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June 24, 1966—Annual Golf Outing, Knollwood Country Club, Elmsford, N. Y.

JUDGE J. R. JACKSON IS THE SPEAKER AT ANNUAL JUDICIAL CONFERENCE

Judge J. R. Jackson, retired associate judge of the Court of Customs and Patent Appeals and sitting by designation in the United States District Court for the District of Columbia, was the featured speaker at the annual Judicial Conference of the NYPLA. The Conference was held on the evening of April 28 at the Hotel Roosevelt.

Patent Cases Difficult to Try. Judge Jackson stated that he had been assigned to handle all the patent cases in his court and that, of all the work he had done during his lifetime as a lawyer and on the bench, trying cases concerning patents was the most difficult. This latter was especially so since he was not an engineer and not a patent attorney. He stated that he believed patent cases were the most important work he had ever done and the most important type of litigation before the federal courts, since they affected the patent system which had given the United States a top technological position.

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Appeals to District Court Recommended. The Judge recommended that in appealing from the Patent Office Board of Appeals, it would almost always be advantageous to go to the District Court. Having been in the CCPA for many years prior to his service on the District Court, Judge Jackson felt that a case *de novo* with a live record could often succeed while a "review" by the CCPA might not.

We are sure the Patent Office believes itself justified in setting up the recently announced requirements for showing diligence in accounting for papers mailed from the Office, but we would feel better if we were certain the effect on applicants and practitioners had been fully considered. There is no indication in the notice appearing in the May 10, 1966, Official Gazette that a hearing was afforded nor is there a hint of what prompted the Patent Office to impose the requirements.

The resulting burden on practitioners is great. Elaborate docketing procedures must be established as a basis for *proving* diligence should the need arise, at no little expense and inconvenience to the practitioner (and thus his applicants). Are there enough petitions to revive, based on loss of mail from the Patent Office to the applicant, to justify it?

The efforts of the Patent Office to eliminate waste motion, reduce costs, and speed up the examination process have received and will continue to receive the wholehearted support of the Patent Bar. But removal of an obstacle within the Patent Office does not necessarily promote efficiency in the administration of the patent system as a whole, and expedients which place a disproportionate burden on the practitioner and his applicant for a small return ought to be carefully weighed.

After all, the applicant and his attorney are part of the public too.

NEUMAN SPEAKS AT NJPLA DINNER ON THE PRESIDENT'S COMMISSION

The New Jersey Patent Law Association held its annual Jefferson Medal Dinner on April 19, 1966, at the Robert Treat Hotel in Newark. For the first time in the fifteen-year history of this event, no medal was awarded; instead the dinner was devoted to honoring past recipients of the award, many of whom were present.

Scheduled Speaker Unable to Appear. The scheduled speaker was Dr. Harry H. Ransom, Chairman of the President's Commission on the Patent System (See BULLETIN, October, 1965) who could not be present.

However Mr. Sidney Neuman, a member of the Illinois bar and of the President's Commission delivered the talk previously prepared by Dr. Ransom and then followed with his own remarks.

Dr. Ransom's paper emphasized the rigorous effort which is being made by the President's Commission to complete its work by the October date set by President Johnson. This group, which is composed of members of the bar, industry, business, and education, has met repeatedly in Washington, and held extended sessions in New York and California in its attempt to carry out the President's mandate of ensuring that the patent system will more effectively serve the public interest.

The speaker's own remarks emphasized the patent system's influence for the public welfare. Mr. Neuman averred that any society which expects to enjoy progress must have a patent system.

Committee Working to Improve Patent System. The speaker affirmed that the patent system has friends in high places, and he quoted from addresses by Senator McClellan and President Johnson. Mr. Neuman concluded with his personal opinion that if the Commission recommends a program of modernization, "it will be designed to improve the system, not to destroy it."

The Board of Governors held an extended meeting on April 26th. Gerald W. Griffin, chairman of the Dinner Committee which handled the Waldorf dinner reported a total attendance of 1,075 at the dinner, with 32 honored guests present. For the first time, the dinner did not show a deficit, in keeping with the Board's current policy to make the dinners self-sustaining. A vote of thanks was given to Mr. Griffin and his committee for their splendid handling of the dinner. The dinner chairman mentioned one point on which there seems to be some misunderstanding, and that is that due to the limited seating capacity and great demand for tickets members should not bring their wives as guests unless they have been asked to act as host and hostess for the occasion.

