

## *Brenner Addresses the APLA*

"Things are moving fast in the patent field," said Commissioner Brenner in the opening remarks of his address before the annual winter meeting of the American Patent Law Association on January 26, 1966. The meeting was held at the Sheraton Park Hotel in Washington, D. C. and was attended by an unusually large gathering of patent attorneys from all parts of the country.

Looking back on 1965, the Commissioner observed that disposal of pending patent applications reached 98,000 with the period of pendency being reduced from 38 months to 34 months. During 1966, it is hoped that the average length of time a patent application will be pending before the patent office will reach 30 months. Two things, said the Commissioner, will help us reach this goal: the new fee bill and progress under the new examination procedure. Breaking the 30 month barrier, however, will be more difficult.

The streamlined examination procedure is still in a period of transition. It has been in operation only 1½ years, but is aiming for a disposal of 100,000 applications in 1966. This should be accomplished since 2000 first actions are issuing per week now.

**Small Budget Increase.** Commenting briefly on the budget, Commissioner Brenner noted that for fiscal 1966, it is \$34,440,000. The 1967 budget will increase this by only \$1,435,000, and most of this increase will be in the manpower area. He indicated that now is the time for anyone interested to give support to our patent system, and added that much support is needed from the attorneys.

As for the hoped-for new building, the General Services Administration has allocated no funds for design or planning. It thus appears that this effort is back on dead center.

Briefly, Commissioner Brenner reviewed the effect expected from the new Fee Bill. No appreciable effect is expected on the number of applications, but it will have a tremendous effect on the support branches, such as the Assignment Branch. The number of appeals are down to 750 per month, from several thousand just a year ago.

All in all, this is a very crucial time, and, he noted, it is most important that the Patent Office demonstrate to Congress that "we are doing a good job."

### CALENDAR

Mar. 25, 1966—Annual Dinner in Honor of the  
Federal Judiciary,  
Waldorf Astoria Hotel.

Apr. 27, 1966—Annual Judicial Conference,  
Roosevelt Hotel.

## SCHIMMEL DISCUSSES ADVANTAGES OF DISTRICT COURT VS. C.C.P.A.

Joseph Schimmel, Acting Solicitor of the United States Patent Office, spoke on the subject of *Court Review of Patent Office Decisions* at a forum meeting of the NYPLA held at the Hotel Piccadilly on January 26, 1966. Despite warnings of heavy snow, there was a large turnout of members and guests at the meeting which culminated in a lively question period stimulated by Mr. Schimmel's provocative talk.

**Discussion Limited to Review In Ex Parte Cases.** After noting that adverse Patent Office decisions in ex parte cases may be reviewed as a matter of right either by appeal to the Court of Customs and Patent Appeals or by civil action in the United States District Court for the District of Columbia, the speaker pointed out certain advantages and disadvantages of the respective avenues of review. Particular attention was given to the settlement opportunities available when an applicant chooses the District Court rather than the CCPA.

**CCPA Appeals Confined to Record.** In the case of appeals to the CCPA, the issues on appeal must be decided on a record which is "frozen" as of the filing of the notice of appeal to the CCPA. Since there is no provision for altering the record either by additional evidence or change in the issues, e.g. change in claim language, there is no opportunity for negotiation as opposed to determination of the issue on appeal.

**Recent Change In CCPA Appeals.** Prior to December 1, 1965, the appellant before the CCPA received from the Patent Office an acknowledgment of the appeal with a suggested list of the papers in the record to be filed in the CCPA along with his Petition to the Court. Since that date however, the burden is on the attorney to determine what papers must be filed and to file certified copies thereof within 40 days of the filing in the Patent Office of the notice and reasons of appeal. The appellant has 30 days after the date of notice of cost to pay printing costs and 40 days after printing of the record to file printed copies of his appeal brief and serve same on the appellee.

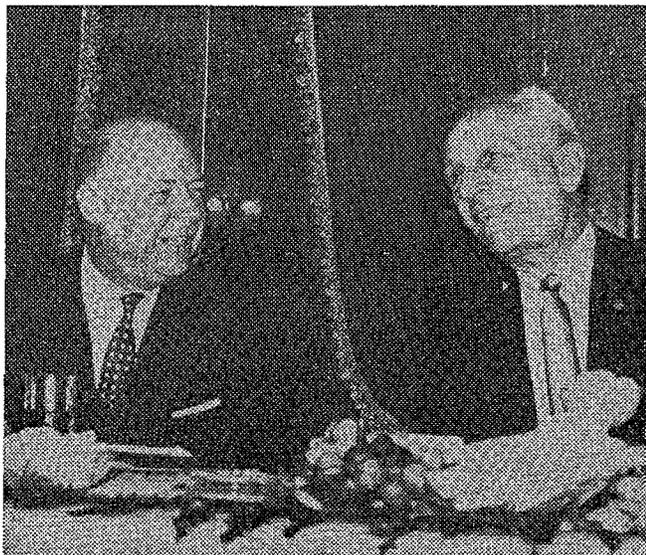
Mr. Schimmel estimated that in view of the early requirement for filing the record and appeal brief an appellant can expect to spend about \$1,500.00 or \$2,000.00 at the early stages of a CCPA appeal.

