



# THE BOSTON PATENT LAW ASSOCIATION NEWSLETTER

*Serving the  
New England  
Intellectual  
Property Bar  
Since 1924*

April 30, 1998

Volume 29, Issue 2

## INTERNATIONAL TRADEMARK ASSOCIATION MEETS IN BOSTON IN MAY BPLA NEGOTIATES DISCOUNT FOR MEMBERS

The International Trademark Association (INTA) will hold its 120th Annual Meeting in Boston next month from May 9 to May 13. The meeting will officially open on Monday, May 11, 1998. Members of the BPLA will be able to register at the discounted INTA member rate of \$795. (The non-member rate would otherwise be \$1270.)

The four day meeting of INTA is expected to be very well attended with thousands of practitioners from all over the world. The INTA meeting serves as a meeting place for the

worldwide trademark community. The meeting should provide an opportunity to network with more than 4,500 trademark and other IP professionals from 120 countries, participate in informal roundtable discussions and learn about the latest products and services available from INTA.

During the four day meeting, speakers will address new developments and practices, particularly in Europe and in the Asia-Pacific Rim region, as well as trademark issues elsewhere around the world. The program will also include basic and advanced trade-

mark and brand management seminars as well as industry-specific breakout sessions.

BPLA President Tim French, a member of the INTA and active on its long range planning committee was instrumental in securing a discount for BPLA members. Although many of larger IP firms in Boston are members of INTA, most practitioners, especially solo practitioners and those in corporate practice, are not.

The keynote speakers will in-

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## BPLA RETAINS PROFESSIONAL AGENCY ALLIANCE BUSINESS CENTERS TO PROVIDE SUPPORT SERVICES

The BPLA now has an address: 8 Faneuil Hall, Boston MA 02109 and phone number: 617-973-5021.

Last month the BPLA Board of Governors approved a contract with Alliance Business Centers to have the group serve as the Association's clearinghouse for inquiries and to provide support services.

Alliance Business Centers' Faneuil Hall office will receive mail, and provide personalized telephone answering services for the BPLA, as well as distribute membership applications, maintain the Association's roster and provide support services for the mailing of announcements and newsletters.

Alliance Business Centers (ABC) is one of the nation's fastest growing

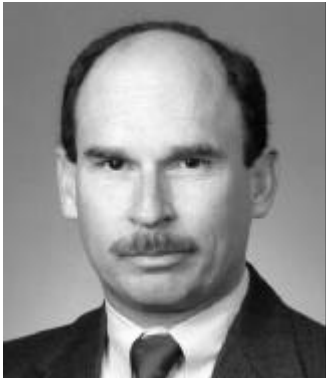
providers of executive office space. The Company currently has offices in three Boston locations and provides fully staffed office space on short notice as well as provide support services for "virtual offices."

Pam Giordano, ABC's representative for the BPLA account looks

forward to working with the Association to meet its present and future needs. She hopes that individual BPLA Members and their start-up businesses will also find ABC's services attractive.

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By Tim French  
Fish & Richardson, P.C.

As mid-April and tax time approach, we find that both the weather and the BPLA activities schedule have warmed perceptibly. Thanks to a cadre of active committee co-chairs this year, we find ourselves with several events scheduled during each of the Spring months.

Already during April, an afternoon seminar, entitled "Overview of Patent Litigation," has played to an overflow crowd, and a luncheon presentation on biotech patent claiming, entitled "Why are These Claims Allowable," was booked to capacity.

The seminar was organized by the Litigation Committee, chaired by Steven Bauer and Susan Glovsky. Speakers included Christopher Barry, Steven Bauer, John Cotter, Susan Glovsky, Dana Hubbard, Janice Mueller, John Regan, John Skenyon, Philip Swaim and David Thibodeau. The luncheon was hosted by the Biotechnology Committee, which is chaired by Doreen Hogle and Patricia McDaniels.

