

Chair's Message

For much of my time in CHAL, we have struggled with a couple of issues: the breadth of our mission and our place within ACS. While interactions between chemistry and the law cover a multitude of technical and legal areas, there is a perception among some that our programming is largely limited to a single area, intellectual property. In addition, concerns have been expressed within the division that the relationship of CHAL to the rest of ACS is less than ideal.

In an attempt to address these concerns, I would like to focus this message and my remaining time as chair on two "themes": Opportunity and Enjoyment.

The first theme, opportunity, comes not from me, but from the incoming ACS president, Bill Carroll. As chair of the division, I recently received an email in which he outlines his vision for ACS during 2005:

My overall theme is "Opportunity" and I have three specific areas on which I would like to focus.

- Outreach, and particularly, how we can continue to make headway in the public's perception of chemists and chemistry;
- Secondary Education, and particularly how we encourage those who have chosen chemistry as their field to consider teaching either at the beginning of a career or at the end; and,
- "Enterprise 2015," which I envision as a built-by-members look at the changing nature of the Chemistry Enterprise in the U.S.—in industry, education and government, influenced by events here and around the world—and a final report on how members might position themselves to understand and be advantaged by the changes.

The theme is Opportunity, because I believe each of these agenda items presents each of us with the opportunity, when viewed in the light of advances in our science, to improve ourselves, our profession, and our

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CHAL EVENTS AT PHILADELPHIA

Executive Board Meeting

All welcome.
6:00 p.m. - 8:00 p.m.
Sunday, August 22, 2004
Loews Hotel, Adams

Joint Reception with SCHB

5:00 p.m. - 7:00 p.m.
Monday, August 23, 2004
Chemical Heritage Foundation
Ullyot Meeting Hall North
315 Chestnut Street, Philadelphia

Presentation of Papers

Sunday to Thursday
August 22 - 26, 2004
Loews Hotel, Adams

Notice of Open Meeting

Monday, August 23, 2004
(after the morning session)

NEWSLETTER INDEX – PAGE 16

The Division of Chemistry and The Law gratefully acknowledges the generous support of **Snell & Wilmer L.L.P.** of One Arizona Center, 400 East Van Buren, Phoenix Arizona, for funding the periodic Board teleconferences.

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Primary version is as print on paper, mailed twice-yearly from Palo Alto, California, prior to ACS national meetings, and distributed at those meetings; also to be on <http://membership.acs.org/C/CHAL/> Opinions expressed are those of the authors and not necessarily of CHAL or ACS. While great effort is made for accuracy, factual errors are possible; CHAL and ACS bear no liability for such errors, and CHAL invites correction for future publication. References, including Internet sites, cited as bibliography or for general interest, are intended for readers' convenience only, and are not endorsed as to opinions or for detailed accuracy or timeliness, which are the responsibilities of the authors and publishers of those references. Internet site citations were thought to be timely within a few weeks before this newsletter went to press; however, some may have become stale. Mention of publications, products, or services is intended for readers' convenience only and not as commercial endorsement. Discussion of legal issues is for information and educational purposes and is not legal advice; legal advice should be sought from licensed lawyers formally consulted for that purpose. Readers' comments are welcome and future articles from them are invited — especially to broaden the range of topics and viewpoints — address to: M. Grossman, editor. Design, layout and printing by MontiGraphics, Palo Alto, California. 94043. Phil Monti, montigrp@aol.net, 650-691-0900, fax 650-691-0902.



ACS President-Elect Bill Carroll (left) visits the CHAL reception in Anaheim. He is shown meeting David Schab (right), Director of Thomson Scientific, the sponsor of the CHAL receptions in Anaheim and Philadelphia.

continued from front page

relationship with the public. We have the ability to shape our futures even if we cannot control all the events that impact them.

In thinking about his e-mail, I was struck at how appropriate and important the concept of opportunity was to our division. We, in CHAL, must never forget that the success of the division comes from opportunity, the opportunity to learn, the opportunity to share, the opportunity to continue to explore the boundaries of chemistry and the law. I believe that we need to embrace the efforts of the president and adopt his theme as our own.

And yet, while I believe that opportunity is important, opportunity alone cannot keep CHAL running. It takes people.

When I first became involved in this division, I was struck by the number of hard-working volunteers that it takes to make this division run. While the people differed, they had a common trait: their enjoyment. They enjoyed chemistry, they enjoyed the law and they enjoyed CHAL.

As chair, the number of people needed to run a successful division has not decreased, and yet, I wonder if the same level of enjoyment is there for those involved. I believe we need to recognize the importance of enjoyment to those who offer their time to the division. I also believe that we need to do what we can to offer an enjoyable experience in order to make the most of the opportunities

Treasurer's Report

January 1 – December 31, 2003

Starting Balance	\$12,631.54
Income	
ACS Division Dues July-Dec.'03	\$ 7,490.00
Thomson Scientific Sponsorship for Anaheim	2,500.00
ACS 2004 Division Allocation	4,429.71
ACS Reimbursement for Councilor Expenses	1,301.00
New Member Dues	45.00
Total	\$17,600.30
Expenses	
Incorporation - C. T. Corp. System	\$ 219.00
Spring Newsletter	5,467.05
Annual Bulk Mail Fee for 2004	150.00
Postal Expenses for Spring Newsletter	233.12
Councilor Reimbursement for Anaheim	3,352.66
Bank Charges (Jan.'04-May '04)	11.80
Leadership Conference Reimbursement	417.50
Chemical Heritage Foundation Deposit	225.00
Total	\$10,076.13
Ending Balance	\$ 7,524.17

that ACS and CHAL can provide in the coming years. Simply put, without the enjoyment, we will lose the people and all the opportunities in the world will not save the division. Thus, I believe that we need to embrace "Enjoyment" as a theme for the division in the coming year.

As chair of the division, I would invite you to do two things:

First, please contact me (wjohnson2001@comcast.net) and let me know what you think about CHAL—the good, the bad and the ugly. Also,

let me know what you want from CHAL and how we can make CHAL more relevant to you and your profession. Perhaps most importantly, let me know how to make your time in CHAL enjoyable.

Then, help us put your ideas into

action. If you have never been to a meeting, give it a try. If you have left the division, give it another chance. Come to the fall annual meeting in Philly, visit the technical program that our program chair set up, the executive board meeting on Sunday, or just come have a drink at our reception on Monday. Just Come...Look Around...Have Fun...

Finally, as this is my last report as chair, I would like to take a moment to thank all of the individuals that so freely give of their time to make this division run. The names are too numerous to mention here (and I would be afraid that I would leave someone out), but you can find them throughout this newsletter, e.g., the list of executive board members and all of those people associated with the technical program for Philadelphia. Each and every person who volunteers his or her time plays an important role in the division. Their hard work is greatly appreciated.

Bill Johnson

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Councilors' Report

The Council has been referred to as the American Chemical Society's legislative body. The Council is made up of representatives from each local section and each division as well as ACS' national officers and the Board of Directors. Local sections and divisions are allocated councilors according to the number of members. CHAL is allotted two councilors. Your Councilors are Howard Peters, who was just re-elected to a three-year term from 2004 through 2006, and Alan Ehrlich, who is finishing his first three-year term in 2004. Alternate Councilors, who attend when their Councilor is unavailable, are James Carver and Alice Robertson.

The Council took several actions at the spring meeting in Anaheim.

First, The Committee on Nominations and Elections presented to Council the following nominees for selection as candidates for President-Elect for 2005: Edward M. Eyring, F. Sherwood Rowland, Gary B. Schuster and Isiah M. Warner. By written ballot the Council selected F. Sherwood Rowland and Isiah M. Warner as candidates for 2005 President-Elect. They join E. Ann Nalley, who was certified as a petition candidate for 2005 President-Elect. Accordingly, the names you will see on your ACS ballots this fall are F. Sherwood Rowland, Isiah M. Warner, and E. Ann Nalley.

