

DOCTOR EDWIN H. LAND TO SPEAK AT JUDICIAL DINNER

The 42nd Annual Dinner in honor of the federal judges will be held on Friday, March 20, 1964. As customary by now, the location will be in the Grand Ballroom of the Waldorf-Astoria Hotel.

Dr. Edwin H. Land, President of the Polaroid Corporation, will be the guest speaker. Dr. Land announced, in 1947, his invention of the one-step photographic process yielding instant finished pictures. This was the beginning of the well known Polaroid Land camera. Prior to this, Doctor Land announced in 1932 the invention of the first practical light-polarizing material in sheet form, which principle found applications in scientific and military instruments, visual and photographic filters, three-dimensional pictures and systems intended to eliminate headlight glare. Dr. Land is the sole or joint owner of over 250 United States patents. In 1963, the instant-color picture was made available to the public.

Dr. Land was born in 1909 and was graduated from Harvard University in 1930. He was President of the American Academy of Arts and Sciences from 1951-1953 and received the Presidential Medal of Freedom in 1963.

The dinner will begin at 7:00 P. M. It will be preceded by a general reception beginning at 5:30 P.M. The cost will be \$17 per member, and \$19 per guest.

PROFIT-SHARING IS PROPOSED FOR THE CORPORATE INVENTOR

The question of whether the hired inventor should share more directly in the profits from his invention is the subject of an intriguing and provocative article written by Albert S. Davis, Jr., a member of the NYPLA, in the December, 1963, issue of *International Science and Technology*.

Mr. Davis suggests that if the employee-inventor were to be given a further monetary stimulus in the form of

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CALENDAR

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| Mar. 20 | 42nd Annual Dinner in Honor of the Federal Judiciary, Hotel Waldorf-Astoria. Reception for judges and guests at 5:45 p.m. and dinner at 7. |
| May 28 | Annual May Business Meeting at the Windsor Terrace, The Biltmore Hotel. |
| Jun. 19 | 8th Annual Spring Outing and Dinner-Dance, Knollwood Country Club, Elmsford, N. Y. |

Wide Interest Evoked

NYPLA CONFERENCE HEARS FEDERAL JUDGES PANEL

The Fifth Annual Judicial Conference of the NYPLA was held at the Hotel Roosevelt on February 19, 1964. The program featured a guest panel consisting of a United States District Judge from each of the metropolitan districts, namely, Hon. Edmund L. Palmieri, Southern District of New York, Hon. Reynier J. Wortendyke, Jr., District of New Jersey and Hon. John F. Dooling, Jr., Eastern District of New York. NYPLA President Ralph L. Chappell introduced the distinguished panelists and served as moderator.

The program consisted of two phases. In the first phase, each panelist presented brief preliminary comments on matters helpful to members of the patent, trademark and copyright bar. In the second phase, each of the judges commented on a series of questions presented by the moderator.

Pretrial Conference Examined. In his preliminary comments, Judge Palmieri, coming from the large multi-judge Southern District court, suggested that the value of the pretrial conference and pretrial order be re-examined. He indicated that he did not find such pretrial orders to be of much worth in the patent cases he has tried. In the Southern District, contrary to the practice in other districts, cases are not assigned to a particular judge from inception through trial, and the judge who tries the case is necessarily not familiar with the discussion at the pretrial conference and will only have a bare pretrial order with which to work. In his view, the pretrial conference and the resulting pretrial order required unnecessary expense on the part of the litigants. Judge Palmieri mentioned one case in which 150 exhibits were marked in the pretrial order, while only 50 were used at trial. The additional exhibits were marked only to prevent their possible preclusion later.

On the other hand, Judge Wortendyke followed the practice of holding a series of informal or formal pretrial conferences for the express purpose of learning

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Panelists at the NYPLA Judicial Conference, left to right, Judge Dooling, Judge Wortendyke and Judge Palmieri.