The BPLA also hosted a two-day practice seminar, conducted in cooperation with the World Intellec-

## Message from BPLA President Tim French

tual Property Organization (WIPO), on "Basic Patent Cooperation Treaty (PCT) Training." This year's speakers were Louis Maassel, consultant to the PCT Legal Division of WIPO, and Carol Bidwell, supervisor of the PCT Special Programs Office of the U.S. PTO. If you were not able to attend, but would like to obtain a copy of a very complete manual of materials, please see the announcement elsewhere in this Newsletter.

In May, the International Trademark Association will visit Boston for its 119th Annual Meeting. Prior to the meeting, which is scheduled for May 9th through 13th, a member of the INTA Board of Directors will brief the BPLA on issues facing the international trademark community. Also, BPLA members will be permitted to register for the INTA Annual Meeting at the INTA member rate. For details, see the announcement elsewhere within this volume of the Newsletter.

Also, on Tuesday, May 12th, from 4 to 6 PM, the Trademark Committee and the Foreign and International Law Committee of the BPLA will co-host a seminar conducted by a panel of trademark practitioners from all regions of the world. This seminar will take advantage of the visit to Boston of 3,500 trademark attorneys and agents for the INTA Annual Meeting.

On Friday, May 29th, the Boston Patent Law Association will hold its Annual Judges Dinner at Bose Corporation on The Mountain in Framingham. The keynote speaker will be the Honorable Arthur J. Gajarsa, of the Federal Court of Appeals for the Federal Cir-

cuit. Formal invitations will be mailed in a few weeks.

In June, the Trademark Committee will host a luncheon with John Bliss, President of the IACC, speaking on issues of trademark counterfeiting, and the Biotech Committee is planning a luncheon with a speaker from the U.S. Patent and Trademark Office on the new sequence listing rules.

Plans are also in the works for the annual BPLA Summer Outing, which this year will be a tailgate picnic at a New England Revolution Major League Soccer game in Foxboro. The time and date will be announced later.

Finally, for those who like to plan ahead, the BPLA Annual Meeting will be held on December 2nd. The speaker will be Q. Todd Dickinson, recently nominated as Deputy Assistant Secretary of Commerce and Deputy Commissioner of Patents and Trademarks.

If you have thoughts or comments on 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

8 Faneuil Hall, Boston MA 02109

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#### Board of Governors:

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# Supreme Court Grants Certorari To Hear On-Sale Bar Case

by Megan Williams  
Lahive & Cockfield, LLP

The Supreme Court will review the Federal Circuit's holding in *Pfaff v. Wells Electronics, Inc.*, (43 USPQ 2d. 1928 (Fed. Cir. 1997)) that an invention does not have to be reduced to practice in a physical embodiment at the time of sale in order for the on-sale bar under 35 U.S.C. §102(b) to apply.

The Supreme Court has granted review of the question "In view of the longstanding statutory definition that the one-year grace period to an 'on sale' bar can start to run only after an invention is fully completed, should the Pfaff patent have been held invalid under 35 USC 102(b) when Mr. Pfaff's invention was admittedly not 'fully completed' more than one year before he filed his patent application?"

Pfaff was asked by Texas Instruments to develop a socket for semiconductor chip carriers. Pfaff sent detailed engineered drawings out for tooling and production in February or March of 1981. On April 8, 1981, Delta V., a company acting on Texas Instrument's behalf, placed a purchase order for sockets confirming a verbal offer of March 17, 1981. The sockets were not tested and shipped to Delta until July, 1981. Pfaff's patent application was filed on April 19, 1982.

The district court found that the invention had not been reduced to practice at the time of sale because it had not yet been built (*Pfaff v. Wells* at 1931). The CAFC reversed, ruling that there was no need for a physical embodiment of the invention to exist at the time of the offer for sale, but rather the invention need only be "substantially complete" (*Pfaff v. Wells* at 1932). The CAFC found Pfaff's invention to be substantially complete since the customized tooling and fatigue testing steps performed after the sale were routine or not relevant to the on sale bar analysis (*Pfaff v. Wells*, 1932-1933).