The Council also elects members to the Committee on Committees and the Committee on Nominations and Elections. The Committee on Nominations and Elections presented Lawrence Barton and Connie J. Murphy to Council as candidates for election to the Committee on Committees (ConC) to fill a vacancy. The vacancy was created by the resignation of Nancy B. Jackson, who was elected to the Board of Directors as a Director-at-Large. By written ballot the Council elected Connie J. Murphy.

Candidates Roger A. Parker and CHAL's Membership Chair, Jack Riley, were presented to Council for election to the Committee on Nominations and Elections (N&E). The election was to fill a vacancy on the committee that was created by the resignation of James W. Long. By written ballot the Council elected Roger A. Parker. Our thanks to Jack for waving the flag for CHAL and for serving CHAL and ACS so well for so many years.

The Council took two other actions at the spring meeting. Each year the Council approves member dues as

authorized in the Bylaws. At this meeting, the Council voted to set the member dues for 2005 at \$123.00, the fully escalated rate established by the formula set two years ago. The Council also voted to formally dissolve, as of June 30, 2004, the probationary Division of Laboratory Automation. This action was taken at the request of the Division's leadership.

The Council also reviews and votes on petitions for changes to the Constitution and By-Laws. The established procedure is for a petition to be presented at one meeting for consideration, and then at the next meeting for action. At the Anaheim meeting, the Council received for consideration three petitions: Petition for Electronic Balloting; Petition to Change Division Annual Report Deadline; and Petition for Membership Requirements for Teachers. There was no discussion at the Council meeting on these new petitions. Action is expected on these petitions at the 2004 fall national meeting in Philadelphia.

The most interesting part of the Council meeting was a special discussion item about a possible partnership between ACS and the American Institute of Chemical Engineers (AIChE). ACS President Charles Casey and Board Chair James Burke briefed the Council on the status of these partnership efforts between the ACS and the AIChE and noted the implication of these efforts for ACS. Councilors then participated in a discussion of this issue, although there were no specific decisions or actions taken by the Council at the meeting. Currently the ACS and the AIChE are pursuing a programmatic alliance that will more fully serve the needs of their members and the chemical enterprise, while enhancing both organizations' abilities to achieve their missions. Consideration also is being given to a membership alliance that could include expanded opportunities for members to participate more fully in both organizations. The discussion at Council revealed strong support for moving forward with these initiatives and identified key factors for consideration.

Alan Ehrlich and Howard Peters

Membership

Application blank is on page 13 of this Newsletter. Ask a colleague to join you in the Best Division in the ACS. Personal invitations support our growth.

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BROOKS & PHILLIPS**
— L.L.P. —
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Program for Philadelphia Meeting

Division of Chemistry and The Law

August 22 - 26, 2004

B. C. Meadows, Program Chair W. R. Johnson, Chair

SUNDAY MORNING

Session A

Loews – Howe

The Many Faces of CHAL

Key Topics in Patent Law from the U.S. and Abroad

B. C. Meadows, Organizer

S. Thompson, Presiding

1. 9:30 What me worry? Patent application publications and provisional rights. *D. L. Rieger*
2. 10:00 Recent updates to chemical patent practice in the United States. *S. Thompson*
3. 10:30 Changes in foreign patent practice. *S. Thompson*
4. 11:00 Changes in foreign patent practice. *S. Thompson*

SUNDAY AFTERNOON

Session A

Loews -- Howe

The Many Faces of CHAL

Key Topics in Patent Law from the U.S. and Abroad

B. C. Meadows, Organizer, Presiding

5. 1:30 Avoiding costly mistakes in obtaining broad patent protection in a post-Festo world. *J. Calve*
6. 2:00 Inventoship: How to get it right the first time. *S. Thompson*
7. 2:30 The law of Eleventh Amendment Sovereign Immunity: Can state university researchers be held liable for patent infringement? *J. J. Hasford*
8. 3:00 Introduction to Israel's idiosyncratic IP infrastructure. *D. J. Feigelson*

MONDAY MORNING

Session A

Loews -- Howe

Pharmaceutical Legislation and Regulation

Cosponsored with Committee on Patents and Related Matters

A. Bloom and A. M. Ebrlich, Organizers
K. Colton, Organizer, Presiding

- 8:30 Introduction. *K. Colton.*
9. 8:45 History of the Hatch-Waxman Act. *J. Leeds*
10. 9:15 Litigation under the Hatch Waxman Act. *S. Stack*
11. 9:45 Foreign drug importation: A cure for what ails you or prescription for trouble? *F. A. Stearns*
- 10:15 Intermission.
12. 10:30 The innovator company's perspective on generic biologics. *D. Elderkin*
13. 11:00 Generic biologicals: The first steps? *B. Moriarity*

MONDAY AFTERNOON

Session A

Loews -- Howe

Value Creation and Protection for High-Tech and Knowledge-based Companies

E. H. Barash, Organizer, Presiding

14. 1:25 Introduction to value creation and protection for high tech and knowledge-based companies. *E. H. Barash*
15. 1:30 The basics of patent law. *E. H. Barash*
16. 2:00 Patent prosecution and traps for the unwary. *J. Cox*
17. 2:30 Patent litigation primer. *J. J. Hasford*
18. 3:00 A case study on building a start-up knowledge-based company. *S. Byrn*
19. 3:30 Licensing for the high-tech knowledge-based company. *S. Florance*
20. 4:00 Licensing issues for small companies. *E. H. Barash*

MONDAY EVENING

Session A

Pennsylvania Convention Center – Hall D

Sci-Mix

H. M. Peters, Organizer

8:00 - 10:00

21. 2004 Inductees: National Inventors Hall of Fame - PART A. *H. M. Peters*

22. 2004 Inductees: National Inventors Hall of Fame - PART B. *H. M. Peters*
23. 2004 Inductees: National Inventors Hall of Fame - PART C. *H. M. Peters*
24. 2004 Inductees: National Inventors Hall of Fame - PART D. *H. M. Peters*
25. Regulating the lawful and safe production of chemical components in Uzbekistan. *B. A. Turaev*

TUESDAY MORNING

Session A

Loews -- Howe

Mock Patent Prosecution: From Preparation of the Application to Examination and Issuance

B. C. Meadows, Organizer, Presiding

26. 9:25 Introduction to mock patent examination. *B. C. Meadows*
27. 9:30 Preparing the application: Drafting claims in view of the prior art. *S. Thompson*
28. 10:00 Search and Examination: A look from the Examiner's perspective. *J. Calve*
29. 10:30 My claims were rejected, what now? *W. R. Johnson, B. C. Meadows*
30. 11:00 Allowable subject matter, what happens next? *J. Calve*
- 11:30 Discussion.

TUESDAY AFTERNOON

Session A

Loews -- Howe

Careers in Chemistry and The Law

Cosponsored with YCC

B. L. Lences, Organizer, Presiding

- 1:25 Introductory Remarks.
31. 1:30 Careers in technology transfer. *A. M. Ebrlich*
32. 2:00 Non-traditional careers in chemistry: Patent Law. *S. Thompson*
33. 2:30 Patent agent man, Episode 2: To chemistry and law, he is no stranger. *D. W. Ladner*

34. 3:00 The chemistry of regulatory.
B. A. Charpentier
35. 3:30 Using science outside the lab:
Intellectual property litigation.
M. A. McKithen

WEDNESDAY MORNING

Session A

Loews -- Howe

**Investigating and Prosecuting
Environmental Crimes***B. C. Meadows, Organizer, Presiding*

36. 9:30 Prosecuting environmental
crimes: From a federal
perspective. *C. Votaw*
37. 10:00 Prosecuting environmental
crimes: The state and local
perspective. *L. Deutchman*
38. 10:30 Investigating environmental
crimes: From the federal
perspective. *T. Browning*

39. 11:00 Investigating releases and
exposures: From the private
sector perspective.
D. M. Stainken
- 11:30 Panel Discussion.

