

HIGH COURT HOLDS *MERCOID* OVERRULED

Annual Outing Success

*"No profit grows, where 'tis no
pleasure taken." —Shakespeare*

The NYPLA's eighth annual Outing and Dinner Dance was held at the Knollwood Country Club in Elmsford, New York on June 19, 1964. The more than 150 Association members and their guests who attended the affair made obvious their enjoyment of the event, and the annual outing was deemed a great success by all.

Those who attended enjoyed an excellent menu including a choice of lobster or roast beef in the country club dining room. Harry R. Pugh, Jr., newly elected president of the Association, presented the prizes for the day's activities after the dinner. Ben Cutler's orchestra performed for the listening and dancing pleasure of everyone.

Golf Prizes. Although there was a little rain during the day, the enthusiasm of the more than 85 members and guests who participated in the golf events was not dampened. The Governors' Cup awarded annually to the member having the lowest net score for 18 holes, was earned for the second year by Phil Churchill. Other valuable prizes were given to the following event winners: Les Taggart, Eric Waters, Al Haffner, Ed Grimes, Carroll Quaintance, Margaret Lewis, Agnes Fayrer, Bill Crowley, John Oram, Bill Ungvarsky and Fred Kump.

The Outing was sponsored by the Committee on Meetings, Richard A. Huetner, chairman, William C. Conner, vice-chairman for the annual outing, and Daniel H. Brown, William F. Eberle, Robert D. Fier and Pauline Newman, co-sponsors of the annual outing.

PATENT OFFICE MAY PRINT FIELD OF SEARCH

Commissioner Brenner has requested comments from members of the Bar concerning a proposal that printed patents list the classes searched by the Examiner, 803 O.G. 2 (June 2, 1964). Such a procedure, he notes, might be an official certification that each patent in the class was considered by the Examiner, whereas frequently partial searches are made and pertinent references are missing when the search is made. This certification may have an effect on the presumption of validity. Comments at an early date are requested.

It has been pointed out that printing the searched classes will provide a quick indication of the most relevant fields of search. Further, it is expected that the listing of cited references will be continued so that both the prior art selected by the Examiner as most applicable and his scope of inquiry will be apparent from the face of the patent.

§ 271(c) RULED CONSTITUTIONAL

The Supreme Court ruled on a number of matters involving the doctrine of contributory infringement as expressed in 35 U. S. C. § 271(c) (1952) in *Aro II*, *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 141 USPQ 681 (June 8, 1964). Mr. Justice Brennan, writing for the Court in a split 5-4 decision, held that "Congress enacted § 271 for the express purpose of reinstating the doctrine of contributory infringement as it had been developed by decisions prior to *Mercoid* and of overruling any blanket invalidation of the doctrine that could be found in the *Mercoid* opinions."

Constitutionality Approved. Mr. Justice Black, for the dissenters, found it necessary to reach the Constitutional issue because the Court's interpretation of § 271 (c), he stated, gave a legal monopoly to an unpatented item. The majority, however, had "no doubt" that the statute was constitutional and briefly so noted in a footnote.

Narrow Meaning Accorded "Knowingly." The High Court, with a different majority of five, Mr. Justice White joining with the four dissenting Justices, stated that the alleged contributory infringer must have knowledge that the combination for which his component was especially designed was both patented and infringing; thus, the view that the "knowingly" provision of § 271(c) required simple knowledge that the component was especially designed for use in a patented combination was rejected. The Court appears to require the contributory infringer to have knowledge somewhat akin to that set forth in the "notice" provision, the difference being that for the direct infringer, notice relates to damage while for the contributory infringer, knowledge is a prerequisite to substantive infringement.

Limited Recovery Possible. In *Aro I*, *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U. S. 336, 128 USPQ 354 (1961), the Court had held that since General Motors (a direct infringer) was licensed, convertible top replacements were "repairs" only; since repair was not a direct infringement, there could be no contributory infringement. In *Aro II*, Ford (a direct infringer) was not licensed during 1954 and part of 1955, and thus, even repair constituted infringement. Therefore, Aro could be liable under § 271(c) for contributory infringement. However, Ford entered into a license agreement in 1955 which, while releasing Ford and Ford's customers for past infringement, did not release or negate Aro's past liability. Since a patentee may not recover profits, said the Court in interpreting § 284, (only "damages" are recoverable) and since the patentee may not recover a royalty based on the contributory infringer's sales (the patentee was "not deprived of a royalty by Aro's infringement, for they could not have licensed Aro's sales in any event; they were denied the right to do so in *Aro I* . . .") the case was remanded to determine the actual damages to Convertible Top Replacement Co., the patent holder.