Pfaff's petition for certorari asserted that the "substantially completed" rule adopted by the CAFC undermines Congress's intent to provide inventors with a predictable standard for determining when the one year grace period begins and is in contradiction to a substantial body of case law. Pfaff further argued that the retroactive application of the "substantially completed" standard is a violation of the Fifth Amendment "Takings Clause."

Respondent Wells contended that Pfaff knew that his sockets would work and that an inventor should be strictly held to filing a patent application within one year of any commercialization of the invention, citing *General Electric Co. v. United States*, 654 F2d 55 (CtCl 1981) in which no reduction to practice was required to create an on-sale bar.

## PCT SEMINAR MATERIALS

Copies of the detailed training materials from the recent BASIC PCT TRAINING SEMINAR conducted in cooperation with the World Intellectual Property Organization are available at a cost of \$50 per set. Contact Ms. Kelly Largey at 542-5070 (largey@fr.com) while they last.

## PCT SEMINAR PROVIDES PRACTICE TIPS

By Angelica Martinez  
Lahive & Cockfield, LLP

The Basic PCT Practice Seminar held on April 16-17 was well received by attendees. The speakers included Louis Maassel, a consultant to PCT Legal Division of WIPO and Carol Bidwell, the supervisor of the PCT Special Programs Office.

The seminar introduced to attendees to the PCT System as an alternative to traditional foreign filing practices and step-by-step instructions on filing International applications, including the Request form, the application format; and required fees. The speakers also explained the International Search procedure; and the differences between the United States Patent and Trademark Office (USPTO) and the European Patent Office (EPO) as an International Searching Authority.

The seminar provided instruction on the formalities of demanding International Preliminary Examination, including necessary signatures and timing issues, as well as the difference between USPTO and EPO preliminary examination. The seminar also covered fees payable under the PCT, including filing and examination fees, and procedures for refunds.

The speakers explained the significance of the various forms issued by the Receiving Offices, Examining Authorities and WIPO, including PCT Forms IB/301; IB/308; RO/198; RO/199; the Written Opinion; and the International Preliminary Examination Report.

In the afternoon, the speakers addressed the requirements for entry into the national phase; special requirements of particular countries; and the time limits for entering national/regional phase processing after PCT Chapter I or II.

## 1997 Trademark Litigation Highlights in the First Circuit

by Scott Rothenberger  
Lahive & Cockfield LLP

This article is the second 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 trademark cases.

*Chrysler Corp. v. Silva*, 118 F. 3d 56 (1st Cir.)  
Jerre B. Swann, of Kilpatrick & Cody Atlanta, GA; Robert D. Caltice, of Goldstein & Manello, Boston, MA,  
and Eric M. Dobrusin, of Harness, Dickey & Pierce, Troy, MI, for Plaintiff.  
Anthony M. Fredella of Fredella & Wheller, Somerville, MA, for Defendant.

Plaintiff, Chrysler Corporation, brought action against Defendant John C. Silva, Jr., in Massachusetts District Court for trademark infringement, specifically trade dress infringement for copying Chrysler's Dodge Viper. Defendant counterclaimed, alleging that Chrysler had stolen the allegedly infringing design from him. The District Court ordered summary judgment for Defendant on complaint, and judgment for Plaintiff on counterclaim. Both parties appealed.

During the District Court trial, Defendant had testified that he contacted Plaintiff and offered to sell Plaintiff a car design dubbed the "Mongoose," for which he included sketches of the vehicle. Defendant claimed that he received no response and that the sketches were not returned. Two years later Defendant Silva produced a custom car based on his earlier designs. When Chrysler's Viper was publicly introduced, Silva also called Plaintiff and eventually spoke with an in-house attorney who, upon learning of Silva's custom "Mongoose," demanded that Defendant destroy the vehicle. The Court found that photographs of the Viper served as a starting point for the car body designed by Defendant but that Defendant made significant modifications to the design of the Viper.

On appeal, Judge Cyr and Senior Judges Campbell and Aldrich reversed the District Court's judgment on the complaint and granted Plaintiff a new

trial. At the same time, the Court affirmed the denial of Defendant's counterclaim, ruling that if Defendant's testimony of significant variances by which the Mongoose departed from the Viper were correct, it was hard to understand how Chrysler could have pirated the Mongoose design. The court reasoned that, while a party's pleadings may be inconsistent, in the final analysis, one cannot have it both ways and therefore held Defendant estopped from asserting misappropriation.

