



# THE BOSTON PATENT LAW ASSOCIATION NEWSLETTER

*Serving the  
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Since 1924*

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## JUDGE GAJARSA SPEAKS AT BPLA DINNER DESCRIBES HIS FIRST YEAR ON THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT

by Merton Thompson  
Fish & Richardson P.C.

The Honorable Arthur J. Gajarsa, of the Court of Appeals for the Federal Circuit spoke on his experiences during his first year on the appellate bench at the BPLA Annual Judges Dinner held on May 29, 1998 at the Bose Corporation World Headquarters in Framingham.

Other honored guests included the Hon. W. Arthur Garrity Jr., Senior Judge, U.S. District Court (Mass); and the Hon. Nathaniel M. Gorton, Judge, also of U.S. District Ct. for Massachusetts.

The Bose Corporate Center pro-

vided an exceptional venue for this event with its state-of-the-art, acoustically perfect auditorium and high tech design. Guests were treated to dramatic weather, as well, with a torrential thunderstorm giving way to a beautiful sunset during dinner.

BPLA President Tim French introduced Judge Gajarsa, and presented him with the traditional Patriot's Plate award.

Judge Gajarsa is the most recent appointee to the Court of Appeals for the Federal Circuit. President Clinton nominated Judge Gajarsa to fill a vacancy on the bench in April of 1996 and he was confirmed

by the Senate in July 1997. J. Gajarsa explained that he was initially reluctant to accept the prestigious, but relatively low paying, nomination because all five of his children were either in college or graduate school at that time. A personal phone call from President Clinton changed his mind. As J. Gajarsa put it, "you can't say no to the President."

Judge Gajarsa brings a diverse legal background to the CAFC bench including his practice at Joseph, Gajarsa, McDermott & Reiner where he represented Native American Tribes in water rights,

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## BPLA Summer Outing To Be Held September 26th At Foxboro New England Revolution Soccer Team To Play NY Metrostars

The BPLA will hold its Annual Summer Outing on Saturday, September 26th, at Foxboro Stadium. The event will begin with a tailgate picnic, followed by the MLS professional soccer game between the New England Revolution and the NY/NJ Metrostars. The game is scheduled to begin at 7:30 pm.

The Metrostars have won four of their last five games to boost their record to 13 wins and 10 losses, and are presently in second place in Major League Soccer's Eastern Conference with 35 points.

The Revolution's record is 7 wins and 17 losses. Although the Revolution are in last place in the Eastern Confer-

ence with 19 points, attendance figures for Revolution home games are among the highest in the league. Despite the poor record, the Rev's goalkeeper Ian Feuer and forwards Joe-Max Moore and Raul Diaz Arce make every game exciting.

For more information, see [www.cnnsi.com/soccer/mls/teams](http://www.cnnsi.com/soccer/mls/teams) or [www.boston.com/globe/sports/revolution](http://www.boston.com/globe/sports/revolution).

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By Tim French  
Fish & Richardson, P.C.

The BPLA has been fortunate over the past few months to have the benefit of not one, but several, very active committees. As a result, our spring schedule was full, and we concluded with a flurry of events, and in every case, those in attendance found ample reward for the time spent.

On May 11th, in conjunction with the visit to Boston of the International Trademark Association, the BPLA's Trademark Committee and Foreign and International Law Committee co-hosted a multi-national panel discussion of trademark issues, held at the Boston Park Plaza Hotel. Participating speakers included: Trevor Stevens, of Davies Collison Cave (Australia); Tan Loke Khoo, of baker & McKenzie (Hong Kong); Juan Carlos Ojam, of Clarke Modet & Cia. (Argentina); Owen H. Dean, of Spoor & Fisher (South Africa); Anna Bagley, of INTELS (Russia); Roberto Arochi, of Arochi & Mar-

## Message from BPLA President Tim French

quelles, S.C. (Mexico); Robert Gould, of Smart & Biggar (Canada); and Esmond A. Hitchcock, of Lloyd Wise, Tregear & Co. (United Kingdom). Each speaker provided a brief overview of trademark law in their own countries, and then contrasted local practices with those of other countries in their region.

On May 29th, the BPLA Annual Judges Dinner was held at Bose Corporation on The Mountain in Framingham. The Honorable Arthur J. Gajarsa, of the Federal Court of Appeals for the Federal Circuit, appearing as guest and keynote speaker, commented on recent and possible future trends in decisions by the Court. He also offered some interesting insights on his life in the judiciary, compared to prior positions as a patent examiner and later at an attorney in corporate and private practice.

