THE NEW YORK PATENT LAW ASSOCIATION

BULLETIN

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FORUM ON JANUARY 22nd

On Tuesday evening, January 22nd, the Forum Committee will present a program covering two topics, **"Patent Prosecution"** and **"Trademark Law Revision."** The two speakers will be announced at a later date. Each speaker is scheduled to talk for one half hour, leaving one half hour for questions. The Committee on Meetings and Forums has requested that, where possible, questions be written and either sent in ahead of time or handed to Mr. Albert C. Nolte, Jr. or to members of the dinner committee at the time of the meeting.

Following previous practice the dinner will be held at the Hotel Piccadilly, 227 West 45th Street. Cocktails will be served at 5:30 p.m., followed by dinner at 6:30. The formal meeting will begin one hour later, with a 9:30 closing anticipated.

TWO RADIO APPEARANCES FOR THE NYPLA

Fay Henle Hostess to NYPLA Panel. On November 26th three members of the NYPLA, John A. Reilly, Richard Whiting and Robert Osann, appeared on Fay Henle's afternoon show "Dollars and Sense," on WOR. Their assignment was to discuss patents, trademarks, and copyrights, but, after reviewing patents in general, the time ran out and they were invited to appear again to continue the discussion.

The second appearance was entitled "Protect Your Brainchild" and took place on December 11th at 3:15. The discussion involved the difference between patents, trademarks, and copyrights; the question as to what can be copyrighted; what to do with a completed manuscript of a book; and who secures the copyright. Miss Henle asked whether an "idea" could be copyrighted, for instance, a doll that was capable of speaking French.

In the ensuing discussion the available pamphlets containing general information on patents, trademarks, and copyrights were mentioned, and the audience was told how to obtain them.

Program Directed to the Layman. In closing, Miss Henle asked for the basic theory behind the patent system, and requested information on the effect of patents on prices, particularly in connection with the recent hearings on drugs. Members of the Association who heard the program felt that while the questions were answered briefly, they were handled in a manner that would be understandable to the lay public. The panel may be called again in the future.

CALENDAR

Jan. 22nd	Forum dinner-meeting on "Patent Prosecution" and "Trademark Law Revision." Cocktails at 5:30 and dinner at 6:30 p.m., Hotel Piccadilly.

THE OPERATION OF THE PATENT OFFICE ACADEMY

When Commissioner Ladd opened the new Patent Office Academy recently he expressed the belief that the newly established Advanced Training Program would mark a major advance in the training of Patent Examiners. He added that "A well-trained, efficient, professional examiner is the heart of a successful Patent Office operation. We expect that the new program will contribute to the development of such an examiner."

Benefits from Program. The benefits which are expected to result from the operation of the program have been stated to be:

- The time required for an examiner to qualify in all phases of examining will be reduced materially.
- There will be a material reduction in senior examiner time required for training new examiners, with a consequent increase in production by the senior examiners.
- The output for the newly-trained examiner should be accelerated as a result of the training, and he should reach maximum productive capacity at an earlier stage in his career.
- The quality of the end product should improve as a result of the knowledge acquired.
- Uniformity in practice should flow from the uniform instructions presented.
- The actions by new examiners should be more complete.
- Searches should be more accurate and productive.
- Pendency time of applications should be reduced.
- There should be a reduction in turnover of examiners, particularly when a significant number of people from outside the Office participate as trainees.

Since the ultimate benefits to be derived from the program will depend in large measure on the courses offered, these become of general interest, particularly in view of the fact that the program will be available for the training of representatives from industry and patent law offices.

The Training Program. The program has been planned so as to cover all aspects of the examiner's work. Special emphasis is placed on the heart of the examining job, with nearly 200 hours of study devoted to Preparation for Search and Retrieval of Prior Art, Patentability, Response by Applicant, and Practice after Final Rejection.

The following is an outline of the curriculum:

	Approximate Hours
1. Introduction to the Patent Examining Operation	5
2. Security Laws and Government-Owned Patent Applications Office Security Requirements	3
3. Basic Requirements of Patent Application Disclosure	12
4. Classes of Invention and Types of Claims	27

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Editorial

In the November issue of CHANGING TIMES, the Kiplinger Magazine, there appears a very helpful article entitled "*Mail-order Patent Services*," subtitled "Are they a help or a gyp?" When he has finished the last page the reader will be able to answer the question for himself. The article refers, of course, to the so-called "patent searchers" and "patent brokers" who are not authorized to practice before the Patent Office and are not subject to regulation by any Bar Association, but who still offer their services through advertisements in well known magazines.

The article is particularly effective in telling of a controlled experiment where an invention already patented was submitted in the form of an inventor's disclosure to a number of these unauthorized practitioners and also to a patent lawyer registered to practice before the Patent Office. Only the patent lawyer and one of the unauthorized practitioners located the original patent during the course of their several novelty searches, and only the patent lawyer advised unequivocally against any further action by the client in view of the broad original patent.