The names of 23 prospective members were presented by Hugh Chapin, chairman of the Membership Committee, and they were duly elected by the Board. • • • Mr. Chapin also presented a proposed amendment to the Constitution setting up a new membership class of "Retired Members," which amendment was scheduled for presentation to the membership for vote at the Annual Meeting. The committee also proposed new and stricter guidelines for election of Life Members. The qualifications for Foreign Associate Membership were also reviewed and it was generally agreed that only persons admitted to practice in the courts of their respective places of residence should be included in this class of membership as provided for in the Constitution.

A number of committee reports and recommendations were considered and acted upon. The President is to write to the Senate Subcommittee expressing strong support for S. 2207 which would amend 35 USC 142-144 to eliminate reasons of appeal in CCPA cases, as recommended by William J. Barnes' Subcommittee on Practice and Procedure in the Courts. • • • In accordance with recommendations made by Allen G. Weise's Subcommittee on Patent Office Affairs and Practice, the president will also address a letter to the Commissioner suggesting modifications in the proposed changes in Patent Office Rules of Practice as announced on March 4, 1966. • • • Mr. Weise's subcommittee also favors adoption of proposed Rule 138 as announced by the Commissioner on March 25, 1966, and the Secretary was requested to inform the Commissioner of the Board's approval. • • • While the majority of Mr. Weise's subcommittee favored the adoption of proposed Rule 84(b) as announced by the Commissioner on March 10, 1966, a communication received by the Board and objections raised at the meeting resulted in disapproval of the recommendation and the Secretary will advise the Commissioner of the Board's disapproval of proposed Rule 84(b).

The Board approved the polling of the membership to accumulate information necessary to determine whether or not the Association can provide group malpractice insurance for its members. • • • Provisional approval was given for use of the NYPLA Conference Room by individual members for specific conference use. • • • On the recommendation of the Publications Committee, the subscription price of the BULLETIN to non-members was raised from \$2.50 to \$4.00 per year, which is more commensurate with the actual cost of publication and distribution.

BRIEFS FROM WASHINGTON

A number of bills of interest to patent practitioners are being considered by Congress:

S. 1809—McClellan has taken a step forward, with a favorable report, announced March 31, 1966, of an amended version by the Senator's Subcommittee of the Committee on the Judiciary. The amended version of S. 1809 provides that the Government will acquire the principal patent rights to inventions resulting from Government-financed research and development contracts relating to the public health, welfare, or safety; contracts for the development of an item, the use of which is required by Government regulations; contracts in a research area where the Government has provided almost all of the funds, or where services of a contractor are for operation of a Government-owned facility.

The bill carries certain special exceptions, e.g., when the purpose of the contract is to build upon existing knowledge of technology in an area in which the contractor has an established commercial position or when the contractor is a small business concern or a non-profit institution. In these cases the contractor may normally obtain the patent rights. However, when a Government contractor obtains patent rights, those rights are subject to the authority of the Government to require the contractor to bring the invention to a point of practical application and the further right of the Government to direct granting of licenses to other parties if required for the public health, safety, or welfare.

S. 2715—Hart, purporting to be a compromise between S. 1809 and Long bill S. 1899, has apparently been shelved. The Hart bill would have granted the contractor a nonexclusive transferable license to practice the invention. Senator Hart would permit the Government to waive its interest in an invention but not where the invention might have "substantial commercial use by the general public" unless the contractor's contribution "substantially exceeds" that of the Government.

According to Senator Hart's version the Government could not waive its patent rights in fields concerning public health or safety nor in fields in which the Government has already been a prime developer. Furthermore, a waiver by the Government according to Senator Hart's bill would necessitate an opinion by the Attorney General that it is in the public interest and that the potential detriment to competition is outweighed by the benefits of waiving the Government's property rights in the invention.

H. R. 12216—Morse and H. R. 12230—Utt are identical bills, each proposing to amend the recently passed fee bill to provide that the increased issue fee apply only to cases filed after October 25, 1965.

H. R. 12222—Rhodes proposes to provide counsel for indigent patentees, whether plaintiffs or defendants. The Commissioner of Patents would be required to first determine that the patentee's case was meritorious and then appoint counsel at a fee which is "reasonable but not to exceed \$50 a day." A judgment and costs levied against an indigent patentee would be paid by the Commissioner, but if the patentee won, the Commissioner would collect costs from the loser.