WEDNESDAY AFTERNOON

Session A

Loews -- Howe

**Current Trends in Patent Procurement
and Litigation**Cosponsored with The Philadelphia
Intellectual Property Law Association
(MCLE credit pending)*L. Malinoski, Organizer, Presiding*

- 1:25 Introductory Remarks.
40. 1:30 Preparing patent applications
with litigation in mind.
J. Lucci

41. 2:00 The application of domestic
patent law to the manufacture
of products abroad.
D. R. Bailey
42. 2:30 The "Cooperative Research and
Technology Enhancement Act"
(CREATE) recently passed by
the House of Representatives.
W. Choi
43. 3:00 Inequitable conduct: A new
plague? *T. Rachinsky*
- 3:30 Panel Discussion.

THURSDAY MORNING

Session A

Loews -- Howe

The Lawyer Is In*B. C. Meadows, Organizer, Presiding*

44. 9:30 Meet the members of CHAL.
B. C. Meadows, W. R. Johnson

Newsletter Costs and Delivery Mode

A significant portion of the divisions budget is expended for our newsletter costs. These include layout and preparation of an electronic file which is needed for printing, generation of a current address file, labeling and packaging for postage, using our non-profit postal permit, and the postage itself. We have reduced the number of pages from a high of 28 to the current 16 pages.

We are considering posting the abstracts and program on the web and sending an email notification to members that the new newsletter is

available at our web site. We would no longer print 1500 copies, nor incur package, label and postage expense.

A high percentage of our members have email addresses. Those members without email would be notified of newsletter posting by U.S. mail. Access to the Internet does not require an email account but we don't have the data on web accessibility.

Also being examined is a combination of a four-page notification which includes a two page program, the chair's message, a listing of officers and board members, special events and election dates. For the abstracts, members would access the web site and print what they wish. The Board will discuss these matters in Philadelphia.

John F. Riley
CHAL Webmaster

CHAL Newsletter Is On the Web

This newsletter (Fall 2004) is Vol. 20, No. 2, and is now available on our web page. The address for the home page for Chemistry and The Law is: <http://membership.acs.org/c/cbal/>.


All sixteen pages are available and the two page program for the Philadelphia meeting is also there as a separate entity. The newsletter was posted on July 30th.

If you haven't visited our home page, you may be surprised to find that we have also posted the previous five newsletters as well. So with the addition of Fall 2004, you have three full years of CHAL newsletters at your beck and call.

The newsletters are in PDF format and to view them you will need the software, Adobe Reader, which is available free at:

<http://www.adobe.com/products/acrobat/readermain.html>.





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Abstracts for Chemistry and The Law Papers

228th ACS National Meeting

Philadelphia • August 22-26, 2004

1. What me worry? Patent application publications and provisional rights

Dale L Rieger, Fish & Richardson, P.C, 12390 El Camino Real, San Diego, CA 92130, Fax: 858-678-5099, rieger@fr.com

A common question patent attorneys receive from chemical researchers is what effect a patent application publication has on the chemist's ability to conduct their research. While patent application publications do not provide the patent applicant with the full panoply of rights conferred by a granted patent, certain rights do attach to the publication. This talk will review so-called provisional rights gained from a published patent application in the U.S., Japan, Europe and other jurisdictions, including how such rights may be exercised and the timing thereof. Strategies for patent applicants and for competitors with respect to such rights will also be discussed.

2. Recent updates to chemical patent practice in the United States

Sandra Thompson, Bingham McCutchen LLP, 600 Anton Boulevard, Costa Mesa, CA 92626, Fax: 714-830-0722, sandra.thompson@bingham.com

Case law, practice tips, and updates from the USPTO are discussed in relation to chemical patent prosecution practice.

3. Changes in foreign patent practice

Sandra Thompson, Bingham McCutchen LLP, 600 Anton Boulevard, Costa Mesa, CA 92626, Fax: 714-830-0722, sandra.thompson@bingham.com

Recent changes and updates to PCT, European and Pacific Rim patent practice will be discussed in relation to chemical patent prosecution practice.

4. Federal Circuit Markman Jurisprudence: Patchwork quilt or jigsaw puzzle?

Brian C. Meadows, Needle & Rosenberg, PC, 999 Peachtree Street, Suite 1000, Atlanta, GA 30309, Fax: 678-420-9301, bmeadows@needlerosenberg.com

This talk will explore the seemingly inconsistent framework for the Federal Circuit's approach to claim construction and attempt to reconcile the Federal Circuit's two canons of claim construction: "Ordinary Meaning" vs. "Recourse to the Specification."

5. Avoiding costly mistakes in obtaining broad patent protection in a post-Festo world

John Calve, United States Patent and Trademark Office, Crystal Plaza, 2021 South Clark Place, Arlington, VA 22202, John.Calve@uspto.gov

In Festo, the patent holder argued that although the competitor's device did not fall within the literal claims of the patent, the device was so similar that it infringed under the doctrine of equivalents (DoE). The United States Supreme Court held that the patent holder could not rely on the DoE unless the equivalent was unforeseeable and therefore could not have been added to the claims when amended. In the recent case Glaxo v. Impax (2004) the Federal Circuit applying the Festo guidelines held that a competitor's use of hydroxypropyl cellulose (HPC) as a sustained release agent did not infringe Glaxo's patented use of hydroxypropyl methylcellulose (HPMC) because HPC was an equivalent that was foreseeable when Glaxo amended the claims. In this talk I will discuss Festo and the DoE, review the post-Festo cases that address foreseeability and suggest ways to circumvent the harness of Festo.

6. Inventoship: How to get it right the first time

Sandra Thompson, Bingham McCutchen LLP, 600 Anton Boulevard, Costa Mesa, CA 92626, Fax: 714-830-0722, sandra.thompson@bingham.com

It is a requirement that U.S. patent applications be filed in the name of the

true inventors of the claimed subject matter. In practice, determining who is an inventor can be a difficult task. This talk will provide an overview of the law governing inventorship and discuss strategies and practice tips for making the inventorship determination.

7. The law of Eleventh Amendment Sovereign Immunity: Can state university researchers be held liable for patent infringement?

Justin J. Hasford, Finnegan, Henderson, Farabow, Garrett and Dummer, 1300 I Street, NW, Washington, DC 20005, Justin.Hasford@finnegan.com

The Eleventh Amendment to the U.S. Constitution prohibits private parties from suing States in federal court. Narrow exceptions to State sovereign immunity include actions for prospective injunctive relief, waiver (State consent to federal suit), and congressional abrogation of immunity. In 1992, Congress passed the Patent Remedy Act, which abrogated Eleventh Amendment immunity and allowed patent owners to sue States in federal court for patent infringement. The Supreme Court responded by invalidating the Patent Remedy Act in *Florida Prepaid v. College Savings*, thereby upholding State sovereign immunity in patent infringement litigation. Senator Patrick Leahy has introduced legislation—the Intellectual Property Restoration Act of 2003—that would require States to waive Eleventh Amendment immunity in order to obtain full intellectual property rights. Upon judicial review, however, the Restoration Act probably would be struck down as unconstitutional under *Florida Prepaid*. Nonetheless, a variety of remedies still exist when a State infringes a patent.