The article is well written and has enough of a detective story flair to maintain interest, while remaining entirely factual. In view of its wide readership CHANGING TIMES has without question rendered a valuable service to the public, and its editorial staff should have the thanks of the Patent Bar for having done a fine public relations job on a regrettable area of patent practice and for having done the job with an effectiveness that the profession can seldom approach in its own public relations efforts.

Operation of Patent Office Academy

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ANNUAL DINNER-DANCE

In harmony with the holiday season, the winter dinner-dance was held December 7th, at the Hotel Pierre Roof Garden.

Legal matters cast aside, a spirited group of one hundred and twenty members and their wives and guests danced past midnight to the very pleasant music of Ben Cutler and his orchestra. Some members were even seen doing the twist, to the envy of the onlookers. Since so few of the members showed any sign of leaving, Mr. Cutler graciously stayed on an additional hour.

Those who attended are already looking forward to next year's dinner-dance, but one question remains unanswered: "Where were the almonds in the sauce Amandin?"

NYPLA DINNER-DANCE GALA SETS HOLIDAY SEASON TEMPO

EDITORIAL CHANGES IN BULLETIN STAFF

Effective as of January first Douglas M. Clarkson will become Editor of the BULLETIN and Cameron K. Wehringer will assume the editorship of the YEARBOOK. Henry E. Sharpe will continue with both publications in the capacity of Editor-in-Chief. Joseph Bercovitz, as Production Editor, will direct the production of both papers. Three new editors, George Gottlieb, Robert J. Sanders, Jr., and Arthur S. Tenser are joining the staff at this time. As a result of these changes some of the NYPLA committees will find a different editor following their activities.

Comments from Members

Editor, NYPLA BULLETIN:

In his article, "The Significance of Compact Prosecution" (44 J. P. O. S. 719), Mr. Whitmore, Superintendent of the Examining Corps, hails this practice as the most promising part of the effort to introduce quality control into Patent Office operations.

I would like to call attention to important side effects of compact prosecution to show that patents of higher quality are not the only benefits to be gained from such streamlining.

Nothing is more unsettling to a client-inventor having limited Patent Office experience than a first action of the familiar sort, in which all claims are summarily rejected. It is all very well to assure the client that the cited references have little to do with his invention, and that such shot-gun rejections are inconclusive. The fact remains that cursory rejections are damaging to an inventor's morale and to his interests.

Not that an inventor has a right to allowance of claims on the first action, but having waited impatiently for six to twelve months or more to see what the Patent Office would do, he is entitled to a fair and reasoned holding.

An inventor usually files on the strength of a preliminary search opinion from his attorney. Despite customary admonitions in such opinions as to the imponderables involved and the impossibility of predicting what an Examiner might come up with, a totally negative first action may shake the client's confidence in his attorney, to say nothing of the Patent System. Experienced corporate clients tend to take shot-gun first actions philosophically, but individual inventors are often hard hit.

A more serious consequence is the uncertainty a shot-gun first action creates in the minds of those backing the inventor. The exploitation of inventions is a risky business at best, and investors are very sensitive to adverse Patent Office holdings. If an invention is clearly anticipated, the sooner the applicant and the backers face this fact, the better. But a first action which fails to come to grips with the merits of the invention and which rejects on the basis of references having only a superficial bearing on the invention, does the applicant a disservice and acts as a depressant on all having an interest in the invention.

Attorneys know that given enough time, questions of patentability can usually be resolved in the course of prosecution. However, the two to five or more years it currently takes to hammer out allowable claims, is not conducive to successful exploitation of an invention. I do not have in mind routine improvements which are filed for purely defensive purposes. But inventions of sufficient stature to attract the entrepreneur, cry out for compact prosecution. . . .

Mr. Whitmore speaks of the need for Examiners to develop, "the courage to allow claims when appropriate on the first action." This appeal for "guts" in the arena of patent prosecution may seem curious, but how much easier it is for an Examiner to make a blanket rejection the first time around, than to undertake the painful task of determining allowability.

Creative ideas and their protection are vital factors in a dynamic society, for protection inspires adoption. A creaky Patent Office and flabby examination do not promote a healthy economy. More power to compact prosecution.

—MICHAEL EBERT

BRIEFS FROM WASHINGTON

The BULLETIN's advice from Washington is that several bills which died on the adjournment of the 87th Congress seem reasonably certain of reintroduction in the 88th Congress. The legislative prospects appear to run as follows:

