

THIS MONTH'S MEETING

TUESDAY,
SEPTEMBER 12, 2006

WPI, WORCESTER
Campus Center Odeum

\$15.00 members
 \$25.00 non-members

NETWORKING: 6:00 PM

MEETING: 6:30 – 9:00 PM

Special: Join before September 30 online, by mail, or at a program and get a free meeting pass. Info at www.wpiventureforum.org/Membership.

Find directions to WPI at www.ventureforum.org/directions.html

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What's Right and Wrong with Massachusetts Business?

Boston Business Journal (BBJ) publisher Michael G. Olivieri returns to the WPI Venture Forum to tackle the best and the worst of today's regional economy. At the September 12 meeting, Olivieri's keynote address will dispel ten myths about the Massachusetts business economy, and offer his projections for change in the coming year.

Olivieri, who is also publisher of *Mass High Tech*, *The Journal of New England Technology* (MHT), has a unique perspective on the business environment. In discussing what's really right — and what's really wrong — with the state of business in Massachusetts, he will offer a forthright analysis of the state's leading and lagging industries. His presentation will also provide some suggestions on altering the business climate to support new growth.

Olivieri has been with American City Business Journals for 12 years. American City owns and operates local business journals in 42 cities in the United States. BBJ specializes in reporting on the area's growth companies and the people who are leading them, and pays close attention to the intersection of business and civic life and the philanthropic activities of the business community. MHT specializes in covering the region's



MICHAEL G. OLIVIERI

incubation of next generation technologies and the people and companies behind our innovation economy.

A resident of the Merrimack Valley for 24 years, Olivieri is a graduate of UMass-Lowell, where he recently joined the Board of the College of Science. He serves on several local non-profit boards including Junior Achievement of Northern New England, The Catalogue for Philanthropy, AccesSport America,

the Board of Visitors for the College of Business Administration at Northeastern University, and the Greater Boston Chamber of Commerce.

September's Case...

NOMIR is a company that is building novel laser systems and techniques to eliminate biofilm bacteria and infection while promoting healthy tissue recovery in medical, veterinary, and dental applications. With technology based on near-infrared photobiology experiments and inventions, Nomir's mission is to develop and commercialize light-based solutions for aesthetic diseases and infectious diseases.

Case presenter Richard Burr, CEO, President, and Director, has over 25 years of senior level experience creating and building profitable

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LETTER FROM THE CHAIR

Tapping Entrepreneurial Energy

I am pleased to invite you to join me in kicking off the 2006-2007 program year of the WPI Venture Forum. This summer, much of the activity has taken place behind the scenes. What you'll find this fall is a year of offerings which promise to build upon the WPI Venture Forum's long history of past successes, drawing upon the energy of a dedicated group of volunteers to add a few new twists to our winning formula.

I am honored to have been elected Chair of the Executive Board of the WPI Venture Forum. I thank Amar V. Kapur for his dedicated service as Chair and look forward to working with him and the Board as we tap into the entrepreneurial energy that surrounds the WPI Venture Forum.

The WPI Venture Forum offers its participants an excellent resource for tracking trends in technology, exploring topics of interest to entrepreneurs, and building a network for success. I encourage you to attend the monthly meetings to learn from our speakers and discover cutting-edge companies examined in the case studies. Use



the networking breaks during the monthly meetings and the special networking events held throughout the year to connect with fellow entrepreneurs, service providers and funding sources.

For those of you with a new technology venture, consider submitting your business plan to next fall's annual business plan

contest. Take advantage of the mentoring made available as part of the competition to hone your pitch. You may notice a few changes in how we run our monthly programs over the next few months, part of our effort to improve the WPI Venture Forum and its offerings.

For a small investment of your time and resources, the WPI Venture Forum can offer you high returns for years to come. I hope you will consider making the WPI Venture Forum part of your plans.

Sincerely,

Patrick R. Jones

Chair, WPI Venture Forum Executive Board
Attorney at Law, Gesmer Updegrave LLP

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New subscribers welcome.

Visit www.wpiventureforum.org and click on Newsletter

Don't Risk Your Right to Patent Your Invention



Given the flurry of marketing and sales activities surrounding the introduction of a new product, it is easy to overlook the finer points of protecting your intellectual property. For example, your right to patent your invention may be lost if you or a third party initiate steps to commercialize or publicize your invention, or a product or method embodying your invention, more than one year before filing a patent application. The good news is that a little diligence goes a long way towards securing your rights.

