



# THE BOSTON PATENT LAW ASSOCIATION NEWSLETTER

*Serving the  
New England  
Intellectual  
Property Bar  
Since 1924*

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## BARNEY FRANK ADDRESSES BPLA SPEAKS OUT ON PTO FUNDING AND CENSORSHIP

Congressman Barney Frank, addressing the BPLA as guest speaker at the 1997 Annual Meeting, spoke out in favor of increased PTO funding and against federal censorship of internet communications. The nine term representative of Massachusetts's fourth Congressional District and ranking Democrat on the Judiciary Subcommittee on the Courts and Intellectual Property also answered questions from the floor.

Representative Frank reported on the progress of House Bill HR 400 which would reorganize of the PTO as a government corporation and cap

the amount of user fee revenues that Congress could divert to other purposes. He explained that the fate of the bill now lies in the Senate which has not yet passed similar legislation. Frank also noted that the "cap" provisions have only symbolic value since the present Congress can

not dictate how future Congresses decide to spend money. Nonetheless, the legislation would serve as an alarm bell less Congress continue to

make patent holders not only fund the PTO but also bail out other government programs.

(Since Frank's address, the House bill still awaits Senate action and the PTO budget bill which was passed in early November still called for diversion of 92 million dollars of PTO user fees to general revenues.)

Frank also spoke out against federal censorship of internet communications. He express concern that the freedom of speech traditions enshrined in the First Amendment were being trampled by government's desire to stamp out pornography in

*(Continued on page 6)*

**"As a freshman I chose the Judiciary Subcommittee because it had jurisdiction over civil rights and public defenders — neither of which is true anymore."  
- Representative Barney Frank**

## FRENCH ELEVATED TO PRESIDENT DAWSON BECOMES PRESIDENT-ELECT

The 1997 Annual Meeting of the BPLA saw the elevation of Tim French to the Presidency for 1998 and the election of Walter Dawson as President-Elect. (Under the By-laws of the BPLA, the President-Elect assumes the Presidency the following year).

Tim French, a principal with the Boston office of Fish & Richardson, P.C. since 1989, has been practicing intellectual property law for 18 years. He is primarily engaged in patent and trademark prosecution with particular emphasis on international practice. French is presently the co-chair of the BPLA's International Practice Committee and is on the planning committee for this year's International Trademark Association

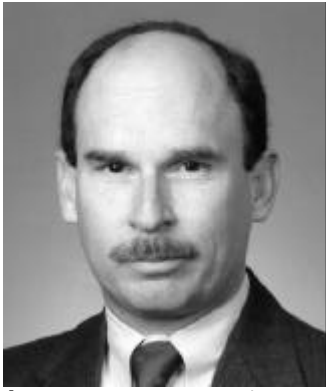
annual meeting in Boston (May 9 - 13).

Walter Dawson practices patent law in Lowell with the firm of Pearson & Pearson where he is also primarily engaged in patent and trademark prosecution with an emphasis on electrical prosecution. Prior to join-

ing the Pearson firm, Dawson worked as a patent attorney at Raytheon for 15 years and is presently the co-chair of the BPLA's corporate practice committee.

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## Message from BPLA President Tim French

hosting a luncheon meeting of the Association on January 28 at Swissôtel Boston. Mark A. Fischer, of Palmer & Dodge LLP, spoke on the topic of "Copyright and the Internet."

The Giles Sunderland Rich Moot Court Committee recently announced that this year's regional competition will be held in Boston on the weekend of March 20-22 at Suffolk University School of Law. If you are interested in acting as a judge at oral arguments on any or all of these dates, or in grading briefs in advance of the oral arguments, please call John M. Berns at (617) 542-5070. This can be a rewarding experience and everyone is urged to participate.

On April 16-17, representatives of the World Intellectual Property Organization (WIPO) will again visit Boston to conduct their very popular training seminar on practice under the Patent Cooperation Treaty. Effective January 1, the fees charged under PCT have been reduced dramatically, and other new rules aimed at making the practice simpler and more forgiving will be effective April 1. Please mark the seminar dates in your calendar.

