



THE BOSTON PATENT LAW ASSOCIATION NEWSLETTER

*Serving the
New England
Intellectual
Property Bar
Since 1924*

December 31, 1998

Volume 29, Issue 4

Q. TODD DICKERSON ADDRESSES ANNUAL MEETING ACTING COMMISSIONER - DESIGNATE SPEAKS ON VARIOUS INITIATIVES AND PROPOSALS FOR CHANGE AT THE PTO

Q. Todd Dickerson, Acting Commissioner Designate of the Patent and Trademark Office, addressed the BPLA as guest speaker at the 1998 Annual Meeting earlier this month at the Meridian Hotel. Mr. Dickerson, formerly the chief IP Counsel for Sunoco and also a previous partner with the Washington firm of Becker, Price and Rhodes, described the PTO's efforts to improve the Examining corps and expedite the examination process.

Commissioner Dickerson noted that the PTO Examining corps had been operating under a hiring freeze (limiting the Examining corps to about 2100 examiners) for the past several years while at the same time

the number of patent applications examined yearly had risen by nearly 50 percent. As a result the average pendency of applications has increased to about two years.

Recognizing this problem, the Administration has convinced Congress to finally authorize the hiring of additional examiners. In 1998, the PTO hired 700 new examiners and plans to hire 700 more examiners in 1999.

Dickerson was also happy to report the progress of the PTO's efforts to put patent records online for free electronic searching by the public. The PTO database of patents and trademarks constitutes the largest single governmental data base available

on the internet anywhere in the world (with over 1.3 Terabytes of data).

He also reported that paperless electronic filing of trademark applications was now operational and that the PTO will accept American Express, MasterCard and VISA for payment of the application fees on such electronic filings.

The Acting Commissioner further reported that the PTO will cut the average application pendency period by a month by sending the text of applications to the General Printing Office at the same time as a Notice of Allowance issues (before the payment of the Issue Fee by the applicant), based on the reasoning that process-

(Continued on page 5)

WALTER DAWSON ELEVATED TO PRESIDENT OF BPLA DAVID THIBODEAU PICKED AS PRESIDENT-ELECT FOR NEXT YEAR

Walter Dawson was elevated to the BPLA Presidency at the 1998 Annual Meeting on December 2, 1998 and David Thibodeau was elected President-Elect. (Under the by-laws of the BPLA, the President-Elect assumes the presidency automatically the following year.)

Walter Dawson practices patent law in Lowell with the firm of Pearson & Pearson where he is primarily engaged in patent and trademark prosecution with an emphasis on electrical prosecution. Prior to joining the Pearson firm, Dawson worked as a patent attorney at Raytheon for 15 years and has also remained active on the BPLA's Corpo-

rate Practice Committee.

David J. Thibodeau is presently of counsel to Hamilton, Brook Smith & Reynolds, P.C. Prior to joining that firm he was General Counsel at AirNet

Communications of Melbourne Florida and a partner with Cesari & McKenna of Boston.

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By Tim French
Fish & Richardson, P.C.

It has truly been a pleasure serving as President of the Boston Patent Law Association. I would like to take this opportunity to thank my Activi-

Farewell from Past President French

ties Chair, Ingrid Beattie, her secretary, Kathleen O'Shea, and Robin Moehn, Client Services Director at Fish & Richardson, for their considerable time and efforts on behalf of the BPLA over the past year. I would also like to thank the Officers and members of the Board of Governors for their support, and to give a special thanks to the Committee Chairs for their contributions to a particularly busy schedule of events in 1998.

I wish also to express my appreciation to our Nominating Committee of Susan G.L. Glovsky, Edward Cohen and P. Louis Myers for providing us with a fine slate of candidates for 1999.

Finally, I wish to offer particular thanks to those members of the BPLA who have participated in BPLA events this past year, and to take this opportunity to invite them and others to take a more active role in the coming year. This is your organization and I urge you to support it by your participation.

Once again, thank you for the honor of allowing me to serve as President of the BPLA.

Catherine Kara Wins 1998 BPLA Writing Contest Suffolk Law School Honors Graduate Takes First Place Prize Daniel Cahoy of Franklin Pierce Takes Second Prize

The 1998 BPLA Writing Contest was won by Catherine Kara, whose paper "A Product is a Product is a Product: An Argument for Broad Interpretation of Product-by-Process Claims in View of the Schism in the Federal Circuit," was the unanimous choice of the judges.