8. Introduction to Israel's idiosyncratic IP infrastructure

Daniel J. Feigelson, Advocate and Patent Attorney, 35 Hanasi Harishon Street, Rehovot, Israel, djfeigel@netvision.net.il

Israel is home to major generic drug and agrochemical companies, one of the world's primary producers of bromine-containing compounds, and a growing biotechnology industry. As many of these companies' exports compete in the U.S. market, obtaining patent protection in Israel is often a necessary component of U.S.-based companies' business strategies. But while the patent system in Israel is similar in many ways to the U.S. patent system, there exist significant and in some cases unique differences that can cause headaches for unprepared applicants and patentees. This talk will focus on some of these differences, as well as the effects of recent legislative efforts ostensibly aimed at minimizing these differences.

9. History of the Hatch-Waxman Act

Jim Leeds, Associate General Patent Counsel, Eli Lilly, Lilly Corporate Center, Indianapolis, IN 46285, LEEDS_JAMES@LILLY.COM

The Drug Price Competition and Patent Term Restoration Act of 1984 (Hatch-Waxman Act) enabled an evolution in the pharmaceutical industry. The Act was a compromise between two competing objectives: provide innovators with meaningful periods of market exclusivity to encourage investment in the research and development of new drug products, and enable competitors to bring cheaper generic versions of those drugs to market. After almost 20 years, most commentators would agree that the Act has been a success as evidenced by the fact that, while the brand name companies continue to invest in the research and development of innovative new drug products, almost fifty percent of today's prescriptions are lower priced generic products. This presentation will include a discussion of the history of the Act, including legislative, regulatory and judicial developments.

10. Litigation under the Hatch Waxman Act

Stephen Stack, Dechert, LLP, 4000 Bell Atlantic Tower, 1717 Arch Street, Philadelphia, PA 19103, stephen.stack@dechert.com

The Hatch Waxman act permits a generic drug maker to choose between applying to the FDA to bring a generic drug to market only after the

patents listed for the drug in the FDA's Orange Book expire or to bring the generic drug to market before all listed patents expire. If the latter abbreviated new drug application (ANDA) is filed, the patent owner and owner of the NDA for the drug may file a patent lawsuit against generic drug maker. The FDA then stays approval of the ANDA for 30 months. Until recent changes to FDA procedures, some companies have used successive patent listings in the Orange Book to delay approvals of ANDA's for generic drugs by triggering successive 30-month stays under the Hatch Waxman Act. Some companies have also used reverse payments from patentee to accused infringer if the accused infringer will stay off the market for an agreed time. These and other issues will be discussed.

11. Foreign drug importation: A cure for what ails you or prescription for trouble?

Frederick A. Stearns, Keller and Heckman, LLP, 1001 G Street, NW, Suite 500W, Washington, DC 20001, stearns@kblaw.com

The high cost of prescription drugs is a hotly-debated health care (and political) issue. The importation of prescription medications from other countries is viewed by an increasing number of consumers (and elected officials) as a way to reduce health care expenses. But is this practice really a solution? This timely presentation will review the legal, policy, and public health concerns with importing drugs that are manufactured abroad. It will also discuss proposed changes in the law that would allow broader public access to imported prescription drug products and seek to protect public health in the process. The issues are complex but this presentation will help you see through the rhetoric and decide for yourself whether the cure is worth the price.

12. The innovator company's perspective on generic biologics

Dianne Elderkin, Woodcock Washburn, LLP, 1 Liberty Place, 46th Floor, Philadelphia, PA 19013, elderkin@woodcock.com

Much attention is now focused on how generic biologics can be approved and brought to market. This presentation will address the concerns and questions that innovator biotech companies are voicing about the procedures and policies for doing so. Questions being asked include: Do current statutes give the FDA authority to approve generic biologics? What are the innovators saying about proposals to amend the law? If the FDA were to approve generics, what should the model be? What is the feasibility of determining bioequivalence without extensive clinical testing? If the FDA were to review, is it fair and reasonable for it to rely on the innovator's proprietary manufacturing, safety and efficacy data to establish safety and efficacy of the generic?

13. Generic biologics: The first steps?

Brian Moriarity, Budd Larner, P.C., 150 John F. Kennedy Parkway, Short Hills, NJ 07078, bmoriarity@budd-larner.com

The FDA has long stated that it wants to create a regulatory or statutory mechanism to allow for the approval of generic biologics, sometimes called "follow-on" biologics, similar to the Hatch-Waxman provisions that apply to small molecule pharmaceuticals. The provisions for applying to the FDA to make a generic pharmaceutical (an ANDA) are premised, in part, on the fact that such small molecule drugs can be fully characterized and thus fully duplicated. However, with biologics, the molecules are not as easily characterized and not easily duplicated. Thus, because it is difficult, if not impossible, to show that one biologic is in all relevant aspects identical to another biologic, it is generally not possible to make a duplicate. However, for some biologics, such as certain insulins and human growth hormones, the molecules can be fairly well characterized and there is a potential pre-existing regulatory pathway that might allow for FDA approval of quasi-generic biologics of these types of drugs. This regulatory pathway under section 505(b)(2) of the FDCA was the subject of a recent FDA letter ruling. That ruling explains that a 505(b)(2) applicant for a modification of an existing drug does not need to show that its drug is identical to the other drug, but can rely on the FDA's prior findings of safety for that other drug and combine that with bridging studies to show safety for the proposed modification. While the FDA ruling relates to a pharmaceutical product, it may have relevance to biologics, particularly well characterized biologics, and provide the impetus for Congress to create a fuller statutory mecha-

nism for consideration and approval of generic biologics in general. Given that there are reported to be in excess of \$10 billion worth of biologics coming off patents in the near future, this is an important development.

14. Introduction to value creation and protection for high tech and knowledge-based companies

Eyal H. Barash, Finnegan, Henderson, Farabow, Garrett and Dunner, 1300 I Street, NW, Washington, DC 20005, Fax: 202.408.4400

In recent years, as the economy has shifted focus from traditional manufacturing to high-technology manufacturing and services, intellectual property has become increasingly important. For example, a strong IP portfolio may provide a competitive advantage over competitors who may be able to produce goods and services at lower cost. This symposium is geared toward addressing some of intellectual property issues associated with starting up and developing such enterprises. Patent procurement and litigation are covered in the symposium along with revenue generation through licensing. In addition, we will hear from speakers in academia and organizations that assist knowledge-based companies mature successfully.

15. The basics of patent law

Eyal H. Barash, Finnegan, Henderson, Farabow, Garrett and Dunner, 1300 I Street, NW, Washington, DC 20005, Fax: 202.408.4400

Abstract text not available.

16. Patent prosecution and traps for the unwary

John Cox, Finnegan, Henderson, Farabow, Garrett and Dunner, 1300 I Street, NW, Washington, DC 20005, john.cox@finnegan.com

A successful inventor must be aware of the requirements for obtaining a patent for strategic planning and developing a patent portfolio. First, the inventor must consider the legal requirements for obtaining a patent. This determines the breadth of what the application can claim. Second, the inventor must consider how the patent fits into a business strategy. This determines the breadth of what the application should claim. Third, an inventor should shepherd a patent application through the Patent Office because the prosecution of the application and the choice of procedural alternatives can have a dramatic affect on the scope of patent rights the inventor ultimately obtains. This presentation will address these issues, including how they manifest themselves during the drafting of patent applications.