The International and Foreign Practice Committee is in the process of organizing two panel discussions for 1998. The first will take place in May in conjunction with the Annual Meeting of the International Trademark Association, to be held on May 9-13, 1998, bringing to Boston over 3,000 U.S. and foreign trademark practitioners. The panelists will be trademark practitioners from each region of the world discussing recent and likely future changes in trademark law and practice in their region. A companion seminar for patent practitioners will be held in the fall.

Our goal is to conduct the trademark panel as the BPLA's first video-conference seminar, with interactive broadcast of the panel from Boston to

one or more remote locations, preferably Worcester and/or Rte. 128. More information will follow. If you have video conference capability and would like to act as a host for such a meeting, please contact me.

Finally, the Board will continue its consideration of outside management services. The goal this year will be to establish a test program, with the objective of providing the membership with improved basic services. These will include a permanent mailing address and dedicated telephone line (answered "BPLA"), replacing the current practice of changing both, typically with less than full success, with every new president, and a system for maintaining a current listing of mail, telephone and e:mail addresses for all members, accessible by committee preference for improved communication on this basis. Eventually, we will address the issue of making this information available to all members on the BPLA Website ([www.bpla.org](http://www.bpla.org)), perhaps via a password system, although this information is already easily available in print form, e.g. in Martindale Hubble.

If you have thoughts or comments on this or any other issue affecting the BPLA, please feel free to contact me at (617) 542-5070 or by e-mail to [french@fr.com](mailto:french@fr.com).

The Boston Patent Law Association looks forward to an active and productive year in 1998, led by our Board of Governors and a group of enthusiastic committee chairs.

The changing of the BPLA guard was, as usual, marked by the Annual Meeting, held this year at Le Meridien Hotel. Our speaker was Congressman Bernie Frank, senior Democrat on the House Judiciary Subcommittee on the Courts and Intellectual Property. Mr. Frank had some interesting comments on past and likely future legislation in the area of intellectual property, and, perhaps most significant, expressed support for legislation to limit raids on USPTO fee income for other budgetary purposes.

On the issue of committee activities, during the coming weeks, Walter Dawson, BPLA President-Elect, will be contacting all present committee chairs to enlist their support for the coming year in a program of regular committee meetings and active use of the committee web pages. Committee chairs will also be encouraged to suggest speakers and topics of broader interest for possible Association-wide meetings.

In this vein, the Computer Law and Copyright Committees, chaired respectively by Lee Bromberg and Edward Porter and by Charles Gagnebin and Thomas Saunders, started the committee year off on the right foot by co-

### Members of the Board of the Boston Patent Law Association:

President:	Tim French, Fish & Richardson PC (617) 542-5070 french@fr.com
President-Elect:	Walter Dawson, Pearson & Pearson (978) 452-1971 pearson1@ziplink.net
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Treasurer:	David Thibodeau, Hamilton, Brook, Smith & Reynolds PC (781) 861-6240 david.thibodeau@hbsr.com
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Board Member:	Peter Corless, Dike Bronstein, Roberts & Cushman LLP (617) 523-3400 pfc1@dbrc.com
Board Member:	Leslie Levine, Transkaryotic Therapies, Inc. (617) 349-0244 llevine@transkaryotic.com

# Major PTO Rules Revisions Effective December 1, 1997

by Mark Russett  
Lahive & Cockfield LLP

Final Rules revising many areas of PTO practice went into effect on December 1, 1997, effecting a wide range of topics from signature requirements to appellate procedures. The full text of the new rules can be found in the Federal Register (XXXXX) and in the BNA Journal (XXXX) as well as on the internet (XXXX).

## CONTINUATION PRACTICE

The new rules have abolished continuation applications under old rule 60 and 62 ("file wrapper continuations") and replace them with new procedures governed by Rules 53(b) and 53(d). Any application erroneously filed under the old rules after December 1, 1997 will be treated as if filed under new Rule 53 (b).

Applications filed under new Rule 53(b) still require a copy of the prior application and a copy of the executed declaration be submitted with the application papers (as formerly required by Rule 60) but the requirement for a verified statement that the application is a "true copy" has been dropped, allowing the applicant to submit a new specification and drawings. (So long as no new matter is added, the application will be considered a "continuation or divisional filing; if new matter is added, the application will be considered a continuation-in-part filing). Filings under Rule 53(b) will be assigned a new serial number.