On June 10th, the Biotechnology Committee hosted a full day educational seminar on the new sequence listing rules, presented by Meredith Beckhardt and Robert Wax of the U.S. Patent and Trademark Office.

On June 25th, at a luncheon meeting organized and hosted by the Trademark Committee, John Bliss, President of the International Anti-Counterfeiting Coalition, spoke on issues of trademark counterfeiting.

Now, after a quiet summer, the BPLA activities schedule is once again heating up. Plans for coming fall months include a meeting to be co-hosted in

September by the Biotechnology Committee and Licensing Committee on the topic of university licensing and technology transfer, and a meeting tentatively scheduled for November on FDA and regulatory issues. In December, Q. Todd Dickinson, Deputy Assistant Secretary of Commerce and Deputy Commissioner of Patents and Trademarks, will speak at the BPLA Annual Meeting.

I hope you all will find time to attend one or more of these events.

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).

### PCT SEMINAR MATERIALS

Course materials from the PCT TRAINING SEMINAR conducted in April by the BPLA in cooperation with WIPO are still available at a cost of \$50 per set. Contact Ms. Kelly Largey at 542-5070 ([largey@fr.com](mailto:largey@fr.com)) while they last.

### The Boston Patent Law Association 8 Faneuil Hall, Boston MA 02109 Telephone: (617)973-5021

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## Highlights of 1998 CAFC Case Decisions

The Court of Appeals for the Federal Circuit continues to exercise *de novo* review of questions of law and, in doing so, has elaborated on many of the legal doctrines of patent law this year

### **Equitable Estoppel**

As little as three years of acquiescence can be sufficient to preclude enforcement of patent rights, according to the CAFC's decision in *Scholle Corp. v. Blackhawk Molding Co.*, 45 USPQ 2d 1468 (Fed. Cir. 1998). Following receipt of a notice letter in 1991, Defendant Blackhawk modified its product and informed Scholle in 1993 that it believed its new design fell outside the scope of Blackhawk's claims. Blackhawk commenced suit in 1996. Judge Michel writing for the panel of Newman, Archer and himself affirmed the District Court's holding that Blackhawk's silence for three years established an equitable estoppel defense.

### **File Wrapper Estoppel**

In *Litton Systems, Inc v. Honeywell, Inc.*, (No. 95-1252, decided April 7, 1998, not yet published) the CFAC found file wrapper estoppel in patentee's Information Disclosure Statement (IDS). Following a common practice at the time, Litton's patent attorney included a brief single sentence summary of each reference as part of the IDS. The opinion of Judge Rader, concurred in by Judge Bryson found that such statements, even though unaccompanied by any amendments, were sufficient to create an estoppel. Judge Newman dissented, stating that the court has adopted a "draconian rule of estoppel flowing from applicant's own compliance with the disclosure rules."

### **Presumption of Validity**

In *Canon Computer Systems, Inc. v. Nu-Kote International, Inc.*, 45 USPQ2d 1355 (Fed. Cir. 1998), the CAFC confirmed that a patent is presumed valid at every stage of litigation - including on appeal. Defendant Nu-

Kote sought to argue that the number of named inventors -sixteen in total - was evidence of invalidity. Judge Lourie writing for the panel of judges Rader, Schall, and himself, disagreed with defendant-appellant NuKote, stating that absent trial evidence that inventorship was erroneously stated in the application, the presumption of validity was not rebutted.

### **Doctrine of Equivalents**

In overturning yet another jury verdict of infringement by the Doctrine of Equivalents, a CFAC panel has casted confusion once again over the interpretation of "means plus function" claims. In *Dawn Equipment Co. v Kentucky Farms, Inc.* 46 USPQ 2d 1109, the panel of Newman, Michel and Plager, concluded (in three separate opinions) that the jury's verdict under the Doctrine of Equivalents could not stand as a matter of law.

Both Judge Plager's and Judge Michel's additional views questioned how a jury could find no literal infringement of a means plus function claim and yet reach a different conclusion under the Doctrine of Equivalents. Judge Plager suggested the doctrine should have no place in such cases.

Judge Newman, on the other hand, stated that the difference between the Doctrine of equivalents and section 112 equivalents is *stare decisis* and has "long been understood by practitioners." She also noted that eliminating recourse to the doctrine would markedly diminish its scope.

