



# Federal Bar Association

Massachusetts Chapter

Tracy Roosevelt, Editor

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# Newsletter

SPRING 2017

## President's Column

By Scott P. Lopez



In September 1975, Chief Justice Warren E. Burger, delivered a speech which he called "The Interdependence of Our Freedoms" to the Utah Revolution Bicentennial Celebration. In his speech Chief Justice Burger identified six freedoms that flow from our Constitution. First, he noted that the three branches of our national government must each remain strong, coequal and independent of each other. However, while independent

and coequal, they must also coordinate with each other to make a workable whole. Second, he said our state governments must also be independent and free as contemplated by our founders' concept of federalism. Third, the great institutions of America, our colleges, libraries, foundations, museums, hospitals, and houses of worship he said "have no parallel anywhere in the world." He noted that the genius of these great institutions derives from their independence and individuality and "stimulated invention and technology by releasing new kinds of freedom of the mind and spirit." Fourth, he emphasized the freedoms of speech and press. Chief Justice Burger observed that during our country's formative years, since at least 1770, "free speech from pulpits, platforms, and open-air meetings flourished." Simultaneously, there was a "vigorous exercise of freedom of the press, both by regular newspapers and the great output of pamphlets, many of them authored by those who signed the Declaration and later the Constitution." Indeed, Chief Justice Burger pointedly observed that without the freedoms of speech and press, it was "doubtful whether the people would have been ready to support separation from England, or whether the Constitution would have been ratified." In Chief Justice Burger's opinion, the "vital institutions, public or private, could not have survived without the protections of the First Amendment." Fifth, although there is no reference to the legal profession in the Declaration or the Constitution or to the crucial role that it plays

in the very idea of freedom, an independent legal profession was taken for granted in 1776. Indeed, Chief Justice Burger noted that "the freedom and independence of lawyers have been key factors in our development before and since 1776." Sixth, the independence of our judges, in whose hands ultimately rests the protection of all of our freedoms, was firmly established in England by 1701. Indeed, had the same independence been extended to the royal judges sitting in the 13 colonies, one of the major grievances in the Declaration would have been removed.

Why I am bringing up the "Interdependence of Our Freedoms" in this President's column? Because on February 17, 2017, the Board of Directors for the Federal Bar Association felt compelled to issue a Statement on Judicial Independence. The statement provided:

*Judicial independence, free of external pressure or political intimidation, lies at the foundation of our constitutional democracy. An independent judiciary needs to remain free of undue influence from the legislative and executive branches and to remain beholden only to the maintenance of the rule of law and the protection of individual rights and personal liberties. We affirm the right to challenge a judge's ruling for reasons based in fact, law or policy. However, when robust criticism of the federal judiciary crosses into personal attacks or intimidation, it threatens to undermine public confidence in the fairness of our courts, the constitutional checks and balances underlying our government and the preservation of liberty.*

Because Chief Justice Burger observed that:

*When attacks were made on the independence of the judicial branch, beginning as early as 1805 with the effort to impeach Justice Samuel Chase of the Supreme Court and repeated as recently as the court packing plan of the 1930s, it was the freedom of the press and the independence of lawyers and of the Congress that combined to repulse those attacks, for the judges could not fight back. These freedoms survived because there were judges strong enough, and independent enough, to enforce the guarantees of the Constitution without regard to political currents or public clamor of the moment.*

Because on July 29, 2016, Robert J. Cordy, an associate justice of the Massachusetts Supreme Court, wrote an article in the Boston Herald entitled "Erdogan trashes Turkish democracy." Justice Cordy began his article with the statement "First they came for the journalists, and then they came for the judges." Justice Cordy's article describes Turkish President Erdogan's war on journalists and noted that in 2012 and 2013, Turkey was the leading jailer of journalists in the world. The article also describes how President Erdogan took control of the High Council of Judges and Prosecutors and began reassigning judges and prosecutors to locations away from their families if he suspected they would not bend to his will. And, after the failed coup in July 2016, President Erdogan summarily dismissed 2,745 judges and prosecutors. Justice Cordy concluded his article by stating: "What history tells us is that judicial independence and a free press are indispensable to a free society and successful constitutional democracy. And that any force that can destroy the one can probably destroy the other."