Under U.S. patent law, an inventor is barred from obtaining a patent if an application is not filed within one year of describing the invention in a printed publication, publicly and commercially using the invention, or selling or offering the invention for commercial sale. Note, however, that this one-year grace period does not apply in most foreign countries.

The publication restriction is relatively straightforward. For example, consider an inventor who envisions a new and improved widget on January 1, 2003, and reduces the invention to practice by developing a working prototype on February 1, 2003. Encouraged by this success, the inventor publishes a complete description of the invention in a trade publication on March 1, 2003, and files a patent application on March 2, 2004. The "critical date" of this invention is now March 2, 2003 – one year prior to the filing of the patent application.

Unfortunately for this inventor, the publication occurred before the critical date, and the patent would be invalid. Keep in mind that publications may include advertisements and brochures, press releases, articles in trade magazines or professional journals, technical papers, handouts from presentations, and anything published on the Internet such as on a website, bulletin board or mailing list.

The "critical date" is similarly relevant to the application of the "on-sale" bar and the "public use" bar. The "on-sale" bar applies when the invention becomes the subject of a commercial offer for sale. Note that this restriction encompasses not only completed sales, as evidenced by a purchase offer or contract, but also offers to sell an invention, such as one made by a salesperson to a prospective customer and even orders for goods that have not yet been delivered. The "on-sale" bar issue often arises in joint development situations. The "public use" bar is similarly restrictive; allowing even one person to commercially use your invention may result in the loss of patent protection. The "public-use" bar should be considered, for example, before conducting beta-testing.

Both the "on-sale" bar and the "public use" bar are subject to an experimental use exception, which applies if the primary purpose of the offer for sale or use of the invention was for field-testing. The corresponding rules, however, are complex. For example, the inventor must maintain control of the invention during the testing and notify the buyer of the experimental nature of the

by

KATHRYN V. CHELINI, ESQ.
Mirick O'Connell, LLC

invention. Other factors considered include whether accurate records were kept, whether a level of confidentiality was maintained, whether the testers were paid, and what promotional activities were conducted.

In summary, while there are potential pitfalls to securing patent rights, inventors can mitigate the risk by closely monitoring promotional materials, technical disclosures, demonstrations to potential customers and investors, prospective licensing and sale agreements, and external testing arrangements.

Kathryn Chelini is an associate in the intellectual property department at Mirick O'Connell, specializing in patent litigation and prosecution for high-tech clients. She can be reached at kvchelini@modl.com. ✓

INCUBATOR SPACE AVAILABLE

Massachusetts Biomedical Initiatives (MBI), a life sciences company incubator, is seeking tenants for Gateway Park in Worcester by early 2007. Part of the WPI Life Sciences and Bioengineering Center, the four-story, 124,600 s.f. facility, will house modern laboratories, offices, and other amenities. WPI's life sciences-related research program and the WPI Bioengineering Institute will occupy about 75% of the space. The remainder of the building is being leased to start-up life sciences businesses through MBI.

Please contact the MBI President, Kevin O'Sullivan, at kosullivan@massbiomed.org or 508-797-4200 for more information.

A LOOK AT JUNE'S MEETING

by

RANDAL CHINNOCK,
Optimum Technologies, Inc.

15th Annual

BUSINESS PLAN CONTEST JUDGES



*Elliot Katzman, General Partner, Kodiak
Venture Partners*



*Steven Wardell, Principal, Apeiron Partners,
LLC*



*Tripp Peake, Managing Partner, Long River
Ventures & Worcester Capital Partners*

The final WPI Venture Forum of the season was the annual Business Plan Competition. Three excellent finalists contended for the \$15,000 prize.

APREDICA

This startup is a CRO (Contract Research Organization) in the drug discovery space. Founder and President Katherine Tsaion, PhD explained that their goal is to “achieve a paradigm shift” in the way pharmaceutical companies use CROs to reduce the five to eight years and \$500 million price tag to develop a typical drug. The company is focused on how novel drugs interact with humans in terms of absorption, distribution, metabolism, excretion, and toxicity (ADMET). They intend to outmaneuver their larger, slower-moving, international competitors that use a factory model for such services. They will deploy small, highly automated labs located near drug companies, starting with the 100 drug firms located in Massachusetts. By staffing their sales force with scientists instead of non-technical sales people, they believe they can offer faster service and better communications.