17. Patent litigation primer

Justin J. Hasford, Finnegan, Henderson, Farabow, Garrett and Dunner, 1300 I Street, NW, Washington, DC 20005, Justin.Hasford@finnegan.com

Whoever without authority makes, uses, offers to sell, sells, or imports into the United States any patented invention infringes the corresponding patent. In an infringement suit, the trial court construes the scope of the patent claims and then instructs the fact finder to apply that claim construction to the accused product or process. An infringement analysis includes both literal infringement and infringement under the doctrine of equivalents, as limited by prosecution history estoppel. An invalid patent, however, cannot be enforced, and patents may be invalidated on a number of grounds including public use or sale, obviousness, and inequitable conduct. Both damages and injunctive relief are available as remedies to a successful patent owner. This presentation discusses these major issues surrounding the legal requirements for asserting and defending against a patent infringement law suit.

18. A case study on building a start-up knowledge-based company

Stephen Byrn, Charles B. Jordan, Professor and Head of the Department of Industrial and Physical Pharmacy, Purdue University, West Lafayette, IN 47907, sbyrn@purdue.com

Abstract text not available.

19. Licensing for the high-tech knowledge-based company

Sam Florance, Purdue Research Park, 3000 Kent Avenue, West Lafayette, IN 47906, florange@purdue.edu

Abstract text not available.

continued on next page

20. Licensing issues for small companies

Eyal H. Barash, Finnegan, Henderson, Farabow, Garrett and Dunner, 1300 I Street, NW, Washington, DC 20005, Fax: 202.408.4400

Abstract text not available.

21. 2004 Inductees: National Inventors Hall of Fame – A

Howard M. Peters, Peters, Verny, Jones & Schmitt, LLP, 425 Sherman Ave., Suite 230, Palo Alto, CA 94306, Fax: 650-324-1678, peters4pa@aol.com

The 2004 Inductees to the National Inventors Hall of Fame in Akron, Ohio did not follow any central theme. They were selected in February and inducted in May. See www.invent.org. Included among the inductees were Frederick Banting, Charles Best & James Collip (posthumous) for insulin for diabetics; Vannevar Bush (posthumous) for the differential analyzer; Harry Coover for SuperGlue; and Wallace Coulter (posthumous) for the blood counter. Their biographies and the U.S. patents involved are presented.

22. 2004 Inductees: National Inventors Hall of Fame – B

Howard M. Peters, Peters, Verny, Jones & Schmitt, LLP, 425 Sherman Ave., Suite 230, Palo Alto, CA 94306, Fax: 650-324-1678, peters4pa@aol.com

The 2004 Inductees to the National Inventors Hall of Fame in Akron, Ohio did not follow any central theme. See www.invent.org. Included were Ray Dolby for noise reduction systems; Edith Flanigen for molecular filters for petroleum processing; Robert Gallo and Luc Montagnier for HIV isolation and diagnosis; and Ivan Getting (posthumous) and Bradford Parkinson for the global positioning System-GPS. Their biographies and the U.S. patents involved are presented.

23. 2004 Inductees: National Inventors Hall of Fame – C

Howard M. Peters, Peters, Verny, Jones & Schmitt, LLP, 425 Sherman Ave., Suite 230, Palo Alto, CA 94306, Fax: 650-324-1678, peters4pa@aol.com

The 2004 Inductees to the National Inventors Hall of Fame in Akron, Ohio did not follow any central theme. See www.invent.org. Included were John Gibbon (posthumous) for the heart-lung machine; Lloyd Hall (posthumous) for food preservation techniques; Elias Howe (posthumous) for the sewing machine and Charles Kelman for cataract eye surgery. Their biographies and the U.S. patents involved are presented.

24. 2004 Inductees: National Inventors Hall of Fame – D

Howard M. Peters, Peters, Verny, Jones & Schmitt, LLP, 425 Sherman Ave., Suite 230, Palo Alto, CA 94306, Fax: 650-324-1678, peters4pa@aol.com

The 2004 Inductees to the National Inventors Hall of Fame in Akron, Ohio did not follow any central theme. See www.invent.org. Included were Bernard Oliver and Claude Shannon (posthumous) for pulse code Modulation; Norbert Rillieux (posthumous) for modern sugar refining; and John Roebling (posthumous) for the modern suspension bridge. Their biographies and the U.S. patents involved are presented.

25. Regulating the lawful and safe production of chemical components in Uzbekistan

Babtiyor A. Turaev, Department of Law, Samarkand State University, University Boulevard 15, Nor Yakubov street 2/18, Samarkand 703029, Uzbekistan, tbabtik@yahoo.com

The development of the chemical industry in Uzbekistan has resulted in a need for the management and prevention of various safety concerns. Ensuring the safety of the general population and the environment has come to represent a complicated social-economic problem, the solution to which will depend on the interactions between economic, social, ecological and demographic factors. One of the current criminal measures designed to address and ensure the safe handling of harmful chemical components in Uzbekistan was adopted in 2001. This presentation will explore the criminal liabilities and the punishments imposed for violations of this measure.

26. Introduction to mock patent examination

Brian C. Meadows, Needle & Rosenberg, PC, 999 Peachtree Street, #1000, Atlanta, GA 30309, Fax: 678-420-9301, bmeadows@needlerosenberg.com

The mock patent prosecution will present some of the issues related to

preparing, filing and prosecuting a chemical patent application in the United States Patent and Trademark Office. The mock prosecution will focus on preparing the application and claims in view of prior art; the various filing formalities and duties of disclosure; the patent examiner's search and examination of the application as filed; responding to an office action that has rejected claims; and what happens after a finding of allowable subject matter.

27. Preparing the application: Drafting claims in view of the prior art

Sandra Thompson, Bingham McCutchen LLP, 600 Anton Boulevard, Costa Mesa, CA 92626-1950, Fax: 714.830.0722, sandra.thompson@bingham.com

Abstract text not available.

28. Search and Examination: A look from the Examiner's perspective

John Calve, United States Patent and Trademark Office, Crystal Plaza, 2021 South Clark Place, Arlington, VA 22202, John.Calve@uspto.gov

Abstract text not available.

29. My claims were rejected, what now?

William R. Johnson, Solvay Chemicals, Avenue Orban, 76, 1150 Brussels, Belgium, Fax: 32 2 763 1730, wjohnson2001@comcast.net, and Brian C. Meadows, Needle & Rosenberg, PC, 999 Peachtree Street, Suite 1000, Atlanta, GA 30309, Fax: 678-420-9301, bmeadows@needlerosenberg.com

Abstract text not available.

30. Allowable subject matter, what happens next?

John Calve, United States Patent and Trademark Office, Crystal Plaza, 2021 South Clark Place, Arlington, VA 22202, John.Calve@uspto.gov

Abstract text not available.

31. Careers in technology transfer

Alan M. Ehrlich, Office of General Counsel, U.S. Environmental Protection Agency, Mail Code 2377A, 1200 Pennsylvania Ave., NW, Washington, DC 20460, Fax: 202-564-5431, ehrlich.alan@epamail.epa.gov

Technology transfer has been defined in many ways. Perhaps the most popular one today refers to the process of commercializing inventions from research organizations, especially universities, non-profit research institutions, and government laboratories. The author will discuss this process, the legislation that has enabled it, and the careers that are available in the field.

32. Non-traditional careers in chemistry: Patent Law

Sandra Thompson, Bingham McCutchen LLP, 600 Anton Boulevard, Costa Mesa, CA 92626-1950, Fax: 714.830.0722, sandra.thompson@bingham.com

Intellectual property is one of the cutting edge sectors of the legal profession and continues to grow each year. A creative chemist can branch out into the field of patent law, while using all aspects of his/her chemical knowledge. Client counseling, litigation, portfolio strategies and company long-term projects and chemical/pharmaceutical products are just a few of the issues that a patent attorney can handle. This talk will focus on making the transition from chemistry into patent law - pitfalls, tips and how to make the most out of your chemical degree.