Because Winston Churchill once famously said "those that fail to learn from history, are doomed to repeat it." But, let me be clear. I am not saying that what happened in Turkey can or will happen here. Nevertheless, given the challenges that we do face, I can think of no better time to become an active member of the Massachusetts Chapter of the Federal Bar Association. The mission of the Federal Bar Association is to strengthen the federal legal system and administration of justice by serving the interests and the needs of the federal practitioner, both public and private, the federal judiciary and the public they serve. Our Chapter has thrived because lawyers who care about the federal legal system and the administration of justice devote their time and energy to making our system of justice the best in the world. As you will learn in the pages that follows, the Massachusetts Chapter brings great value to its members and our community. The time to join in our work is now. And, feel free to bring a friend or colleague with you.



## The Ginny Hurley Memorial Scholarship

Ginny Hurley joined the Clerk's Office of the United States District Court, District of Massachusetts in 1976 as a Deputy Clerk. Through the years her responsibilities grew and she touched the lives of virtually every member of the Court family. From 2003 until her passing, Ginny was responsible for organizing all of the educational programs at the Court for the bench, bar and public. Her title of "Outreach Coordinator" reflected the fact that she was the face of the court, welcoming all who came to take part in the judicial system, including dignitaries from around the world, international and national press, and students from down the street, all with grace and a smile. Ginny was a good friend, teacher and mentor. She was a quick wit, and had the ability to make people laugh.

Ginny derived great satisfaction coordinating the Court's summer programs for high school and college students – the Lindsay and Nelson Fellowship programs. She helped nurture and train the next generation to appreciate and participate in the legal progress. In memory of her tremendous work

for these students, the Massachusetts Chapter of the Federal Bar Association has established the Ginny Hurley Memorial Scholarship. This scholarship, for books or tuition expenses, will be awarded annually to all graduating Lindsay and Nelson Fellows.

### The Lindsay Fellowship

Every year, the Court selects approximately six Lindsay Fellows for a program that lasts approximately nine weeks. Fellows are college upperclassmen with an interest in a legal career. Each Fellow is assigned to a judge during the first month of the program. During that first month, the Fellows also attend an intensive program on legal research and writing with a qualified instructor. Each Fellow is assigned to either the United States Attorney's Office, Federal Defender Office or the United States Probation Office during the second month of the program. Prior to graduation, the Fellows return to the district court to compete in a moot court program before a federal judge.

<http://www.mad.uscourts.gov/outreach/lindsay.htm>

### The Nelson Fellowship

Every year, the Court selects approximately twelve Nelson Fellows. Fellows are high school students who are encouraged to attend college. Each Fellow is assigned to a judge and works in that judge's chambers. The Nelson Fellows attend trials and other court proceedings with their assigned judge and assist in office operations and court management. The Fellows take part in structured classes in subject areas such as civil rights and public speaking. During this intensive summer program, students meet community leaders, visit local colleges, and are introduced to organizations that facilitate the college application process. The final and most exciting event is the mock trial before a federal judge.

<http://www.mad.uscourts.gov/outreach/nelson.htm>

Donations are welcome. Checks should be made out to **Federal Bar Association – Massachusetts Chapter.**

**Please include a note designating the funds for Ginny Hurley Memorial Scholarship.**

Donations should be sent to FBA Treasurer Erika P. Reis c/o Eversource Energy, 800 Boylston Street, Boston, MA 02210.



THE MASSACHUSETTS CHAPTER OF THE  
FEDERAL BAR ASSOCIATION

Cordially invites you to attend its

**Annual Federal Judicial Reception**

**June 13, 2017**

6:00 pm - 9:00 pm

Boston Harbor Hotel

Wharf Room, 70 Rowes Wharf

Boston, Massachusetts 02110

The Massachusetts Chapter will proudly recognize:

**The Honorable Denise J. Casper**

For her Dedicated Service to the Judiciary,  
the Bar, and the Community that the Court serves

To reserve tickets, please contact:

Debora Corbett

Brody Hardoon Perkins & Kesten, LLP

699 Boylston Street, Boston, MA 02116

617-880-7134 \* dcorbett@bhpklaw.com

\$85 - individual tickets (FBA members)

\$100 - individual tickets (non-FBA members)

\$ 850 Firm Sponsors

(10 tickets and FBA recognition of sponsorship at event)

Please make checks payable to: **FBA Mass. Chapter**

**Your firm is invited to sponsor this event. Please inform Debora Corbett  
no later than May 26, 2017, if your firm will be a sponsor.**