The new decision that the Patent Office would no longer grant a filing date to an application presenting *photoprints or other copy* of a drawing is a substantial departure from prior practice. It also appears to differ from Rule 85 which states that "A drawing not executed in conformity thereto, may be admitted for examination. . . ." Because of the suddenness of this change, on motion by Ernest F. Mamorek, Esq., and supported by R. Morton Adams, Esq., the members of The NYPLA present at the Annual Meeting on May 28, 1964 voted *unanimously* to request that the Board of Governors express the Association's concern over the adoption of this change. It was pointed out that this change would deprive patent applicants of substantive rights as to the effective filing dates of their applications. The problem is severe, particularly in the case of foreign applicants or those running close to the statutory bar date who must file informal drawings or lose their right to priority or even a patent.

Regardless of the merit of the proposed change, a rule, or at least an old custom, has been substantially altered by the Commissioner, without even a hearing or an opportunity for the Patent Bar to consider and comment. As a quasi-judicial agency, administrative rulings and decisions must be fair and speed of action is not a virtue in and of itself. As Judge Learned Hand said at 162 F.2d 893, 903 (2nd Cir. 1947):

"Speed and hurry ought to be the antipodes of judicial behavior."

NYPLA Joins in "Law Day, USA"

On May 1, 1964, Richard L. Cannaday represented The NYPLA in a panel discussion on station WOR in celebration of "LAW DAY, USA", commemorating individual freedom under law and responsible citizenship. Appearing with Mr. Cannaday on Faye Henle's afternoon show, "Dollars and Sense", were Ephraim London, a general lawyer and Director of the New York Civil Liberties Union and Prof. Erwin O. Smigel, Professor of Sociology and Anthropology, Washington Square College, New York University and author of the recent book, "The Wall Street Lawyer."

In keeping with the theme of Law Day, the topics discussed by the panel included the place of the lawyer and his development and responsibilities in society, the problems of specialization, the desirability of more personal contact with clients, and the preservation of the lawyer's individuality. Mr. Cannaday spoke particularly of the role of the patent lawyer in these areas, emphasizing the nature of the patent lawyer's background, training and activities.

SUPPORT ABA HOST FUND

The NYPLA will act as host for the Patent, Trademark and Copyright Section of the American Bar Association when it holds its annual convention in New York City in August. To help defray expenses, each NYPLA member will receive an appeal for funds. We urge you to support this Host Fund. Make your check payable to "THE NEW YORK PATENT LAW ASSOCIATION", and send it to: Joseph J. Previto, Esq., (WH 4-2590) 63 Wall Street (Room 3305), New York 5, N. Y.

REPORT FINDS NEED FOR PATENTS EVALUATION

The Subcommittee on Patents, Trademarks and Copyrights, Senate Committee on the Judiciary, issued on May 1, 1964, its annual report on the status of the United States patent system. The main thrust of the report was that the time had arrived for a serious re-evaluation of the administration of the Patent Office and of the patent laws, with a view of catching-up with many long standing serious problems besetting the system.

The report stated that in recent years the attention which Congress had focused on the patent system had been principally directed at matters which were ancillary to the problems of general patent prosecution and litigation. An example is the present interest in the establishment of a uniform Government policy regarding the disposition of patent rights in inventions arising from Government-sponsored research.

Review Required. As a first step, the Congress had charged the subcommittee with the responsibility of conducting a full investigation and examination of the administration of the Patent Office, and a complete review of the patent, trademark and copyright statutes. The present report was issued pursuant to that Congressional mandate.

The subcommittee, in initiating the review, found certain trends of considerable concern:

- The ever increasing Government expenditures for research and development, now \$15 billion annually, are not being reflected in the number of patents being filed, and the "spinoff" benefits from these expenditures have been disappointing;
- Many inventors, especially the independent inventor, have become disillusioned with the patent system due to such factors as the high cost of securing a patent, high mortality rate among litigated patents, and the great expense of litigating patent rights; and
- The backlog of more than 200,000 patent applications in fiscal 1963, including many disclosing complicated subject matter in new areas of technology, was still mounting.

