

BOSTON PATENT LAW ASSOCIATION NEWSLETTER



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The 78th Annual Meeting of the Boston Patent Law Association

The 78th Annual Meeting of the Boston Patent Law Association will be held at a luncheon at the Seaport Hotel on December 4, 2002. The focus of the Annual Meeting will be the annual organizational business, including reports on the Association's finances and membership, planned activities for the coming year, and the election of the new Officers and Governors.

We also are fortunate to have U.S. Patent and Trademark Office Director James E. Rogan as the featured speaker. Mr. Rogan manages the USPTO's operations and is policy advisor to the Bush administration on all domestic and international intellectual property matters. He also co-chairs the National Intellectual Property Law Enforcement Coordination Council, which oversees domestic and international intellectual property law enforcement issues among federal entities.

On December 4, a reception will commence at 11:30 am and the Annual Meeting will begin at noon.



*USPTO Director
James E. Rogan*

The Federal Circuit's Boston Visit



During the week of October 7, several panels of the Court of Appeals for the Federal Circuit heard cases in Boston. Oral arguments were heard at Boston's Joseph J. Moakley Federal Courthouse as well as at several local law schools.

The Boston Patent Law Association also co-sponsored a well-attended reception and dinner for the Federal Circuit Judge at the Federal Courthouse on October 9. Federal Circuit Judge Pauline Newman delivered an excellent talk, including some interesting history of the formation of the Federal Circuit. Chief District Court Judge William Young also spoke, noting the high number of patent cases litigated in the District of Massachusetts.

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President's Message



Boston was fortunate this year to have been the host city for a visit by the Court of Appeals for the Federal Circuit. Judges Newman, Michel, Lourie, Gajarsa, Dyk, Prost, and Plager, and their staff, arrived in Boston on Monday, October 7, and departed on Thursday October 10. The Boston Patent Law Association, together with other local bar associations, organized a small reception for the judges and staff members on Monday evening upon their arrival. We also held a larger reception and dinner for the judges and staff members at the Joseph J. Moakley Courthouse on Wednesday, October 9. Chief District Court Judge William Young provided some brief remarks and introduced Judge Pauline Newman. Judge Newman gave a delightful talk about the history and functioning of the CAFC, and a brief biographical sketch of the other CAFC judges in attendance. Judge Newman also presented an award to BPLA member Phil Swain for his outstanding contributions to the Court during his term as president of the Federal Circuit Bar Association. In addition to our distinguished visitors from the CAFC, we also had fifteen judges and magistrates in attendance from the First Circuit.

We received many favorable comments about the reception and dinner from those in attendance, and on a personal note, I am glad that we had such a successful event in the twilight of my presidency. The final numbers counted over 300 attendees for the dinner and reception on Wednesday night, and we stretched the seating capacity of the Federal Courthouse to its limits. A special note of thanks as well to the other local bar associations for co-sponsoring the dinner and the other activities during the CAFC visit. I received a nice thank you note from Chief Judge Mayer that I will read at the Annual Meeting next month.

Speaking of the Annual Meeting, I would like to encourage everyone to attend the luncheon on Wednesday, December 4, at the Seaport Hotel. The Annual Meeting will commence at noon, and will include a summary of committee activities for the past year, awards for special achievements, reports on the status of the organization, and the election of new officers and directors. In addition, we are very fortunate to have as our guest speaker this year Under Secretary of Commerce and USPTO Director James E. Rogan. Those members wishing to attend the Annual Meeting should plan on making reservations at an early date. Please contact activities chair Martina Rozumberkova at (617) 761-0527, or email mrozumberkova@tofi.com, to make reservations or for more information. Although I have enjoyed serving this year, I am looking forward to passing on the reins to my successor.