## Goldilocks On Trial

On February 28, 2017 many members of our Chapter – including our President Scott P. Lopez – participated in “Goldilocks On Trial,” a mock trial led by Judge Frank J. Bailey in Boston’s Bankruptcy Court. Judge Bailey and his staff put on the event and once again called on us to help recruit attorney volunteers. The mock trial participants, 5th graders from the Curtis Guild School in East Boston, acted out roles of prosecutors, defense counsel, witnesses (i.e., Baby Bear), and the defendant herself, Goldilocks. In an interesting twist, Goldilocks was not guilty by virtue of a hung jury. The jury – also comprised of 5th graders – had several holdouts on each of the counts (vandalism, trespass, and theft). The Curtis Guild School was especially grateful to our Chapter for donating \$320.00 to cover the cost of busing the students into town. As the photos show, the students, teachers, and attorney volunteers were all smiles all morning.



**PHOTOS:**

**Top:** The bench keeping order.  
**Left:** Baby Bear preparing to testify.  
**Bottom:** Curtis Guild School Students, Attorney Volunteers, The Honorary Judge Frank J. Bailey & Bankruptcy Court Staff



## Government Relations Update

By Nathan A. Olin – National Council Delegate, Massachusetts Chapter

As the FBA National Council Delegate for the Massachusetts Chapter, I am pleased to summarize several pieces of interesting information recently coming out of Washington, D.C. First, President Scott Lopez and I attended the March mid-year National FBA meeting where the strong growth of the association nationally was stressed. Our Massachusetts chapter was highlighted not only for its increased membership, but also as being a test-chapter for law-student mentoring. Thanks to the hard work of board member Joshua Segal, we have begun the process of matching interested law students with chapter mentors.

The Government Relations Committee also sponsored a timely panel discussion, 'Protecting the Homeland and Honoring Civil Liberties: How Can the Constitution Guide Us?' The panel explored the delicate balance between national security and Constitutional rights amid the war against terrorism, featuring government and legal experts. In addition, Jeffrey Rosen, professor of law at George Washington University Law School and CEO/President of the National Constitution Center, delivered an equally scintillating keynote address.

Second, our chapter will again be providing leadership at Capitol Hill Day on April 20th. President-Elect Harvey Weiner and Vice President Jonathan Handler will join FBA leaders from across the country where they will meet with House and Senate offices and discuss FBA legislative issues that impact the administration of justice and the federal courts. Funding of the courts and the filling of judicial vacancies continue to be areas of critical concern, particularly as the association connects with new leaders in the executive branch. As articulated in the recent issue of *The Federal Lawyer*, veterans' issues will also dominate much of the Government Relations Committee's agenda in the months ahead.

Finally, at the mid-year meeting, Scott Lopez and I were proud to see our former chapter President, Matthew Moschella, in action in his new role as the FBA national's general counsel. Matt has dedicated many years of service to the national FBA, wearing many hats, for example, as chair of the Younger Lawyers Division, the First Circuit Vice President, and a member of the FBA Executive Board. Matt approaches each role with a calm demeanor and hard work. As such, it was not surprising that the national legislative session, under Matt's watchful eye, proceeded smoothly and efficiently.



FBA-MA Board Member Nathan Olin, FBA-MA President Scott Lopez and FBA-MA Former President Matthew Moschella.

Interested in contributing  
to the next edition of the  
FBA Massachusetts Chapter  
Newsletter?

Please send your submissions to  
the editor, Tracy Roosevelt, at  
[troosevelt@foleyhoag.com](mailto:troosevelt@foleyhoag.com).

## News from the Western Division

By *Nathan A. Olin, Connor, Morneau & Olin LLP*

On January 25th, the Massachusetts Chapter's Western Division hosted District Judge Mark G. Mastroianni, Magistrate Judge Katherine A. Robertson and surprise guest Senior Judge Michael A. Ponsor for a bench-bar meeting attended by over fifty lawyers. The event, focusing on civil practice, took the form of a question and answer session moderated by Kevin Maynard of Bulkley, Richardson and Gelinas, LLP. Members of the Chapter and guests participated in a lively discussion of issues relevant to civil practitioners. Thanks to Springfield Designee Board Member David Lawless for organizing, to chapter member Kevin Maynard for leading the discussion, and to everyone who attended – including Clerk of Court Robert M. Farrell and others from Boston and former board member Ken Pickering from Worcester.