Editorial

During the Judicial Conference, Judge Palmieri suggested that the pretrial conference and resulting order as it now is applied to patent cases in the Southern District be re-examined since he did not find the pretrial order to be very helpful. The subject of pretrial in the Southern District was discussed by the Hon. Sylvester J. Ryan, the Hon. Archie O. Dawson and the Hon. David N. Edelstein in a meeting before the Bar on March 6, 1962 (BULLETIN, Vol. 1, No. 7).

At that time, the judges indicated that the key rules, Rules 13 and 14, were intended to require a good-faith meeting of the adversaries to reduce the issues. The necessity for these rules apparently stemmed from practices in cases which are quite different from patent cases. Judge McLean indicated in a previous Judicial Conference on February 26, 1963, that neither the pretrial examiners nor the judges in the Southern District went into patent matters in sufficient detail in the pretrial conference and that the rules were not working out well as applied to patent cases (BULLETIN, Vol. 2, No. 7). Judge McLean suggested, at that time, that special rules might be developed for patent cases.

Judge Wortendyke's favorable experience with a series of informal and formal pretrial conferences to allow the trial judge to get "on top" of cases which are initially assigned might be considered perhaps as part of the "re-examination" in the Southern District.

COURT REVERSES PRIOR DECISION ALLOWING PATENTEE'S DJ ACTION

The Texas District Court has reversed its previous holding in *Proler Steel Corp. v. Luria Brothers & Co., Inc.*, 139 USPQ 169 (See BULLETIN Vol. 3, No. 2), and has declined to accept jurisdiction of this declaratory judgment action, 140 USPQ 373. The suit was brought by the patent owner before any infringement had occurred and sought injunctive relief against future infringing acts by the defendant. Impliedly, such relief would include an adjudication of the validity of the patent.

The defendant's plant in California was not completed at the time the suit was brought and, thus, posed a threat of future infringement which, the Court held, the plaintiff was entitled to seek to enjoin. At the time of the defendant's motion for reconsideration however, the plant was in commercial operation.

In reaching this conclusion, the Court felt that its previous reasoning remained valid and would be appropriate in the proper circumstances. Under its discretionary powers, the Court declined to accept jurisdiction of the declaratory judgment action since the plaintiff was now in a position to attempt to show actual rather than threatened infringement.

BULLETIN SUBSCRIPTIONS

There have been so many requests for the BULLETIN from persons and institutions outside of the New York area that the Board of Governors has decided to make it available to non-members on a subscription basis at a rate of \$2.50 per year. Annual subscriptions will cover 9 issues, and will start with the October issue. Requests for subscriptions should be addressed to the Editor, NYPLA BULLETIN, Room 4004, 60 East 42nd Street, New York 17, N. Y. 10017.

PROFIT-SHARING IS PROPOSED

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cash payments, bonuses, or royalties on a percentage basis, he might turn out enough extra inventions to more than repay his employer for the added compensation.

Trend Cited. As indicative of a growing awareness that a change in the existing pattern could bring benefits, he cites: HR 4932 introduced by Rep. George E. Brown, Jr., which would bar the assignment of inventions as a requirement of employment; Study No. 30 of the Senate Subcommittee on Patents, Trademarks and Copyrights, where in the introduction Senator McClellan raised the question whether "steps should be taken to restore the patent system, in at least some measure, to its traditional role of rewarding the inventor, in order the better to carry out the constitutional objective of 'promoting the progress of science and useful arts?"; and the increasing number of European countries which have legislated special compensation for corporate inventors. (See BULLETIN Vol. 2, Nos. 7 and 8 and Vol. 1, No. 5)

The writer concedes that there is no satisfactory proof to date that the proposed forms of compensation would bring out more inventions than the present systems of rewarding inventors which can bring to the outstanding inventor promotions, added salary, fringe-benefits, and positions of prestige (where the good inventor may prove to be a poor executive and unhappy to boot).

Mr. Davis' suggestion that to withhold a share of the profits from the inventor is a violation of the Judaeo-Christian moral tradition epitomized in the Biblical instruction "Thou shalt not muzzle the ox that treadeth out the grain", would seem to lead him onto dangerous ground, as he himself presumably recognizes. The argument has been made that if the inventor is to be specially rewarded for his outstanding invention, what about the particularly big order brought in by the salesman or the highly profitable merger worked out by the executive, either of which may do much more for the corporation than the invention? Where does one draw the line?