Ms. Kara was reached via e-mail in New Zealand, on the first leg of a round-the-world vacation following her graduation (at the top of her class) from Suffolk University Law School.

The writing competition winner is a registered patent agent and has been working for the past five years as a technical specialist and patent agent while attending Suffolk University at night.

Ms. Kara obtained her undergraduate education at McGill University (B.Sc., Immunology, 1986) and received her doctorate from Harvard University (Ph.D., Medical Sciences, 1991). Before entering the field of patent law, she was a National Cancer

Institute fellow at Massachusetts General Hospital.

Second prize was awarded to Daniel Cahoy for his paper "New Legislation Regarding On-Line Service Provider Liability for Copyright Infringement: A Solution in Search of a Problem," which was recently published in *IDEA: The Journal of Law and Technology*. The second prize winner is a Franklin Pierce Law Center graduate (and an editor of the *IDEA* journal) and received his undergraduate training at the University of Iowa where he majored in Biology.

Mr. Cahoy was reached in New York City where he is presently a first year associate with the law firm of Fitzpatrick, Cella, Harper & Scinta.

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

Board of Governors:

President:	Walter Dawson, Pearson & Pearson (978) 452-1971 wfd@pearson.com
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Message From New President Dawson

The following are excerpts from remarks made by Walter Dawson upon accepting the BPLA Presidency at the Annual Meeting this month.

First, I want to sincerely thank the Nominating Committee and you, the members of our Association, for giving me the opportunity to serve as your President for the coming year.

I have been a member of the BPLA for almost 20 years and I have benefited from attending many Seminars and Meetings sponsored by the BPLA over this period of time, and over the last 10 years I have tried to contribute to the Association as Co-Chair of the Corporate Practice Committee and as a Member of the Board of Governors.

I have known, admired, and observed the performance of, every President since 1980 and I intend to perform this job at least to the high level of my predecessors and in particular, to meet your expectations.

My Activities Chair for the coming year will be Mary Dawson. Mary is a member of the BPLA and Legal Assistant at Pearson & Pearson in Lowell. Many of you have known Mary over the past ten years from her work in arranging meetings of the Corporate Practice Committee, and last year she assisted with the preparation of the BPLA Newsletters. I know she will play a key role in the success of the BPLA functions for the coming year.

We will also be appointing a Co-Chair to work with Mary and to handle publicity or public relations matters; if any member is interested, particularly if you have news media experience, please let us know. This is an opportunity to get involved with planning and publicizing the major functions of your Professional Association.

Also, I want to welcome Doreen

Hogle as a new member of the Board of Governors, and to congratulate the other new Officers.

My goals for the coming year include continuing to improve the infrastructure of the Boston Patent Law Association which now has a membership of over 700. Earlier this year the Board of Governors retained a professional management firm to provide business support services including the maintenance of up-to-date membership lists from which various forms of information can be easily obtained, such as lists of particular Committee members. The Service also provides the BPLA with a mail address and telephone number and performs printing and mailing services for meetings, seminars and the BPLA Newsletter.

Maintaining and controlling accurate and current records of addresses, telephone numbers, Fax numbers and now E-Mail addresses are a key element of improving our ability to ensure that announcements of the Association and Committee events, and other information of general interest to IP Law practitioners, reach the membership in a timely fashion. Bookkeeping services and newsletter publishing assistance may also be provided in the future. We will also be monitoring the cost effectiveness of these support services.

We will continue to take advantage of the potential of the BPLA Web Site. We have recently obtained the capability to update the Web Site ourselves, and now need to consider what information should not be available to non-members. In fact, we would appreciate hearing from any member who may be skilled at Web Site development and maintenance, to provide guidance and recommendations to the Board or to be Chair of a Web Site Committee.

One of the objectives of this Association from the beginning has been to provide "information of interest to au-

thors, to inventors, and others concerned with the laws of intellectual property." One of the ways that we can accomplish this goal is by the use of our Web Site.

As you know, the Management of the BPLA and the scheduling of many functions, have a price. Based on our costs over the past 2 years, the Board will probably be considering a dues increase for "active membership" effective next year. The \$40.00 membership fee has been in effect for as long as I can remember, but the costs of services and functions have increased significantly over the years. Although we generally try to make functions self-supporting, this is not always possible.