New Rule 53(d) provided for "Continued Prosecution Applications" (CPA) which, like the old file wrapper continuations do not require submission of a copy of the prior application. Unlike old Rule 62 filings, CPAs will not be assigned new serial numbers. More importantly, CPAs will be processed by the examining group handling the prior application as a submission in that case, thereby

eliminating the pre-examination delays inherent in processing new applications.

## INVENTORSHIP CORRECTION

Rule 48 has been amended to simplify the correction of inventorship on patent applications (other than reissue applications). New Rule 48 eliminates the diligence requirement of the former version of the Rule. Moreover, the revised Rule requires only a statement that the error in inventorship was made without deceptive intent, removing the former requirement for a statement of facts as to how the error arose. Under the new version of Rule 48, it is no longer necessary to provide a statement from each of the inventors. Instead, a statement is required only from a person who was erroneously not named an inventor, or a person who was, through error, improperly named as an inventor. These statements are no longer required to be verified.

These changes are significant in light of the amendment to Rule 41(a), which no longer requires that any inventors be named at the time of filing in order for the application to be accorded a filing date. If an application is filed naming no inventors, or the wrong inventors, and no executed oath or declaration is filed, the inventorship may be corrected by simply filing a petition (and fee) under new Rule 41(a), stating that the inventorship is being changed.

Furthermore, if no executed oath or declaration has been filed, submission of an executed oath or declaration naming the correct inventors will be sufficient to correct inventorship without requiring a petition under Rule 41 or Rule 48.

## TIME PERIODS FOR RESPONSE

Rule 1.136(a) has been amended to authorize a maximum extension of time of up to five months upon payment of the appropriate fee. As before, however, the total time period for response cannot exceed the statutory period (typically six months). Rule 1.136(a)(3) now provides that a general authorization to treat any reply as requesting any necessary extensions of time will be treated as containing a

petition for the proper extension of time.

## ABANDONMENT

The procedure for revival of abandoned applications and lapsed patents has been changed by amendment of Rule 1.137. The new Rule provides that an unintentionally abandoned application can be revived upon submission of a response and fee as before, but that the petition for revival must state that the entire delay, from the deadline for filing the reply until the filing of a grantable petition, was unintentional. Unlike the old version of the Rule, there is no longer an absolute one-year time limit for filing a petition under this section.

## APPEALS

The procedure for appeals to the Board of Patent Appeals and Interferences has been substantially altered by the new rules. For example, a Notice of Appeal under amended Rule 191 can be unsigned, and does not need to identify the appealed claims.

New grounds of rejection in the Examiner's answer are now forbidden by amended Rule 1.193(a). However, appellants may now file a timely reply brief as a matter of right, and the examiner cannot enter a new ground of rejection or respond to the appellant's reply brief unless the Examiner reopens prosecution (which he or she may do under amended Rule 1.193(b)(1)).

## Patent Litigation Highlights in the First Circuit During 1997

by Scott Rothenberger  
Lahive & Cockfield LLP

This article is the first in a series of articles that provide summaries of case decisions during 1997 of interest to the members of the BPLA. This article is devoted to decisions of the Federal District Courts in New England on patent cases. Future articles will focus on trademark decisions, and appellate decisions.

**McArdle v. Bornhofft**, 44 USPQ2d 1470 (D. Me. 1997)

Richard N. Hewes, of Hewes & Nye, Portland, Me., for Plaintiffs

Richard I. Samuel, of Cobrin, Gittes & Samuel, New York, NY; and Elizabeth A. Germani, of Friedman & Babcock, Portland, Me. for Defendant.

Plaintiffs, McArdle and VPP Corp., brought action against Defendant, Bornhofft, in the Superior Court of Maine, alleging breach of contract, defamation, and tortious interference with prospective economic advantage. Defendant subsequently removed the case to the Federal District Court on the grounds that Plaintiffs alleged patent infringement claims over which the Court had exclusive jurisdiction pursuant to 28 USC 1338. Plaintiffs filed a Motion to Remand to state court. Defendant contended that Plaintiff's tortious interference claims were in fact patent infringement claims.