Need For Reform. The subcommittee stated that it did not believe the present system could continue much longer, and that measures had to be taken to bring the examining system into accord with scientific realities. The recent increase in the number of Patent Office Examiners and sizable budget increases had not helped. The need for reform in the Patent Office was recognized, and a management survey by Earl Kintner was conducted, with Commissioner Ladd implementing a number of recommendations. Additional efforts should be devoted to improving Patent Office procedure.

Basic Changes Necessary. The subcommittee noted its concern with the current state of administration in the Patent Office. The departure of the Commissioner of Patents soon after an extensive reorganization added to the already existing serious problems. Larger budgets and more Examiners are not feasible answers. Congress must now consider what modifications in practices may be instituted without impairing the incentives to invent which are afforded by the patent system. A major activity of the Subcommittee in the future will be to explore possible areas where changes may be necessary and feasible.

— Comments from Members —

Editor, NYPLA BULLETIN

As a member-reader of your Bulletin (Vol. 3, No. 8, p. 3, May, 1964) I note your comment on the *Mogen David Wine Corp.* case, 140 USPQ 576 (CCPA 1964).

May I correct some errors?

First, you say Mogen David was handed down *before* the *Sears* and *Compco* cases. Mogen David was handed down March 12th (140 USPQ 575). *Sears* and *Compco* were handed down March 9th. What actually happened was that Mogen David was *decided* by the CCPA and the opinion put into the handing-down routine before the Supreme Court announced its decisions. Between the deciding and the handing down, no consideration was given to the Supreme Court's decisions or opinions.

Second, you report that it has been reported that rehearing has been granted by the CCPA. This is not so. The Patent Office has filed a request for reconsideration but no action has been taken on it yet.

Faithfully yours,

(Editor's Note: Reconsideration was denied.) —Giles S. Rich
Editor, NYPLA BULLETIN

Public Law 88-292, an "Act to Amend Title 35 of the United States Code to Permit a Written Declaration to be accepted in lieu of an oath" was approved March 26, 1964. It certainly is none too early that such a provision should be enacted into law. It is hoped that the Commissioner will promptly implement this law by promulgating an appropriate rule or amendment to existing rules.

Before this law becomes part and parcel of the Rules of Practice, it may be appropriate to add a footnote to its passage and especially to the need for its passage. While administrative convenience of the Patent Office was probably the more important reason why the Patent Office and bar association were in favor of the "oath bill," convenience to the inventors and especially to the rising number of foreign inventors (cf. *Chemical and Engineering News*, March 9, 1964, page 28) was also a weighty consideration. The problem of the inventor in the Amazon region 600 miles away from the closest United States consulate became almost proverbial in this respect. There is a better case in point, a case that cries out for Public Law 88-292 even more intensely.

Last year the United States closed its consulates in six European cities, namely, Geneva, Basel, Venice, Turin, LeHavre and Manchester (*New York Times*, July 20, 1963, page 1). Some of these cities are extremely well-known and important industrial centers. It was estimated that, for instance, in Basel, Switzerland, at least about fifty inventors daily signed patent documents before United States consulate officials. These inventors and the inventors in all of the above cities must now trek to United States consulates in other cities or resort to "chain certification" by mail involving a local notary who must be able to administer oath, a United States Consul and one or more intermediate officials. Both alternatives are onerous and time-consuming. See, DeSimone and Gambrell, *The Impact of Oaths and Written Declarations on Person's Transacting Business with the Government*, 22 *Federal Bar Journal*, 277, 279, (1962).

Thus, passage and approval of the "oath bill" will be most welcome to inventors in those cities and to inventors everywhere and an expression of hope bears reiteration that the Commissioner will soon "by rule prescribe" that documents which are now required to be under oath may be subscribed to by a written declaration.

