

JUDICIAL CONFERENCE FEATURES EMINENT JURISTS

The Fifth Annual Judicial Conference will be held on Wednesday, February 19th, in the Terrace Suite of the Hotel Roosevelt, Madison Avenue at 45th Street. The three judges who will speak, **Hon. Edmund L. Palmieri** of the Southern District, **Hon. John F. Dooling, Jr.**, of the Eastern District and **Hon. Reynier J. Wortendyke, Jr.**, of New Jersey are each well versed in patent law. The judges will discuss patent and trademark law.

The Judges' talks will begin promptly at 5:30 p.m., with cocktails beginning after the talks. Dinner will be served at 6:45 p.m. The cost is \$7.50 each for members and \$8.50 for guests.

For information and reservations, write or call Mr. Joseph C. Sullivan, Kane, Dalsimer & Kane, 420 Lexington Avenue, New York 17, New York LE 2-9400.

WESTERN HEMISPHERE INDUSTRIAL PROPERTY ASSOCIATION IS FORMED

Inter-American Association of Industrial Property or ASIPI (Asociacion Inter Americana de la Propiedad Industrial), a recently formed organization concerned with industrial property matters in the Western Hemisphere will hold its first session of the general meeting at Acapulco, Mexico on Sunday, April 12 and on April 13, 1964. The group will then meet in Mexico City on April 14 to 16.

Formation. ASIPI is a group which was conceived by Dr. Jose Barreda Moller, a practicing patent and trademark lawyer from Lima, Peru who wanted to organize an association of practicing patent and trademark lawyers and agents in the Western Hemisphere with a view to improving practices and procedures in industrial property matters, particularly in the Western Hemisphere.

In January 1963, a meeting was held in Mexico City to draft a statement of principles for the proposed organization. Basically, two committees were formed at that time, one designated an organization committee and the other a promotional committee. The promotional committee has obtained the formation of about a half dozen national groups, and it is expected that another half dozen national groups plus many individuals from countries which have not as yet formed national groups will be in attendance at the forthcoming general meeting.

United States Group. In this country the prime movers are Jeremiah D. McAuliffe, Francis C. Browne and Harold L. Roditi. In the New York area further information can be obtained from Harold L. Roditi, Haseltine, Lake & Co. The temporary secretary is Bernardo Gomez Vega, c/o Javier Uhthoff & Cia., Post Office Box 2059, Mexico City 1, Mexico.

CALENDAR

Feb. 19—Judicial Conference, Hotel Roosevelt,
Meeting at 5:30 p.m., dinner at 7:30 p.m.

Controversy Over Design Bill

The Design Protection Bill, H. R. 323, the same as other bills before Congress, has aroused the enmity of the National Retail Merchants Association and the fervor of the National Committee for Effective Design Legislation. The Bill aims to extend to designers of useful items some of the protection accorded authors and inventors. (See BULLETIN, Vol. 3, No. 4.) It would apply to designers and manufacturers of items such as textiles, apparel, hard goods, jewelry, and silverware, as well as high-fashion designs.

This Bill, designed to protect the creative rights in dress designs, among other items, will end a long argument as to how protection can be achieved, if at all. For some time, it was thought that the rationale of *International News Service v. Associated Press*, 248 U. S. 215 (1918) would apply. But even if this case could be extended, and this assumes a major shift in position as developed through the years, all that would be gained would be a time advantage most likely measured in far less than years. Wehringer, *Dress Designs: Time Protection and Copyrights*, 40 J. P. O. S. 816 (1958). Although copyright protection was argued as possible, and sought, for items such as dress designs, the Copyright Office never permitted this extension. However, the protection proposed is akin to that obtained by copyright procedures.

ABA PENSION PLAN ANALYZED

The much-discussed Keogh Law, authorizing tax deductible retirement plans for the self-employed, has brought forth little activity. But, as pointed out by the American Bar Association, "the tax advantages of the Act are a great deal more than nothing—which is what self-employer lawyers had before the Act."

The American Bar Association, for its members, has a plan. Each participant, in effect, adopts this as "his" plan. The American Institute of Certified Public Accountants also has a plan. The American Medical Association is due to follow as well as other organizations such as the American Institute of Architects. The ABA plan is under a separate corporation, the American Bar Retirement Association.