**District Court Action Relatively Simple.** It is a relatively simple matter to file a civil action against the Commissioner in the United States District Court under 35 USC 145. The bill of complaint must identify the application and claims allegedly erroneously rejected and is otherwise easy to prepare. The Patent Office has 60 days to respond to the complaint. A separate calendar is maintained for patent cases and Mr. Schimmel pointed out that cases are reached for trial in six to eight months.

## JOSEPH SCHIMMEL DISCUSSES ADVANTAGES OF APPEALS TO DISTRICT COURT V. THE C.C.P.A.

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**Opportunity For Negotiation and Settlement.** Mr. Schimmel stressed the opportunity to negotiate a possible settlement with the Solicitor in District Court cases and noted that extensions of time can be readily obtained for that purpose. The first extension does not require court approval. Although subsequent extensions do require court approval, they are ordinarily granted where the Solicitor agrees.



Dinner Committee Chairman Edward Halle and Speaker Joseph Schimmel

Mr. Schimmel emphasized the importance of the opportunity to change the record in a District Court suit prior to trial as basis for settlement.

The record that was before the Board of Appeals can be changed either by presentation of different issues, in the form of different claims, or by the presentation of additional evidence of invention, e.g. affidavits or other proofs showing unobviousness. If he is satisfied with the new evidence, the Solicitor can then recommend that the examiner reconsider the case, but only on the different claims or new evidence, and the case may thus be settled prior to trial. There is no corresponding possibility of settlement in the case of appeals to the CCPA under 35 USC 141.

**Refiling During Suit.** It is also possible for an applicant to file a continuation application to introduce new claims or new evidence for consideration by the Patent Office while a District Court suit is pending on the parent case. Under appropriate circumstances, the District Court will postpone trial on the parent case to await action by the examiner on the continuation case. In such situations, however, the applicant must keep the parent case alive by extensions stipulated with the Solicitor. In answer to a question from the audience, Mr. Schimmel noted that such stipulations are ordinarily conditioned on an agreement that any adverse decision of the Board of Appeals in the continuation case will be contested in the District Court rather than the CCPA.

The Solicitor can also settle cases before the Court of Appeals when the District Court has affirmed the Board of Appeals. However, such a settlement requires a differ-

## TRADEMARK COMMITTEES MET IN JANUARY

Notwithstanding the recent transit strike, chairmen of the various subcommittees of the Committee on Trademarks and members of the Subcommittee on Foreign Trademarks met in January to review progress on various activities.

The meeting was called by Philip T. Dalsimer, Chairman and Board of Governors Liaison of the Committee on Trademarks. The Subcommittee on Patent Office Affairs and Practice is considering the Intention to Use Bill, while the Subcommittee on Unfair Competition is studying proposals to amend the Lanham Act in dealing with unfair competition cases.

Other bills are under consideration also, including HR 9187 to amend the Lanham Act to provide for cancellation of trademarks which are used to violate the antitrust laws of the United States. A Uniform Trade Name Registration Act is under consideration also. The Subcommittee on Foreign Trademarks considered the Madrid Arrangement and drafted a tentative resolution subject to consideration by the subcommittee as a whole proposing that the United States not adhere to the Madrid Arrangement.

## NEW MEMBERS ARE ELECTED BY BOARD OF GOVERNORS

At its meeting on February 8th the Board of Governors elected the following candidates to membership in the Association: Charles B. Cannon, Neil Anthony Eisner, Francis W. Guay, John E. Lynch, Roe D. McBurnett, Jr., John J. Schlager, Irving N. Simmons, James F. Snowden, Henry Sternberg, George J. Seligsohn, James F. Woods, James P. Welch, and Robert A. Kulason.

ent record than that which was before the Board of Appeals, e.g. different claims or new evidence, as discussed above.