33. Patent agent man, Episode 2: To chemistry and law, he is no stranger

David W. Ladner, Bayer Pharmaceuticals Corporation, West Haven, CT, david.ladner.b@bayer.com

A previous presentation dealt with the author's recent career transition from a Research Chemist/Manager to a Chemistry Patent manager, and outlined the skill set and qualities which he found common to both. Now, after several years of experience, he will share further insights into the sim-

ilarities and differences he has observed. Such insights may assist others who are considering a move from research into Patent Law. Other common pathways for scientists to enter a Patent Law career will be discussed, and suggestions will be given to help applicants better position themselves for consideration by employers.

34. The chemistry of regulatory

Bonnie A. Charpentier, Genitope Corporation, 525 Penobscot Drive, Redwood City, CA 94063, bcharpentier@genitope.com

As the pace of development quickens in pharmaceutical and biotechnology enterprises and the technologies become more complex, it is increasingly critical for regulatory professionals to have a sound grounding in science. The role of the regulatory professional at the interface of scientific and legal disciplines is important to effective drug development. Experience as a chemist can provide a strong science background and analytical skills, which are valuable tools in developing, and gaining approval for new drugs and biologics. This presentation will summarize one chemist's experience in regulatory affairs in large pharma and in small biotech, with an emphasis on the role of chemistry in regulatory, and regulatory in discovery and development.

35. Using science outside the lab: Intellectual property litigation

Marc A. McKitthen, Milbank, Tweed, Hadley and McCloy, 1 Chase Manhattan Plaza, New York, NY 10005

The advantages and application of a chemistry education in patent litigation will be presented.

36. Prosecuting environmental crimes: From a federal perspective

Catherine Votaw, United States Attorney's Office, 615 Chestnut Street, Suite 1250, Philadelphia, PA 19106, cathy.votaw@usdoj.gov

Abstract text not available.

37. Prosecuting environmental crimes: The state and local perspective

Leonard Deutchman, Philadelphia District Attorney's Office, 1421 Arch Street, Philadelphia, PA 19102, leonard.deutchman@pbila.gov

Abstract text not available.

38. Investigating environmental crimes: From the federal perspective

Thomas Browning, Criminal Investigations Division, U.S. Environmental Protection Agency, 1650 Arch Street, Philadelphia, PA 19103, thomas.browning@epamail.epa.gov

Abstract text not available.

39. Investigating releases and exposures: From the private sector perspective

Dennis M. Stainken, Princeton Somerset Group, 4 Carroll Drive, Hillsborough, NJ 08844, prinsongrp@aol.com

Abstract text not available.

40. Preparing patent applications with litigation in mind

Joe Lucchi, Woodcock Washburn, LLP, 1 Liberty Place, 46th Floor, Philadelphia, PA 19013, lucchi@woodcock.com

This presentation will focus on some unforeseen problems that many all-too-common drafting and prosecution practices can create in subsequent patent litigation, and provide practical tips for avoiding them. The presentation will provide up-to-date advice on dealing with recent decisions of the CAFC concerning claim construction, equivalents, prosecution history estoppel, and inequitable conduct.

41. The application of domestic patent law to the manufacture of products abroad

David R. Bailey, Woodcock Washburn, LLP, 1 Liberty Place, 46th Floor, Philadelphia, PA 19013, bailey@woodcock.com

Recent district court decisions have struggled with the issue of whether 35 U.S.C. μ 271(f) provides the authority to regulate the transfer of information to foreign countries for use in the manufacturing of products that are used as components of a patented invention. At its broadest level, these decisions suggest that district courts have the power to impose worldwide injunctions against American companies who develop products domestically, but manufacture abroad. The ramifications of the decisions in the Eolas, Imagexpo, and AT&T cases are particularly troubling for the American software industry. Those decisions, if affirmed this year by the Federal Circuit, could essentially prohibit software companies from exporting their information abroad for manufacture and sale in any foreign country.

The presentation will explore the background of μ 271(f) from the Supreme Court's 1972 DeepSouth Packing decision, the legislative history leading to the enactment of the statute in 1984, and the application of μ 271(f) to date. Particular emphasis will be paid to the various cases currently on appeal before the Federal Circuit concerning μ 271(f) and the manner in which they could affect the way in which American companies develop products in the United States if those products are ever to be manufactured and sold in foreign countries.

42. The "Cooperative Research and Technology Enhancement Act" (CREATE) recently passed by the House of Representatives

Wendy Choi, Woodcock Washburn, LLP, 1 Liberty Place, 46th Floor, Philadelphia, PA 19013, choi@woodcock.com

Recently, the House of Representatives passes CREATE to ease the obviousness standard for patenting inventions that result from joint R&D programs. CREATE was prompted by the Federal Circuit's obviousness ruling in OddzOn Products Inc. v. Just Toys Inc. CREATE would shore up the validity of patents arising out of joint R&D program by defining the statutory term "owned by the same person" in to include parties to the joint R&D agreement, subject to a set of conditions.

43. Inequitable conduct: A new plague?

Tara Rachinsky, Woodcock Washburn, LLP, 1 Liberty Place, 46th Floor, Philadelphia, PA 19013, rachinsky@woodcock.com

The case of Hoffmann-La Roche, Inc. v. Promega Corp. illustrates some types of statements made by applicants that could potentially give rise to charges of inequitable conduct with respect to patents on chemical (and other) inventions. These include: characterizations of the prior art, (non) disclosure of experimental results, and presentation of examples (prophetic vs. actual).

44. Meet the members of CHAL

Brian C. Meadows, Needle & Rosenberg, PC, 999 Peachtree Street, Suite 1000, Atlanta, GA 30309, Fax: 678-420-9301, bmeadows@needlerosenberg.com, and William R. Johnson, Solvay Chemicals, Avenue Orban, 76, 1150 Brussels, Belgium, Fax: 322-763-1730, wjohnson2001@comcast.net

This will be an informal drop-in session where questions can be asked of the lawyers and/or patent agents including, but not limited to those listed above. These lawyers and patent agents will be members of CHAL, available here without fee. Questions may be about any topic you desire: about legal career options, and about the law itself: patent, trademark, copyright, tradeselect, etc. Questions may be of practical or theoretical interest. The discussions should be interesting, notwithstanding that correct answers are not guaranteed. This session will be of an informational and educational nature only; the considerations of questions asked will not be in the context of any lawyer-client relationship; answers (if known) will not be given as legal advice

Minutes of CHAL Executive Committee Meeting

March 28, 2004 Anaheim, California

Attendance: Bill Johnson (Chair), Brian Meadows (Chair-Elect), Charles F. Hauff, Jr. (Previous Past Chair), Barbara L. Lences (Treasurer), Dr. Sandra P. Thompson (Secretary, Acting), Dr. Howard M. Peters (Councilor), Dr. Alan Ehrlich (Councilor), Dr. James C. Carver (Alternate Councilor), Dr. Hubert Dubb (Archivist), Dr. John F. Riley (Membership), Carl Lippenberger (Chair of Ad-hoc Sub-committee), Edlyn Simmons (Board-Member-At-Large), Dr. Neal Langerman (CHAS Representative)

Goals for Programming and Involvement

Bill Johnson

It was discussed that the CHAL group comprises a list of deeply involved members who want a broad range of programming at National Meetings, including programming related to intellectual property and programming related to fields outside of intellectual property, such as toxic torts, forensics, safety issues, alternate careers in chemistry, chemical and related legal issues that are regional to the site of the particular National Meeting.