On April 6th, Judge Mastroianni and Magistrate Judge Robertson will return for a similar event geared toward anyone interested in criminal practice and procedure in the Western Division. That session will be moderated by David Hoose of Sasson Turnbull Ryan & Hoose.

The Western Division is also pleased to welcome newly-appointed United States Bankruptcy Judge Elizabeth D. Katz to her courtroom at 300 State Street in Springfield. Judge Katz is well-respected throughout the state as a fair, pragmatic and intelligent bankruptcy attorney and bar leader. She took the oath of office on March 13th and the Western Division is planning a more formal reception for Judge Katz later this Spring.

Further, Western New England University law student Sara McMahon, with the assistance of Kelsey Baran, has served well as President of the WNEU student chapter. Under Sara's leadership, the chapter has planned an April civics event at a local Springfield middle school.

*For further information about anything happening at the Western Division, please contact Board Members Nathan A. Olin, David S. Lawless, or Andrea O'Connor.*



*Judge Mark G. Mastroianni and Magistrate Judge Katherine A. Robertson (seated) and moderator Kevin Maynard*

## Breakfast with the Bench:

On March 22, 2017, the Massachusetts Chapter of the Federal Bar Association hosted a "Breakfast with the Bench" with the **Honorable Donald L. Cabell**, Magistrate Judge of the Massachusetts Federal District Court. The subject was **"Reflections on My First Two Years on the Bench and French Lawyers."**

Please save the date for upcoming Breakfasts with the Bench:

- April 27, 2017 in Worcester with **Magistrate Judge David Hennessy** (topic to be determined)
- May 2017 in Boston with **Magistrate Judge M. Page Kelly** (exact date and topic to be determined)



*From L to R: FBA-MA Past President Lisa Tittmore, FBA-MA President-elect Harvey Weiner, Magistrate Judge Donald L. Cabell and Clerk of Court Robert M. Farrell.*

## Municipality Was Not Acting in a Sovereign Capacity When it Allegedly Breached a Construction Contract and Detained Property

By David S. Lawless, Robinson Donovan, P.C.

In *Massó-Torellas v. Municipality of Toa Alta*, 845 F.3d 461 (1st Cir. 2017), the United States Court of Appeals for the First Circuit held that where a municipality acted in its “proprietary capacity” under a contract, rather than its sovereign capacity, the plaintiffs’ complaint was properly dismissed for failure to state a constitutional claim that could be brought pursuant to 42 U.S.C. § 1983. The decision firmly establishes a defense that is available to cities and towns in this circuit.

The case arose from contracts to build a municipal transportation terminal. After the contractor issued a notice of default based on the municipality’s alleged failure to pay for work that had been completed, the municipality terminated the contract. Police officers and municipal officials took control of the construction site (which the municipality owned) and the contractor was prevented from removing most of its property from the site for two weeks. The municipality argued that its detention of property was required to inventory the property at the construction site as called for by the contract. The contractor countered that a sub-contractor had been allowed to remove its equipment. At the time the case was filed, the municipality had not returned or released the contractor’s fences and security barriers. See *Id.* at 464, 466.

The contractor brought Fourth Amendment, Fifth Amendment, and Fourteenth Amendment seizure and takings claims. The First Circuit has repeatedly held, without extended discussion, that “a simple breach of contract does not amount to an unconstitutional deprivation of property.” *Id.* at 467, quoting *Redondo-Borges v. United States HUD*, 421 F.3d 1, 10 (1st Cir. 2005); see also, *Lee v. Life Ins. Co. of N. Am.*, 23 F.3d 14, 20 n.11 (1st Cir. 1994); *Boston Env’tl. Sanit. Inspectors Ass’n v. City of Boston*, 794 F.2d 12, 13 (1st Cir. 1986); *Casey v. DePetrillo*, 697 F.2d 22, 23 (1st Cir. 1983); *Jimenez v. Almodovar*, 650 F.2d 363, 370 (1st Cir. 1981). In *Redondo-Borges*, the First Circuit specifically held that revocation of a bid award could not support a constitutional claim because the existence of a contractual relationship with a governmental entity, without more, does not give rise to a constitutionally protected property interest. See *Redondo-Borges*, 421 F.3d at 10.