—Karl F. Jorda

RECENT CASES OF SPECIAL INTEREST

Patent. A machine is "repaired" not "reconstructed" although it was corroded, rusted, inoperative and required resizing and relocation of 6 of the 35 elements to convert it from operating on a "1 pound" fish packing can to operating on a "5 ounce" can, *Wilbur Ellis Co. v. Kuther*, 141 USPQ 703 (U. S. Sup. Ct. 1964), reversing, 136 USPQ 332 (9 Cir. 1963). Where a machine has a useful life remaining, adaptation to a related use, although amounting to more than repair in the customary sense, is kin to repair since it relates to the useful capacity of the old combination.

Patent. A terminal disclaimer avoids the rejection on the ground of double patenting although the claims of the second application are distinct from, but obvious in view of the claims of the first patent and the only real objection is extension of monopoly, *In re Robeson*, 141 USPQ 485 (CCPA 1964). Terminal disclaimer, however, is not effective where the claims are only a "mere colorable variation" of the claims of the first patent.

Patent. A rejection of claims solely "as being for an aggregation" is an indefinite rejection, *In re Gustafson*, 141 USPQ 585 (CCPA 1964). The test of the presence or absence of "invention" and the subsidiary question of whether the device or process is an "aggregation," "combination" or an "unpatentable combination for want of invention" is replaced by the statutory test of unobviousness, 35 U. S. C. § 103.

Trademark-Antitrust. Franchise agreements between a parent company and 400 franchise dealers which require the dealers to refrain from selling any but the parent company's product and which require the dealers to purchase from the parent company ingredients for the end product to be sold to the public are not in violation of the antitrust laws, *Susser v. Carvel Corp.*, 141 USPQ 609 (2nd Cir. 1964). The requirement that dealers buy "Carvel mix" as well as other products is a tying arrangement which can be justified as a means for protecting the value of the trademark and associated business goodwill. The trademark owner must be able to exercise control over the use of the mark. The requirement that the dealer sell only "Carvel" products is an exclusive dealing arrangement. It is desirable that the public identify each outlet as one of a chain offering uniform quality of goods. The antitrust laws do not require a trademark owner to permit licensees to associate with its mark products not under the control of the owner.

WOMEN INVENTORS SOUGHT

Research for a book entitled "American Women Inventors" is currently being done by Miss Doris Willens and while she is receiving assistance from many sources, patent attorneys themselves should be in an excellent position to refer information to Miss Willens. If anyone has women clients who are inventors and have success stories to tell, please contact Miss Willens, 2945 Newark St., N. W., Washington, D. C.

Playboy Writeup.—An article on the Patent Office and the Patent System will appear in a forthcoming issue of *Playboy Magazine*.

SPECIAL PATENT JUDGES SUGGESTED

In an article entitled "Special Judges for Patent Cases" 50 *ABA Journal* 475, May, 1964, Emanuel R. Posnack, Esq. of our Association suggests that technically trained triers of fact in district courts are needed because of the increased complexity of modern patent suits. He refers to Judge Wyzanski's recent statement in *Nyysone v. Bendix*, 137 USPQ 853, 860 (1963) that "a judgment by a layman in a field of advanced technology is less likely to reflect original thought or expression than a deliberate, informed, conscientious choice between proffered courses of action." He notes that the increasingly complex patent cases arrive at a time when the federal judiciary is already overburdened.

Judge Hand's Alternative Suggestion. In 1955, the late Judge Learned Hand offered some remarks concerning the desirability of a somewhat different special court of patent appeals. *Hearings, American Patent System, Senate Subcommittee on Patents, Trademarks and Copyrights* (84th Cong. 1955), p. 132:

"I think it might be desirable to have one court of patent appeals provided, with this proviso, and I for myself would regard it as absolutely critical, that is, that it should be a rotating court. I do not want to have a court of specialists, because we all get in love with ourselves.

And courts are particularly of that kind, as you know, although you may not be willing to say so. But it is true. And if you get a court of experts you will get out of line. I think that was Mr. Fish's idea. He was in his day perhaps the head of the patent bar. He thought of a single court of patent appeals, that it would be good.

Perhaps it would be too much work for one. But, anyway, providing the assignments were only for a period of time, so that you would not get arterial sclerosis, which we all are in danger of."

Mr. Fish had stated: "I have never heard one single reason advanced by anybody that seemed worthy of consideration against this Court of Patent Appeals." *Senate Subcommittee on Patents, Trademarks and Copyrights, Study No. 20, "Single Court of Patent Appeals—A Legislative History"* (1959) p. 21.