Moreover, many corporations see in the "suggestion awards plans"—with the administration of which they are now struggling—samples in miniature of some of the problems which would come in bigger sizes if they were to put in a full-scale reward program for their "captive inventors."

Pressures for Change. Mr. Davis sees three areas of pressure which could expand to a point where the corporations would be persuaded to take their inventors into partnership. The first, he describes as "gradual agreement with the proposition that such an incentive system will make invention-oriented personnel more productive."

The second area would be legislation. "If there is a legislative requirement, it will be produced by judgment that special compensation to the corporate inventor is justified by basic equity concepts, and in the hope that such action will lead to a fresh spurt of invention and innovation." This he says would not be Senator McClellan's approach, since he sees the Senator as willing to wait for proof that a change can be justified. Nor does he think it would be Rep. Brown's attack on the problem, which would presumably be by way of collective bargaining.

The third area of pressure, as Mr. Davis views it, would be united action by the inventors, which, he says, presupposes heavy union involvement in such a move, and which does not appear to be in sight, as yet.

BRIEFS FROM WASHINGTON

H. R. 8190—Willis, the patent fee bill passed by the House on January 22, 1964, is now before the Senate Judiciary Committee. Contrary to previous indications, Senator McClellan plans to hold subcommittee hearings on this bill. This subcommittee reported favorably on a similar bill two years ago.

It is considered likely that both the American Bar Association and the American Patent Law Association will concentrate their attention on opposition to the maintenance provision of the fee bill in the Senate. This is consistent with the position taken by these associations in the House. The National Association of Manufacturers has also opposed the maintenance fee provision.

When **H. R. 8190** was considered by the House, Representative Anderson offered an amendment to strike out the section of the bill requiring payment of maintenance fees. Representative Robert N. Giaino (D. Conn.) supported the opposition to the maintenance provision arguing on the basis of their cost to small firms. On the other hand, the maintenance provision was supported strongly by Representative John V. Lindsay (R. N. Y.), on the basis of alleged necessity of self-sustaining the Patent Office. He contended that the objection to maintenance fees comes principally from big corporations.

S. 1466 which opens practice before the Patent Office to all members of the bar, has been passed by the Senate and hearings were held in the House in early February.

Government Patent Policy. Senator McClellan's Committee will probably not hold hearings on government patent policy during the present session of Congress. It is deemed likely that Senator McClellan's Committee will follow a "wait and see" program in light of the late President Kennedy's patent policy statement which was issued on October 10, 1963.

CORPORATE PRIVILEGE CONFIRMED

The U. S. Supreme Court has declined to review the 7th Circuit Court of Appeals decision holding that the attorney-client privilege is available to corporations, *Radiant Burners*, 84 S. Ct. 330. The controversy over the corporation's right to assert the privilege thus appears to be stilled. (See BULLETIN, Vol. 2, No. 6 and Vol. 3, No. 1).

Ohio joined the growing list of states providing the corporation's right to the privilege by legislative enactment and recently passed Section 2317.021 of the Ohio Revised Code. This section appears to follow generally the language of the Model Code of Evidence and specifically defines "client" as "a person, firm, partnership, corporation, or other association" for the purpose of the attorney-client privilege.

OPENINGS ON BULLETIN STAFF

The BULLETIN has openings on its staff for two or three young men who have a law review or college newspaper background, or who just like to write. The BULLETIN offers a rare opportunity to sharpen up your writing and at the same time keep in intimate touch with what is going on in your profession. If you are interested, please send a brief resumé of your background and special interests to Douglas M. Clarkson, General Counsel, Potter Instrument Company, Inc., 151 Sunnyside Boulevard, Plainview, N. Y.

BE THE MAN WITH THE ANSWERS

Are you ready to answer inquiries for information on patents, trademarks and copyrights? What do you say when a scientifically inclined high school student asks you where he can get information about the patent system; when an inventor-client asks you where he can get more information on what constitutes invention; when a plant engineer asks where he can find out how to find things in the patented art; or when a commuting neighbor puts down his morning paper to inquire where he can get some elementary background on copyrights and trade-marks. These are common questions and the patent attorney is expected to have the answer.