*Digital Equipment Corp. v. Altavista Technology, Inc.*, 960 F. Supp. 456 (D. Mass.)  
Shepard M. Remis, and Victoria C. DeMaret, of Goodwin, Procter & Hoar, Boston, MA, for Plaintiff.

Mark Schonfeld, Ieuan-Gael Mahony, of Sherburne, Powers & Needham, Boston, MA for Defendant.

Plaintiff, Digital Equipment Corp., owner of the trademark "AltaVista" sought preliminary injunction against Defendant, AltaVista Technology, Inc., for breach of a trademark licensing agreement, trademark and service mark infringement, unfair competition and trademark dilution.

Plaintiff owned an Internet and World Wide Web "search-engine" service known as AltaVista. Plaintiff purchased Defendant's rights in the trademark "AltaVista" and licensed back to Defendant, the right to use the trademark as part of Defendant's corporate name and as its Uniform Resource Locator ("URL"). The license agreement precluded Defendant from associating the trademark with "the name of a product or service offering". Shortly after the license agreement was signed, Defendant changed the appearance of its website to closely resemble that of Plaintiff's. Over time, Defendant changed its website to sell software under the name "AltaVista" and linked its website to Plaintiff's search engine (including reference to Plaintiff's search engine). In short, a visitor to Defendant's website could easily have thought they were actually using Plaintiff's website.

Judge Gertner found that Defendant's actions breached the license and that the license expressly authorized only two uses of the trademark; use of the trademark "AltaVista" as part of the cor-

porate name and as part of the URL. Judge Gertner also found that Plaintiff was the owner of the mark, used the mark in interstate commerce and that unauthorized use by Defendant would cause confusion as to the origin of the goods or services.

The court determined the likelihood of confusion by applying the eight factors of the *Pignons'* case to the "AltaVista" trademarks. Judge Gertner found that the trademarks were remarkably similar, the goods and services were similar, the channels of trade were similar, that there was actual confusion between the trademarks, that Defendant admitted to intentionally benefiting from use of Plaintiff's trademark as a service mark, and that the trademark was a suggestive mark, into which significant amounts of money and energy were invested.

The court held that there was a strong likelihood of confusion by Defendant's continued use of the trademark and that Plaintiff had met its burden for preliminary injunctive relief to stop irreparable harm that could arise from such confusion.

*Lanier Group v. Bandwagon, Inc.*, 983 F. Supp. 292 (D. Mass.)

Steven N. Fox, of Fox & Associates, P.C., Canton, MA, for Plaintiff.

William Hilton, Maurice Gauthier, Sibley Reppert, of Samuels, Gauthier & Reppert, Boston, MA, for Defendant.

Plaintiff, Steven Lanier, sought a preliminary injunction against Defendant, Bandwagon, Inc., for trademark and trade dress infringement under the Lanham Act. Plaintiff produced and sold a telescoping portable backscratcher to mail order catalogs, which resold the item to their customers. Defendant Bandwagon developed a similar backscratcher which it planned to sell through mail order catalogs at a substantially lower cost than Plaintiff's backscratcher. Plaintiff's nickel plated backscratcher resembled a telescoping television antenna having six telescoping segments with a small, four pronged bent lobster fork at the distal end and a pen clip. Defendant's backscratcher was a larger version of Plaintiff's product with the fork being double in size and having 6 prongs.

(Continued on page 5)

## Trademark Decisions

(Continued from page 4)

Judge Saris found that the trade dress of Plaintiff's backscratcher had four elements: the shape of the fork, the telescoping handle, the pen clip and shiny nickel plating and that taken together, or separately, these elements were not inherently distinctive. The court concluded that Plaintiff's assertions of trade dress were merely descriptive of functional aspects of the product and that such elements inherently could not identify a particular source and hence could not be protected. Judge Sarkis reasoned that "the Court could no more protect a dinner fork from copying." Accordingly, preliminary judgment was denied.

