

NEWS FROM ABROAD

Algeria: A patent law has now been enacted similar in many respects to the French patent law, including a term of 20 years from the filing date for a regular patent. Algeria also adhered to the International Convention.

Confirmation patents of 10 years are obtainable based on patents issued in a foreign country before January 1, 1966 and of particular economic value to the Algerian Republic.

The new Algerian Trademarks Act has also now come into force. French registrations which were in force on July 3, 1962, can be reinstated for a period of fifteen years from the date of the French registration.

Algerian Trademark registrations, effected by deposit at the Tribunal of Commerce of Algiers, between July 3, 1962 and March 24, 1966: must be "regularized" also before this date.

Canada: The Canadian Exchequer Court held that the Commissioner of Patents had no jurisdiction to grant extensions of the three months' term available for lodging an appeal in conflict proceedings. (*Philco Corporation vs. R. C. A. Victor Corporation*).

Ireland (Eire): A new Irish Patents Act and Rules came into force on July 1, 1966.

A patent may now be revoked if published *anywhere* prior to the priority date.

An applicant, as previously, must provide evidence of novelty. The least expensive method will be the submission of a certified copy of the corresponding British application if available.

It will be possible to obtain claims to chemical, food and medicinal products.

Mexico: The Supreme Court of Mexico in a decision rendered on June 24, 1966 held that the Commissioner acted without legal authority in refusing to renew for non-use a trademark registration which had already been renewed once on that ground.

NEW MEMBERS OF LIBRARY COMMITTEE

The following members are appointed to the Library Committee in addition to those in the 1966 YEARBOOK: Edward G. Curtis, Sidney A. Johnson, Joseph D. Lazar, and Thomas F. Moran. The Board of Governors Liaison now is John R. Shipman.

CALENDAR

Oct. 18, 1966—Forum Meeting, Hotel Piccadilly.
Speakers: George D. Cary of Copyright Office on "Effect of Copyright Revision Bill" and Alan Latman of NYPLA on "Effect of Design Protection Bill"
5:30 P. M., dinner 6:30 P. M.

Nov. 15, 1966—Dinner-meeting in honor of the Commissioner of Patents, Edward J. Brenner, Hotel Roosevelt,
5:30 P. M., dinner at 6:30 P. M.
Speaker: The Commissioner.

COMMISSIONER BRENNER CITES PATENT OFFICE PROGRESS IN FISCAL 1966

Commissioner of Patents Edward J. Brenner, in recent addresses to the Patent Examining Corps, and at the American Bar Association convention, reviewed the highlights of Patent Office activity during the past fiscal year and outlined the projections and programs for fiscal year 1967.

During Fiscal Year 1966, the Patent Office received 93,000 patent applications, an all-time record, as compared with 89,000 patent applications the previous year. Nearly 67,000 patents were issued as compared with 53,000 in Fiscal Year 1965. This was another all-time record for the Patent Office.

The number of appeals pending before the Office were reduced to 5,500, the lowest number of pending appeals since 1956.

The Office of Patent Classification re-classified 79,000 original patents, 7,000 more than the previous year.

The number of patent examiners leaving the Patent Office were fewer and approximately 30% of the new patent examiners joining the staff had previous technical experience in industry or government.

The work load handled by the Patent Copy Sales Branch and the Document Services Branch was up 10%. The number of patents processed was up 20% and the number of assignments recorded was up more than 50%.

The Patent Copy Document Fulfillment System contract was signed, which when it becomes fully operational in 1968 will result in substantial savings to the Office and provide faster and more efficient service to the public.

As a result of the enactment of the new fee bill income from patent operations increased from \$9.2 million in 1965 to \$18.2 million in 1966.

Projections for 1967. The Patent Office expects to receive in Fiscal Year 1967, 92,000 patent applications; disposals of 102,000 applications and a reduction in the backlog of 10,000 cases. Further projections indicate 75,000 patents will issue in Fiscal Year 1967.

A Speaker's Bureau is being established to furnish speakers for local groups on the Patent Office and Trademark Examining Operations.

Continuing efforts are being taken to develop and improve quality control, equal employment opportunity and career development programs. Complimenting the employees of the Patent Office, Commissioner Brenner stated: "It is appropriate, I believe, to recognize the fine job done throughout the year by the clerical groups of our Patent Examining Corps and other patent organizational units, the Office of Patent Services and the Administrative Services Division in handling the heavy workloads resulting from our professional patent operation, as well as the activity generated by the passage of the new fee bill."