## PTO Records Will Soon Be On the Internet

The PTO has announced that the government's patent and trademark records will soon be available online. Upon completion, the PTO website will be the largest government data base on the Internet, and will include both text and images for patents since 1976. Over two million patents will be searchable.

By September, trademark records should be available. In November, full patent texts will be available and images linked to the text records should online by March, 1999.

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## Letter to the Editor

### *Cubicle-ization of the PTO ?*

The BPLA (and individual members) should consider writing to protest the planned cubicle-ization of the entire examining corps of the PTO. Several examiners and Group Directors have expressed concern over the PTO plan to consolidate all personnel into open cubicles, in much smaller space, as a cost saving measure. Apparently, the PTO is currently seeking proposals from major cubicle manufacturers.

According to one Group Director, senior level directors will get "big" cubicles of 120 square feet (10 ft. x 12 ft.), while the rest of the examiners would get even smaller cubicles, with no room for files or privacy for telephone communications. Interviews would be conducted in communal rooms, with multiple interviews sharing the space.

Prototypes have apparently been built on the sixth floor of Crystal Mall Two. Examiners using these "offices" report that one can hear everything said in the surrounding cubicles. Noise levels are so distracting that music is piped in to camoflage it.

- Leslie Levine

Transkaryotic Therapies, Inc.

## CAFC Reverses *State Street Bank* Decision Deals a Blow to the Business Matter Exception under §101

By Scott Rothenberger  
Lahive & Cockfield, LLP

The recent case of *State Street Bank & Trust Co., v. Signature Financial Group, Inc.* 1998 U.S. App. LEXIS 16869 (Fed. Cir. 1998) reveals a significant departure from caselaw precedent. In its holding, the CAFC appears to have abolished the "business matter" exception to patentable subject matter under 35 USC 101. Local counsel represented both sides in this litigation.

William L. Patton, James L. Sigel and James S. DeGraw, Ropes & Gray, of Boston, Massachusetts, and Maurice E. Gauthier, Samuels, Gauthier, Stevens & Reppert, also of Boston, for Plaintiff-Appellee.

Steven L. Friedman, Dilworth, Paxson, Kalish & Kauffman LLP, of Philadelphia, Pennsylvania, Steven J. Henry, Wolf, Greenfield & Sacks, P.C., of Boston, Massachusetts; and Philip G. Koenig, Pittas Koenig, of Winchester, Massachusetts for Defendant-Appellant.

William T. Ellis, Foley & Lardner, of Washington, D.C., With him on the brief were Harold C. Wegner, Richard L. Schwaab, and Mary Michelle Kile. Of counsel was John F. Cooney, Venable, Baetjer, Howard & Civiletti, LLP for amicus curiae Information Technology Industry Council.

Robert C. Scheinfeld, Baker & Botts, L.L.P., of New York, New York, for amicus curiae Mastercard International Service. With him on the brief was Lawrence T. Kass. Of counsel on the brief for amicus curiae VISA International Service Association were Laurie S. Hane, Donald S. Chisum, and Alan L. Durham, Morrison & Foerster LLP, of Palo Alto, California.

JUDGES: Before RICH, PLAGER, and BRYSON, Circuit Judges.

Defendant-Appellant, Signature Financial Group, Inc. (Signature), appealed the decision of the United States District Court for the District of Massachusetts which granted a motion for summary judgment in favor of Plaintiff-Appellee, State Street Bank & Trust Co. (State Street), finding U.S. Patent No. 5,193,056 ('056) invalid under 35 U.S.C. § 101 as being a mathematical algorithm or as a business method exception. State Street and Fi-

ancial, are both in the business of providing custodial and accounting services for multi-tiered partnership fund financial services.

State Street negotiated with Signature for a license to use its patented data processing system described and claimed in the '056 patent. When negotiations broke down, State Street brought a declaratory judgment action asserting invalidity, unenforceability, and noninfringement in Massachusetts district court, and then filed a motion for partial summary judgment of patent invalidity for failure to claim statutory subject matter under 35 U.S.C. § 101.

The '056 patent pertains to a system that allows an administrator to monitor and record the financial information flow and make calculations necessary for maintaining a partner fund financial services configuration. A partner fund financial services configuration allows several mutual funds, or "Spokes," to pool investment funds into a single portfolio, or "Hub," which minimizes of the costs of administering the fund combined with the tax advantages of a partnership. This system provides means for a daily allocation of assets for two or more Spokes that are invested in the same Hub. The system determines the percentage share that each Spoke maintains in the Hub, while calculating both the value of the Hub's investment securities and the concomitant amount of each Spoke's assets. The system also tracks all relevant data determined on a daily basis for the Hub and each Spoke, so income, expenses, and capital gains or loss can be determined for accounting and for tax purposes for the Hub and, as a result, for each publicly traded Spoke.