*Maple Grove Farms of Vermont, Inc. v. Euro-Can Products, Inc.*, 974 F. Supp. 85 (D. Mass.)

Richard L. Binder and Jack R. Pirozzolo, of Wilcox, Pirozzolo & McCarthy, Boston, MA, for Plaintiff.

Edward T. Robinson and Michael B. Cosentino, of Seegel Robinson & Lipshutz, Wellsley, MA, for Defendants.

Plaintiff, Maple Grove Farms, a maple syrup producer sought damages and a permanent injunction under the Lanham Act against Defendants, Spring Tree Corporation, a maple syrup producer, and its distributor, Euro-Can Products, Inc. Defendant's motion for summary judgment on all counts denied.

Plaintiff was the primary supplier of maple syrup to BJ's Wholesale Club until the spring of 1994 when BJ's began purchasing maple syrup from Defendants at a lower price. BJ's repeatedly gave Plaintiff opportunities to match lower Defendant's price.

Plaintiff bought jugs from Hillside Plastics, Inc., one of the nation's largest producers of maple syrup jugs, and printed a bright green and red design on red-lidded, almond-colored Hillside jugs. The design included a vertically-oriented oval which contained a farmhouse-barn-silo image and the words "maple grove farms" written in red. The sides of the jug displayed a woodland scene which included a snow covered red building, sap buckets hanging on maple trees, a wood pile, an ox, and men in red jackets laden with sap buckets striding through snowy woods. A border of thirteen red maple leaves circled the bottom of the jug.

Defendant's almond colored jug also included a red plastic lid but had a

horizontally-oriented oval in which there were three red maple leaves and the name "Red Leaf Farms" printed in green. On either side of the oval was a woodland scene which contained a red building with a snow covered roof, a woodpile, several dark green trees on which red sap buckets were attached, and a man wearing a red shirt carrying red sap buckets from the trees. The entire design was in bright red and green.

Judge Ponsor's decision adopted the Report and Recommendation of US Magistrate Neiman which found that an injunction was moot as Defendant was no longer using the syrup jugs in question. However, the court found that a reasonable jury could conclude that the combination of elements on Plaintiff's jug could render the jugs inherently distinctive and that genuine issues of fact existed. Moreover, the court found Defendant's assertions unavailing since BJ's did not accept Defendant's product, even at a price lower than Plaintiff's, until the maple syrup was packaged in a maple syrup jug that was similar to Plaintiff's maple syrup jug.

### Reminder: 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 were due by February 1, 1998. A \$10.00 late fee is also due for renewals at this time. 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)

## G.W. Law Team Wins Regional Moot Court Suffolk Team Takes Second in Giles Rich Competition

By John M. Berns and  
Merton E. Thompson  
Fish & Richardson, P.C.  
Co-Chairs, BPLA Giles Rich Moot  
Court Competition Committee

The 25th Annual Giles Sutherland Rich Moot Court Competition, N.E. Regional Competition, sponsored by the AIPLA and BPLA, was a great success, thanks to all who participated.

Nine teams from around the country competed in what was one of the premier moot court competitions in the nation.

The winning team consisted of **Boading Hsieh Fan** & **Peter M. Midgley** from George Washington University Law School. The runners-up were **Jacqueline Gonzalez** and **James J. Richards** of Suffolk University Law School. Both of these teams will advance to the national finals in Washington. We hope for a repeat of last years 1-2 finish for the Northeastern representatives.

The Giles S. Rich Moot Court Committee would like to express its apprecia-

tion to the numerous volunteers who made the competition a success. William Gosz, Philip Koenig, Robin Longo, Robert Silverman, Thomas Tuyschaevers, Timothy Murphy, Eileen Herlihy, David Mello, David Suhl, Thomas Saunders, Bob Rigby, Russell Binns, Jr., John Gunther, Michael Siekman, Denise DeFranco, Paul Pysher, Robert Clark, David Ries, Richard Gamache, David Powsner, Paula Campbell, David Lane Jr., Robert Sayre, Sue Maloney, Charles Eric Schulman, David Johnson, Jason Reyes, Charles Hieken, Joseph Lichtblau, Craig Smith, David Cerveny, Kurt Glitzenstein, Jolynn Lussier, Thomas Workman, and Edward Kriegsman all volunteered their time as judges. Robert Greenberg, Mike Healen, Nan Wu, and Marc Wefers volunteered as bailiffs. A sincere thank you to all!