Mr. Schimmel stated that during the past thirty years the Solicitor has asked the Court to remand about twenty cases to the Patent Office for review or allowance of the case. An example of such a situation involved a double patenting rejection on the basis of another pending allowed application. The examiner was affirmed by the Board of Appeals. Thereafter, the other application was forfeited and a petition for reconsideration was submitted to the Board calling attention to the forfeiture. The Board denied the petition for reconsideration. The case was thereafter appealed to the District Court which upon review remanded it to the Patent Office.

**Question and Answer Period.** In the question and answer period following Mr. Schimmel's talk, it was brought out that the cost of a trial might add considerably to the cost of a District Court Civil Action but that in many instances settlement made these expenditures unnecessary.

In response to a question from the floor asking how new claims are introduced into a District Court suit, Mr. Schimmel answered that the applicant's attorney should present proposed claims to the Solicitor who will then take them up with the examiner and make appropriate recommendations.

During the discussion Mr. Schimmel brought out the fact that the decisions of the CCPA and District Court for the District of Columbia have not always been consistent and referred to the Manson case awaiting decision by the Supreme Court on an appeal from the CCPA. (See review in the NYPLA BULLETIN, Volume 5, Number 4, Page 4.)

## MOVE TO AMEND FEE BILL

**Public Law 89-83 Being Evaluated.** The effects of the provisions of the patent fee bill are presently being evaluated by the Patent Bar in the wake of the recent enactment of this statute. During the pendency of the bill, patent attorneys were heavily concerned with the elimination of the maintenance fee section, and, as a result, less attention was directed to many other portions of the legislation.

One provision of the statute to which interest is presently being directed is Section 7(c). This section provides, in effect, that the new (increased) final fees shall apply to all applications which were not allowed by October 25, 1965. It is argued that as a matter of fairness, all applications which were filed by the above date, which is the effective date of the bill, should be subject only to the much lower final fee which was previously in effect. (See BULLETIN, Vol. 5, No. 2)

**Failure of Petition.** In one reported case, *In re Uljstedt*, 147 USPQ 423 (Comm. 1965), the Commissioner denied a petition requesting that a final fee for an application filed before October 25, 1965, be set at \$30.00, rather than the new rate which in this case amounted to \$130.00. The Commissioner held that no constitutional question was involved, and that unreasonable delay by the Patent Office in allowing the application was not a proper issue since the Commissioner has no discretion in the collection of final fees.

**New Bills Introduced.** Activity in behalf of changing Section 7(c) of P. L. 89-83 has resulted in the introduction of several bills in Congress. These are:

- H. R. 11453—Ellsworth (Kansas)
- H. R. 11458—Mathias (Maryland)
- H. R. 11477—Horton (New York)
- H. R. 11598—Dague (Pennsylvania)
- H. R. 11692—Reinecke (California)

All of the above bills are identical, and they seek to amend the fee bill so that the new final fee rate will apply only to applications filed after October 25, 1965.

It is reported that the Commissioner of Patents is not disposed to support the proposed amendment, since it would cost the Government about \$14,000,000 in fees over a two-year period.

### GORDON A. WILKINS

Gordon A. Wilkins, a recently elected Life Member of the NYPLA, passed away on January 9, 1966, in Bayside, L. I., at the age of 60. He had retired only recently as Assistant General Counsel-Patents for Allied Chemical Corporation.

Mr. Wilkins, who was a former Governor of this Association, was a graduate of the University of Richmond, and received his LL.B. degree from the George Washington University. He is survived by his wife, three children, a brother, a sister, and six grandchildren.

### FELIX THOMAS

Felix Thomas, a Life Member of the NYPLA, passed away on January 24, 1966, at the age of 77. A resident of Essex, Connecticut, he retired in 1955 from the firm of Cooper, Dunham, Dearborn & Henninger. He had served as an Army Ordinance officer in both World Wars.

In addition to the NYPLA, Mr. Thomas was a member of The A. S. M. E. and The Cornell Club of New York. He is survived by his wife, a daughter and one grandchild.

## U.S. CHAMBER OF COMMERCE RECOMMENDS A FLEXIBLE TITLE POLICY FOR GOVERNMENT

Flexibility in Government patent policy and a valid patent instead of a quick one were called for by a National Chamber of Commerce spokesman on the Chamber's *Whats The Issue* radio program, December 26, 1965, on MBS.

James G. Brooks, Chairman of the Chamber's Science and Technology Committee, said that we need "a government patent policy sufficiently flexible" to ensure that the rights of the public and the contracting parties are reconciled. Replying to a question by Arch N. Booth, Chamber Executive Vice President, Mr. Brooks said that although the shortening of time in awarding patents is advantageous, "it is still of primary importance to have a valid patent rather than a quick patent."