As I complete my term of office, I would like to thank everyone who made this year the success it has been for our organization. Our service to the profession starts with our committees, and our committee co-chairs who did their usual excellent job this year in planning and hosting seminars and events of particular interest to our community. In this vein, I would like to extend a special thanks to Walter Dawson and Faith Driscoll, co-chairs of our corporate practice committee, Doreen Hogle, chair of our biotechnology committee, Maria M. Eliseeva, chair of our international and foreign practice committee, Peter Corless, co-chair of our chemical practice committee, Ed Porter and Karen Buchanan, co-chairs of our computer law committee, Buzz Gagnebin and Tom Saunders, co-chairs of our copyright committee, Leslie-Meyer Leon and John Prince, co-chairs of our patent law committee, Grant Houston and Dave Conlin, co-chairs of our patent office practice committee, and Cindy Johnson and Andrea Jacobs, co-chairs of our trademark and unfair competition committee. I would also like to thank Martina Rozumberkova, who did a great job this year as my activities chair, and Patricia McKenney and all the folks at Ropes and Gray for supporting me throughout the year. Have I left anybody out? Oh yes, and on behalf of the entire board of governors, I would like to thank you the members for supporting this organization and for giving us the opportunity to be of service to you this year. See you at the Annual Meeting.

Corporate Practice Committee Upcoming Event

Co-Chairs: Walter F. Dawson & Faith F. Driscoll

The Corporate Practice Committee held a luncheon meeting on February 6, 2002 at Anthony's Pier 4 which featured William D. Belanger of Mintz, Levin, Cohen, Ferris, Glovsky and Popeo, P.C. who spoke on "How Does the In-House Patent Counsel Protect Communications With Inventors".

Plans are currently being made for an interesting luncheon/speaker meeting early in 2003, and another meeting is in the planning stages with the Patent Office Practice Committee which will focus on what the corporate counsel should or should not put in a patent application to avoid invalidity attacks and consider the merits of "Low Profile-Common Denominator" patent practice advocated at "Kayton" courses. Speaker suggestions are always welcome from committee members.

Trademarks and Unfair Competition Committee Annual Meeting

By: Andrea A. Jacobs, Edwards & Angell, LLP

The Trademarks and Unfair Competition Committee of the BPLA hosted its annual meeting on November 5, 2002. This year's meeting focused on methods for determining the valuation of a company's intellectual property assets and strategies for building value via licensing transactions. The Committee was pleased to have two experts in the industry as guest speakers, Mr. Weston Anson, the founder and Chairman of CONSOR, an intellectual asset management firm, headquartered in La Jolla, California, and Mr. Imran Nasrullah, Director of Business Development at Millennium Pharmaceuticals, Inc.

Mr. Anson's talk focused on the identification, bundling, valuation and sale of intangible assets, intellectual property and IP licenses, with an emphasis on patents and trademarks, both as a going concern and in bankruptcy. Specifically, Mr. Anson discussed both traditional methods of valuing trademarks, patents and other IP, as well as more modern and proprietary techniques developed by CONSOR and other leaders in the industry. Additionally, Mr. Anson shared his own hands-on experience with recent clients in the form of case studies, including, his firm's involvement in handling the valuation and sale of Boston Market's intellectual property assets and the recent bankruptcy and reorganization of Polaroid Corporation, with respect to the identification,

valuation and securitization of Polaroid Corporation's intellectual property assets.

Mr. Nasrullah expanded on Mr. Anson's topic to share with us his insight and experience in the biotechnology industry, from the academia, large company and investor vantage. In particular his presentation focused on (i) the valuation of an intellectual property asset as it relates to assets of a biotechnology company; (ii) the importance of building, maintaining and protecting intellectual property assets; (iii) the valuable role of in-licensing in the formation and development of a biotechnology company; and (iv) the strategic use of the intellectual property asset valuation in deal making. Mr. Nasrullah also discussed the current trends in the biotechnology industry with respect to strategic alliances, acquisitions and licensing arrangements and the important roles a company's intellectual property assets play in achieving market and revenue expansion and the opportunity for corporate spin-offs.

Weston Anson is Chairman of CONSOR®, an intellectual asset consulting firm specializing in trademark, patent and copyright licensing, valuations, and expert testimony. The firm is headquartered in La Jolla, California, and has offices in New York and London. He served for six years as Vice President of the Licensing Industry Merchandisers' Association and is a lifetime member of the Board of Advisors. Mr.