## INTA Meets in May

(Continued from page 1)

clude Dr. Kamil Idris, Director General of the World Intellectual Property Organization (WIPO), Mr. Doug Hall of Eureka Marketing and Mr. Roderick McGeoch of the Sydney Organizing Committee for the 2000 Olympic Games.

The program for Monday, May 11th will include seminars on trade dress protection, choosing and using a local language mark, searching a clearing a mark and combating counterfeiting.

Tuesday, May 12th's program will feature workshops on trademark protection in Eastern Europe and the former Soviet Union, as well as trademark issues on the Internet.

Seminars for Wednesday May 13 will include a review of recent Federal

Court decisions, TTAB practice and Asian developments.

The Annual Meeting and seminars will be spread out between the Marriott and Weston Hotels in Copley Place, the Sheraton Boston Hotel at the Prudential Center and the Hynes Convention Center.

For information or registration materials call 212-768-9887 x.157 or fax requests to the INTA at 212-768-1234 or visit the INTA's website at [www.inta.org](http://www.inta.org).

## Positions Available

**Lahive & Cockfield, LLP** seeking motivated patent attorneys with at least 1-2 years patent experience in prosecution of electrical patents. An advanced degree 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](mailto:alh.@lahcoc.com)

**Genetics Institute, Inc.** seeking a registered patent attorney with 2 to 7 years experience in patent prosecution and drafting in the field of biotechnology. Licensing and opinion experience desirable as would be experience in organic chemistry and other pharmaceutical practice, or advanced degree in the molecular fields. Send resume and salary requirements to Steve Lazar, Senior Patent Counsel, Genetics Institute, Inc., 87 CambridgePark Drive, Cambridge, MA 02174 or via facsimile to (617) 876-5851.

**Lappin & Kusmer LLP** - seeks Patent Attorney with 5-8 years experience in biotechnology patent writing and prosecution, client counseling, patent portfolio management and strategizing, technology licensing and transfer, and experience working with VC firms, patent bar required, advanced degree (Ph.D.) in biological or medical discipline preferred. Excellent writing and communicating skills required. Preference given to portable billings. Partnership opportunity. Send resume and writing sample to Hiring Partner, Lappin & Kusmer LLP, 200 State Street, Boston MA 02109.

**Clark & Elbing LLP** is looking for Ph.D. biologists and chemists who are interested in patent prosecution and licensing work. Excellent scientific, writing and oral skills are required. One or more years of patent law experience is preferred. A J.D. is desirable, but not required. Interested individuals should send a resume and writing sample in confidence to Kristina Bieker-Brady, Hiring Attorney, Clark & Elbing LLP, 176 Federal Street, Boston, MA 02110.

**Millennium Pharmaceuticals, Inc.** seeking bright, innovative patent agent/tech specialist. Req: BS in life sciences; 1 year exp drafting applications in biotech or chemistry; excellent science, communications and interpersonal skills. Ph.D. and patent bar a plus but not required. Also seeking patent counsel to advise, identify and develop strategies for small molecule discovery program and to oversee preparation and prosecution of patents. Ph.D. (Chemistry), J.D. and 5-8 yrs exp. Contact Jackie Hodges at (617) 679-7192. Send resume to JH, Human Resources/Employment, Millennium Pharmaceuticals, 238 Main Street, Cambridge MA 02142 1017 or via fax (617) 225-0884 or email to [jhodge@mpi.com](mailto:jhodge@mpi.com)

**Small Manchester New Hampshire IP firm** seeks associate for its growing IP practice. Mechanical or electrical background preferred. call Hiring Partner at 603-624-9224. or e-mail resume to [patent@tiac.net](mailto:patent@tiac.net).