Page the Patent Office. One way to be ready for such inquiries is to keep in your desk a sheet put out by the Department of Commerce in June 1963, which lists all of the pertinent publications obtainable from either the Patent Office or the U. S. Government Printing Office, with a brief description and the cost of each one. These range all the way from a pamphlet entitled "*General Information Concerning Patents*", up to the "*Manual of Classification*". Not mentioned in this list are two very elemental folders, "*Answers to Questions Frequently Asked About Patents*", and "*Questions and Answers About Trademarks*."

For the inventor-client who wants to learn more about the inventor's problems, there is "*Patents and Inventions—An Information Aid for Inventors*", while the plant engineer who wants to find his way around in the patented art hits the jackpot with the most elaborate information booklet of the list, which covers the subject of "*How to Obtain Information From United States Patents*." This is nicely illustrated and detailed enough so that it could even constitute a good reference volume for the attorney who is a bit rusty in his searching techniques.

A full itemization of the literature listed is as follows: **From the Patent Office** (remit the price to the Commissioner of Patents):

- Classification Bulletins. (Price depends on size.)
- General Information Concerning Patents. (First copy free from the Patent Office, additional copies 15¢ from Superintendent of Documents.)
- General Information Concerning Trademarks. (Same as above.)
- Patents. (25¢; design patents 10¢.)
- Trademarks. (Price varies.)
- Weekly Class Sheets. (Subscription \$5 per year.)

From the U. S. Government Printing Office (communications and remittances should be sent to Superintendent of Documents, U. S. Government Printing Office):

- Decisions of the Commissioner of Patents. (Price varies.)
- Guide for Patent Draftsmen. (15¢)
- How to Obtain Information From United States Patents. (20¢)
- Manual of Classification. (\$8.50)
- Manual of Patent Examining Procedure. (\$4)
- Official Gazette of the United States Patent Office. (Annual subscription \$35; \$1 per issue.)
- Patent Attorneys and Agents Available to Represent Inventors Before the United States Patent Office. (55¢)
- Patent Laws. (30¢)
- Patents and Inventions—An Information Aid For Inventors. (15¢)
- Roster of Attorneys and Agents Registered to Practice Before the U. S. Patent Office. (70¢)
- Trademark Rules of Practice of the United States Patent Office With Forms and Statutes. (45¢)
- Rules of Practice of the United States Patent Office In Patent Cases. (50¢)

NYPLA Conference Hears Panel of Three Federal Judges

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more about the case so that he could get "on top of it" at an early time. Judge Wortendyke found that pretrial conferences of this type save considerable trial time and are worthwhile despite their cost. In Judge Wortendyke's district, the District of New Jersey, cases are assigned to the trial judge immediately when filed. This difference may be fundamental in considering the comments of Judges Palmieri and Wortendyke.

The Expert Evaluated. Judge Dooling's preliminary comments were directed principally to the role of the expert in patent cases, including the so-called "neutral" expert. Focusing attention on the very nature of the neutral expert, Judge Dooling raised the question as to whether or not there is any such thing as a truly "neutral" expert. Experts have ideas and ideas must have partisans. The expert may be disinterested in the outcome but he is not neutral as to the ideas involved.

It was suggested that though ideally an expert may consider himself neutral, nevertheless there is an underlying assumption of a willingness to act as expert for one side in a particular case and once retained the expert may become an advocate for the idea of his employer. You can't hire an expert without telling him what side you are on, at which point the expert must decide whether or not he will serve on that side.

Although "neutral" experts have been used in cases, such as the *United Shoe Machinery* case where Judge Wyzanski used an expert on economics as his law clerk, Judge Dooling suggested that many lawyers would not want an expert of this type who conferred with the judge in chambers without the presence of counsel for the parties.

Judge Dooling pointed out that the basis for judicial interest in such "neutral" experts lies in the fact that the average judge with a liberal arts background is unfamiliar and uncomfortable with technical matters, and he may necessarily require expert assistance. The judge commented, however, that in his view, this dependence on an expert smacks of delegation of decision-making power.