Recent Decisions Noted. In his address before the Patent, Trademark and Copyright Section of the ABA, Commissioner Brenner referred to the recent Supreme Court decisions on patentability, pointing out that in the

Comments from Members

Editor, NYPLA BULLETIN

The May, 1966 issue of your excellent "Bulletin" reports toward the bottom of the first column the change in forms for trademark cases recently announced by the Patent Office, and adopts verbatim the Patent Office's instruction that the application for trademark registration is to terminate with an "acknowledgment in the form (etc.)".

The Ohio form of acknowledgment is:

—Individual: State of....., county of....., ss: Before me, a notary public (or justice of the peace, etc.), in and for said county, personally appeared the above named....., who acknowledged that he (she or they) did sign the foregoing instrument, and that the same is his (her or their) free act and deed. In testimony whereof, I have hereunto subscribed my name at....., this..... day of....., 19.....—

Notary Public

(Ohio Law Digest: Martindale-Hubbell 1966, p. 1558)

My recollection is that the New York form was somewhat similar except that it ordinarily required the acknowledgment of the Secretary, in addition to an executive officer, and that their addresses be included.

In any event, an acknowledgment is a wholly different animal from a jurat, as is clear from checking the respective definitions in Black or Bouvier. As indicated in the enclosed correspondence the Patent Office apparently does not care, but perhaps the trademark committee of your association will. Even on the face of the amended rules, forms 4.14, 4.15 and 4.16 instruct "Use jurat from rule 4.1", but form L does not have a jurat; it has an acknowledgment.

Someone not familiar with trademarks could be misled, and the "Bulletin" may want to draw the matter to their attention.

—DAILEY BUGG

PERIOD BETWEEN FINAL FEE AND ISSUE INCREASED

According to a notice currently attached to Notices of Allowance from the Patent Office, applicants and attorneys can anticipate a period of 14 to 15 weeks to elapse after the final fee payment before the patent will be issued. An increase in workload caused the increase from the prior processing period of 6 to 7 weeks. The new time schedule will be in effect until further notice.

GOLF OUTING WINNERS

The annual NYPLA golf outing this past June was well attended and the many golfers found the Knollwood Country Club course in fine shape. The excellent weather contributed to the success of the event.

Al Fey's low gross of 78 carried off the Governor's Cup, while Eric Waters and Clyde Metzker took the awards for low net, Class A and Class B, respectively. Other prize-winners were: Roe McBurnett, second low gross; Les Taggart, second low net, Class A; Charles Baxley, second low net, Class B; W. Crowley, low gross guest; Stan Raub, low net guest; Mary Walsh, low gross ladies; Cathy McElwain, low net ladies; Fritz Kump, putting; and Ronald Ball, nearest to pin.

The presentations were made at the dinner-dance that evening. Music was provided by the Ben Cutler orchestra.

OUT-OF-STATE ATTORNEY ALLOWED FEES FOR SERVICES IN NEW YORK

The Second Circuit Court of Appeals has affirmed the decision of the District Court for the Southern District of New York, holding that an attorney not admitted to practice in New York or *pro hac vice* in the local District Court, but duly admitted in his home State, is entitled to all his fees for his advice and assistance relating to questions of Federal law involved in the action. *Spanos v. Skouras Theatre Corp.*, 35 U. S. Law Week 2091 F. 2d.

The defendant had persistently urged the plaintiff, a California attorney, to assist local counsel in anti-trust litigation pending in the N. Y. District Court and ultimately overcame his hesitancy to do so. In later refusing to pay for the legal services rendered by the plaintiff, the defendant contended that Section 270 of the New York Penal Law, which prohibits the unauthorized practice of law, applied and justified his refusal to pay. Both the District Court and the Court of Appeals refused to accept this argument and found the Federal law to be overriding. Judge Friendly, speaking for the majority, noted:

"We are persuaded, however, that where a right has been conferred on citizens by federal law the constitutional guarantee against its abridgment must be read to include what is necessary and appropriate for its assertion. In an age of increasing specialization and high mobility of the Bar, this must comprehend the right to bring to the assistance of an attorney admitted in the resident state a lawyer licensed by 'public act' of any other State who is thought best fitted for the task, and to allow him to serve in whatever manner is most effective, subject only to valid rules, of course, as to practice before them."

In this case, admission of the plaintiff for purposes of the particular case in the District Court had not been moved by defendant's local counsel. However, no actual court appearances had been made by the plaintiff.

In a vigorous dissent, Chief Judge Lombard and Judge Smith contended that the plaintiff's failure to comply with the Southern District rules and be admitted for purposes of the action was such a violation of both the court rules and the public policy of the State as to outweigh any federal considerations.

BOOKLET ON PATENT CLASSIFICATION RELEASED

A new publication, "*Development and Use of Patent Classification Systems*", was recently announced by Commissioner Brenner, to stimulate public use of the vast reservoir of applied technology available at the U. S. Patent Office.