Judge Giles Rich noted that the district court construed the '056 patent apparatus claims as process claims in which "means" clauses represented steps in that process. The court acknowledged that apparatus claims with "means" clauses may be viewed as process claims if there was no supporting structure in the written description.

However, the sole independent claim in question recited a variety of means to be carried out by structures such as a personal computer, a data disk, and arithmetic logic circuits. The court found that the subject matter claimed an apparatus which included proper means language.

The Federal Circuit next addressed the lower court's conclusions that the patent claimed a mathematical algorithm and/or a business method, which both fall outside the statutory subject matter under 35 U.S.C. §101. The court summarized recent decisions which involved mathematical algorithms, e.g., *In re Alapat* and *Arrythmia Research Technology Inc. v. Corazonix Corp.*, and held in favor of Signature. The court found that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula or calculation, because it produces a useful, concrete and tangible result.

The CAFC also addressed the district court's alternative holding that the '056 patent was invalid under the "business method" exception to statutory subject matter. The Federal Circuit took this opportunity to "lay this ill-conceived exception to rest" stating that since its inception, the "business method" exception had merely represented the application of some general, but no longer applicable, legal principle which was eliminated by 35 U.S.C. § 103.

The district court found the '056 patent invalid under 35 U.S.C. § 101, but noted other primary reasons for finding the patent invalid under the business method exception. The district court found that if Signature's invention were patentable, any financial institution desirous of implementing a multi-tiered funding complex modeled on a Hub and Spoke configuration would be required to seek Signature's permission before embarking on such a project. According to the district court, this was so because

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## Sultans of Patent Law ?



**Past Presidents of the Boston Patent Law Association gather at last year's Annual Meeting**

Rear Row (l. to r.) David Conlin, William Robeson, Jack Skenyon, George Neuner, Ron Kransdorf, John DuPre, William Ertman, and Andrew Karnakis.  
Front Row (l. to r.) Frank Porcelli, Jesse Erlich, David Wolf, Richard Wise, Susan Glovsky, Faith Driscoll and Ron Paglierani.  
(Not shown: Hugo Liepmann and Jason Mirabito)

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## State Street Bank Loses On Appeal

*(Continued from page 4)*

the '056 Patent was claimed sufficiently broadly to foreclose virtually any computer-implemented accounting method necessary to manage this type of financial structure.

The Federal Circuit stated that whether the '056 claims were too broad to be patentable was not to be judged under 35 U.S.C. § 101, but rather under §§ 102, 103 and 112. The court went on to state that assuming the above statements were correct, they have nothing to do with what is claimed as statutory subject matter.

The lower court's determination that '056 did not claim statutory subject matter under 35 U.S.C. § 101 was reversed and the case remanded for further proceedings consistent with the Federal Circuit's opinion.

**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)

## PTO Fees To Go Down On Oct. 1, 1998 Surcharge Imposed by Congress to Expire

Unless Congress enacts a new surcharge law, PTO fees are scheduled to go down on October 1, 1998 as a result of the sunset provisions incorporated into the 1996 law requiring patent applicants and other users of the PTO to not only fully fund the operations of the PTO but also contribute towards balancing the federal budget.

In 1998 the PTO is expected to collect \$796 million dollars in fees. However only \$691 will be allocated to fund PTO operations. Thus, this year PTO users will "contribute" \$105 mil-

lion to fund unrelated activities.

The President's budget for 1999 calls for no fee reductions but allocates \$786 million dollars to PTO operations (and only diverts \$50 million to other federal programs).

In contrast, the House has passed HR 3723 eliminating the surcharge and adjusting patent fees to recoup only the funds the PTO can productively use. Unfortunately, no similar bill is before the Senate.

## Judge Gajarsa speaks at BPLA Dinner

(Continued from page 1)

land claims, and gaming law, as well as maintaining a corporate and commercial law practice. Judge Gajarsa is also an electrical engineer (BSEE Rensselaer 1962), a patent attorney, and the first member of the CAFC who has worked as a patent examiner.