One of the issues discussed was that the programming is largely determined by those who want to participate in the meetings. Several ideas were brought up in order to involve members who have been relatively inactive in the programming to date, including announcements on programs at other related ACS symposia, programming with other divisions (for example, CHAS, Small Business Section, Analytical Section), public relations, E-mailing newsletter and other announcements to members, reviving the positions of litigation chair and regulatory chair.

Program Chair Report

Brian Meadows

Brian reported that the programming for the Philadelphia National Meeting was coming together. A full day of forensics talks had been arranged, along with intellectual property talks. A patent examination

demonstration has been arranged for one of the sessions.

Possible programming for future meetings was discussed, including the Washington, DC meeting. Ideas for programming included talks from FDA employees, USPTO employees or Board of Appeals judges, Chesapeake Bay legal issues.

CLE was provided for a couple of sessions during the Anaheim meeting as a trial for future meetings. CLE at the Philadelphia meeting may be possible, but Carl was going to check with possible Philadelphia providers. The San Diego meeting should be able to be CLE supported for several law related sessions. One of the key issues to providing CLE credits for attorneys is the ability to submit the written materials being provided to the provider before the conference. If written materials are submitted, the CLE provider can give full credit for a session or part of a session. Attorneys at future meetings should check the tables outside of the session for CLE sign-in sheets.

Treasurer's Report

Barbara Lences

Barbara provided the Board with a Treasurer's Report for January 1 – March 25, 2004. The Starting Balance was \$1,834.59 with income reported as \$7,490.00. Expenses totaled \$9,065.87 and included incorporation fees, costs associated with the Spring newsletter, bulk mail fees, postal expenses, Councilor reimbursements for Anaheim and bank charges. The

ending balance was reported as \$258.72.

The first topic discussed was the reception at the Philadelphia National Meeting and possible sponsors for the reception. The Chemical Heritage Foundation of Philadelphia was discussed as a possible site for the reception. Barbara agreed to follow up with Thomson Scientific regarding sponsorship for Philadelphia reception.

Discussion then centered around division income and expenditures. One large expenditure is the newsletter (layout, printing and mailing). Several solutions to cut the costs of the newsletter were discussed, including e-mailing the newsletter to members, reviewing how the newsletter is being produced and possibly moving to another graphics person/company, including the ballot mailing with the newsletter. Approximately 1,600 copies of the newsletter are produced twice a year at an estimated cost of \$5,000/mailing.

Councilor's Report

Dr. Alan Ehrlich

Alan reported that three petition items are being discussed:

- Electronic Balloting Petition
- Requirements for Membership
- Deadline for Annual Report (15 March now, 15 February proposed)

Minutes from the previous Board meeting were approved.

A teleconference for April 13 was scheduled for the Board.

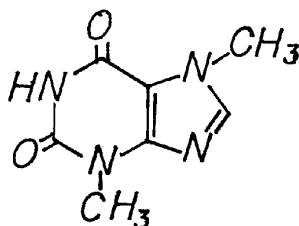
Meeting Adjourned.

PATENT TRUTHS

Howard Peters¹

Chocolate Food of the Gods²

1. "Theobroma" really does translate from the Greek as "God's food." Theobromine,³



a component of chocolate, is an N-demethylated derivative of caffeine.

2. Use the Google search engine for "chocolate" and you will get about 6,500,000 hits. Which ones are of interest? Here are some to consider:

- Hershey www.hersheys.com
Chocolate for the trencherman. The Hershey's facility in Oakdale, CA stopped plant tours after 9/11.
- Nestlé www.nestle.com The Swiss food giant is credited with inventing condensed milk and canned milk. Daniel Peter, a Nestlé employee, is credited with inventing solid milk chocolate for bars in Basel in the 1840s. So far, I have not been able to connect this Daniel Peter to my Peter(s) (the spelling of my original German family name) family tree – but I will continue trying.
- Mars www.mars.com Snickers, Milky Way, Pedigree dog food? A \$41 billion conglomerate started by Frank and Ethel (Ethel M.) Mars about 1911 in Tacoma, Washington; and vastly expanded by their son Forrest. The company is still privately held, and one book describes the Mars family as "strange." Judge for yourself.
- See's Candies www.sees.com A personal favorite! See's is a part of Warren Buffet's hugely successful Berkshire-Hathaway growth fund. Charles Huggins, the then See's president, spoke to our SCV group in 1997. (Thank you, Herb Silber.)

Mr. Huggins brought truffles for everyone, but I got the 10-pound solid bar of Guittard chocolate, the Burlingame chocolate supplier for See's (a single serving at our house!). Guittard dark bittersweet in the 10-pound bar is available at the Milk Pail market in Mountain View (San Antonio Road and California Ave., 650-941-2505. Call ahead – it goes really fast.) Did you know the classic 'I Love Lucy' candy making assembly line episode was filmed in Pasadena at the See's facility?

- Scharffenberger www.scharffenberger.com A new local chocolate company specializing in dark bittersweet chocolate – wonderful stuff. Their plant tour in Berkeley is great – the smell is worth the trip in itself. See the web site for a 90 sec MPEG virtual tour – a must-see.
- Ghirardelli www.ghirardelli.com It was started in 1852 in San Francisco and it was the oldest family owned chocolate company in the country.

3. The "CHUNKY" candy bar was really named for the founder's daughter. Thanks, DAD.

4. "Baby Ruth" the candy bar from the Curtis Candy Company of Philadelphia was named for Ruth Cleveland the infant daughter of U.S. President Grover Cleveland – with the new parents' agreement. [It is not to be confused with Curtis Publishing Company (Look, Vogue) of Philadelphia with Edward Bok as publisher. Derek Curtis Bok, a grandson of Bok graduated from Stanford in 1968 and went on to get a law degree at Harvard, and

later become the Dean of the Harvard Law School. He was named President of Harvard College about 1983. This was the time when the president of Harvard was a Stanford grad, and the president of Stanford Dr. Donald Kennedy was a Harvard grad. Will wonders never cease?]

5. Percy L. Spencer – who was he? See www.invent.org, at the National Inventors Hall of Fame. He was the self-taught engineer with a grammar school education that first created the mass production of the magnetron (U.S. Patent 2,405,235 – useful in radar) for Raytheon in Mass. He won the DOD's highest civilian award for this. Spencer is mostly remembered as the engineer who had the chocolate bar in his shirt pocket when he got too close to an operating magnetron. The chocolate bar melted. (we don't ask what happened to his heart and lungs). He sent out for popcorn and it popped – as he assumed it would. Next he tried eggs – they exploded. Raytheon's RADARRANGES soon incorporated the expensive magnetron (sort of like having a Porsche engine in your lawn mower) and never really were a commercial success. By 1970 when the patent rights ran out, Raytheon had lost money and considered the RADARRANGE to be a financial flop. Yet today 80% of all U.S. households have a microwave oven.

7. THE CHOCOLATEFEST is usually held locally in the evenings on

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continued from previous page

the weekend close to October 13th at the Belmont Congregational Church on Alameda de las Pulgas (Avenue of the Fleas). It is all the chocolate from local vendors you can eat, plus champagne and coffee. For us, it is a bargain for \$15 each. There is usually a string quartet, a raffle, and lots of fun. For more information, go to www.uccbmont.org/CFflyercol.pdf or contact the church BelmontUCC@aol.com.

8. When we were students at Stanford 40 years ago, we didn't have the money to celebrate with a bottle of wine – even Thunderbird. So when a big exam was over, a course passed, I would bike over to See's at Stanford Shopping Center to get four white chocolate divinity puffs – at 15 cents each. We left Stanford in October to go Dow Chemical in Midland Michigan. During winter, with so much snow, we couldn't see the ground until the next April. That December, I searched in vain for the white chocolate – the local product white birch bark – just didn't do it. Finally, in desperation, I put \$10 bill into an envelope to See's at Stanford with a letter explaining this dire situation. On December 23rd, I came home from the Dow lab to find Sally hunched over the See's candy box, the entire top layer was gone, she had a big smile on her face and there were all these white wrappers on the floor.