This 200 page guide, available from the Superintendent of Documents, Government Printing Office, Washington, D. C. 20402 for \$1.50, furnishes details and illustrations on how the U. S. Patent Classification Systems are presently organized, and bases and techniques used in developing and administering the system.

The booklet explains the present classification as a systematic arrangement of subject matter to facilitate the selective retrieval of such scientific and technological information when desired.

The publication was prepared by a group of four patent classifiers Ivan R. Lady, Joseph R. Leclair, Irving J. Rotkin, and Herbert S. Vincent under the direction and supervision of George A. Gorecki, Director of the Office of Patent Classification.

THE BOARD OF GOVERNORS

Your Board of Governors held a meeting on August 30th at which it noted with regret the death of Ralph L. Chappell, a past president and member of the Board of Governors and passed the following resolution:

"Be it resolved by the Board of Governors of The New York Patent Law Association:

"We have noted with deep regret the death of our esteemed colleague and past president, Ralph L. Chappell. Mr. Chappell served his profession and this association with distinction and highest honor. We extend to his family and his partners our sincerest sympathy for the loss they have suffered."

The new membership class of *Retired Member* was discussed and annual dues of \$5 were set by the Board for this membership. Any revisionary action on dues for *Associate Members* and for *Active Members* admitted to practice for less than five years, was deferred. • • • In line with the policy to make Association affairs self-sustaining, the recommendation of the meetings committee that the dinner-dance charge be increased to \$25 per couple was noted. • • • The majority of the meetings committee favors continuing the recent format of the annual Waldorf dinner by continuing to provide a noted speaker rather than professional entertainment as has been suggested by some members.

A question was raised at a previous Board meeting as to whether the completion of a suitable questionnaire by our membership might be useful to the President's Commission. Informal approaches to Commission members and the Commission's staff indicate that such a questionnaire would not be useful or welcome at this time. The Board therefore concluded that no questionnaire would be circulated. It was suggested that further discussion may be in order after the preliminary report of the Commission is made public.

In a discussion of his committee appointments and the duties of the committees, President Johnston mentioned that the Committee on Economic Matters is considering revision of the Association's disability insurance plan, and the adoption of a plan providing professional liability insurance to members. • • • The Library Committee has been requested to assume the function of office-keeping, etc. in connection with the Association's Library and Conference Room at the Columbia Club.

RALPH L. CHAPPELL

The members of the New York Patent Law Association were saddened by the death of Ralph L. Chappell on August 29, 1966. The untimely death of Mr. Chappell came only two years after his term as President of the Association.

Mr. Chappell, who was born in Kalamazoo, Michigan, received his college degrees from Cornell University and his law degree from Harvard.

As a Commander in the Naval Reserve during the Second World War, he served as director of the Patent Division of the Office of Research and Inventions and was awarded the Legion of Merit.

Mr. Chappell, in addition to his many services to our Association, was also a member of the American Bar Association and the American Patent Law Association.

MADRID ARRANGEMENT TO BE RESTUDIED

The NYPLA Subcommittee on Foreign Trademarks, on June 22, 1966, conducted a mail poll of its members on the question of United States adherence to the Madrid Arrangement. Two members voted for immediate adherence, 4 voted against adherence under present circumstances and 8 voted to study the question further. It was the consensus of the Subcommittee that the question warrants further consideration and that it would be premature for the Subcommittee to make a recommendation for or against adherence. Meetings of the Subcommittee are scheduled for this fall.

Previous Recommendation. The 1965-66 Subcommittee on Foreign Trademarks recommended to the NYPLA Board of Governors on February 8, 1966 that the Association take a stand opposing U. S. adherence to the Madrid Arrangement under present circumstances. (See BULLETIN, Vol. 5, No. 6, March, 1966) The Board voted to recommit the question of adherence to the Subcommittee for clarification. The Subcommittee's Annual Report dated May 20, 1966 failed to report any further action.

No Stand by ABA Section on Patent, Trademark and Copyrights. The American Bar Association's Committee on International Treaties and Laws reported at the August 5-11, 1966 Annual Meeting of the ABA that of 25 members polled, 18 voted against immediate U. S. adherence to the Madrid Arrangement, 2 definitely voted for immediate adherence, 2 voted apparently for immediate adherence and 3 sustained. However, the Committee Report suggested that further study of the question was warranted. No resolution was introduced at the Meeting.

The September, 1965 and May, 1966 issues of the Trademark Reporter contain a text of the Madrid Arrangement, Act of Nice, and discuss positions pro and con of the question of U. S. adherence to the Madrid Arrangement.

COMMISSIONER BRENNER CITES PATENT OFFICE PROGRESS IN FISCAL 1966.

Continued from page 1

two cases in which the Patent Office was directly involved, its position was upheld.