RECENT CASES OF SPECIAL INTEREST

Patents. One issued determined by the Court in **I. C. E. Corp. v. Armeo Steel Corp.**, 148 USPQ 537 (S. D. N. Y. 1966) was whether a German patent application reproduced on microfilm and stored in the Library of Congress was a prior printed publication within the meaning of 35 U. S. C. 102. The Court stated that a printed publication would include a document printed, reproduced or duplicated by modern day methods, upon a satisfactory showing that the document was disseminated or made available to the extent that persons skilled in the art could locate it. However, whether the German application met this test was a question of fact which could not be determined upon a motion for summary judgment. The Court declined to follow a CCPA decision which held that an application on microfilm which could only be obtained upon request from the Secretary of Commerce was not a printed publication, *In re Tenney*, 117 USPQ 348 (1958).

Patents—Privilege. A registered patent agent, licensed to practice before the Patent Office, but not an attorney admitted to practice before any state or federal court, may not invoke the attorney-client privilege with respect to communications between the agent and his client concerning the preparation of the client's patent application, **Joh. A. Benckiser G. M. B. H., Chemische Fabrik v. Hygrade Food Products Corp.**, 149 USPQ 28 (D. N. J. 1966). The Court found that the circumstances that the agent might have been doing a lawyer's work, was a member of the Patent Office "bar", and that agents were recognized in the U. S. Supreme Court's *Sperry case* (137 USPQ 578), still did not make the agent an attorney.

Patents—Obviousness. A product which is claimed in its free-flowing and crystalline form is not obvious under 35 USC 103, where the prior art discloses the same product in its normal form as a viscous liquid, **In re Cofer**, 148 USPQ 268 (CCPA 1966). The Board of Appeals had stated in its decision that merely changing the form, purity or another characteristic of an old product, the utility remaining the same as that for the old product, does not render the claimed product patentable. The CCPA, in reversing the Board, ruled that whether two closely related materials had the same usefulness was only one and not a conclusive test. It stated that the Board failed to consider whether the prior art suggested the particular form or structure of the claimed compound or methods for obtaining the same. *Held*, that persons skilled in the art would not have known that the claimed compound existed in crystalline form and would not have known how to obtain it.

Trademarks—Descriptiveness. Applicant attempted to register *SNAP TOP* for beer cans with tear-open lids, and was opposed by a distributor of beer in cans, who alleged that the applicant's mark was descriptive of his containers and the registration thereof would interfere with the free use of the term by the opposer in his description of his goods. *Held*, **F. & M. Schaefer Brewing Co. v. Pittsburgh Brewing Co.**, 148 USPQ 449 (Tm. Tr. & App. Bd. 1966), the term is descriptive of a can top that can be torn open. That other terms may more aptly describe the top does render the term *SNAP TOP* less descriptive.

THE FEDERAL RULES OF CIVIL PROCEDURE ARE TO BE AMENDED

On July 1, 1966, several substantial changes will be made to the Federal Rules of Civil Procedure. These changes may be found in full in 37 FRD 69 and following. Those revisions of particular interest are summarized below.

Waiver of Defenses. Amended rule 12(g) and (h) attempts to clear up the ambiguity in the present rule and the resulting split in decisions as to when a waiver of defenses takes place. The amended rule clearly states that the defenses of lack of personal jurisdiction, improper venue and insufficiency of process or service of process is waived (a) if omitted in a motion raising other defenses or (b) if not raised by motion or set forth in a responsive pleading or in an amendment thereof permitted by Rule 15 to be made as a matter of course.

Joinder of Parties. Rule 19 has been completely rewritten to set forth more liberal tests for the joinder of parties and to place more stress on the discretion of the court in ordering or refusing joinder. The present rule is not textually precise and fails to point out the proper basis for the court's decision to join or not. The new rule defines who should be joined as a party as those without whom complete relief cannot be obtained between those already parties or those whose own interest would be unprotected without joinder or whose absence would place those already parties to the action in an inequitable position.

If it is impossible to join a person who should be joined, the court then must decide in equity and good conscience whether the action should proceed without him. Prior decisions had shown the apparent belief of some courts that they did not have the power to continue without all the parties joined who should be joined. In determining the propriety of continuing without a particular party, the rule provides that the court must consider (a) to what extent the absentee and present parties will be injured, (b) to what extent the judgment can be framed to lessen the injury, (c) the adequacy of a judgment without the absentee, (d) if the plaintiff will have adequate remedy elsewhere if the suit is dismissed.

Intervention. Rule 24 has been amended to bring it into line with new Rule 19 so that a person, may intervene if his situation is similar to the party sought to be added under Rule 19 and if his interests are not adequately represented by those already parties.

