license agreement is first drafted and anytime it is amended.

***BPLA Files Amicus Brief in Highmark Inc. V. Allcare Health Mgmt. Sys., Inc.***  
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Experience with patent law as a whole, not personal observations of the litigants in a single case, is relevant to the objective baselessness test. Thus, district courts' objective baselessness determinations need not be given deference. The Federal Circuit, with its unique experience and

expertise in patent law, on the other hand, is uniquely positioned to determine whether a position is objectively baseless. *De novo* review of the objective test also increases uniformity and predictability in the patent laws, goals for which the Federal Circuit was created.

Finally, the Petitioner and several *amici* have attempted to style Section 285 as a tool for controlling

patent trolls. Section 285, however, is agnostic as to the identity of the party being sanctioned and is intended to compensate a prevailing party—whether plaintiff or defendant—where it would be grossly unjust to require that party to bear its own fees.

## Job Opportunities

### MCLANE LAW FIRM

Manchester, NH

#### IP/Patent Attorney

McLane, Graf, Raulerson and Middleton Professional Association seeks a intellectual property patent attorney with 2-5 years of experience of patent drafting and prosecution experience, with a solid understanding of patent law. For consideration, the qualified candidate should be USPTO licensed and possess outstanding academic credentials, a Ph.D. in chemistry or bioscience preferred and excellent writing and communication skills. Technical expertise in the areas of biotechnology, chemistry, and materials science is required. The position is at our fast growing Woburn, Massachusetts office. McLane presents a fine opportunity for professional development and personal satisfaction in a fast-paced and stimulating work environment. Competitive compensation and benefits package offered.

Qualified candidates should send a resume, writing sample, and transcript to:

Jessica Boisvert  
Hiring Coordinator  
McLane Law Firm  
P.O. Box 326  
Manchester, NH 03105-0326  
or by email to [tojessica.boisvert@mclane.com](mailto:tojessica.boisvert@mclane.com)  
Phone: 603-628-1398

All submissions kept confidential.

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**Job Opportunities***Continues from Page 20*

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Roberta O'Brien

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*Continues on Page 22*



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We are currently looking for a Docketing Administrator who will be responsible for the docketing and document management functions for Pierce Atwood IP prosecution matters. The position will focus primarily on patent prosecution and will handle the docketing of inbound, outbound and internal communications and proactively monitor to ensure that all deadlines are met. This position may also provide administrative support to IP attorneys, including facilitating the intake process, calendaring, billing, annuity payments, and drafting of correspondence to clients and foreign legal associates. This position would also, preferably, provide quality review of domestic and foreign patent filing documents.

**Responsibilities**

- Review and docket all inbound, outbound and internal communications in connection with all IP prosecution US and foreign matters. Create and maintain new records as needed; including all hardcopy files.
- Save all communications (inbound, outbound and internal) to the firm's document management system. Assist in on-going audit of files. Process original paper mail and report out mail to assigned personnel as required.
- Follow-up with attorneys and staff on necessary activities to ensure the docket is actively managed on a daily basis. Maintain a log of all communications, including docket requests, and ensure processing in a timely manner.
- In conjunction with the Docket Administrator ensure the integrity of the IP prosecution database through quality review

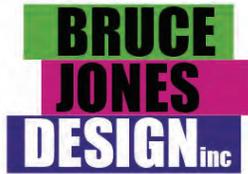
of docketed actions. Create and update new records/actions in a timely manner and enter, monitor and clear deadlines in a timely manner.

- Maintain updated data on contacts in the IP database and assist in the reassignment of matters to internal personnel as needed.
- Review routine audit reports to make corrections or updates to the IP prosecution database as needed.
- Keep current with patent and trademark (to the extent necessary) practice rules and regulations worldwide.
- Review all patent filing documents prior to submission to the USPTO or the International Bureau.
- Review and pay annuities based on client instructions.
- Work collaboratively with all IP department members including attorneys, patent legal admins and docketing staff, to ensure efficient handling of all docketing matters for the department.

**Job Requirements:**

Qualified candidates will possess a Bachelors or Associate's degree and five or more years of IP prosecution US and foreign docketing experience; Demonstrated expertise in US and foreign patent rules, procedures and timetables; Experience managing an IP docket; Experience with CPI preferred; Experience with First to File a plus; Experience with patent filing quality review procedures; Experience with Annuity review and payments procedures; Excellent communication and interpersonal skills; Superior attention to detail; Ability to interact effectively within the organization; Ability to maintain a professional demeanor in all situations and work effectively under pressure.

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