Judge Brody held that even if Defendant's assertion was correct, the Defendant failed to show why this would require the court to resolve a substantial question of patent law. The fact that the allegedly tortious conduct of Defendant may also constitute patent infringement was irrelevant as "the party who brings suit is master to decide what law he will rely upon." Because the Plaintiffs' tortious interference claim did not arise under federal law, the court found that it lacked jurisdiction to consider the and remanded the case to Superior Court.

**Vitronics Corp. v. Conception Inc.**, 44 USP2d 1536 (D. N.H.)

Martin B. Pavane & William A. Alper, of Cohen, Pontani, Lieberman & Pavane,

New York, NY; Michael Lenehan & Gary L. Lane, of Ransmeier & Spellman, Concord, NH; and Lawrence M. Green, of Wolf, Greenfield & Sacks, Boston, Mass., for Plaintiff;

Paul Hayes & Dean G. Bostock, of Weingarten, Schurgin, Gagnebin & Hayes, Boston; George R. Moore, of Devine, Millimet & Branch, Manchester, NH; Kenneth A. Sweder, of Fialkow, Richmond & Rothstein, Boston; Lee A. Strimbeck, Littleton, N.H.; and David S. Philips, of Gottesman & Hollis, Nashua, N.H., for Defendant.

Plaintiff, Vitronics, brought action against Defendant, Conception, Inc., for infringement of U.S. Patent No. 4,654,502 which Defendant had assigned to Plaintiff. Defendant moved for stay of action pending completion of reexamination of the patent requested by Defendant. Plaintiff argued that the doctrine of assignor estoppel prevents one who has assigned rights to a patent from later contesting validity of the patent and, hence, Defendant was estopped from raising reexamination against it and therefore the stay should not be granted.

Chief Judge DiClerico ruled that the doctrine of assignor estoppel does not bar an assignor from filing for reexamination of the patent. The court found that because the doctrine is equitable in nature and reexamination provision are statutory mandates, the conflict should be resolved in favor of the statute and the motion to stay pending reexamination should be granted. The court stated that the statutory language does not limit who may apply for reexamination and that the Plaintiff's argument that the doctrine should bar the Defendant from asserting an unfavorable reexamination premature since the reexamination procedure could more precisely define the claims.

**Provide Technologies, Inc. v. East Coast Heat Seal, Inc.** 974 F. Supp. 65 (D. Mass.)

Steven H. Goldberg, Cosgrove, Eisenberg & Kiley, Boston, MA, for Plaintiffs;

David Murray, Forbes & Murray, Boston, MA, and Paul Newman, Braintree, MA, for Defendants.

Plaintiffs, Provide Technologies and Costa Chitouras, brought an action for infringement of U.S. Patents Nos. 5,460,674 and 5,370,761 disclosing methods for resealing toner cartridges and moved for partial summary judgment.

Defendant opposed the infringement motion and brought a cross motion for summary judgment asserting that Plaintiff's patents were invalid for concealing prior art from the USPTO during prosecution and/or the patent was unenforceable because Plaintiffs were restricting competition in violation of antitrust laws. The patents in issue were directed to methods for resealing reconditioned toner cartridges. The patented method required a sealing strip with adhesive pre-patterned to conform to the configuration of a gasket but the accused sealing strip consisting of an unpatterned bondable surface.

Judge Stearns found that Defendants did not infringe the patent literally and that further briefing was necessary to find infringement under doctrine of equivalents. The court stated that "[t]he doctrine of equivalents should not become a means of subverting the definitional and public notice functions of the Patent Act by expanding the claims of a patent beyond the parameters of what a skilled practitioner in the art would recognize as equivalent." The court continued that "a distinction without a difference would not defeat a claim under the doctrine of equivalents..." Plaintiffs were granted leave for 21 days for further briefing as to the existence of a triable issue of fact.