During the coming year, it will be our objective again to offer something for everyone in the way of meetings and functions. These will include the traditional Luncheon Meetings with speakers, the first of which is scheduled for February of 1999, the afternoon seminars and reception functions that have been so well received, and the continental breakfast meetings with guest speakers, which have been popular with the Corporate Practice Committee. Also, again we will be sponsoring the law student Writing Contest.

We will continue to monitor and consider, via our Patent, Trademark and Copyright Committees, the continuing changes to Patent, Trademark and Copyright laws and rules, and provide our viewpoint and comments to the PTO and the Copyright Office.

Finally, I want to say: This is your association and I firmly believe in the old adage: "You get out of an organization what you put into it."

Thank you for the opportunity to serve as your President.

NEW FEDERAL COURTHOUSE IS OPEN FOR BUSINESS ARCHITECTURE IS BOTH PRAISED AND CRITICIZED

The new Federal Courthouse for the District of Massachusetts opened its doors on September 26th. The 750,000 square foot facility on Fan Pier, with its red brick and glass facade, was designed by architect Henry Cobb. The courthouse, seven years in planning, is one of the first major development projects in Boston's new Seaport District and opens onto a two acre public park. Spectacular views of Boston Harbor and the city skyline are afforded from glass-walled interior of the building.

During the opening ceremonies, U.S. District Judge Douglas P. Woodlock was awarded a golden hard hat for his years of planning and help in the designing of the building. Supreme Court Justice Stephen Breyer has also been a long-time supporter of the project and an advocate for the integration of the new courthouse with the community and Boston's Harborparks project.

The 10 story building has 27 courtrooms, 30 jury deliberation rooms, a comprehensive law library, a restaurant and public spaces for civic and community organizations.

The Boston Globe, however, reports that many courtroom clerks and the U.S. Attorney's staff have voiced complaints about the design of their



offices and the general lack of windows in their workspaces. One assistant U.S. Attorney bitterly complained in the Globe about the "long narrow corridors" and the "dimly lit holes in which people will work." (Under present General Services Administration guidelines, prosecutor's offices must not exceed 150 sq. ft.)

Architects have also criticized the massive brick facade presented by three sides of the building. The front of the courthouse, with its heavy, almost fortress-like face, has been roundly criticized as "uninviting."

These criticisms have been rebutted by the planners and designers. Most of the space allocations were dictated by efficiency; plus, the benefit of having many previously dispersed court-related offices under one roof (and often on a single floor) is cited as justifying the interior designs.

Moreover, Judge Woodlock is quick to point out that the best views (from inside the curved 10 story glass wall) belong to everyone.

PTO CANCELS BOSTON AND SAN DIEGO HEARINGS HEARING ON ENABLEMENT GUIDELINES CANCELED BY COMMISSIONER

Citing "insufficient interest" on the part of the public, PTO Commissioner Lehman abruptly canceled public hearings scheduled for last month in Boston and San Diego. A single hearing was held in Washington instead.

The hearings were planned to permit interested parties to comment on the PTO's proposed guidelines to assist examiners in finding "attributes necessary to support the written description

requirement of 35 U.S.C. 112." (The proposed guidelines can be found at 63 FR 32639, June 15, 1998 and at 1212 O.G. 15, July 7, 1998.)

Although the guidelines were primarily intended for the examination of biotechnology inventions, the PTO now describes the guidelines as applicable "across the board."

The controversial proposals have not yet been finalized and there is a

possibility that a Boston hearing may still be held if enough interest is expressed by the public.

The PTO proposal directs examiners to determine the level of predictability in the art and apply this standard to each claim. For biotechnology, claims to an exact nucleic acid or amino acid sequence would fall into a "safe harbor," while all other claims would be suspect.

DICKERSON SPEAKS AT ANNUAL MEETING

(Continued from page 1)

ing a small percentage of allowed applications that are subsequently abandoned is a price worth paying in order to get the bulk of new patents issued more quickly.

Dickerson also informed the BPLA members that the process of finding a developer to construct and lease a new building complex to the PTO has been narrowed to three bidders, with two of the three proposed sites located in Alexandria, Virginia.

Finally, the new Commissioner was very happy to report that the recent reduction in official fees across the board (by about six percent) was the first such reduction in modern history, and that the Administration has finally

persuaded Congress to stop siphoning PTO user fees to fund other governmental projects. Unless the new Congress reneges on this commitment, 1999 will be the last year that user fees are taken for other purposes. Starting in the year 2000, users fees will be used exclusively to fund PTO operations.