CHANGES IN INTERFERENCE PRACTICE PROPOSED

On Tuesday evening, April 28, 1964, a capacity audience attended a NYPLA Forum meeting at the Hotel Piccadilly to hear three speakers present their views on proposed revisions in the Rules of Practice for interferences. The speakers panel included Dean Laurence of Laurence & Laurence, Washington, D. C., William R. Woodward of the Western Electric Company and Edwin L. Reynolds, First Assistant Commissioner of Patents. Harry R. Pugh, Jr., then NYPLA First Vice President, introduced the speakers.

Liberalizing Counts Proposed. Mr. Woodward's discussion focused on a proposal for liberalizing the procedures for setting up interferences on the basis of similar, not necessarily identical claims. Contrary to present practice where the parties argue at length over the interference issue to get broad counts, he proposed that the parties be permitted to have different claims in interference so long as they are not patentably distinct, i.e., so long as one would be properly rejected as not unobvious in view of the other.

Liberalizing Discovery Advocated. Emphasizing the problem of the junior party who is anxious to terminate the interference for commercial reasons, Mr. Laurence proposed that liberalization of discovery proceedings will give the attorneys an opportunity to judge each others proofs as basis for settlement or concession without the need for time consuming and expensive testimony taking which is now necessary to develop this information.

Limitations in Proposed Changes. Commissioner Reynolds endorsed the proposed discovery proceedings if the parties went to the District Court first, but suggested that under present law the Patent Office would have to handle the discovery through the Board of Interference Examiners. A generally similar practice was tried in trademark work some five years ago and found to be unworkable from the viewpoint of the Patent Office. Mr. Reynolds also questioned the aspect of the proposed changes which would appear to permit the Motion Period to run concurrently with the discovery proceeding, thus resulting in possible dissolution by motion with a needless waste of the effort involved in the discovery proceeding.

Judge Rich Receives Kettering Award—Discusses "Patentability"

The George Washington Patent Foundation has selected the *Honorable Giles S. Rich* of the Court of Customs and Patent Appeals as the recipient of its 1963 annual Charles F. Kettering award.

The award recognizes outstanding work in the patent, trademark and copyright fields. The presentation was made on June 18, 1964, at the 8th Annual Public Conference of the *Patent, Trademark and Copyright Research Institute of the George Washington University*.

Judge Giles S. Rich received his B.S. degree from Harvard University and his L.L.B. degree in 1929 from Columbia University. He served as president of NYPLA in 1950-51 and practiced patent law until he was appointed in 1956 by President Eisenhower to the U. S. Court of Customs and Patent Appeals. Judge Rich had been one of the draftsmen of the Patent Law of 1952, and it was a most happy circumstance that made him now one of the interpreters of that law on the Bench.

The **BULLETIN**, which has received much encourage-

ment from Judge Rich, now adds its enthusiastic applause to the choice made by the Foundation.

Legislative Intent Considered. In his acceptance address entitled "*The Vague Concept of 'Invention' as Replaced by § 103 of the 1952 Patent Act*," Judge Rich recalled the legislative background with particular reference to the intent of eliminating the requirement of "invention." The real vice or inadequacy of the judge-made requirement for invention was its immeasurable character. "It left every judge practically scot-free to decide this often controlling factor according to his personal philosophy of what inventions should be patented. . . ." Section 103 was a "statement of something to take the place of this concept."

Judge Rich's speech will appear in a forthcoming Conference Number edition of the Institute's *Patent, Trademark, and Copyright Journal of Research and Education* and is basic reading for all concerned with the interpretation of § 103 of the Patent Act.

Association's Annual Meeting Terminates Year's Activities

Harry R. Pugh, Jr. Elected NYPLA President

Harry R. Pugh, Jr. was elected President of The NYPLA at the Annual Meeting on May 28, 1964. Other elections were John N. Cooper, First Vice President; Albert C. Johnston, Second Vice President; Edward Halle, Third Vice President; Alfred L. Haffner, Jr., Secretary; and Albert C. Nolte, Treasurer.