Partisan Experts. As opposed to the so-called neutral expert with disguised partisan views, Judge Dooling noted the desirability of using admittedly partisan experts, who do not assume the disguise of neutrality. Here factors affecting the witnesses' partisan position and credibility may be brought out in the open and taken into account.

The Role of the Patent Lawyer. Judge Dooling suggested that it is the lawyers function to assist the court in understanding expert testimony. The patent lawyers are the "faithful friends" of the court and often translate expert testimony into recognizable relevant evidence.

Question Period Followed. Judge Palmieri stated during the subsequent question and answer period that he likes to see briefs dated to flag the exact stage of the case when the brief was prepared so that the judge can properly relate the brief to the case as it then stands.

The post-trial brief should be broken up into logical parts and should not be a long rambling continuous discussion. The component parts should include a statement of facts, a statement of law, an index and a topical summary. The parts of the brief should be made inde-

pendently readable, should serve as a handbook for the judge in post-trial use, and should be accurate and precise about the subject content of the case.

Judge Wortendyke suggested that counsel should assume that the judge will read all cited cases and should give the context from which a quote was taken, not just a sentence quote. The post-trial brief should contain a written summation based upon the court record with page references to the trial transcript.

Judge Dooling reiterated Judge Palmieri's comments and suggested the desirability for headings and sub-headings in the brief in the form of "talking headings." Also, he suggested the use of a summary, and he indicated a preference for briefs which tend to emphasize important points and are directed principally to the issues which need to be decided, to the exclusion of unnecessary material.

Judge Palmieri commented that a good case presentation should show that (1) the lawyer understands his case very well, (2) the lawyer is saturated with both the facts and the law, (3) that he welcomes questions from the bench, and (4) he can tolerate interruption without losing track of his presentation.

Live Witnesses Preferred. With respect to the use of depositions versus live witnesses, all three judges preferred the opportunity to observe live witnesses, subject to cross-examination, when testifying to issues which might be subject to controversy.

In discussing the weight to be accorded the testimony of a professional, paid witness as distinguished from an interested witness such as the inventor, all three judges again appeared to agree that there is no firm conclusion as to the advantage of one over the other and that all of the circumstances will be taken into account in weighing the witnesses' credibility. Judge Dooling commented that if the patentee is able to testify and is not called, his lack of presence should be explained or it will be misunderstood.

The Fifth Judicial Conference will be remembered among the most successful in view of the large turn out of about 200 members and guests, all of whom were extremely attentive to the interesting and informative program arranged by the NYPLA Committee on Meetings under the guidance of Edward O. Halle, John M. Calimafde and Joseph C. Sullivan.

A Moot Question

According to the Coordination Service of the American Bar Association, the term *moot question* stems from early Norse use. Among early Norsemen, it was customary to settle many important questions by means of the public assembly or *mot*.

Contact with the British Isles led to adoption of the word there. Gradually the meaning changed from that of a meeting to a public argument; at the same time another "o" was added. Law students reading at Inns of Court began holding *moots* at which they argued hypothetical cases. As early as 1531, this was regarded as an "Ancient practice."

Cases tried in a moot court seldom were settled with any satisfaction. Therefore, any perplexing problem came to be termed a *moot question*.

In The Law Reviews

Two notes concerning patent matters were included in the November, 1963, issue of the *New York University Law Review*. "**The Patentability of Computer Programs**" urges that computer programs are patentable and outlines the most effective procedure for securing such protection. Several types of claims are suggested as well as what should constitute an adequate disclosure of the program. The author effectively argues that the benefits of the patent system should not be denied those laboring in the computer program art.

"**The Manufacturer's Right to Resell Patented and Copyrighted Goods**", the second article, analyzes the situation wherein a manufacturer has cause to sell without consent goods he has produced, pursuant to contract with a patent or copyright holder. The manufacturer may be exercising a common law or statutory right of resale, when the patent or copyright holder has refused to accept or pay for the goods he has ordered. The propriety of an infringement action to prevent such resale is evaluated in light of recent case law.