Welcome to New 1998 BPLA Members

Regina S. Bautista
Eugene Berman
Daniel Boxer
Maureen A. Bresnahan
Sandra Ann Brockman
Lauranne S. Butler
Kevin Canning
John Capone
Kenneth L. Carson
Christopher Centurelli
Alakanada Chatterjee
Christopher Cianciolo
Cheryl Clarkin
Gregory J. Cohan
Kenneth J. Collier
James Gregory Cullem
Viana Daly
Carl M. DeFranco, Jr.
Robert V. Donahoe
Ivor Elrifi
Marianne Flynn
Barry Gaiman
Robert W. Gauthier
Lisa N. Geller
Joseph E. Grotych
Antoinette Guigliano

Daniel W. Halston
George B. Haven
Iva Heffan
Danielle Louise Herritt
David Howley
Radha Ivengar
Thomas M. Johnston
Sandhya L. Kalkunte
Madge Kanter
Robert A. Karwic
Brendan Kennedy
Thomas Krivulka
Paul P. Kriz
C. Steven Kurlowecz
Dr. Kaplesh Kumar
Christine M. Kuta
Maria C. Laccotripe
John T. Li
Timothy P. Liukkila
Brenda A. Madden
Stanley C. Mah
William A. Marino
Robert Mazzaresse
Christine McCormack
Marianne McLaughlin
Ami Mirabito
Peter P. Mitrano
Richard J. Musgrave
Joanne Pappas
Sean D. Petweiter
Amir Razaizadeh
Christopher P. Ricci

Richard Roos
Margaret D. Rosa
Armand J. Rossetti
Martina Rozumberkova
Michael J. Schanelzer
Mark D. Seltzer
Justin J. Sergio
Karoline K.M. Shair
Jeffrey A. Shapiro
Smita A. Sharma
Evelyn D. Shen
Garfield B. Simms
Gary B. Solomon
Mark B. Solomon
Cynthia Soroos
James Thompson
Richard Tomlins II
Pamela Torpey
Thomas J. Tuytschaevers
Natasha Us
Machael G. Verga
Ralph R. Veseli
Marc A. Vivencio
Robert J. Waeldner
Patrick R.H. Waller
Donald R. Ware
Ned Whalen
Lisa R. Whitman
Nan Wu
Constance Yeung

Announcing the 1999 WRITING COMPETITION sponsored by the BPLA

1st Prize: \$300

2nd Prize: \$200

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

Aug. 1, 1998 and July 31, 1999

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, 1999. 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 Doreen Hogle
Hamilton, Brook, Smith & Reynolds
One Militia Drive
Lexington, MA 01776**

Notice to All BPLA members who have not yet paid their 1999 dues:

The annual BPLA membership fee of \$40.00 is due by February 1, 1999. A \$10.00 late fee is also due for renewals after that date. Membership renewal forms can be obtained from BPLA Treasurer William G. Gosz at (617) 720-3500 or via the internet from our web site www.BPLA.org

BPLA TO CO-SPONSOR RICH MOOT COURT AGAIN VOLUNTEER JUDGES SOUGHT TO HEAR AND GRADE

The AIPLA and BPLA are pleased to announce the 26th 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.

The oral arguments will take place at the Suffolk University School of Law in Boston during the weekend of March 12-14, 1999.

The Regional Competition relies upon 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), or 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 volun-

teer brief graders, who will be asked to read the briefs critically and to grade them.

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. The hearing schedule is as follows: Friday evening, March 12, 1998 from 6:00PM to 9:00PM; Saturday, March 13 from 10:00AM to 1:00PM, and Sunday, March 14 from 10:00AM to 3:30PM.

NOTICE OF MEMBERSHIP EXPIRATION

Pursuant to BPLA By-Laws, notice is hereby given of the expiration of memberships granted to the following individuals for failure to pay the 1998 dues. Unless these dues are paid by December 31, 1998, the following individuals will need to reapply for membership:

Joseph P. Aiena
John V. Ala
D. Dennis Allegretti
Holmes W. Anderson
Barbara A. Barakat
David B. Bernstein
David L. Bohan
Eva M. Bonis
Damon J. Borrelli
Karen Brown
Robert L. Buchanan
Randolph P. Calhoun
Charles G. Call
David L. Cavanaugh
Isabelle Clauss
Stanton E. Collier
Paul J. Cook
Paul Coryea
Anne I. Craig
William C. Cray
Viana Daly
Loletta L. Darden