**Biogen v. Amgen**, 973 F. Supp. 39 (D. Mass.)

John Sylvia, Patrick T. Clendenen, Mintz, Levin, Cohen, Ferris, Glovsky & Popeo, P.C., Boston, MA, and James F. Haley, Kenneth B. Herman, Andrew S. Marks, Madge R. Kanter, Jane A. Marsaro, Janis P. McLaughlin, Kathleen M. Walker, Fish & Neave, New York City, NY for Plaintiff;

Paul F. Ware, Eileen M. Herlihy, Goodwin, Procter & Hoar, Boston, MA, Karen J. Kramer, Lloyd R. Day, Jr., David M. Madrid, Robert M. Galvin, Ricardo Rodriguez, Gary H. Ritchey, Darren B. Mitchell, Karen A. Gibbs, Cooley Goodward LLP, Palo Alto, CA, Steven M. Odre, Karol M. Pessin, Amgen, Inc. Thousand Oaks, CA, Vernon M. Winters, Cooley Goodward LLP, San Francisco, CA, for Defendant.

Plaintiff, Biogen, brought suit for infringement of U.S. Patent 4,874,702 which claims a "method of inducing production of human proteins in non-human "host" cells through recombinant DNA" and, specifically, "a technique for preparing a plasmid vector."

(Continued on page 5)

## Patent Decisions

(Continued from page 4)

Defendant, Amgen, moved for summary judgment, attacking the validity of the patent as anticipated in view of an abstract by Horn and Wells published in April, 1979 (more than a year prior to Biogen's earliest priority date.

Judge Stearns found that the abstract, which described preparation of plasmid vectors, did not anticipate the filing of the patent since the abstract did not enable one of ordinary skill in the art to reproduce a vector without undue experimentation. In its decision, the court analyzed the abstract, including the amount of direction or guidance presented, presence or absence of working examples, nature of the invention, state of the prior art, the relative skill in the art and the predictability or unpredictability of the art in 1979.

**Rome v. Galilean Seafoods, Inc.** 974 F. Supp. 97 (D. Mass.)

Howard Monte Rome, Rockport, MA, pro se, and Robert S. Wolfe, Wolfe Associates, Boston, MA, for Plaintiff,

David B. Gittelsohn, Soble, VanDam, Pearlman & Gittelsohn, Chestnut Hill, MA, Rosemary A. Traini, Gittlesohn, Traini & Cohen, Framingham, MA, for Defendant.

Plaintiff brought suit against Defendant for infringement of U.S. Patent No. 4,715,091 which discloses and claims a method of processing clams. Competitor (defendant) moved for summary judgment for noninfringement. The claims of the '091 patent recite a method for cleaning and preparing clam tongues, by 'butterflying' the tongues into cutlets. According to prior art cited in Plaintiff's patent specification, "none of the references disclose using the tongue or the foot of the clam as a one-piece food product."

Judge Keeton found that Defendant's process performs a substantially different function in a substantially different way for a substantially different result and, therefore, was not substantially equivalent. The patent in question required the clam tongue to be cut in half along a plane parallel to the flat surface of the tongue. In contrast, Defendant's process involved cutting the tongue on a plane perpendicular to the

flat surface.

## PTO PROPOSES ELECTRONIC FILE HISTORIES

Public Hearings were held on November 18, 1997 regarding a PTO proposal (62 Fed. Reg. 49471) for electronic recording of telephonic and personal interviews to ensure a fuller record of patent prosecution. Many speakers criticized the proposal because of the chilling effecting it could have on the willingness of examiners to grant interviews, and the present ability to have open and frank discussions during interviews. Others suggested the proposal would delay the examination process or add unnecessary costs to PTO operations.

### Announcing the 1998 WRITING COMPETITION sponsored by the BPLA 1st Prize: \$300 2nd Prize: \$200

will be awarded to the author of best article on a subject relating to the protection of intellectual property written or published between

Aug. 1, 1997 and July 31, 1998

#### CONTEST RULES

To be eligible for consideration, the articles must have been written solely by a student or students either in full time attendance at a law school (day or evening) within the jurisdiction of the First Circuit or prepared in connection with a course at a law school situated in the First Circuit. The article must be submitted to the Boston Patent Law Association on or before July 31, 1998. Papers should be no more than the equivalent of 10 law review pages including footnotes (30-40 pages typed copy). Submission of 5 copies is required. Submissions must include the submitter's name, current address, current telephone number, law school and employment, if applicable.