VENICE ENACTED FIRST PATENT STATUTE IN 1474

It is generally assumed that the first patent law, in the sense of a general promise of exclusive rights to inventors, was enacted in 1474 by the Republic of Venice (See Study No. 15, 85th Cong. 2d Sess. (1958)).

For those of our readers who are interested in this historical document, we print below what we believe is an accurate English translation of the Italian text:

"1474, the 19th day of March.

There are in this city, and also there come temporarily by reason of its greatness and goodness, men from different places and most clever minds, capable of devising and inventing all manner of ingenious contrivances. And should it provided, that the works and contrivances invented by them, other having seen them could not make them and take their honor, men of such kind would exert their minds, invent and make things which would be of no small utility and benefit to our State. Therefore, decision will be passed that, by authority of this Council, each person who will make in this city any new and ingenious contrivance, not made heretofore in our dominion, as soon as it is reduced to perfection, so that it can be used and exercised, shall give notice of the same to the office of our Provisioners of Common. It being forbidden to any other in any territory and place of ours to make any other contrivance in the form and resemblance thereof, without the consent and license of the author up to ten years. And, however, should anybody make it, the aforesaid author and inventor will have the liberty to cite him before any office of this city, by which office the aforesaid who shall infringe be forced to pay him the sum of one hundred ducates and the contrivance be immediately destroyed. Being then in liberty of our Government at his will to take and use in his need any of said contrivances and instruments, with this condition, however, that no others than the authors shall exercise them.

favorable 116

contrary 10

uncertain 3"

NEW YORK LAWYERS PAY ONE-TIME "LICENSE FEE"

The New York State lawyer's registration act (Judiciary Law § 467a) requiring payment on or before January 1, 1964 of a \$15 registration fee by each attorney licensed and admitted to practice on September 1, 1963, has met with some protest by members of the New York Bar. Criticized as being purely for revenue purpose, the law is a "one-shot" measure and the collected fees fall into the state's general funds.

The establishment of a regular license fee for lawyers has been approved by many and is the subject of a recommendation by the Association of the Bar of the City of New York. The latter calls for a \$15 biennial fee, the proceeds being devoted to the improved administration of justice in the state. One such use would be the setting up of a client's security fund for the protection of the public.

Many States Have Fees. A recent report issued by the American Bar Association indicates that New York lawyers are by no means alone in the payment of a registration or license fee. A surprisingly large number of municipal, county and state governments exact periodic fees from lawyers practicing within their respective jurisdictions. Although most of the fees or taxes are fixed annual amounts ranging from \$10 to \$50, some are graduated in accordance with the individual lawyer's income.

The city of Birmingham, Alabama, for example, imposes an annual license fee increasing from \$30 for a gross annual income of \$3,000 or less, to \$100 for an income of \$7,500 or more per year. In addition, an employer must pay \$20 a year to the city for each salaried attorney in his employ. The Roanoke, Virginia lawyer pays a city license tax of \$20 on the first \$4,000 of gross receipts plus \$1.10 per \$100 of gross receipts in excess of \$4,000.

The ABA report goes on to point out that with but few exceptions, moneys collected by the state or local governments are for revenue purposes only and do not find their way into activities related to legal administration.

Proposed Patent Office Rule Change Dropped Voluntary Compliance By Attorneys Sought

The proposal to amend Rule 104 to require applicants to file a list of pertinent prior art references with their applications (see NYPLA BULLETIN, Vol. 3, No. 2), has been dropped *at least temporarily* by the Patent Office.

In a notice first published in the Official Gazette of December 24, 1963, (797 O. G. 733) the Patent Office indicated that its action was prompted to some extent by objections raised at the oral hearing and in written comments. However, the results sought to be achieved by the proposed rule change still are considered to be highly desirable and applicants and attorneys are advised to submit "in a separate paper either at the time of filing of an application or as soon as practicable thereafter . . . any prior patent or publication which, in their opinion, may be helpful to the Office in its examination of the application."