Anson is an active member of the Licensing Executives Society, as Committee Chairman and a member of the International Board. He is also active in INTA, the ASA and the Euro-American Tax Institute. In addition, Mr. Anson is an International IP Arbitrator with NAM (National Arbitration and Mediation) and a WIPO approved arbitrator. Mr. Anson graduated with honors from Harvard Business School.

Imran Nasrullah is the Associate Director of Business Development at Millennium Pharmaceuticals, Inc. At Millennium Pharmaceuticals his primary responsibilities include negotiation of various intellectual property licensing transaction and technology platform deals with government, academia and the corporate sector. Mr. Nasrullah has fifteen years of experience in the biotechnology sector, having spent the earlier part of his career as a bench scientist at the Joslin Diabetes Center in Boston. He also worked as the Associate Director at the Office of Technology Transfer at Dana Farber Cancer Institute, out-licensing early stage biotechnology inventions, and prior to that, as a Licensing Professional at the Mayo Clinic's Mayo Medical Ventures. Mr. Nasrullah received his Masters of Science in exercise biology from the University of Colorado, Boulder, and his J.D. from Suffolk University Law School.

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The US Adopts Legislation to Adhere to Madrid Protocol

By: John E. Ottaviani, Edwards & Angell, LLP

On November 2, 2002, President Bush signed the Madrid Protocol Implementation Act, as part of a larger bill authorizing appropriations for the Department of Justice. See 21st Century Department of Justice Appropriations Authorization Act, Pub. L. No. 107-273, §§13401 – 13403 (2002) (adding Title XII to the Lanham Act). Beginning November 2, 2003, U.S. trademark owners will benefit from a simplified procedure to register their trademarks in a number of countries around the world. The bill will also provide benefits to trademark owners in other countries seeking U.S. protection.

What is the Madrid Protocol?

The Madrid Protocol is an international treaty that is administered by WIPO. It is related to, but is different from the “Madrid Agreement” that also is administered by WIPO. The Madrid Protocol is not a trademark law and, of itself, does not confer rights. Rather, the Protocol provides a mechanism for obtaining multinational trademark protection and maintaining international registration rights through a centralized system, without having to institute separate filings and retain counsel in the various international countries.

Presently, a U.S. trademark owner generally is required to file a separate national application and retain trademark counsel for each country in which it wishes to seek protection (although some efficiencies have been created by the use of the Community Trade Mark system adopted by the European Union, a separate filing and separate counsel still have been required to date). Currently, 56 countries are parties to the Madrid Protocol, including the major European countries, Japan, China and Korea.

Who Benefits from the Madrid Protocol Implementation Act?

Adherence to the Madrid Protocol will be of tremendous benefit to U.S. trademark owners. Presently, if a U.S. trademark owner seeks protection in other countries, it must retain counsel, file a separate application and pay fees in each country in which trademark protection is sought (with the exception of the European Union, where a single Community Trademark application may be filed to cover all of the EU member countries). After the effective date, U.S. trademark owners will be able to reduce administrative costs and paperwork by only having to file one application with one fee with the U.S. Patent and Trademark Office, rather than to having to retain counsel, file applications and pay fees in every country in which the applicant desires protection. This will result in cost savings both in the initial application and in ongoing maintenance and renewal fees.

U.S. adherence to the Madrid Protocol is also important to companies in countries that have not ratified the Madrid Protocol, such as Canada and Mexico. These companies may be able to obtain an international registration through Madrid Protocol by first filing applications in the U.S. Patent and Trademark Office, if they can show that they have a “real and effective industrial or commercial establishment” in the United States. This does not mean that the headquarters or principal place of business must be in the United States, but the business must have some bona fide industrial, commercial, sales, marketing or management activity in the United States.

Trademark owners in other countries that have adopted the Madrid Protocol will also benefit from U.S. adherence to the Protocol. These trademark owners will now be able to extend their registrations or applications under the Madrid system to the United States, rather than filing separate U.S. applications.