*Massó-Torellas* expands on this precedent, none of which involved the physical detention of property, by denying a cause of action pursuant to 42 U.S.C. § 1983 where a municipality does not act in its sovereign capacity. The First Circuit assumed that the contractor’s rights under the contract could represent a constitutionally protected property interest. See *Massó-Torellas*, 845 F.3d at 468. “But when a municipality acts in a contractual or proprietary capacity, actions such as contract termination or detention of property under the contract that would constitute a simple breach of contract when a non-governmental entity is involved do not become a constitutional violation simply because the contracting party is a municipality.” *Id.*

The First Circuit noted that the Supreme Court of the United States and other circuits have distinguished between circumstances in which the government acts in its capacity as a sovereign and its capacity as a contracting party. See *Id.* The distinction usually operates to expose municipalities to liability by removing claims from the intersecting networks of statutory provisions and common law rules that limit governmental liability. *Massó-Torellas* stands for the proposition that the capacity in which a municipality acts can also serve to shield it from certain forms of liability.

The First Circuit rested its analysis on an application of *Monell v. Dep’t of Social Services*, 436 U.S. 658, 690 (1978). See *Massó-Torellas*, 845 F.3d at 468-469. In *Monell*, the Supreme Court overturned *Monroe v. Pape*, 365 U.S. 167 (1961) and held that liability can be imposed upon municipalities pursuant to 42 U.S.C. § 1983. The statute provides, in part:

Every person who, under color of any statute, ordinance, regulation, custom, or usage, of any State or Territory or the District of Columbia, subjects, or causes to be subjected, any citizen of the United States or other person within the jurisdiction thereof to the deprivation of any rights, privileges, or immunities secured by the Constitution and laws, shall be liable to the party injured in an action at law, suit in equity, or other proper proceeding for redress . . . .

*Monell* made it clear that a municipality cannot be held liable based on a *respondeat superior* theory. See *Monell* 436 U.S. at 691, 693. “Instead, it is when execution of a government’s policy or custom, whether made by its lawmakers or by those whose edicts or acts may fairly be said to represent official policy, inflicts the injury that the government as an entity is responsible under § 1983.” *Monell*, 436 U.S. at 694.

The First Circuit, in *Massó-Torellas*, stated that the contractor had not plausibly alleged that the municipality “was acting in a

(continued on next page)

sovereign capacity pursuant to any statute, ordinance, regulation, or custom when it terminated the contract and took over the construction site and temporarily detained [the contractor's] property." *Massó-Torrellas*, 845 F.3d at 469. It concluded, therefore, that there was "no sufficient allegation that the Municipality acted under color of law." *See id.* The First Circuit held that absent a "sovereign act" there was no constitutional claim that could be brought pursuant to 42 U.S.C. § 1983.

*Massó-Torrellas* is a reminder that that the text of 42 U.S.C § 1983 cannot be overlooked in assessing the viability of a claim for municipal liability under § 1983. In appropriate cases, the statute itself provides grounds for a defense based on the capacity in which a municipality has acted.

## Expanding the Reach of Pharmaceutical Patents: Generic Manufacturer Held Liable For Inducing Infringement By Physicians and Patients

By W. John Keyes, Ph.D., Associate at Sunstein Kann Murphy & Timbers LLP

Pioneer pharmaceutical firms are sure to welcome the boost to their patent portfolios resulting from a recent opinion by the Court of Appeals for the Federal Circuit. In the wake of *Eli Lilly & Co. v. Teva Parenteral Meds., Inc.*, 845 F.3d 1357 (Fed. Cir. 2017), infringement may now be found even where the defendant follows none of the steps in a patented method of treatment and no single actor performs all the steps of that method of treatment. Depending on the wording of the patent claims and the content of the prescribing information provided with their products, generic pharmaceutical manufacturers might not escape liability even if some steps of the method are performed by physicians and others by patients.

The claims of Eli Lilly's patent are directed to methods of administering the chemotherapy drug Pemetrexed after pretreating a patient with two common vitamins—folic acid and vitamin B12. The pretreatment is designed to reduce the toxicity of Pemetrexed. Eli Lilly markets Pemetrexed under the brand name ALIMTA®, and the drug is used to treat certain types of lung cancer and mesothelioma.