Jodi Doherty
David M. Driscoll
John S. Economou
Douglas C. Fay
Gillian M. Fenton
Mark A. Fischer
Milton E. Gilbert
Harry J. Gwinnell
Roberta L. Hahn
Julia D. Hart
John Hayden
George A. Herbster
Karl Hormann
Madeline I. Johnston
Ellen L. Kapinos
Warren A. Kaplan
Herbert S. Kassman
Edward Kelly
James P. Kelly
Susan Riley Keyes
Christopher A. Klein
Gabriela Krockmalmic
Prithvi C. Lall
Patricia A. LaMarche
Marylou J. Lavoic
Celia Ketley-Leber
James J. Livingston, Jr.
Robin R. Longo
Anthony M. Lorusso
David E. Lurie
Sandra E. Marxen
James E. Maslow
Jerald Meyer
Thomas C. Meyers
Jennifer T. Miller
Henry S. Miller
Donald F. Mofford
Kittie Murray
Ronald E. Myrick
Richard A. Mysliwicz

Ted Naccarella
Kathleen Neuner
Karen M. Nichols
Bruce R. Parker
Edmund R. Pitcher
James E. Pittman
Jeannette Potts
Sanjay Prasad
Judith Roesler
Alfred H. Rosen
David J. Rotondo
Mark D. Russett
Edward J. Scahill, Jr.
Stephen P. Scuderi
David E. Seaver
Joseph M. Sollecito
Hans A. Stoekler
Thomas C. Stover
Maureen Stretch
Jennifer McCabe Taggart
Matthew P. Vincent
Robert J. Waeldner
Raja H. Wakim
Russell Weinzimmer
Ted Workman
Frederick P. Zotos

If you have been placed on this list in error, please contact William G Gosz at (617) 720-3500 or by email at wgg@wgslaw.com

Positions Available

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

Nutter, McClennen and Fish, LLP seeking experienced patent attorneys for patent prosecution,

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BPLA Committees

All committee lists will updated from membership renewal forms early next year. However, if you wish to switch committees (or join another committee) immediately, members are encouraged to contact the committee chairpersons listed below to have their names added to committee rosters. Most committee chairpersons can be contacted through the BPLA web site: www.bpla.org (For committees that have co-chairs, please contact the person marked by the asterisk.)

Activities and Public Relations

Ingrid A. Beattie (617) 542-5070

In April, speakers Louis Masse, Consultant to PCT Legal Division of WIPO, and Carol Bidwell, PCT Special Programs Director, addressed 40 attendees at a PCT seminar.

In May, a panel of international trademark practitioners spoke at a seminar on international trademark practice. On the panel were: Roberto Arochi of Arochi & Arguelles (Mexico), Anna Baglay of INTELS (Russia), Owen H. Dean of Spoor & Fisher (South Africa), Robert Gould of Smart & Biggar (Canada), Esmond A. Hitchcock of Lloyd Wise, Tregear & Co. (United Kingdom), Juan Carlos Ojam of Clarke, Modet & Cia (Argentina) and Trevor Stevens of Davies (Australia).

Also in May, Arthur J. Gajarsa of the U.S. Court of Appeals for the Federal Circuit addressed 102 attendees at the annual Judges Dinner at Bose Corp. In June, John Bliss, the President of the International Anti-Counterfeiting Coalition, addressed 27 attendees at the Trademark Committee luncheon and, finally, earlier this month, Q. Todd Dickinson, Deputy Assistant Secretary of Commerce and Deputy Commissioner of Patent spoke on current PTO developments.

AIPLA Moot Court

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

John M. Berns (617) 542-5070

See the announcement on page 6 for details of the 1999 Moot Court Competition to be held on March 12-14.

Antitrust Law

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

Martin O'Donnell (617) 951-2500

Litigation

Susan Glosky (781) 861-6240

Steven M. Bauer (617) 248-7594

Biotechnology

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

Doreen M. Hogle (781) 861-6240

Chemical Practice

Peter F. Corless (617) 523-3400

Madge Kanter (508) 872-8400

On October 5, 1998, over 80 people attended a breakfast seminar on combinatorial chemistry by the Chemical Practice and Licensing Committees. Karoline Shair of Choate Hall & Stewart and Brenda Madden of Dike, Bronstein, Roberts & Cushman provided an introductory overview of combinatorial technology followed by a presentation by SPE John Knight of USPTO views on examination of combinatorial chemistry applications. Dave Conlin of Dike, Bronstein, Roberts & Cushman, Peter Fasse of Fish & Richardson and Michael Rivard of ArQule then discussed selected prosecution, enforcement and licensing issues relating to combinatorial chemistry patents. Copies of the written seminar materials may be obtained by contacting Charles Danes at (617) 523-3400.