Elected Governors for three-year terms were Henry E. Sharpe, Robert Osann, and William R. Woodward. The Nominating Committee for the coming year consists of Ralph L. Chappell, Chairman, Granville M. Brumbaugh, George S. Hastings, Sylvester J. Liddy and Albert C. Nolte, Jr.

Mr. Pugh was born in 1911 in Charters, Kentucky and grew up in Charleston, West Virginia. He received a Bachelor of Science degree from the University of Virginia in 1933 and an LL.B. from the Yale Law School in 1936.

Mr. Pugh is a partner at Fish, Richardson & Neave, with which firm he has been associated since graduation from Law School. In addition to membership in our Association, he is a member of Phi Beta Kappa, Phi Delta Phi, the American Bar Association, the Association of the Bar of the City of New York, the American Patent Law Association, and the American College of Trial Lawyers.

Mr. Pugh resides in Darien, Connecticut, with his wife and three daughters.



Henry E. Sharpe



Frank W. Ford, Jr.

MESSAGE FROM RETIRING PRESIDENT CHAPPELL

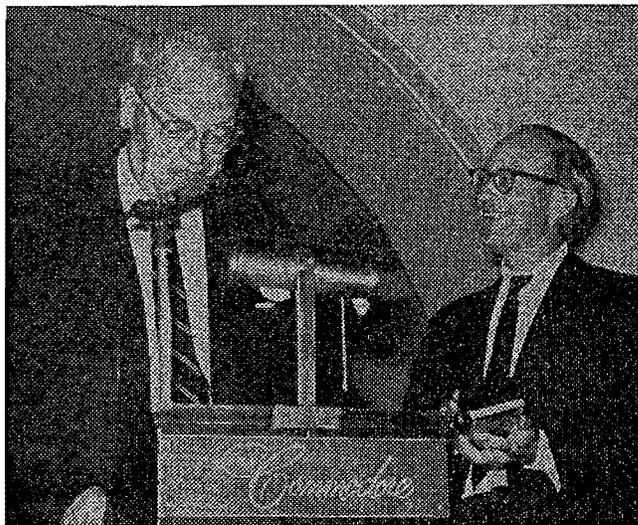
I am gratified to have had the honor of serving as president of the New York Patent Law Association.

I have had the pleasure of working closely with the members of the Board who have all cooperated to make possible constructive and cohesive action. The various committees have really given of themselves, all demonstrating that the Association is a well organized unit.

I would like to extend my thanks and sincere appreciation to each of the officers and members of the board and to each chairman and each committeeman and also each member for the hard work and fine cooperation which has, I believe, made this last year a success.

I know my successor will find the same fine cooperation and energy at his disposal. If he derives half as much pleasure as I did, he will have it in ample measure.

—Ralph L. Chappell



NYPLA President Chappell, left, hands reign of office to President-elect Pugh at the NYPLA Annual Meeting.

JOTTINGS ON THE ANNUAL MEETING

Before transferring the President's Gavel to **Harry R. Pugh**, President Chappell reviewed the activities of the Association during the past year.

Senator McClellan's statement of general aims in connection with Government Patent Policy was endorsed by the NYPLA with specific recommendations for changes. . . . We supported the Design Protection Bill and favored salary increases for judges. . . . We favored the reforms in the CCPA with respect to reasons for appeal and opposed Court of Claims legislation narrowing the definition of ownership. . . . We gave extended consideration to the naming of a new Commissioner of Patents, but took no action. . . . The NYPLA BULLETIN has achieved such recognition and so many requests for it have been received from persons outside of the NYPLA, that an individual subscription rate has been provided for non-members. . . . **Henry E. Sharpe** was given a silver cigarette box having an engraved masthead of the first BULLETIN as expressing the Association's appreciation for his initiation and development of the BULLETIN. He was also elected to Board of Governors. . . . Retiring Secretary **Frank W. Ford, Jr.** was also given an engraved silver cigarette box expressing the Association's gratitude for past services rendered in handling the secretarial matters of the Association. . . . **Albert Nolte**, Treasurer reported that the finances are in excellent condition. . . . **Alan Latman** was guardedly optimistic in predicting the passage of the Design Protection Bill. . . . **Eric Waters** reported on the many new laws concerning foreign patents and the Common Market. . . . **Robert Osann** for the Committee on Public Information and Education announced that the Association's second annual award for an outstanding law review article on patents, trademarks and copyrights was being given to **Douglas S. Liebhafsky** for his article in 38 *N. Y. U. Law Rev.* 324 (April, 1963) entitled "Industrial Secrets and the Skilled Employee." The \$150 award was given to Mr. Liebhafsky after the dinner by President Pugh.