ABA Approach. The American Bar Association program permits the participants annually to specify how they want their money invested. They may be directed to investment in a Fixed Income Fund, the Equity Fund, or in deferred annuities, or any combination of the three. In addition, when benefits can be had, the participant may take all or part of his benefits as a lump sum and may at that time shift the balance from any of the three investment media to any then desired, or combination of the three, while his remaining benefits are paid out in periodic installments.

The ABA Plan and Trust Agreement form permits Internal Revenue Service approval of each attorney's plan

COMPARISON OF PATENT OFFICE FEE BILLS

The accompanying chart shows a comparison between present Patent Office fees and three other proposed bills. The Willis bill **HR 8190** was passed by the House on **January 22, 1964**. Only the Willis Bill proposes maintenance fees, which amount in total to \$300. The first fee is \$50 payable at the end of five years, with \$100 and \$150 fees payable at the end of nine and thirteen years respectively.

	<u>Present</u>	<u>WILLIS H.R. 8190</u>	<u>BELCHER H.R. 8043</u>	<u>LAIRD H.R. 8420</u>
FILING FEE	\$30	\$50	\$60	\$75
EXCESS CLAIMS	\$1 for each claim in excess of 20	\$10 indep. in excess of 1 \$2 excess of 10	\$5 in excess of 20	\$5 for each indep. claim in excess of 5 \$2 per claim in excess of 10
PROVISION RE FILING DATE AND AMENDMENT	No	No	Not applicable	Yes
ISSUE FEE	\$30	\$75	\$60 \$5 for each claim in excess of 20	\$100 \$5 for each indep. claim in excess of 5 \$2 per claim in excess of 10
PRINTING	—	\$10 ea. pg.		
DRAWING	—	\$2 ea. sheet		
TIME FOR PAYING FINAL FEE	6 mos.	3 mos.	No change	No change
DESIGN FILING FEE	\$10	\$20	\$20	\$40
ISSUE				
3½ YRS.	no additional	\$10	\$10	\$10
7 " "	\$5 " "	20	20	15
14 " "	\$20 " "	30	30	25
DISCLAIMERS	\$10	\$15	\$20	
APPEAL		\$100	\$50	\$25
W/O HEAR'G	\$25	50	25	
W/O CONSID'N		25	25	
				\$25 on Brief \$75 with Hrg. Refund before decision
REVIVAL ABANDON. APPLN.	\$10	\$15	\$20	
DELAYED ISSUE FEE	—	\$15	\$20(?) *	
CORRECTION	\$10			
SEC. 255	—	\$15	\$20	\$15
SEC. 256		15		15
RECORDING	\$3 \$1 ea. add'l 2 pgs. 0.50 ea. add'l patent	\$20	\$6 \$2 ea. add'l 2 pgs. \$1 ea. add'l patent	
FEES APPLY TO GOV'T. AGENCIES	No	Yes	Yes	Yes
PROVISION RE DEPENDENT CLAIMS	No	Yes (Sec. 11)	No	Yes (Sec. 4)
MAINTENANCE FEES	No	Yes	No	No

* This is apparently a mistake in drafting the Bill because the Bill contains no provision for delayed payment of the issue fee.

MEET COMMISSIONER BRENNER

When news came from the White House on January 16th that President Johnson had nominated **Edward J. Brenner** to be the new Commissioner of Patents the comment on every hand, as one patent attorney met another, was "Who is this man?" Mr. Brenner has not been in the public eye before, either as a public office holder or as a leader in the Patent Bar, or even as a prominent trial lawyer. Nor has he spoken or written extensively on patent problems. Consequently, most members of his own profession have had no opportunity to get acquainted with him or to appraise his qualifications.

Interestingly enough, this is the second time in a row that a relatively unknown attorney has been named to the top post in the domestic patent field. Former Commissioner Ladd came to the Patent Office at a time when drastic measures were needed to cope with the serious problems facing the Office. He instituted his own reform program and pushed it vigorously during the two years he was in office. Brief though his term was, he left a marked imprint on the Office. This very fact creates unusual problems for the new Commissioner, since he moves in on a partially completed program.