On September 3, 1998, the USPTO issued the final Guidelines for the Examination of Claims Directed to Species of Chemical Compositions Based Upon a Single Prior Art Reference. Those Guidelines are available on the USPTO website, or can be obtained from Charles Dane at the above telephone number. In April 1997, the Chemical Practice Committee submitted comments to the USPTO on the Interim Guidelines, and the final Guidelines included several revisions proposed in the Committee's comments.

Community Services

David J. Powsner (617) 248-5000

Computer Law

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

Lee Carl Bromberg (617) 443-9292

The upcoming Computer Law Committee seminar on software patent prosecution on February 9th will include a panel with extensive experience in software patent applications and litigation issues. Issues to be covered include: claim drafting strategies, the best mode requirement in software applications, and the effect of recent cases involving the written description requirement.

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 is now planning a meeting for February 3, 1999 at Arthur D. Little in Cambridge at 8:30 AM. This meeting will focus on managing and licensing corporate IP assets.

Ethics and Grievance

Henry S. Miller (508) 448-3130

International Practice

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

Thomas A. Turano (617) 248-7378

The International and Foreign Practice Committee organized two events during 1998. In April, it sponsored a two day seminar on PCT Practice. In May, in conjunction with the International Trademark Association's visit to Boston for its Annual Meeting, it sponsored (jointly with the Trademark Committee) a discussion of the similarities and contrasts of foreign trademark practice.

Law Students

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

Tom Johnston (781) 769-9450

The Law Student Committee is planning three events for 1999: 1) An educational program for law students interested in careers in patent litigation; 2) a social event (likely a happy hour) for members of the IP law student organizations of all area law schools; and 3) a mentorship program that would match volunteer IP practitioners with law student members to offer ideas and encouragement regarding career opportunities in the IP field.

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

The Trade Secrets Committee is planning a seminar covering the major aspects of trade secrets. The seminar will include: an overview of the law of trade secrets (including the Uniform Act), protection of trade secrets, civil litigation issues and tactics, criminal law issues, trade secret valuation, presentation of expert testimony, and judicial commentary.

Trademarks & Unfair Competition

** Michael A. Alpert (617) 832-1175*

Donna M. Weinstein (617) 5425070

UPCOMING 1999 EDUCATIONAL EVENTS

February 3 - Corporate Practice Seminar

The BPLA Corporate Practice Committee will present a morning seminar on "Managing and Licensing a Corporate IP Portfolio" beginning at 8:30AM at Arthur D. Little in Cambridge. Speakers will include Joseph Cody of ADL and Edward Kahn.

February 9 - Computer Law Committee Seminar

The BPLA Computer Law Committee will present a morning seminar on "Software Patent Protection" beginning at 9:00AM at the MBA Conference Center, 20 West Street, Boston.

March 5 - BPLA / Suffolk Law School Conference

The BPLA and Suffolk University Law School will jointly present a program entitled "High Technology Law - Licensing" at Suffolk University.

March 12-14 - Giles Sutherland Rich Moot Court Competition

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.

May 7 - Annual Judges Dinner

This year's dinner dance in honor of the federal judiciary will be held at the Westin Hotel in Waltham.

December 1 - BPLA Annual Meeting

Mark your calendars now. The BPLA Annual Meeting will be held on December 1st. Elections for next year's officers and board members will be held.

Positions Available

(Continued from page 6)

technology licensing and client counseling. Persuasive advocacy skills and excellent writing ability essential. Particular needs include attorneys with medical device, chemistry, electronic instrumentation or biotechnology experience. 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. 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

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.

Biogen, Inc. seeks Assistant General Counsel for intellectual property matters. Contact Janet

Thompson at (617) 679-2340.

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

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

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.

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

Membership in the BPLA is available to attorneys and other professionals practicing intellectual property law within the Federal First Judicial Circuit (Maine, New Hampshire, Vermont, Massachusetts, Rhode Island, and Connecticut). Applications for membership can be obtained from our web site at www.bpla.org. Full membership for 1999 (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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