They estimate the drug discovery outsourcing market size at \$500 million, with a 40 percent annual growth rate. Apredica will target small drug companies that don't have extensive in-house ADMET capabilities, as well as large drug companies that need overflow and specialty services. They have already inked a distribution deal with MaxThera, and have formed collaborations with Biomodels, LLC and Biopoint Solutions.

They have raised \$196,000 so far, and are seeking an additional \$150,000 for capital



Members enjoy networking during a break.

equipment and operating funds. The judges expressed concerns about the small size of their targeted investment, and how they will differentiate themselves from their competitors.

CHAMPION METRICS

“The best way to improve performance is to measure it,” according to Founder and CEO Charlie Squires. This startup is developing instruments to provide biometric measurements to high-performance athletes. They have working prototypes under test in the rowing market that consist of sensors pressing against the rowers' feet, plus a display showing the boat's coxswain real-time performance data for each rower. They have filed patents relating to sensors and software. Competitors include WEBA and Powerline, although neither of those companies offer “at a glance” performance data. Champion Metrics estimates the sports biometrics market at \$500 million, with \$106 million and a 10 percent annual growth rate in rowing alone.

“We must get on the boats,” says Squires, “and replace existing electronics.” He is convinced he has superior technology and can sell it at a lower price point than his

Business Plan Contest



Contest finalists for Apredica, Champion Metrics, and Crescent Innovations gather with judges and coordinators.



Winner and Crescent Innovations founder Albert G. Prescott '90 (holding mock check) claims the prize from contest coordinator Brian Dingman, Esq. (left) and judges Steven Wardell, Elliot Katzman, and Tripp Peake.

competitors, if necessary. The company seeks \$1.2 million in investment that will carry them to \$5 million in sales at year 5, with a projected 30% net income and 50% annual growth rate. This could result in a five to seven times return on investment, and make them an attractive acquisition target for a sports equipment manufacturer, biometrics company, or rowing equipment manufacturer.

The judges liked the focus on a well-defined market (rowing), though it was not clear to them how this technology might be applied to other markets. They asked whether a data subscription model might be possible.

CRESCENT INNOVATIONS

Some ten million Americans suffer from temporo-mandibular joint (TMJ) pain, but only half of them respond to drug treatments. WPI graduate Albert G. Prescott '90 has a model for changing that. As Founder and President of Crescent Innovations, he has developed a biopolymer gel that can be injected in the jaw joint in a doctor's office. In a trial with pigs with

induced TMJ, the injection resulted in a dramatic improvement in joint pathology in two out of three animals. They already have two patents issued and five applied for, relating to purification, formulation, packaging, and methods of development, described as a good start at a "picket fence" around their intellectual property.

As an alternative to replacement joints and drugs, including powerful nonsteroidal anti-inflammatory drugs (NSAIDs), Champion Metrics' price point of \$200 per injection would be very attractive. The potential market in the U.S. alone could be 5 million, which at \$200 per injection equals \$1 billion.

They have raised \$182,000 so far, including an SBIR award, and have submitted a Phase 2 SBIR application. They seek \$1 million in equity funding for securing more intellectual property, and building sales and marketing and finance teams. They forecast \$50 million in sales at year 3.

The judges wanted to know if the science behind this is well understood, and whether

there is currently reimbursement for the procedure. They were also concerned that \$1 million wasn't nearly enough to complete the trials they need.

Following the individual company presentations, the judges retired to their deliberations. While waiting for their decision, Dennis Guberski, CEO and founder of Biomedical Research Models took to the podium (*see related story, "Tales from the Trenches," on page 6*).

AND THE WINNER IS...

Despite some concerns from the judges, Crescent Innovations walked away with the prize! Many thanks to all the contestants, organizers, and judges!

Randal Chinnock is a member of the Program Committee, and President of Optimum Technologies, Inc., an engineering services company helping its clients use light for the diagnosis and treatment of disease. He can be reached at www.optimum-tech.com or 508.765.8100. ♡

Tales from the Trenches

by

CHRIS GOLDEN,
Mission Critical Advisors

While waiting to learn which company won the WPI Venture Forum Business Plan Contest, audience members were treated to advice from the self-described “rat man,” Dennis L. Guberski, MS, CEO and founder of Biomedical Research Models (BRM). He has worked with the BB rat model of autoimmune diabetes from the early days of its discovery and is credited with having produced the most reliable and uniform inbred lines of diabetes-prone and diabetes-resistant BB rats available for research.