Inquiry among the friends of the new appointee, who as of this writing must still be confirmed by Congress, indicates that he has a solid background in the patent field and that he should make a good Commissioner.

A Wisconsin Graduate. Edward J. Brenner is a product of the Midwest. He was born in Wisconsin Rapids, Wisconsin in 1923, and studied chemical engineering at the University of Wisconsin, receiving his B.S. degree in 1947 and an M.S. degree in 1948 from that University, where he was president of the graduating class of 1947. He also took his law work at the University of Wisconsin and graduated with an LLB degree in 1950.

Mr. Brenner's education was interrupted by World War II, during which he served for two years as an enlisted man in the U. S. Army. Because of his engineering background he was assigned to the Manhattan District atom bomb project at Oak Ridge, Tennessee and he was a member of the radiological safety team during the Bikini atom bomb tests which were held in the Pacific Ocean in the summer of 1946.

Patent Experience Received at Esso. From law school the nominee went directly to Esso's refinery at Baton Rouge, Louisiana where he served as a chemical engineer for three years before transferring to the Esso Research and Engineering Company at Elizabeth, New Jersey as a patent attorney.

Esso Research is widely known for its patent activity and the range of its patent interests. During the nearly ten years that Mr. Brenner has been directly involved in patent work with Esso Research he has had the opportunity to get broad training and experience in all the basic aspects of the patent law.

His work took him into the fields of radiation, lubricants, polymers, and catalytic cracking. Later he served for three years as contract attorney dealing with the preparation and negotiation of contracts concerning patents and licenses. Most recently Mr. Brenner has had responsibility for the supervision of patent activities relating to petroleum processes, products, and engineering, as well as to the marine and pipeline aspects of the company's work.

During his career with Esso Research he also had a chance to gain experience in another related area, which could be helpful to anyone filling the Commissioner's shoes, when he was appointed to serve for a year as assistant director of the Technical Information Division of Esso Research. In traditional fashion the nominee worked up through the ranks into the administrative echelon where he is now one of the Patent Counsel for Esso Research.

His friends report that he has a very solid patent background. He is also rated by his associates as a strong administrator, and his superiors at Esso apparently thought highly of his potential as a leader since they sent him to a Management Training Course at Columbia University, an assignment reserved in most companies for the bright young man with a future.

Interviewed by Holloman, Hodges, and Johnson. Mr. Brenner's nomination as Patent Commissioner cannot be tagged as a political appointment since he has not been



Edward J. Brenner

active in politics. It is understood that his name was submitted directly to the special committee headed by Dr. Ralph Connor, Chairman of the Rohm & Haas Board of Directors, which had been appointed by the Department of Commerce to find a Commissioner. Interviews with J. Herbert Holloman, Assistant Secretary of Commerce for Science & Technology, with Luther Hodges, Secretary of Commerce, and finally with President Lyndon B. Johnson, followed. His ability to sell himself to his interviewers comes as no surprise to his friends who in addition to crediting him with "lots of ability", a broad background, and tremendous energy and enthusiasm, also characterize him as being a man who gets along well with everyone.

Mr. Brenner lives in Westfield, N. J., with his wife, Jane, and four children, Beverly, 11, Douglas, 8, Carolyn, 4, and Mary, 2.

Mr. Brenner is said to have been so engrossed in his work in recent years that there has been little free time to indulge in his favorite sport of tennis—he was on the University of Wisconsin tennis team—and there has been even less opportunity to get out on the golf course. Such free time as he can find he reserves for activities with his family. He and his wife do fit in a bridge game when they can by way of relaxation.

Mr. Brenner is a member of the Wisconsin Bar Association, the New Jersey Patent Law Association and the American Chemical Society.

What Kind of Commissioner? How will the Patent Office fare in his hands? It is, of course, too early to even guess the impact that Mr. Brenner will have on the Office, particularly coming into it while it is in a state of "partial reformation." Time alone will tell, but the picture that shapes up right now is that of a young man who is a firm believer in the American patent system; who has given a lot of serious thought to the problems of the Patent Office; who is not afraid of new ideas; and who will not be satisfied with past practices or things as they are if he believes that there is a reasonable chance that change will bring improvement.