The notice states the intention of the Patent Office not to rely on such cited prior art as a substitute for the official search, nor to consider it an admission by the applicant or attorney that the cited art is anticipatory of any claim or should form a basis for a rejection. Its expressed purpose is simply to facilitate the work of the Patent Office.

Implicit in the notice is the possibility that if the Patent Bar does not respond voluntarily to the Patent Office's request, the rule change may again be considered.

RECENT CASES OF SPECIAL INTEREST

Trademark. An operator of service stations, providing automotive service and maintenance for customers who are travelling interstate on federal highways in the course of interstate commerce, renders such services "in commerce" within the meaning of Sec. 45 of the Lanham Act, *In re Gastown, Inc.*, 140 USPQ 216 (CCPA, 1964). Although all of the service stations are located in one state and the services are rendered wholly within this state, the services directly affect interstate commerce. In the Lanham Act, Congress intended to regulate commerce to the full extent of its constitutional powers. The **Bookbinder** case, 112 USPQ 326, 240 F. 2d 365, which held that the flow of out-of-state traffic to a well-known restaurant did not impress the restaurant's services with the stamp of interstate commerce, was distinguished because of its lack of affidavit evidence.

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Patent. The basis for a rejection of an otherwise proper method claim as being drawn to the inherent function of a claimed apparatus is that the inventive concept was not completed until the apparatus was perfected, the method could not be performed by hand, no other suitable apparatus was apparent and that, therefore, the invention was in the apparatus, not the method, *Ex parte Packard*, 140 USPQ 27 (P. O. B'd App., 1963). A strong dissent urged that no statutory basis for such a rejection existed, that the pertinent case law only barred claiming the end result of the use of an apparatus and not the method the apparatus carried out, and that the fact that the inventor disclosed a novel rather than a conventional apparatus should not place a greater burden on him in the prosecution of his patent application.

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Copyright. When a claim of unfair competition is pendant to a claim for copyright infringement, the federal law of unfair competition should apply, *Neal v. Thomas Organ Co.*, 140 USPQ 103 (9th Cir., 1963). Since jurisdiction is based on a federal question rather than diversity of citizenship, state law is not applicable. The federal law of unfair competition has been enacted by the Lanham Act.

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BRUCE B. CLYMAN

Bruce B. Clyman, a member of our Association since 1950 and Patent Counsel of Bristol Laboratories, died December 23, 1963. Mr. Clyman was born in Philadelphia and was educated at Rutgers University (B. S. 1942) and Harvard University Law School (LL.B. 1948). In addition to membership in the NYPLA, he was a member of the Association of the Bar of the City of New York, the American Bar Association, the Onondaga County Bar Association, and Phi Lambda Upsilon, an honorary chemical society, as well as the Temple Society of Concord. He initiated the thinking behind the formation of the NYPLA Forums Committee.

Surviving Mr. Clyman are his wife, two sons, his mother, and three sisters.

DOUGLAS H. KENYON

Douglas H. Kenyon, a member of the Association since 1922, has died after a long illness. Mr. Kenyon was a partner in the New York law firm of Kenyon & Kenyon, a graduate of Princeton University (cum laude) in 1916 and of Columbia University Law School in 1919. He was admitted to the Bar in 1920. His association membership included the American Bar Association and the Association of the Bar of the City of New York in which he was a past chairman of the Patent Committee. He was also a former magistrate of the Village of Belle Terre, Long Island.

Surviving are his wife, Mrs. Elizabeth Church Tompkins Kenyon, two sisters, and his two cousins both of whom are members of the Association, Theodore S. Kenyon and W. Houston Kenyon, Jr.

PATRICK PAUL TETTA

Patrick Paul Tetta, a member of the NYPLA since 1961, recently died. Mr. Tetta, a graduate of City College of New York (B. S. Chem. E.) in 1948 and Brooklyn Law School (LL.B.) in 1956, was a member of the patent department, Union Carbide Corporation, working in organic chemistry. He was a member of Alpha Phi Delta, Phi Delta Phi Law Fraternity, the American Chemical Society and the Bar of the State of New York. His wife, Milda D., and four children survive him.