His presentation on how to use a business plan to raise money was liberally spiced with wisdom, anecdotes and humor that informed and entertained the audience.

A geneticist who retired from the University of Massachusetts at Amherst, Guberski provided a brief profile of BRM. He described the company’s mission as developing therapies for the treatment of diabetic neuropathies and creating new vaccination technology platforms.

Guberski founded the company to provide genetically pure test animals for medical research and to provide services as a contract research organization (CRO). But that was only the beginning. Touting his 75 percent

success record in winning Small Business Innovation Research (SBIR) grants, Guberski is rapidly recreating his organization as a true bio-med company.

He advised budding entrepreneurs to fully utilize the federal government’s SBIR programs in order to gain credibility, cash flow and a vehicle to develop a unique portfolio of intellectual property. In drafting a grant proposal, Guberski emphasized the need to “write to win,” not to show off “how smart you are.” He also suggested writing grants “like you were writing a great book” as well as writing “so anyone can understand,” at an 8th grade level.

Plow profits back into the company, he advised, in order to enhance the value of your company as it moves towards its intended exit point. This boosts your return on investment by retaining as much equity as possible for as long as possible. Raising money is the primary job of a company’s leader. And in his experience, he said, always add a “zero” to whatever figure you think you need.

Chris Golden is President of Mission Critical Advisors, specialists in coaching and orienting leaders in early stage entrepreneurial strategy and finance. He can be reached at chriscgolden@rcn.com.

September’s Case Continued...

CONTINUED FROM FRONT PAGE

technology, life sciences, and software businesses. The three “burning questions” that panelists will critique are, *How do we attract early adopters to our medical device technology that is displacing an oral drug? How can we effectively market to three different medical specialties (PCPs, dermatol-*



Richard Burt

ogists, and podiatrists), and Can a blended revenue model work? The company is privately funded and is approaching an A round of equity financing. It occupies space at Massachusetts Biomedical Initiatives in Worcester and also has offices in Natick, MA. ✓

Improper Small Entity Status Claim Can Lead to Patent Loss

United States patent law offers a financial break to a “small entity” by allowing it to pay specific fees at a reduced rate. However, this financial relief is not without certain risks. Deciphering the United States Patent Office (USPTO) definitions of small entity can be challenging and, as a recent decision shows, improper designation can render patents unenforceable.

WHO, OR WHAT, IS A SMALL ENTITY?

Generally, the USPTO defines a “small entity” as any “person,” “small business concern” or “non-profit organization.” Among the requirements within the definition of each term is that, at the time small entity status is claimed, there must be no obligation to assign, grant, convey, or license any rights to the invention to any entity that would not, in turn, qualify for small entity status.

Understanding these qualifications can be, at best, difficult. For example, the USPTO definition for “small business concern” makes reference to a separate set of rules and presents one of the rare instances where the reader with questions is referred to another entity—in this case, the Small Business Administration.

NILSSEN CLAIMS SMALL— BUT LOSES BIG

In *Nilssen v. Osram Sylvania*, (Northern District of Illinois) Nilssen sued Osram Sylvania for infringement of several patents, the maintenance fees for many of which had been paid by Nilssen on the basis of his professed status as a “small entity.”

The court found that, at the time Nilssen claimed small entity status, he had previously

entered into an agreement with Phillips Electronics North America Corp. (Phillips) that obligated Nilssen to license several of the patents to Phillips. The court also found that Phillips did not qualify as a small entity at the time of agreement and “[b]ecause Nilssen had an obligation to license to Phillips, all the patents subject to the [agreement] were not entitled to a small entity status and required payment of large entity fees.” Further, the court found Nilssen’s reliance on licensing the patents to an intermediate non-profit charitable organization, the Geo Foundation, to be unavailing.

The court stated that, “Nilssen was required to pay large entity fees for all patents licensed to the Geo Foundation because the Geo Foundation itself licensed the patents to large entities.”