He continued:

"I have emphasized to all of our patent examiners the important responsibility they carry in making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied *in each and every case*. In order to further clarify Office policy on this important aspect of patent examination, I have recently instructed the Patent Examining Corps that any application covering an invention of doubtful patentability should not be allowed, unless and until such doubt is removed in the course of examination and prosecution, since otherwise the resultant patent would not justify the statutory presumption of validity, nor would it 'strictly adhere' to the requirements laid down by Congress in the 1952 Act as interpreted by the Supreme Court. Our objective, the timely issuance of valid patents is in the best interest of the inventor, the scientific community, industry, the patent system and the Patent Office."

VARIOUS CHANGES IN PATENT OFFICE PRACTICE INTRODUCED RECENTLY

The Fee Bill has prompted a steady flow of changes in practice by the Office in an effort to streamline the mechanics of assessing and collecting the proper fees.

Dependent vs. Independent Claims. One source of difficulty, and perhaps the most significant one, is in distinguishing dependent from independent claims. In an effort to clarify the distinction, Commissioner Brenner at 828 O. G. 1 (July 5, 1966) explained that

"An essential characteristic of a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U. S. C. 112) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim."

Thus, Commissioner Brenner continued, a product by process claim or a claim to a particular process for making a specific product recited in an earlier claim would be examples of proper dependent claims. However, a claim to a specific product set forth in an earlier process claim but not limited to the process conditions recited in the earlier claim would not be a proper dependent claim since the product might be made by other processes.

Initially, the determination of proper dependency of claims, for fee purposes, is made by administrative personnel, not examiners. Hence, virtually every claim referring to another claim is accepted as a dependent claim subject to subsequent review by the Examiner. On determination by the Examiner that a claim, ostensibly in dependent form, does not include every limitation of the claim on which it depends, he will require cancellation of that claim and of any further claim depending on that claim. The applicant can then optionally amend the claims to render them properly dependent or redraft the claims in independent form and pay any necessary additional fee.

Commissioner Brenner warned against the presentation of a basic independent claim "which on its face is obviously unpatentable or indefinite" in an effort to evade payment of the proper fees. The basic independent claim should represent a bona fide attempt to define the invention and distinguish it from the prior art.

Deposit Accounts. The difficulty of determining proper dependency of claims for fee purposes has, in part, contributed to an administrative difficulty with respect to deposit accounts. In an effort to insure against the loss of

a filing date from the payment of an improperly calculated filing fee, practitioners have increasingly resorted to the use of deposit accounts.

Commissioner Brenner at 828 O. G. 377 (July 12, 1966) discontinued the practice of closing Deposit Accounts merely because they are overdrawn, effective August 1, 1966. Instead, an overdrawn account will be suspended and no charges accepted against it until a proper balance is restored, together with a payment of \$10 to cover the work done by the Patent Office incident to suspending and reinstating the account.

Filing Fees. The same desire on the part of the Patent Bar to insure against the loss of a filing date from an improper calculation of a filing fee has resulted in the practice of overpayment of filing fees. Assistant Commissioner Wahl at 828 O. G. 1085 (July 26, 1966) stated that an application will not lose its filing date for the payment of an incorrect filing fee "... if the basic fee of \$65 is submitted, and if the deficiency is not more than \$25 of the required filing fee...". Payment of the deficiency must be made within a stated period upon notification by the Office. Assistant Commissioner Wahl urged that practitioners discontinue submitting excessive fees since processing such fees has proved costly to the Office.

Other Changes. The Patent Office has requested that patent and trademark applicants seeking a request for an extension of time file that request in duplicate and enclose a stamped return-addressed envelope. The Office will indicate the action taken on the duplicate and return it promptly in the envelope. 829 O. G. 1307.

Examiners are now authorized, upon oral permission by an applicant or his attorney, to amend or cancel claims for passage of an application to issue. 827 O. G. 2 (June 7, 1966).

Effective May 21, 1966, Rule 138 is amended to permit an express abandonment of an application by a Declaration signed by an attorney or agent of record, except in cases involved in an interference.

Effective September 1, 1966, the privilege of hand delivery of amendments and other papers to Examiners will no longer be extended by the mail room. The mail room will accept hand delivery but will then process the papers in the normal manner. The mail room will not return the documents to the applicant for the purpose of hand delivery to an Examining Group.

BULLETIN

of The New York Patent Law Association

165 Broadway, New York, New York 10006

Volume 6. October 1966 Number 1.

The BULLETIN is published monthly (except in July, August, and September) for the members of The New York Patent Law Association. Annual Non-Member Subscriptions \$4.00/year. Correspondence may be directed to The Editor, 90 Broad Street, New York, N. Y. 10004

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