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## BPLA Committees

New committee lists are still being 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

\**Merton E. Thomson (617) 542-5070*

*John M. Berns (617) 542-5070*

The N.E. Regional Giles Rich Moot Court Competition was held on March 20-22. (See story on page 6.)

### Antitrust Law

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

*Martin O'Donnell (617) 951-2500*

### Biotechnology

\**Patricia A. McDaniels (603) 437-8970*

*Doreen M. Hogle (781) 861-6240*

The Biotechnology Committee presented a seminar on April 9th entitled; "WHY ARE THESE CLAIMS ALLOWABLE?" Mock invention disclosures: on expressed sequence tags, monoclonal antibodies and a novel small molecule were examined by three panelists.

### Chemical Practice

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

*Madge Kanter (508) 872-8400*

### Community Services

*David J. Powsner (617) 248-5000*

### Computer Law

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

*Lee Carl Bromberg (617) 443-9292*

### Copyright Law

\**Charles L. Gagnebin (617) 542-2290*

*Thomas M. Saunders (617) 227-0700*

The Computer Law and Copyright Law Committee jointly presented a Luncheon Meeting on Wednesday, January 28, 1998 on the topic "COPYRIGHT AND THE INTERNET". The Luncheon Speaker was Mark Fischer.

The BPLA held, as its spring activity, a

joint session with the BBA Arts and Entertainment committee, cochaired by Lucy Lovrien and Howard Zaharoff. The meeting focused on a discussion on: derivative works and the perpetual struggle between protection of what would clearly be copyrightable had the underlying work been in the public domain and interference with the underlying work; the Feist decision and the level of activity required to reach the statutory threshold for protection; and the recent First Circuit decision on the Leibovitz photo of Demi Moore and the new standard of parody since *Acuff-Rose*.

### Corporate Practice

\**Walter Dawson (978) 452-1971*

*Faith F. Driscoll (978) 294-6165*

The Corporate Practice Committee met on May 19, 1998 at 8:30 AM at the offices of Arthur D. Little in Cambridge. Ronald Reiling of Digital Equipment Corp. will speak on "Pending Patent Reform Legislation." BPLA members who plan to attend are requested to contact Walter Dawson at 978-452-1971.

### Ethics and Grievance

*Henry S. Miller (508) 448-3130*

### International Practice

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

*Thomas A. Turano (617) 248-7378*

The Foreign and International Law Committee, in cooperation with the Trademark Committee, will host a seminar on Tuesday, May 11th, from 4 to 6 PM. The seminar will be conducted by a panel of trademark practitioners from all regions of the world visiting in Boston for the 120th Annual Meeting of the International Trademark Association. A program of foreign patent practitioners is also in the works for this Fall.

### IP Law Career

*Linda M. Buckley (617) 523-3400*

### Law Students

\**Janice M. Mueller (617) 573-8171*

*Barry W. Chapin (718) 861-6240*

### Licensing

\**Gregory B. Butler (617) 225-0600 P.C.*

*Lall (401) 841-4736 x 24221*

### Litigation

\**Susan Glovsky (781) 861-6240*

*Steven M. Bauer (617) 248-7594*

The Litigation Committee presented a seminar on April 8th entitled: "OVERVIEW OF PATENT LITIGATION." Speakers included Christopher Barry, Steve Bauer, John Cotter, Susan Glovsky, Dana Hubbard, Janice Mueller, John Regan, John Skenyon, Philip Swain and David Thibodeau. In addition to litigation strategies, the panelists addressed opinions of counsel, pre-litigation investigations and Markman hearings.

### Patent Law

\**David S. Resnick (617) 523-3400*

*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*

On June 10, from 12-2 PM, John Bliss of the International Anti-Counterfeiting Coalition will speak on trademark counterfeiting at the Meriden Hotel.

## UPCOMING EDUCATIONAL EVENTS

### May 9-13 International Trademark Association Annual Meeting

INTA comes to town. (See cover story.) BPLA members can register for the \$795. discounted INTA member rate. Call Monica Laws of INTA at 212-768-9887 x. 149 for details and registration forms or download from [www.inta.org](http://www.inta.org).