Foreign Law. New Rule 44.1, in order to avoid surprise, requires a person who intends to raise an issue concerning foreign law to give written notice thereof to his adversary. In determining the foreign law the court may, under the new rule, consider any relevant source.

Injunctions. Rule 65 will now empower the court to order the advancement of the trial on the merits so that it can be tried concurrently with the hearing on the injunction. If such consolidation is not ordered by the court, any evidence introduced in support of or in opposition to the injunction, which would be admissible at trial, becomes part of the record on the trial and need not be repeated at the trial. More restraint upon the issuance of temporary restraining orders has also been added.

Offer of Judgment. The imposition of court costs for refusal of an offer of judgment (Rule 68) has been extended so that it will apply not only to the question of liability but also, after liability has been determined, to an offer of judgment on the amount or extent of liability.

PATENT AND TRADEMARK LAWS OF COLOMBIA DUE FOR CHANGE

A bill is now pending before the Colombian Senate which provides for certain radical changes in the Colombian Patent and Trademark Laws. The bill has been approved by the Colombian Chamber of Representatives which is their lower House and is now pending before the Senate.

Some of the changes proposed are as follows:

Patents

- Elimination of product protection for pharmaceutical products.
- Adherence to the International Convention for the Protection of Industrial Property.
- Provision of a one year period for the filing of patent and utility model applications, and a six month period for filing of trademark and design applications.
- Elimination of confirmation patents.
- Accessibility to an application will be denied the public only during the time of pendency up to its publication in the Official Gazette, and after such publication, anyone may obtain access to the published application.
- Institution of a requirement that the invention be exploited, and exploitation is to take place within four years of the grant of the patent; and if no exploitation takes place within the four years after grant, revocation is possible, but the owner may explain this away.

Trademarks

- Loss of a trademark, if the registered owner does not use his trademark within three years.
- Trademarks issued to joint owners must be used by the owners jointly.
- Opposition to the grant of a trademark does not have to be based upon articles in the same class; it is expected that oppositions will be accepted even though they are based on articles of the same nature which may fall into different classes.
- The international classification of trademarks with its 32 classes will be used.
- Clear distinction between trademarks, commercial names, labels, and slogans is expected to be made.

Colombia is also following the lead of many other countries and is proposing extremely large increases in its fees; the fees presently contemplated are expected to be more than twice the present fees.

Appeal. Several changes to Rules 73 through 75 have simplified appellate procedures and sought more uniformity between the Federal Rules and rules of the individual Courts of Appeal. Of particular interest are the following:

- District Courts are not limited in the reasons for which they can extend time for appeal.
- A party need no longer anticipate the appeal of his adversary in order to make certain to file his appeal. Once one party appeals all other parties have 14 days thereafter to file their appeals.
- All extensions of time to file appeals with the Court of Appeals and to docket the record must now be supported by a showing of good cause for delay.

CONVENTION PRIORITY DATE IS SUBJECT OF NEW CCPA RULING

In a decision handed down late last month, Judge Rich, speaking for the majority of the CCPA, held that the convention priority date of a U. S. patent used as a reference was *not* available as the reference date under 35 U. S. C. 102(e), and the effective date of the patent reference was its actual U. S. filing date, *In re Hilmer et al.*, 149 USPQ 480. Chief Judge Worley wrote a dissenting opinion.

The lengthy opinion written by Judge Rich traced the legislative history of the various sections of the patent statute involved and analyzed the several pertinent decisions in depth.

In the case at bar, the availability of a key reference patent depended upon whether it was effective as of its convention priority date or its actual U. S. filing date.

Conflict with District Court. The CCPA decision is in direct and acknowledged conflict with the holding of the District Court for the District of Columbia on precisely the same point, *Lilly v. Brenner*, 147 USPQ 442. **In that case, the District Court found that 35 USC 119 confers a "status" on an application and the resulting patent for all purposes and therefore its reference date under 35 USC 102(e) is its foreign priority date as to all subject matter entitled to the priority right.**

Disagreeing with the "status" theory relied on by the Patent Office and the District Court with respect to Section 119, the CCPA opinion states:

"... we are clearly of the opinion that section 119 is not to be read as anything more than it was originally intended to be by its drafters, the Commission appointed under the 1898 Act of Congress, namely a revision of our statutes to provide for a right of priority in conformity with the International Convention, for the benefit of United States citizens, by creating the necessary reciprocity with foreign members of the then Paris Union."