- The **fee bill** will undoubtedly be reintroduced in both Houses early in the next Congress. It is assumed that it will be in essentially the same form as amended after the Senate hearings. A bill of some sort increasing Patent Office fees is likely to pass in the first session of the 88th Congress.
- A bill providing for a written **declaration in lieu of an oath** is also likely to be introduced. This bill would presumably be in the amended form submitted by the Patent Office to the 87th Congress. There have been hearings in both Houses and action in the first session on this bill seems likely.
- The **ornamental design bill** will also be reintroduced, presumably in the form in which it passed the Senate during the 87th Congress. This legislation has been the subject of very extensive consideration over a period of years and was the subject of hearings in the 87th Congress. It is anticipated that it will be passed in the 88th Congress and possibly in the first session.
- In view of the extensive consideration which has been given the subject it seems likely that a bill, or perhaps more than one bill, providing for actual **revision of the copyright law** will be introduced in the 88th Congress. It is doubtful, however, whether the potential disagreements over particular language can be overcome within one Congress.
- It seems likely that Rep. Daddario will reintroduce a bill corresponding to **H. R. 12812,** the bill which he succeeded in having reported by the full committee but did not succeed in bringing to the floor in the 87th Congress.
- There will undoubtedly be additional bills relating to **government patent policy** and also amendments incorporating provisions in this area in bills not otherwise specifically directed to government patent policy. For example, such provisions were incorporated in the Saline Water Bill, the Disarmament Agency Bill, and the Marina Research Bill in the 87th Congress.
- One or more bills can be anticipated proposing expansion of the **government title policy** to include other agencies. The Senate and the House in the 87th Congress seemed to be at somewhat different poles on this subject. Unless there is a substantial change in the political and economic complexion of one or the other of the two Houses of Congress, it seems somewhat doubtful that any satisfactory compromise will be proposed in the 88th Congress which will be acceptable to both Houses.

NEW MEMBERS ELECTED

Saul R. Bresch and Robert J. Habenicht have been elected to associate membership in the NYPLA and Joseph A. Barbosa, Walter J. Baum, William J. Brunet, Michael A. Cornman, George Gottlieb, Harrie M. Humphreys, Burton E. Levin, Richard A. Levy, Leopold Presser, Anthony C. Scott, John L. Shortley, and Daniel H. Steidl have become active members. Edward Thomas, a charter active member of the Association, and George F. Heuerman have been elected to life membership in the Association.

A MIDWESTERN VIEW OF SPECIALIZATION

The following letter is reprinted from the columns of THE DISCLOSURE, the newsletter of the Milwaukee Patent Law Association:

"LETTER TO THE EDITOR:

"The ABA's work on specialization raises the question whether the practice of law can be neatly catalogued into separable areas to support specialty certificates as they will be understood by the public. In the public mind specialization means that the certified lawyer is far better qualified in the specialty than other lawyers, and most likely people will assume that a specialist is absolutely necessary for their case if it falls within a specialty area. Since the prime purpose of certifying specialists is to inform the public, we should view the problem of specialization from the public standpoint.

"In medicine no doctor is qualified to practice ophthalmology, nor to practice neurosurgery without special training, and so on through the medical specialties. The law appears distinctly different, for the ablest of our profession are superior in sifting, analyzing and applying facts, in interpreting court decisions, in guiding clients, writing briefs, presenting their cases, and performing other skills, none of which are catalogued by legal subject. The able practitioner is at home in a municipal corporate matter, a banking question, a knotty issue involving real estate, a tax question, or the framing of a pleading. Over the years none of Wisconsin's ablest lawyers have specialized in a particular field, for he who can tie together facts and law in a logical, persuasive manner does not know the boundaries of 'fields' of law. The better the lawyer the more likely he has been led into diverse fields. It is questionable then, whether we do a public service by certifying those who specialize over the years, for it will detract from many able men. For example, there may not be a single Wisconsin attorney who could become certified in antitrust (because they haven't spent requisite time), yet several outstanding men in this field are in our midst.

"If practitioners should have specialties, then so should the courts. Why have a specialist work on a matter to be decided by a non-specialist? Isn't there a basic inconsistency in adhering to a philosophy that a judge should be able to sit in any type of matter, but then holding out to the public that a specialist should be consulted.

"It seems to this writer that certifying specialists will have one major disturbing result. The large firms who can keep individuals active in certified categories, and the large cities where an individual can confine himself to a given field will garner the certifications. This will inure to their increased business at the expense of the general practitioner. One other point should be made, and that is members of the public having special problems are usually well acquainted with the bar and can easily seek those who can best handle their matters.

"The patent practitioner is astride two divergent professions, he is trained both in the technical sciences and the law. His unique position may call for some special recognition, but this should not make him a proponent of specialization when the greatest effects will occur in general practice."

LANGLEY ELIMINATED AS SITE FOR PATENT OFFICE

President Hapgood attended a meeting on November 30th at which the Commissioner of Patents advised representatives of the patent profession on the status of the proposed new building for the Patent Office. The Commissioner stated that the location previously requested at Langley, Virginia, which had the general approval of the profession, now appears to be unavailable because of higher priorities.

Mr. Ladd said it would be impossible to obtain a new Patent Office building within a reasonable length of time unless a site was selected at a more remote location than Langley, Virginia. Since the Patent Office desperately requires additional facilities and space, the consensus of opinion of those present at the meeting was that the profession would not oppose location of the Patent Office at a site within 40 miles of Washington, if it had ready access to the circumferential and radial highway system now proposed for the Washington area.

LAWRENCE LANGNER

Lawrence Langner, an NYPLA member since 1922 and a founder of the patent firm of Langner, Parry, Card and Langner, died on December 26, 1962, at the age of 72. In addition to an outstanding career in the foreign patent field he was also a leading producer and playwright and a founder of the Theatre Guild. His wife, Armina, survives him.

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