### May 11 BPLA's Own International Trademark Practice Seminar

Various speakers from the INTA will provide the BPLA with a distilled report on global trademark developments on May 11 at the Boston Park Plaza Hotel. Look for more details and registration materials in the mail.

### May 19 Mass. Biotechnology Council Annual Symposium

All-day symposium at the Museum of Science, including presentations on roles of proteases in disease and prevention, cellular expression of proteins, embryonic growth factors, and mammalian cloning. \$125 MBC members, \$175 non-members \$20 students. Call MBC at 617-577-8198 for registration forms.

### May 29 Annual BPLA Judges Dinner

This year's dinner dance and tribute to the members of the First Circuit Federal Judiciary will be held at the Bose Corporation World Headquarters in Waltham. Look for more details and registration materials in the mail.

### June 10 BPLA Luncheon Meeting on Unfair Competition

John Bliss of the Anti-Counterfeiting Coalition will speak at the Meridian Hotel.

### June 25-27 Summer Meeting of the Licensing Executives Society (LES)

LES's summer meeting will include numerous workshops and a special hands-on negotiating session. Call 703-836-3106 for details and registration materials.

## Positions Available

(Continued from page 6)

**Eaton Corporation** seeks Patent Atty for its Beverly, Massachusetts R&D/semiconductor equipment facility. EE/Physics background, patent bar registration and 1-5 years experience required. Contact Donald Rowe, General Patent Counsel at Eaton Corporate Headquarters, Eaton Center, Cleveland, OH 44114, Tel. no. 216-523-4555

**Weingarten, Schurgin, Gangnebin, & Hayes LLP** seeks patent atty. with degree in Chemistry or Biochemistry. Strong qualifications in organic/polymer chemistry, catalysts, pharmaceuticals. Responsibilities include preparation and prosecution of domestic/foreign patent applns, client counseling. Min. 2 yrs exp required. Salary competitive. Send resume to Hiring Partner, WSGH, 10 Post Office Sq., Boston MA 02109

**Wolf Greenfield and Sacks, P.C.** seeking exceptional lawyers with degrees in science/ engineering, industrial experience or advanced degrees preferred. Particular needs: computer science, EE with 1-3 years patent prosecution exp; mechanical engineering with at least 2 years exp; biotech, at least two years experience; laterals with chemistry or biotech backgrounds and at least 15 years experience. Contact Timothy Oyer, Esq., Wolf Greenfield and Sacks, P.C. 600 Atlantic Ave, Boston, MA 02210

### In-House Corporate Patent Attorney Sought

Major Semiconductor Corp based in Maine seeks patent atty to manage portfolio. Successful candidate will be first in-house IP counsel. EE degree and semiconductor experience required.. Min. 5 years experience. Send resume to Kate Oliver, 333 Western Avenue, M/S 01-05, South Portland Maine 04106

### Dike, Bronstein, Roberts & Cushman, LLP

seeking: 1) Tech Specialist with a Ph.D. in biochemistry, molecular biology, immunology, or other biotech discipline, at least one year of patent law experience. Consideration to highly qualified candidates without legal experience; and 2) Patent Atty, for partnership-track position, with degree in the field of biotech, biochemistry, or chemistry, at least one year patent law experience. Send résumés:Hiring Committee, Dike, Bronstein, Roberts & Cushman, LLP, 130 Water Street, Boston, MA 02109.

### Portland Maine Patent Practice for Sale

retiring, successful, diversified IP practitioner wishes to sell practice. Call 207-865-0833 or write to P.O. Box 87 South Freeport ME 04078-0087.

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](http://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, Vermont, Massachusetts, Rhode Island, and Connecticut). Applications for membership can be obtained from our web site at [www.bpla.org](http://www.bpla.org). Full membership for 1998 (available only for attorneys practicing within the First Circuit) costs \$40.00. Associate membership (available to non-attorney intellectual property professionals) costs \$35.00. Mailing list-only affiliation costs \$15.00

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

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