RECENT CASES OF SPECIAL INTEREST

Patent. The dismissal of a portion of a defendant-intervenor's answers and counterclaims which included prayers for injunctive relief is an interlocutory order refusing an injunction within 28 U. S. C. § 1292(a) and is therefore appealable, **Stewart-Warner Corp. v. Westinghouse Electric Corp.**, 140 USPQ 1 (2d Cir. 1963). The Federal Rules do not limit an intervenor to raising those issues which the original defendant could have interposed. Rather, where the intervenor's claims for unfair competition and patent infringement closely relate to the original defendant's claims, and might avoid separate trials, the intervenor should be allowed to advance those claims. Judge Friendly, dissenting, found that the holding as to the appealability of the dismissal needlessly extended federal appellate jurisdiction.

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Patent. "Plaintiff seeks to avoid the aforesaid conclusions (of invalidity) with respect to each of the three patents by noting that each is directed to a machine in a crowded art and that . . . under such circumstances smaller advances than might otherwise be required satisfy the test of patentable invention. One justification given for the doctrine is the metaphor of Judge Evens . . . that 'an invention in a crowded art may be like a fertilizer on exhausted soil'. That unfortunately chosen metaphor, quite apart from the earthy picture and sense of smell it evokes, implies that garden varieties of improvement constitute patentable invention. Such a lowering of the constitutional standard finds no support in recent Supreme Court cases." **United Shoe Machinery Corp. v. Industrial Shoe Machinery Corp.**, 140 USPQ 10, 16-17 (D. Mass. 1963) (Wyzanski, J.).

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Shop Right. The mere existence of an employment relationship and the use by the employee of the time and facilities of his employer does not entitle the employer to ownership of an invention of the employee. An engineer who invents while assigned the job of studying patents to become an expert is not hired to invent. His inventive act is incidental to his assigned duties. **Otis Elevator Co. v. Magee**, 140 USPQ 148 (Sup. Ct. N. Y. 1964). The employer has a "shop rights" in the invention, i.e., the right to a free, non-exclusive, personal license to use the invention in his business.

ABA Pension Plan Analyzed

Continued from page 1

by the filing of a simple one page form. ABA has a master annuity contract with Prudential Insurance Company. ABA says its investments will use annuities and securities. The Continental Illinois National Bank and Trust Company of Chicago is the Trustee of all the trusts. This concentration was made to permit volume operating economy.

Deficiencies of Keogh Law. In general, the Keogh Law program, which all seem to agree must be broadened extensively, permits the self-employed person to choose for his own plans four investment channels. These are an insurance annuity (and some insurance companies are now in the field on this), mutual fund shares bought through a bank custodian, a bank trust account, and certain 3.75% government bonds issued specially for the Keogh arrangement. Only the last noted is clearly out of favor.

Any Employer (self-employed person, or partnership) can set up a plan by contributing 10% of his earned income annually, but not more than \$2,500 a year. Half, up to \$1,250, is tax deductible. *The participant must set up a similar plan for any employee with three years service, putting in for them at least the same percentage of income as he does for himself.*

A criticized feature is that only 30% of any income derived from capital investments can be counted in a Keogh Law plan. Once the money is invested, any income or capital appreciation is tax-deferred until payout. This begins at 59½ (except in case of prior death or disability) and at least by the end of the tax year in which the participant reaches 70½. Then, taxation is at normal rates.

Withdrawal. Withdrawal from the plan before 59½ can be for three reasons. If the participant is disabled, he may elect to receive benefits. If he dies before benefits have been received, his beneficiary will receive benefits. If the participant has never been an Owner-Employee (a term referring to a person with at least a 10% partnership interest), he can receive his benefits one year after his employment ends. And, his employer (which would be the partnership) may consent to earlier receipt of benefits.

Further information can be obtained from the American Bar Association. A copy of the ABA Retirement Plan, the implementing Trust Agreement, instructional materials and other forms is available to ABA members for \$5.00.

BULLETIN

of The New York Patent Law Association

90 Broad Street, New York, New York 10004

Volume 3.

February 1964

Number 5.

The BULLETIN is published monthly (except in July, August, and September) for the members of The New York Patent Law Association. Correspondence may be directed to The Editor, Room 4004, 60 East 42nd Street, New York, N. Y. 10017.

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