Obtaining Protection

To obtain protection for a mark in some or all countries that are members of the Protocol, an individual or business domiciled in the U.S. must own a U.S. trademark application or registration. This national application or registration is the basis for a Madrid Application and is referred to as the “basic” application or registration. Once the U.S. Patent and Trademark Office receives the basic application, and an indication that the applicant wishes to extend protection to other countries participating in the Madrid System, the application will be examined and then sent to WIPO on behalf of the applicant by the U.S. Patent and Trademark Office.

Upon receipt of a Madrid Application, WIPO will enter the information contained in the application in its database and determine whether the applicable filing requirements are met and the necessary fees are paid. Once WIPO confirms that the necessary Madrid requirements have been met, it “registers” the mark and publishes it in the *WIPO Gazette of International Marks*. At the same time, it conveys information about the Madrid registration to the national offices of the Madrid Protocol member countries to which the trademark owner wants to extend its Madrid registration.

National offices must treat requests to extend Madrid registrations received from WIPO as properly filed national applications. Initially, the national offices cannot require any additional information from the applicant. As the request for extension is processed, the national office may later require the applicant to provide additional information or respond to office actions. Only at this point, will the applicant need to appoint a

local trademark attorney for such communications.

There are also strict time periods to take action. If the national office fails to act within the prescribed time period (initially 12 months, with extension to 18 months or, subject to certain conditions, a longer period), the Madrid registration takes effect in that country and the trademark owner enjoys the same rights as it would as if it acquired national registration.

Priority Date

Madrid registrations enjoy the right of priority provided for by Article 4 of the Paris Convention. Under the Paris Convention, if a trademark owner files national applications in member countries within six months of its first application to register the mark anywhere, the national applications are given the same filing date as the original application. Therefore, the Madrid Protocol enables trademark owners to benefit from the Paris Convention priority attached to trademark applications without the need to institute separate national filings.

For U.S. applicants, the date on which a Madrid application is filed with the U.S. Patent and Trademark Office is the date of the Madrid registration, provided WIPO receives the application from the Patent and Trademark Office within two months of filing and the application meets certain requirements. This will also be the effective date under the Paris Convention for all requests for extending the application to other countries made within six months after filing. A request for extension submitted after the initial Madrid Application is filed is effective from the date on which it is submitted. Trademark owners may also request extension of their Madrid registrations to additional member countries at a later date, using similar procedures, but will receive a priority in these countries only as of the date of the new request.

Dependence

For the first five years, the Madrid registration is dependent upon the basic trademark application or registration on which it is based. For U.S. trademark owners, this means that if the U.S. application or registration is limited or canceled, the Madrid registration and all the rights obtained in the member countries based on extensions to that registration are similarly limited or canceled. Such a cancellation or limitation does not necessarily cost the trademark owner its rights in priority, however. Under the Protocol, trademark owners have a three-month window in which to transform the limited or canceled Madrid

Continued on next page

Madrid Protocol Cont'd

application to corresponding national applications in each country, which will receive the same priority as the failed or limited Madrid registration.

The dependence of the Madrid registration on the basic U.S. applications may also pose another disadvantage for U.S. trademark owners. The United States Patent and Trademark Office requires applicants to narrowly specify the goods and services in a trademark application, while other countries permit broader descriptions. This means that international registrations based on U.S. applications and registrations will probably be narrower than registrations that could be filed in each other country. To the extent that a broad scope of protection is important to a trademark owner, he or she will have to analyze the relative costs and benefits of registration under each system before deciding how to proceed.

Term

The term of registration for a Madrid registration is ten years. Renewal, which is also for a term of ten years, is accomplished through a single filing with WIPO. By renewing its Madrid registration, a trademark owner also renews the national rights it has obtained through extension of the Madrid registration in each country

Potential Traps for the Unwary

In at least two areas, changes in practice suggested or necessitated by the Madrid System may pose problems for unwary practitioners. Implementation of the Madrid registration system may require trademark owners to change established procedures in searching and clearing trademarks for use and registration in the U.S. In

addition, assignments of applications and registrations will need to be closely monitored.