(Further biographic data on Judge Gajarsa can be found online at [www.fedcir.gov/judgbios.html#Gajarsa](http://www.fedcir.gov/judgbios.html#Gajarsa))

Judge Gajarsa gave an informative talk which outlined his personal approach to considering cases and his view on the role the CAFC should play in guiding patent law. On the subject of appellate briefs, Judge Gajarsa expressed a preference for concise briefing which first identified the critical issue(s) well and then delivered a focused argument on the identified issue(s). J. Gajarsa also intimated that he finds a short, well written brief impressive because it conveys confidence in the argument.

The most notable position J. Gajarsa outlined was his intent to work for more consistency and predictability in the CAFC's precedential opinions. He identified the Doctrine of Equivalents and Prosecution History Estoppel as two areas where he feels the CAFC has created a level of inconsistency and uncertainty in the patent law. He further noted that one of the benefits to BPLA members of his push toward

consistency would be to enhance the bar's ability to counsel clients with confidence. His preference for resolving inconsistent precedent is *en banc* review of important cases. He particularly favors such review for cases remanded from the Supreme Court for reconsideration. Gajarsa has followed through on his principles, vigorously dissenting from the denial of *en banc* rehearing in *Litton Systems, Inc. v. Honeywell, Inc.* (Fed. Cir. 6/18/1998, No. 95-1242) and *Hughes Aircraft v. United States* (Fed. Cir. 7/28/1998, No. 94-5149).

Judge Gajarsa also noted the relationship between the patent law and classic American entrepreneurship. He impressed BPLA members by taking the time to learn how many patents our corporate host, Dr. Bose, had been awarded.

## Positions Available

**Lahive & Cockfield, LLP** seeking motivated patent attorneys with at least 2-5 years patent experience and a background in biotechnology, electrical engineering or physics. An advanced degree or equivalent work experience is desired. Send resume to Recruitment Administrator, 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 patent counsel to advise, identify and develop strategies for small molecule discovery program and to oversee preparation and prosecution of patents. M.S. or Ph.D. (Chemistry), J.D. and 4-8 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)

**Nutter McLendon and Fish, LLP** seeking experienced patent attorneys for patent prosecution, technology licensing and client counseling. Persuasive advocacy skills and excellent writing ability essential. Contact IP Hiring Coordinator at (617) 439-2000.

**Hale and Dorr LLP** seeks attys. admitted or qualified for admission to practice before the PTO to join its growing Intellectual Property practice in its Boston and Washington, D.C. offices. Excellent writing skills and academic credentials required.

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## BPLA Committees

All committee lists have been updated from membership renewal forms. However, if you wish to switch committees (or join another committee), 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*

### 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*

On June 10, the Biotechnology committee sponsored an all day seminar on the changes to the Sequence Listing Rules that went into effect on July 1, 1998 and the new version of PatentIn which has been developed by the PTO. The seminar was conducted by Robert Wax, SPE, Group 1630/1650 and Meredith Beckhardt, Technical Information Specialist, search and Information Resources Administration.

Planning is in process for a talk by Nick Kirkham from Graham Watt on the new European Directive which impacts biotech (e.g. EST applications and plant applications). The tentative date for this seminar is September 10. More information will be coming soon.

### Chemical Practice

*Peter F. Corless (617) 523-3400*  
*Madge Kanter (508) 872-8400*

### Community Services

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

### International Practice

*\*Timothy A. French (617) 542-5070*  
*Thomas A. Turano (617) 248-7378*

### Computer Law

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

The BPLA's Computer Law Committee is about to start planning its program for the Fall of 1998 and would be interested in hearing comments from any of its members concerning seminar subjects. Please call either Lee Bromberg or Edward Porter with your suggestions.

### Copyright Law

*\*Charles L. Gagnebin (617) 542-2290*  
*Thomas M. Saunders (617) 227-0700*

### Corporate Practice

*\*Walter Dawson (978) 452-1971*  
*Faith F. Driscoll (978) 294-6165*

The Corporate Practice Committee met on May 19, 1998 at Arthur D. Little Enterprises, Inc. in Cambridge. The guest speaker was Ronald T. Reiling, Esq., manager of Intellectual Property Programs at Digital (now Compaq Computer Corporation) and a member of the BPLA. Ron discussed pending patent and copyright legislation including the Omnibus Patent Reform Bill (H.R. 400 and S 507) the WIPO Copyright Treaties and Online Liability (S 2037 and HR 2281).

The Corporate Practice Committee thanks Donald Mahoney and Bernard J. Lacomis of ADL Enterprises for hosting our meetings at their conference facility. The next meeting of the Corporate Practice Committee is being planned for October 1998. Members are invited to recommend topics and speakers for future meetings.