I asked, "What was she doing with my candy?"

She retorted with, "What do you mean, buddy? This is my candy. All mine." The next day, a second 2 pound box arrived in the mail. She had done exactly the same thing I had done with See's (I have often wondered what See's thought was going on). Don't be surprised, but all the candy was gone in two days.

Death by Chocolate – More Patent Truths⁴

After our chocolate talk in

February, some attendees asked for some more chocolate tidbits, trivia, truths, etc. Have you heard these?

1. "DEATH BY CHOCOLATE" is the name of (1) a good mystery novel; (2) many chocolate filled desserts in any number of restaurants; (3) a chain of made-to-order chocolate dessert shops in New Zealand, Australia, Canada, UK, etc; and (4) a colourful chocolate cookbook written by Marcel DeSaltenis, a co-owner of the Trellis Restaurant in Merchants Square adjacent to Colonial Williamsburg, Virginia. Does anyone else out there have an autographed copy?

2. What candy product did the 1981 Steven Spielberg film, E.T., of the same name follow to the shed in the back yard? Give up? "Reese's Pieces". Mars had originally agreed to participate using M&M's. But, someone high up in the company finally took a hard look at this new venture – and saw a film by an unknown director about a "friendly alien"! Mars backed out at the last minute and Hershey stepped into the breach. The movie E.T. was wildly successful and the sales of the new Reese's Pieces quadrupled in four weeks!

3. The chocolate chip cookie was occurred in the 1980's. Duncan Hines (a part of Proctor and Gamble) had issued patents to a desirable specialty chewy chocolate chip cookie. Keebler (of the elves fame) had a competing product - much too close and much too profitable. P&G sued Keebler and Dr. Rose Ann

Dabek, a patent attorney at P&G (an ACS member and former chair of the ACS Division of Chemistry and The Law and the ACS Patent Committee), was the P&G inside counsel. Jim Gould, a Penn State chemical engineer and

University Penn law graduate with Morgan & Finnigan of NYC, was the lead litigation attorney. After much maneuvering, Keebler finally settled and paid P&G \$129,000,000.00 for their infringement and ceased producing their cookies -- until the patent rights ran out. Gould was recently written up in the magazine IP Today as having won patent lawsuit judgments for his clients during his career of over \$300,000,000.00. Not too shabby. I do love stories with happy endings.

Side note: Jim and I had worked together in the Chicago federal courts for 2+ years on a soft contact lens case Syntex Ophthalmics v. Novickyin the early 1980's.

4. Russell Stover in the 1920's bought the rights to the Eskimo Pie from Christian K. Nelson of Ovarra, Iowa, as found in US Patent 1,404,539, issued Jan. 24, 1922. Within months there were many imitators and infringers. Within a year, Stover had to give up trying to enforce the legal patent rights in the courts. There were too many. The legal costs were just too high - \$4,000.00 a day in 1923 dollars. There were just too many "Eskimo Pi-rates." - that is not original with me. In 1923, the courts declared the U.S. patent invalid.

FYI – Russell Stover Candies is still the country's largest maker of boxed chocolates.

5. Chocolate has been extolled for

Snell & Wilmer
— L.L.P. —
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years as having aphrodisiac qualities. Montezuma was reported to drink his chocolate daily before he visited his harem. Writings about Don Juan in Spain describe his frequent use of chocolate. The Austrian Princess Maria Theresa who married Louis XIV (the Sun King) of France brought her chocolate and own chocolatier with her. She was addicted and is reported to have said, "Chocolate and the king are my only passions." Notice, which came first! At our February talk, I said that my wife Sally had her own comments about chocolate as an aphrodisiac and handed her the microphone. The silence was deafening. I thought she was going to say, "Candy is dandy, but liquor is quicker." Is that line original with Ogden Nash or W. C. Fields?

6. With my chocolate addiction, it can be said that, "When I am faced with a choice between two evils, I always try the one I haven't tired before." Is that line original with Mae West? I do show my age.

Notes:

1. Dr. Howard Peters is a founding and charter member of CHAL. He is a patent attorney in Palo Alto, California. He is an ACS Councilor for CHAL. This regularly appearing column, inspired by Dr. Peters'

Mission/Goals of CHAL

The mission of the Division of Chemistry and The Law is to provide a forum within ACS for members who work in careers involving the interaction of Chemistry and The Law. Some typical examples would include chemists and chemical engineers working in the fields of patents, copyright, trademarks, intellectual property, occupational health and safety, regulatory compliance, forensic science, product liability, toxic tort and environmental law.

Our goals are to provide an interactive forum for chemists who work

in these positions, to provide Division members and the ACS membership at large with high quality, inter-disciplinary programs, symposia, and publications in these areas, and to promote and increase the public understanding of chemistry and its interactions with the law.

We also desire to expose ACS members (chemists, chemical engineers, and students) to alternative career opportunities which provide an interdisciplinary challenge, between chemistry and its application to areas of law, and in law and its applications to chemistry.

Trivial Pursuit confrontations with his family, also appears (similarly) in the Silicon Valley Chemist – Newsletter of the ACS Santa Clara Section.
<http://www.scvacs.org/newsletter/index.html>

2. from Silicon Valley Chemist, February 2004, Volume 26 No. 2, pages 2 and 3.
3. also see www.acs.org Molecule of the Week – Archive – December 23, 2002 – Theobromine – CAS 83-67-0.

4. from Silicon Valley Chemist, April 2004, Volume 26 No. 4, page 3.



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12 Benefits of ACS Division Membership

Whether you join CHAL or several ACS Divisions, you will find your professional life enhanced – by new knowledge, new contacts, and new accomplishments. Division membership affords unique benefits – at modest cost. Among the benefits most valued by division members are:

1. Access to national meeting abstracts, preprints, and/or reprints of papers
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10. Recognition of your discipline's vital contribution to chemistry's advancement
11. Opportunity to suggest symposia topics and participate in technical programming
12. Continuing education and professional development opportunities

Volunteers

As everyone should know, there are no paid positions in the ACS Division of Chemistry and The Law! There is however a lot of “pro bono” work on behalf of our Division and we should acknowledge our appreciation for the many hours contributed by the volunteers. In particular, Barbara Lences, our Treasurer as been doing double-duty by serving as Secretary as well. Brian Meadows, our Chair-elect, has served as Program Chair for the past two national meetings. For Michael Grossman, our Newsletter Editor, this has been 3.5 years of labor and deadlines. Any progress we make is due to our volunteers and their willingness to “pitch in” and serve CHAL.

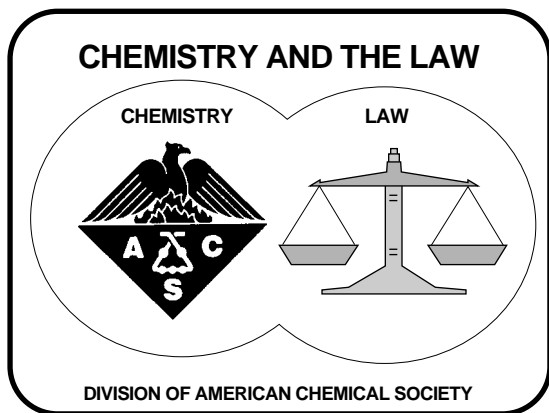
Thank you to the “movers and shakers” of our Division.

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