The patent owner sued a number of generic pharmaceutical manufacturers, including Teva, to prevent their launch of a generic version of ALIMTA® with accompanying product literature that would allegedly infringe methods of treatment claimed by the patent. The district court found that no single actor performed all the steps of the asserted claims because the actions of both physicians and patients were required. Nonetheless, by applying the theory of divided infringement, the court attributed direct infringement to physicians and held the generic manufacturers liable for inducing that infringement.

As for the pretreatment of patients with folic acid and vitamin B12, physicians administered the vitamin B12 (and the pemetrexed), while patients self-administered folic acid with guidance from physicians. The judicial analysis therefore weighed liability under a theory of divided infringement, an area of law which has recently undergone important developments.

Specifically, the *Akamai V* decision, *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, 797 F.3d 1020 (Fed. Cir. 2015), has broadened the circumstances in which others' acts may be attributed to a single actor to support direct-infringement liability. The Federal Circuit held that one person can be deemed accountable for directing or controlling another person's performance if the first person (1) conditions participation in an activity or receipt of a benefit upon the performance of one or more steps of a patented method, and (2) establishes the manner or timing of that performance. The question in *Eli Lilly v. Teva* thus became: Did physicians direct or control patients to self-administer folic acid within the meaning of this two-part test?

In addressing this question, the Federal Circuit noted that Teva's proposed product labeling was much the same as Eli Lilly's ALTIMA labelling, which consists of two documents: the Physician Prescribing Information and the Patient Information. The former explained that folic acid is a "[r]equirement for premedication" in order "to reduce the severity of hematologic and gastrointestinal toxicity of [pemetrexed]." The product labeling stressed that physicians should "[i]nstruct patients" to take folic acid and included information about dosage ranges and schedules. The Patient Information reinforced the message by cautioning that physicians may withhold Pemetrexed until the patient has initiated or resumed folic acid treatment.

These instructions, said the court, showed that physicians were not merely guiding or instructing patients to take folic acid, but were conditioning pemetrexed treatment on their self-administration of folic acid.

With regard to part (2)—establishing the manner or timing of the performance—the product labeling was again decisive. The Physician Prescription Information instructed physicians not only to tell patients to take folic acid, but specified a daily dosage of

400 to 1000 micrograms beginning seven days before the first dose of Pemetrexed.

The court's analysis required one further step, since the generic manufacturers, not the doctors, were charged with infringement. This involved inquiring whether the manufacturers were inducing the doctors to infringe. Liability for inducement requires proof that the alleged inducer intended to cause infringement. The defendants resisted the inducement claim by arguing that the proposed drug labelling was advisory and that the doctors could decide how and whether to follow the labelling.

The Federal Circuit responded by noting that the proposed labelling was sufficiently clear to be seen as encouraging, recommending and promoting the infringing activity. This clarity was enough to infer an intent to cause the doctors to infringe. Had the instructions been vaguer, the court suggested, induced infringement might not have been found.

The *Eli Lilly* decision holds valuable guidance for practitioners. Now that generic pharmaceutical producers may be held liable under *Akamai V's* theory of induced infringement, patent applicants should expand their claiming strategy to cover instances of divided infringement where steps of treatment methods are performed by parties other than the physician. By tailoring one's claims to cover concerted activity by multiple parties, valuable scope may be added to pharmaceutical patents.

## Plenty of IP Decisions Expected From the Supreme Court This Year

*By Gozde Guckaya, Patent Agent, Sunstein Kann Murphy & Timbers LLP*

The high court ended 2016 with the attention-grabbing decision in *Samsung Electronics v. Apple* pertaining to the calculation of design patent damages. The judgment reversed the Federal Circuit's holding that an award could be calculated based on the product as a whole despite infringement found only on individual components. The present docket proves to be no less important, with the Court poised to answer questions of great interest to patent, trademark, and copyright practitioners.

### Laches defense in patent infringement claims

Decision: In the March 21, 2017 decision in *SCA Hygiene Products v. First Quality Baby Products*, the Supreme Court decided that laches is not a defense in cases subject to the Patent Act's 6-year limitations period.

Link to decision: [https://www.supremecourt.gov/opinions/16pdf/15-927\\_6j37.pdf](https://www.supremecourt.gov/opinions/16pdf/15-927_6j37.pdf)

In *SCA Hygiene Products v. First Quality Baby Products* (No. 15-927), the question was whether the defense of laches, or unreasonable delay in bringing a claim, can bar a patent infringement claim brought within the six-year statutory period of 35 U.S.C. § 286. The Federal Circuit found that the presumption of laches applied due to SCA's six-year-plus delay in suing *First Quality* for infringement. SCA Hygiene filed a petition to the Supreme Court based on the high court's decision in *Petrella v. Metro-Goldwyn Mayer*, 134 S. Ct. 1962 (2014), which held that laches is not available as defense to copyright infringement.