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

#### Send papers to:

The BPLA Writing Competition  
c/o Attorney Leslie M. Levine  
Transkaryotic Therapies, Inc  
195 Albany Street  
Cambridge, MA 02139

### Notice to All BPLA members who have not yet paid their 1998 dues:

The annual BPLA membership fee of \$40.00 is due by February 1, 1998. After that date a \$10.00 late fee is also due.

Membership renewal forms can be obtained from BPLA Treasurer David Thibodeau at (781) 861-6240 or via the internet from our web site  
[www.BPLA.org](http://www.BPLA.org)

## BPLA to Cosponsor Rich Moot Court Again Volunteer Judges sought to Hear and Grade

The AIPLA and BPLA are pleased to announce the 25th Annual Giles Sutherland Rich Moot Court Competition, Northeastern Regional Competition. This competition provides an opportunity for members of the New England intellectual property law community to meet and interact with top law students representing law schools from Boston, New York, Philadelphia, Washington, D.C., and other Northeastern cities. Many of these students will go on to become members of the local intellectual property law community. The oral arguments will take place at the Suffolk University School of Law in Boston during the weekend of March 20-22, 1998. All participants are invited to a reception immediately following the first round of arguments on Friday evening.

The Regional Competition relies on members of the local intellectual property community to volunteer to grade student briefs and to judge oral arguments. It is anticipated that 10 to 12 teams of students will compete this year, making it necessary to assemble a large number of volunteers. The BPLA asks you to consider volunteering as a brief grader or judge.

To volunteer, please contact John Berns via e-mail (berns@fr.com), phone (617-521-7026) or fax (617-542-8902) as soon as possible.

Each brief grader and judge will receive a copy of the problem and a bench memorandum on which arguments for each side of the issue will be based. In mid-February, student briefs and grading forms will be provided to the volunteer brief graders, who will be asked to read the briefs critically and to grade them accordingly. The grading forms must be returned by Wednesday, March 12, 1998.

Each volunteer judge will sit on a panel of three judges; each round of arguments should take about an hour. Thereafter, the judge panel will grade the participants and provide their comments. Approximately 21 judges will be needed for the first round of arguments on Friday evening, March 20, 1998 from 6:00PM to 9:00PM. Twelve judges will be needed for Saturday, March 21 from 10:00AM to 1:00PM, and three judges will be needed to preside over the final round on Sunday, March 22 from 10:00AM to 3:30PM. All BPLA members are encouraged to participate on Friday and Saturday when there is the greatest need.

## Letter to the Editor

### *Martindale Hubble Scam*

Recently, several members of my firm have received email messages soliciting confirmation or updates of their e-mail addresses. This message was purportedly sent by Martindale Hubbell's Editorial Department.

The reply address, however, is not from Martindale Hubbell, but from a group apparently in Egypt called the International Advanced Studies Institute (advstudies.org).

We have independent confirmation from Martindale Hubbell that this is a false message.

Replying to the message will only confirm to the sender that your address is active, and it belongs to the attorney listed in the Martindale Hubbell publication. It is likely that this group is compiling a list of e-mail addresses to be used for future solicitation purposes.

We thought the BPLA should be aware of the deception behind this message.

David S. Resnick,  
Dike Bronstein Roberts  
& Cushman LLP

## Barney Frank Speaks

*(Continued from page 1)*

electronic communications. Frank explained that the federal government has treated electronic communications (e.g., over the radio and television frequencies) as a different type of speech subject to greater restriction because of limited bandwidths available and the need to allocate such communications to those that were most likely to serve the public good.

However in this case of internet communications, Frank opined that there was no compelling government interest in restricting speech and, to the contrary,

electronic communications in the future are more likely to assume many of the same functions that public oral speech traditionally has served.

Frank also answered questions from the floor. He was asked about his position on the pre-grant publication provisions of H.R. 400. In response he told the audience that he was leaning in favor of publication but had an open mind. He explained that the House bill included provisions that address the most problematic issues. (The proposed legislation would allow patent applicants who qualify for small entity status and do not file abroad to request exemption from the 18 month publication requirement.)

Frank expressed support for the gen-

eral concept of pre-grant publication because it can provide companies with greater certainty with regard to patent clearance for new products.