The Madrid Protocol is likely to extend the period during which a trademark search may not reveal all possible conflicts. Presently, the period of uncertainty in U.S. trademark searching and clearance is approximately seven months (six months of time to cover the Paris Convention priority filings, plus a month or so before information pertaining to new applications is generally loaded or made available electronically for searching on the U.S.P.T.O.'s database). Under the Madrid system, this time period is likely to increase to eight months or more. These time periods are based on the amount of time that the national office has to review and forward an application to WIPO and that WIPO has to transmit the application to the offices of the designated countries to which extensions of the registration is sought. While there seems to be no practical way to avoid the extended period of uncertainty, follow-up searches and reviews of the *WIPO Gazette of International Marks* or WIPO databases may serve to avoid potential problems.

In addition, U.S. trademark owners also may wish to include WIPO international trademark registration databases as part of their trademark search and clearance procedures, even if the applicant only intends to seek registration in the U.S. While WIPO searches will not replace searches of the registers of each foreign country, the expanded searches will nevertheless give prospective trademark owners more certainty when adopting a mark.

Another potential point of confusion for U.S. trademark owners deals with assignments and name changes. Under the Madrid System, assignments and changes of name are recorded by a simple filing. However, a Madrid registration may be assigned only to a party that is qualified to file a Madrid Application under the Protocol. This means that the assignee must be domiciled or have an establishment that is a real and commercial one in a country that is a member of the Madrid Protocol. While this requirement sometimes can be met by assigning the trademarks to a subsidiary or other affiliate of the acquiring company, U.S. trademark owners are not used to having to be aware of such issues.

Conclusion

Many of the procedural details related to the Madrid filings remain to be determined by U.S. Patent and Trademark Office regulations. The new law gives the P.T.O. a year to prepare and adopt implementing regulations.

Ultimately, it is up to each trademark owner, in consultation with his, her or its trademark counsel to determine on a case-by-case basis whether to file nationally, or through a regional system such as the European Union Community Trade Mark system, or through the Madrid System. However, adherence to the Madrid Protocol promises to simplify the process and reduce the cost of international registration for the vast majority of U.S. trademark owners.

Festo Remand

By: Christopher P. Silva, Edwards & Angell, LLP

On May 28, 2002, the Supreme Court of the United States, in a unanimous opinion, vacated the judgment of the United States Court of Appeals for the Federal Circuit in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.* ("Festo"), and remanded the matter to the Federal Circuit or the United States District Court for the District of Massachusetts. *Festo*, 122 S. Ct. 1831. The Court held that further proceedings were required to determine whether Festo could overcome the presumption that the amendment of its patent applications surrendered the particular equivalents that it claims give rise to actionable infringement.

In the time since the Court's order, the Federal Circuit has wrestled with the

question of how to proceed. On September 20, 2002, it issued an Order requiring the parties to brief the following four issues:

1 Whether a party's rebuttal of the presumption of surrender of equivalents via amendment is a question of law or of fact, and what role a jury should play in the rebuttal inquiry;

2 What factors should be considered in determining whether a party has successfully rebutted the presumption;

3 If a rebuttal determination requires factual findings, whether the existing record is sufficient to allow such a determination, or if the matter must be

remanded to the district court for further factual findings; and

4 If remand to the district court is not necessary, whether Festo can successfully rebut the presumption of surrender.

Festo, 304 F.3d 1289. The Circuit Court also invited amici curiae to brief the first two issues. While the court's Order originally required the parties and amici to file briefs within 30 days of its issuance, the deadline was subsequently extended to November 19, 2002 for all briefs.

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

Membership in the BPLA is available to attorneys and other professionals practicing intellectual property law within the Federal First Judicial Circuit (Maine, New Hampshire, Massachusetts, and Rhode Island). Applications for membership can be obtained from our web site at www.bpla.org. Full membership for 2001 (available only for attorneys practicing within the First Circuit) costs \$55.00. Associate membership (available to non-attorney intellectual property professionals) costs \$45.00. Mailing list-only affiliation costs \$25.00.

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