SCA argued that although the Federal Circuit agreed that there is "no substantive distinction material to the *Petrella* analysis" between copyright and patent, the court perplexingly held that laches may be used to bar patent infringement claims even if they're commenced within the statutory six-year period. Thus, according to SCA and the numerous amicus briefs, there should be no substantive difference between copyright and patent law with respect to the laches defense. Arguments in *SCA Hygiene* were heard November 1, 2016.

Here are links to the [petition](#) for certiorari and the [question](#) that the Court agreed to consider.

Link to petition: <http://www.scotusblog.com/wp-content/uploads/2016/04/SCA-Petition.pdf>

Link to question: <https://www.supremecourt.gov/qp/15-00927qp.pdf>

### Inducing infringement outside of the United States

Decision: On February 22, 2017, the court held that the supply of a single component of a multicomponent invention for manufacture abroad does not constitute a substantial portion of the components that can give rise to liability under Section 271(f) (1) of the Patent Act.

Link to decision: [https://www.supremecourt.gov/opinions/16pdf/14-1538\\_p8k0.pdf](https://www.supremecourt.gov/opinions/16pdf/14-1538_p8k0.pdf)

In *Life Technologies Corporation v. Promega Corporation* (No. 14-1538), the question was whether supplying a single commodity component of a multi-component invention is an infringing act under 35 U.S.C. § 271(f)(1). The statute is concerned with the supply from the United States of “all or a substantial portion” of the components of a patented invention to induce the combination of components outside the United States.

The term “substantial” caused much of the concern, with parties alternately arguing for “substantial” to be defined in terms of quantity (for example, the number of components) or quality (the importance of the component to the end product). In *Life Technologies*, the specific question was whether the US export of the commodity *Taq* polymerase is a “substantial” enough portion of a genetic testing kit assembled in the UK. Arguments were heard December 6, 2016.

Here are links to the [petition](#) for certiorari and the [question](#) that the Court agreed to consider.

Link to petition: <http://www.scotusblog.com/wp-content/uploads/2016/03/Life-Techs-Pet-App-14-1538.pdf>

Link to question: <https://www.supremecourt.gov/qp/14-01538qp.pdf>

### Trademark application refusal

In *Michelle K. Lee, Director, United States Patent and Trademark Office, v. Simon Shiao Tam* (No. 15-1293), the question presented is whether Section 2(a) of the Lanham Act, which reads that no trademark shall be refused registration on account of its nature unless it “consists of or comprises...matter which may disparage...persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute,” is invalid under the First Amendment protection of free speech. The trademark examiner cited this statute in refusing registration of “THE SLANTS” for an Asian-American rock band. Arguments in *Lee v. Tam* were heard January 18, 2017.

Here are links to the [petition](#) for certiorari and the [question](#) that the Court agreed to consider.

Link to petition: <http://www.scotusblog.com/wp-content/uploads/2016/04/Petition-for-writ-Michelle-K.-Lee-Director-United-States-Patent-and-Trademark-Office-Petitioner-v.-Simon-Shiao-Tam.pdf>

Link to question: <https://www.supremecourt.gov/qp/15-01293qp.pdf>

### Domestic and international patent exhaustion

The “patent exhaustion” doctrine provides that once a patented product has been sold by a patent owner (“the first unrestricted sale”), the patent owner’s control over the sold product is exhausted. In *Impression Products, Inc. v. Lexmark International, Inc.* (No. 15-1189), the questions presented are (1) whether the patent exhaustion doctrine applies to a conditional sale of a patented item that transfers title to the item while specifying post-sale restrictions on the item’s use or resale, and (2) whether a sale of a patented item that takes place outside of the United States exhausts the U.S. patent rights on that item. Arguments were heard March 21, 2017.

Here are links to the [petition](#) for certiorari and the [questions](#) that the Court agreed to consider.