Accordingly, the CCPA held, Section 119 does not affect Section 102(e), and both may be applied as written; Section 119 to matters related to an applicant's efforts to obtain a patent and Section 102(e) to questions involving the effective date, as a reference, of a U. S. patent.

It should be noted that from the decision in *Viviani v. Taylor v. Herzog*, 72 USPQ 448 (1935), until recently, the Patent Office adhered to the view expressed by the CCPA. However, in the decision on the appeal which resulted in the Lilly case, the Board of Appeals in 1964 held contrary to the established rule.

YEARBOOK ADDRESS CHANGES

All members are urged to check their addresses in the 1965 NYPLA YEARBOOK and if a correction or change is in order, notify the YEARBOOK Editor, J. Harold Nissen, Haseltine, Lake & Co., 119 W. 44th Street, New York, N. Y. 10036, as soon as possible for inclusion in the 1966 edition, which is now being prepared. A copy of the change should be sent at the same time to the Secretary of the Association, Alfred L. Haffner, Jr., Ward, Haselton, McElhannon, Orme, Brooks and Fitzpatrick, 165 Broadway, New York, N. Y. 10006.

Please also inform Mr. Nissen of your Zip Code, if it does not already appear in the 1965 YEARBOOK listings.

MUSIC PUBLISHER CONVICTED OF WILFUL COPYRIGHT INFRINGEMENT

After a four day trial, a music publisher has recently been convicted by a Federal Grand Jury of charges of wilfully infringing a number of copyrights.

The Law. Section 104 of the Copyright Law (17 U. S. C. 104) defines wilful infringement of a copyright as a misdemeanor punishable by not more than one year imprisonment and/or a fine of not less than \$100 nor more than \$1000. Ordinarily, injunctive and compensatory relief is sought to protect authors' and composers' rights, but in some cases of copyright infringement, the ordinary civil remedies have proven inadequate due to such factors as difficulty in detecting infringement, difficulty in identifying the infringer, delays in legal processes, and difficulty in collecting any judgment.

A particularly troublesome problem in the area of musical copyrights is presented by the publication of music books containing numerous copyrighted popular and show tunes for which royalties have not been paid. In order to give the appearance of originality, only the melodies of the tunes are printed. The harmony and rhythm are left out. This is done by cutting off the bass clef and pasting over the treble clef before photocopying. The purchaser must devise his own harmony and rhythm. These fake books would probably constitute copyright infringement because note-for-note copying of the melody, even though the harmony and rhythm are not copied, is usually found to be an infringement.

Joint Action. The Music Publisher's Protective Association, Inc., representing about 50 publishers, concerned with the ineffectiveness of ordinary civil remedies in protecting copyrights against "fake books," has been campaigning against them. Their campaign appears to have borne fruit in the recent indictment and conviction of a Long Island handleader on 60 counts of wilful copyright infringement. According to United States Attorney Robert M. Morgenthau, the criminal indictment for copyright infringement was the first of its kind in New York.

The accused was reported to have been charged with publishing, without payment of royalty, several "fake books," each containing about 1,000 copyrighted songs, during a month and a half period in 1964. A total of 46,000 books were supposedly sold for \$35 a piece, thereby returning to the accused about one and a half million dollars, on an investment of less than \$82,000.

Deterrent Effect. Even though a copyright owner may be able to enjoin publication of "fake books" by one infringer, because of the profitability of such publications, the practice by other infringers is difficult to eradicate. The publisher's association has reportedly sought government prosecution of infringers under Section 104 of the copyright laws for many years. They were reportedly pleased at the conviction which may serve as an example and discourage further publication of "fake books" without compensation for the copyright owners.

REILLY TO ANALYZE U. S. v. ADAMS

John A. Reilly, a member of the NYPLA, who argued successfully before the Supreme Court in behalf of the patentee Adams, in *U. S. v. Adams et al.*, 148 USPQ 479, will discuss the techniques and strategy employed in "The Trial and Appeals in the Adams Case" on June 7, 1966, at 8:00 p.m. at the House of The Association of the Bar of the City of New York, 42 West 44th Street. All interested persons are invited to attend.

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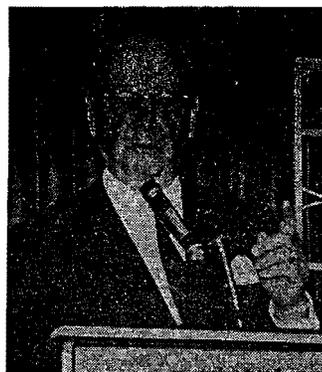
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