### Ethics and Grievance

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

### IP Law Career

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

### Licensing

*Gregory B. Butler (617) 225-0600*

### Litigation

*susan Glosky (781) 861-6240*  
*Steven M. Bauer (617) 248-7594*

### Law Students

*\*Janice M. Mueller (617) 573-8171*  
*Tom Johnston (781) 769-9450*

This year we would like to make the BPLA Student Section a more active body within the BPLA. The Student Section can be a vehicle to learning about the various aspects of patent law practice, from prosecution to litigation,

and to communicating with practicing attorneys in the Boston area. If you have any suggestions, please contact us via email at [joh01833@acad.suffolk.edu](mailto:joh01833@acad.suffolk.edu). We would also like to establish a contact person for each of the local law schools to inform students and faculty at those schools of upcoming events. If you are interested in serving as your school's representative, please contact us towards the beginning of the school year.

### Patent Law

*\*David S. Resnick (617) 523-3400*  
*Peter M. Dichiara (617) 526-6466*

Tuesday, September 1st at noon at Dike, Bronstein, Roberts & Cushman, LLP, 130 Water Street, Boston, there will be a committee lunch meeting to discuss the USPTO Interim Guidelines for Examination of Patent Applications Under the 35 U.S.C. 112, first paragraph, "Written Description" Requirement. See, [www.uspto.gov/web/offices/com/sol/notices/fr986-27.html](http://www.uspto.gov/web/offices/com/sol/notices/fr986-27.html).

The USPTO has requested comments on these guidelines. While these guidelines are mainly directed towards biotechnology, they reflect the current understanding of the PTO and may be applied across the board to all relevant technologies. Please RSVP by email. Seating is limited.

### 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*

## UPCOMING EDUCATIONAL EVENTS

### September 10 - BPLA Seminar on EU Biotech

The BPLA Biotechnology Committee will present a program on the European Union's Biotech Directive from 4:00 p.m. to 6:00 p.m. at the Boston Park Plaza Hotel

### September 26 - BPLA Summer Outing at Foxboro Stadium

The BPLA will be sponsoring a tailgate party and offering tickets to the New England Revolution soccer game versus the NY Metrostars on Saturday, September 26th. A fun-filled event for the entire family.

### also in September - BPLA Seminar on University Tech Transfer

The BPLA Licensing and Biotechnology Committees will jointly present a program on university licensing and technology transfer programs, including tips on negotiating with university licensing officers and constraints imposed by government sponsorship.

### October - Chemical Practice Seminar

The Chemical Practice Committee will sponsor a seminar on recent developments.

### November - FDA Regulatory Practice Seminar

The Biotechnology Committee will sponsor a seminar on the basic regulatory framework of the Federal Food and Drug Administration's drug and medical device approval process, as well as the issues typically encountered by patent holders seeking relief under the Patent Term Extension Act due to regulatory delays.

### December 2nd - BPLA Annual Meeting

The BPLA Annual Meeting will be held on December 2nd. Elections for next year's officers and board members will be held. The business meeting will commence at 12:00 PM followed by a luncheon at which Q. Todd Dickinson, Deputy Assistant Secretary of Commerce and Deputy Commissioner of Patents and Trademarks, will speak.

## Positions Available

(Continued from page 6)

Particular need for attorneys with at least two years legal experience and an advanced degree in biology, molecular genetics, biochemistry or organic chemistry, electrical engineering or computer science. Send resume in confidence to Evelyn Scoville, Hale and Dorr LLP, 60 State Street, Boston MA 02109 or Karyn Thomas, Hale and Dorr LLP 1455 Pennsylvania Avenue, N.W., Washington, DC 20004

**Weingarten, Schurgin, Gangnebin, & Hayes LLP** seeks patent attys. with EE, Chemistry or Biochemistry degrees. Experience needed in electronics, polymer chemistry, catalysts, or pharmaceuticals. Responsibilities include preparation and prosecution of patent applns. and client counseling. Min. 2 yrs exp required. Salary competitive. Send resume to Hiring Partner, WSGH, 10 Post Office Sq., 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.

**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. 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; 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.

**Biogen, Inc.** seeks Assistant General Counsel for intellectual property matters. Contact Janet Thompson at (617) 679-2340.

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

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Lahive & Cockfield, 28 State Street, Boston, MA 02109 or via e-mail to [tje@lahcoc.com](mailto:tje@lahcoc.com)

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