Link to petition: <http://www.scotusblog.com/wp-content/uploads/2016/04/Impression-Products-v.-Lexmark-cert-petition-no-appendix.pdf>

Link to questions: <https://www.supremecourt.gov/qp/15-01189qp.pdf>

### Biologics notice of commercial marketing

The Biologics Price Competition and Innovation Act of 2009 (“BPCIA”) created an abbreviated regulatory pathway for the Food and Drug Administration to approve biological products that are similar (“biosimilar”) to a previously approved biological product. The “notice of commercial marketing” provision of the BPCIA requires a would-be competitor (to the established biologic provider) seeking approval for a biosimilar to provide a notice of intent to market the biosimilar. The notice allows the provider of the reference biologic to seek a preliminary injunction.

The Federal Circuit held that, while the biosimilar provider does not have to hand over application information to the reference biologic provider (in a process known as the “patent dance”), the notice itself was mandatory. The notice, which can be given only after the biosimilar application is approved, effectively adds 180 days of exclusivity for the reference biologic provider.

In *Sandoz Inc. v. Amgen Inc.*, the first question deals with whether the notice of commercial marketing can be given before FDA approval (thus starting the 180-day clock in parallel with the lengthy FDA approval process). The second question is whether the delaying of all biosimilars to market by 180 days improperly grants an additional six months of exclusivity to the reference biologic provider. Arguments are scheduled for April 26, 2017.

Here are links to the [petition](#) for certiorari and the [questions](#) that the Court agreed to consider.

Link to petition: <http://www.scotusblog.com/wp-content/uploads/2016/07/15-1039-Sandoz-v-Amgen-cert-petition.pdf>

Link to questions: <https://www.supremecourt.gov/qp/15-01039qp.pdf>

### Venue choice

The choice of where one can bring a suit affects any domestic company or individual subject to a patent infringement claim. The Eastern District of Texas has infamously evolved over time into a haven for patent holders, especially of the non-practicing type. Interestingly, the Supreme Court has previously considered this question in a 1957 case, *Fourco Glass Co. v. Transmirra Products Corp.*, holding that venue was governed by 28 U.S.C. § 1400(b), a statute that defines narrowly where infringement suits may be brought: only in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.

Since 1957, Congress has tweaked laws concerning venue, and the Federal Circuit ruled contrary to the Supreme Court decision. *TC Heartland LLC v. Kraft Foods Group Brands LLC* (No. 16-341) revisits the same question 60 years later: whether the narrower patent venue statute is the exclusive authority on venue, or whether it is supplemented by the broader venue statute, 28 U.S.C. § 1391(c). Amicus briefs have been filed, most arguing that the Court should put a stop to forum-shopping in patent cases. Although the case doesn't actually involve the Eastern District of Texas, a decision restricting venue would keep most suits out of the district, since few patent defendants are based there. Arguments are scheduled for March 27, 2017.

Here are links to the [petition](#) for certiorari and the [question](#) that the Court agreed to consider.

Link to petition: <http://www.scotusblog.com/wp-content/uploads/2016/09/16-341-cert-petition.pdf>

Link to question: <https://www.supremecourt.gov/qp/16-00341qp.pdf>

### Copyrighting a feature of a useful article

Decision: On March 22, 2017, the court held that decorative elements of a useful article can be protected by copyright law, addressing a long-standing issue over the separability of aesthetics from the functionality of the underlying article. The case returns to a trial court to determine the distinct issue of whether Varsity's designs are original enough to warrant copyright protection.

Link to decision: [https://www.supremecourt.gov/opinions/16pdf/15-866\\_0971.pdf](https://www.supremecourt.gov/opinions/16pdf/15-866_0971.pdf)

Copyright law extends its protection to the "design of a useful article" only to the extent the design stands apart from the utilitarian aspects of the article. In *Star Athletica, LLC v. Varsity Brands, Inc., et al.* (No. 15-866), the question was whether the decorative elements of cheerleading uniforms can be distinguished from the functionality afforded by the decorative elements. The March 22, 2017 ruling could have a major impact on the fashion industry, which has long faced difficulties in using copyright protection for clothing and apparel. Arguments in *Star Athletica* were heard October 31, 2016.

Here are links to the [petition](#) for certiorari and the [question](#) that the Court agreed to consider.

Link to petition: <http://www.scotusblog.com/wp-content/uploads/2016/05/SACP.pdf>

Link to question: <https://www.supremecourt.gov/qp/15-00866qp.pdf>

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