CORRECTIONS ALLOWED FOR GOOD FAITH

The USPTO provides for correction of errors in making small entity payments if establishment of small entity status was made in good faith and the consequent fees were paid in good faith. However, as noted by the court, “while the PTO is not required to make an inquiry into whether the patentee has established good faith as a condition of late payment, if a patentee seeks to correct an incorrect payment of fees as a small entity...[made] without good faith, the patentee may be found to have engaged in inequitable conduct.” Here, the court found inequitable conduct by Nilssen in establishing small entity status, and determined that all of his defenses in this regard were not credible or without merit.

by

N. SCOTT PIERCE,
Hamilton, Brook, Smith & Reynolds, P.C.

CONSIDERATIONS

- **Don’t Disregard Risk.** Establish small entity status for the purpose of paying reduced USPTO fees at your peril. The small amount of money saved in proportion to the significant investment and value of a patent estate rarely justifies the risk involved in establishing small entity status.
- **Look Before You Leap.** Assess the status of all those involved, directly and indirectly, in potential obligations. Your status may be dictated by that of your business partner or a business partner once-removed—or beyond.

N. Scott Pierce, Esq. is a Principal with Hamilton, Brook, Smith & Reynolds, P.C., an intellectual property law firm located in Concord, Mass. Scott devotes his practice to patent prosecution, trademarks, and intellectual property licensing, due diligence, and opinions. He can be reached at Scott.Pierce@hbsr.com or (978)-341-0036. ✓

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Member Spotlight

Membership for Love or Money *Why I Joined the WPI Venture Forum*

by

JERROLD M. SHAPIRO, PHD
Fem-Medical LLC

I have found joy at the WPI Venture Forum in many ways. Most recently, it has helped restore my faith in humanity. Last September, I met a new attendee and her husband, someone with many ideas for new products. She later introduced me to a friend who shared many of the same interests, and we fell in love.

My history with the WPI Venture Forum dates back to October 1995, when I felt mobbed at a crowded Boston forum meeting. So I ventured forty miles west to a friendlier place – the WPI Venture Forum. I spoke with the meeting moderator about the need for more networking opportunities, and the next evening, Brian Dingman invited me to join the Program Committee to work on this issue.

After navigating the twisting passages of WPI's Higgins House, I met the most wonderful and helpful group of people in my lifetime of volunteer activity. I learned to respect the WPI traditions as I was required to construct, run and analyze surveys of WPI

Venture Forum attendees for three consecutive months to prove that networking was the major reason for attendance. Armed with these data, I initiated programs like collecting business cards at the beginning of each WPI Venture Forum meeting and distributing copies at the end, posting industry-specific signs outside Kinnicut Lecture Hall to create gathering points, and moving the food outside the auditorium into the networking area to draw people out.

I learned that Program Committee people make long-term commitments to the WPI Venture Forum – eleven years later, Brian, Norm Brust, Bob Creeden and I are still on the committee. Many of the committee's members have gone on to become Chairs of the WPI Venture Forum.

I also learned much about starting and running a technology-based company in an atmosphere that took away my fear of sales, marketing, distribution channels, accounting and all those topics that are missing from the formal education of a bioengineer.

I started Fem-Medical LLC with a fellow Program Committee member in 2002, and my women's health company is now growing strong. Last fall, I co-founded another medical device company, Hemetrics. We won several business competitions, and our team is now meeting with venture capitalists as we raise our seed round of funding.

For those of you who are not yet members: for love or money, or for both, join the WPI Venture Forum.

Jerry Shapiro is the founder, President and CEO of Fem-Medical LLC in Framingham, Mass., which gives incontinent women the freedom to enjoy their lives via nonsurgical, drug-free treatment. He can be reached at Shapiro@FemiScanUSA.com ♡

North Central Mass. Business Plan Competition

The Entrepreneurial Resource Center at Mount Wachusett Community College is holding its second business plan competition. Established to highlight, stimulate and celebrate the region's entrepreneurial spirit, the competition is designed to encourage the creation of new businesses and new jobs, support sound management and sustainable practices for non-profits, and increase involvement in community and social issues in north central Massachusetts.

Categories: Start-up for profit; Expanding for profit; Start-up nonprofit;
Expanding nonprofit

Deadline: September 18, 2006

Guidelines and application can be found at www.mwcc.edu/devens/erc/comp.html