All Committee Reports will appear in full text in the forthcoming Yearbook.

PERFORMERS' TREATY BECOMES EFFECTIVE

The International Convention for the Protection of Performers, Producers of Phonograms and Broadcasting Organizations was concluded in Rome in 1961. The treaty has been characterized as a "neighboring rights" treaty since the scope of protection embodies principles which neighbor on rights under the copyright law. The Convention came into effect on May 18, 1964, when the United Kingdom became the sixth country to ratify the Convention.

Although the United Kingdom was among the first countries to sign the Convention, it was not possible for the United Kingdom to ratify the Convention until the Dramatic and Musical Performers Protection Act of 1958 was revised. The enactment of the British Performers Protection Act of 1963 which granted the minimum protection accorded performers under the Rome Neighboring Rights Convention enabled Great Britain to ratify the treaty.

Although the United States is not party to the Convention, difficult questions may arise in the future on the possible effect of the Convention on United States industry.

MEETING ON FOREIGN PATENTS

On March 31, 1964, a Forum Meeting was held under the sponsorship of the Foreign Patents Subcommittee. The Chairman of the Subcommittee, Burton P. Beatty, introduced Stephen H. Frishauf who discussed the administrative mechanisms involved should maintenance fees become part of the U. S. patent law and H. Geoffrey Lynfield who discussed Utility Model protection in Brazil, Germany, Italy, Japan, Korea, Poland, Portugal and Spain.

Mr. Frishauf pointed out that the major problem is to determine whether or not a patent should be dropped or maintained. He indicated that record keeping problems while important are not as important as ascertaining while patents are to be maintained. Persons at lower levels in industry usually are more conversant with the actual use and marketing of the invention, and field engineers, marketing personnel and general engineering personnel may be better informed of the actual facts concerning the success of an invention.

Mr. Lynfield pointed out that while a large number of Utility Model applications are filed in Germany and Japan, the major proportion of these are filed by the local applicants rather than by U. S. applicants.

DANIEL STRYKER

Daniel Stryker, who for 32 years prior to his retirement in 1955 was a patent attorney with Texaco, died of a heart condition in White Plains Hospital on February 7th after a short illness. He graduated from the Sheffield Scientific School of Yale University and after working for Kennicott in Alaska was associated with Westinghouse in Washington, D. C., where he took his law degree at The George Washington University. Mr. Stryker was a member of the NYPLA for many years. He is survived by his second wife, Gwendolyn Welch Stryker, two daughters, Mrs. Robert C. Walker and Mrs. Charles O. Pratt, a son, Dr. Winfield Stryker, and seven grandchildren. He was 68 years of age.

USE OF PATENT ATTORNEY TITLE BY NON-LAWYERS BARRED IN N. Y.

In a decision handed down May 28, 1964, *People v. Miller*, 141 USPQ 758, the Supreme Court of New York County ruled that non-lawyer patent practitioners may not use the designation "patent attorney" in New York State, despite the "grandfather" right to do so granted by the Patent Office to pre-1938 registrants. The action, for injunction, was brought by the N. Y. Attorney General against a non-lawyer patent attorney to enforce the provisions of Sections 476(a) *et seq.* of the Judiciary Law which relate generally to actions for unlawful practice of the law.

Recognizing the principle set down in *Sperry v. State of Florida*, 373 U. S. 379, that a state may not take any action which will interfere with the registered patent attorney in any detail necessary to his function as a practitioner before the Patent Office, the Court stated:

"State insistence that only a patent practitioner who is an attorney-at-law pursue his practice with the designation connoting status as an attorney-at-law is not inconsistent with a Congressional statute or current patent office rule and does not interfere with the necessary scope of practice before the patent office."

The decision also pointed to the present Patent Office rules establishing separate attorney and agent categories and providing that no registered agent shall represent himself to be "an attorney, solicitor or lawyer" [Rule 345(c)], as a basis for maintaining a clear distinction between the attorney and agent.

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