## BPLA Committees

It will be several months before new committee lists can be compiled from membership renewal forms. In the interim, members are encouraged to contact the committee chairpersons listed below to have their names added to committee rosters. (For committees that have co-chairs, please contact the person marked by the asterisk.)

### Activities and Public Relations

Ingrid A. Beattie  
(617) 542-5070

### AIPLA Moot Court

\*Jason A. Reyes  
(617) 542-5070  
Robert J. Silverman  
(617) 542-5070

### Antitrust Law

\* Paul R. Gupta  
(617) 338-2482  
Martin O'Donnell  
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### Biotechnology

\* Patricia A. McDaniels  
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Doreen M. Hogle  
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### Chemical Practice

Peter F. Corless  
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### Community Services

David J. Powsner  
(617) 248-5000

### Computer Law

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

### Copyright Law

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Thomas M. Saunders  
(617) 227-0700

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\* Walter Dawson  
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Faith F. Driscoll  
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### Ethics and Grievance

Henry S. Miller  
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### International and Foreign Practice

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Barry W. Chapin  
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P.C. Lall  
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Steven M. Bauer  
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Peter M. Dichiaro  
(617) 526-6466

### Trade Secrets

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

### Trademarks & Unfair Competition

\* Michael A. Albert  
(617) 832-1175  
Donna M. Weinstein  
(617) 542-5070

### Biotechnology Committee Report:

The Biotechnology Committee is planning to invite a representative of John Doll's office for a panel discussion with representative practitioners in March or April. Several "disclosures" will be distributed to the panelists ahead of time, and the panelists will be asked to devise

sets of claims they think are supported by the "disclosures". Ms. Margaret Parr of the PTO is enthusiastic about the approach, both as a BPLA discussion and as a training mechanism for Chemical Matrix examiners. At this time "disclosures" directed to a small molecule invention, an EST invention, and a monoclonal invention are being prepared. Suggestions for other "disclosures" are welcome. A second PTO presentation is being planned for June at which a PTO representative will instruct local practitioners on the new version of PatentIn and the new sequence listing rules. The timing of this presentation will depend somewhat on release of the new version of PatentIn to beta testing sites and the exact date that the new sequence listing rules will go into effect.

A panel discussion on licensing issues by technology transfer officers from local universities and hospitals is also planned.  
- Pat McDaniels and Doreen Hogle

The BPLA is happy to announce that the winners of the 1997 Writing Competition (in a tie for first place) are:

#### **Marianne McLaughlin**

Suffolk Law School, '97  
for her paper

"Protecting Investment Instead of Innovation--Is A New Copyright Regime Necessary for Databases and Other Compilations" and

#### **Robert Greenberg**

Boston University School of Law  
for his paper

"Database Copyrightability: A Technical Correction"

Ms. McLaughlin and Mr. Greenberg will each receive a \$250 award from the BPLA for their work

## UPCOMING EDUCATIONAL EVENTS

### April 16-17 - PCT Practice

The BPLA will sponsor a two day training seminar by the World Intellectual Property Organization on practicing under the Patent Cooperation Treaty to review filing procedures and discuss the latest revisions in PCT practice. The seminar will cover all aspects of PCT practice from filing an initial request under Chapter I of the Treaty through Preliminary Examination and entry into the national phase. Look for a future mailing announcing the time and location.

### Early May - International Trademark Practice

During the week of the International Trademark Association meeting in Boston (May 9-13), the BPLA will present a seminar on international practice and invite some of the distinguished guests to a panel discussion of current topics in international trademark practice. Again look for a future mailing announcing the time and location.

## Positions Available

**Lahive & Cockfield, LLP** seeking motivated patent attorneys with at least 1-2 years patent experience in prosecution of biotechnology patents. A Ph.D. or equivalent work experience is desired. Send resume to Hiring Partner, Lahive & Cockfield, 28 State Street, Boston, MA 02109 or via facsimile to (617) 742-4214 or via e-mail to alh.@lahcoc.com

**Polaroid Corporation** seeks Patent Attorney with 2-5 years experience in electronic arts, along with substantial prosecution experience and a technical background in digital signalling techniques. Send resume to Executive Recruiter /DML/ Ingalls, 8th Floor, 1 Design Center Place, Boston, MA 02210.

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