Mr. Brooks and Mr. Booth were joined by Secretary of Commerce John T. Connor for the patent system discussion program.

Mr. Booth remarked that "patents are the heart of the great industrial mechanism; patents make our technological world go around." Secretary Connor said one of the objectives of his department is to reduce the patent-application waiting time down to one and a half years. He attributed present delays to a shortage of trained personnel.

### CONNOR APPOINTS PATENT ADVISORY COMMITTEE

On October 31, 1965, Secretary of Commerce John T. Connor announced the formation of an **Advisory Committee to the Patent Office** consisting of eight experts, each of whom will serve one-year terms.

The committee has been organized primarily to serve two purposes:

- To advise the Patent Office on measures which can increase the efficiency and effectiveness of its operations; and
- To provide liaison between the Patent Office and the scientific, business, and legal communities in an effort to identify patent problems and needs.

The committee will advise the Patent Office on changes in its operations which can be accomplished by administrative action—specifically relating to current operations and those which are foreseeable in the near future.

**Members:** The eight members of the committee are listed below:

Vice Admiral (ret.) Oswald S. Colclough, Director Emeritus of the Patent, Trademark, and Copyright Research Institute.

Frederic O. Hess, President, Selas Corporation of America.

Dr. William A. LaLande, Vice President, Research, Pennsalt Chemical Company.

Dr. Samuel Lehner, Vice President, E. I. duPont de Nemours.

Jacob Rabinow, President, Rabinow Engineering Co. William E. Schuyler, Jr., former Chairman of the Patent, Trademark, and Copyright Section of the ABA.

John R. Shipman, Director, International Patent Operations, IBM.

R. Frank Smith, General Patent Counsel, Eastman Kodak.

The committee held its first meeting on November 2, 1965, with Commissioner of Patents Edward J. Brenner presiding as chairman.

## JOSEPH GARON TALKS TO CITY BAR ON SUBJECT OF PATENT VALIDITY

At a recent meeting co-sponsored by several committees of The Association of the Bar of the City of New York, the topic "Patent Validity—Today and Tomorrow" was discussed by Joseph D. Garon, a member of the NYPLA.

The talk was directed principally to the three cases before the Supreme Court involving § 103 of the Patent Statute; *Graham et al. v. John Deere Company of Kansas City et al.* (8 Cir. 1964) 142 USPQ 243; *Calmar, Incorporated and Colgate-Palmolive Company v. Cook Chemical Company* (8 Cir. 1964) 142 USPQ 412; and *United States v. Adams et al.* (Ct. Cl. 1964) 141 USPQ 361. (See BULLETIN: Vol. 4, No. 8; Vol. 5 No. 2)

**The Hotchkiss Test.** The development of the requirements for patentability was traced from the purpose of the Constitutional grant to advance science and the practical arts, through the first appearance of the statutory tests of utility and novelty in the second patent act in 1793, up to the first attempt by the Supreme Court in *Hotchkiss v. Greenwood* (11 How 248) (1850) to crystallize the elusive third element that raises the average new and useful development to the level of invention intended to be rewarded by the Constitution.

With the appearance of the holding in the *Hotchkiss* case of the requirement that the new combination of old elements be unobvious to one skilled in the art, there then began a series of decisions adding their own glosses to the *Hotchkiss* rule. These cases culminated one hundred years later in the *Cuno* and *A & P* decisions wherein the Supreme Court apparently added additional and more stringent tests or standards of invention in determining the validity of combination patents.

**1952 Patent Act.** It was noted that, in § 103 of the 1952 Patent Act, for the first time a third element of patentability—non obvious subject matter—became a statutory requirement. The Reviser's Note to the new § 103 indicated not only that it was Congress' intent to have a stabilizing effect on the patent system by obtaining more unanimity in the court decisions but also to present a test that might "serve as a basis for the addition at a later time of some criteria which may be worked out."

Mr. Garon suggested that the new statute, rather than having its intended stabilizing effect, increased the conflict between the circuits as well as between writers on the subject; one side arguing that Congress intended to liberalize the test of patentable invention by doing away with the holdings in more stringent cases since *Hotchkiss*, and the other side arguing that Congress did not intend to do away with *A & P* and *Cuno* but to codify their holdings as well as the holdings in other cases. Ammunition for both sides was freely found in the legislative history of § 103 as well as the comments by those involved in drafting the statute.

**No Easy Solution.** The Supreme Court now, for the first time, has taken the opportunity to comment on § 103 and on what Congress could do and intended to do by its enactment. It was further observed that no matter what the Supreme Court's position on § 103, there will be and can be no simple solution to the question of what is patentable invention, and no overnight change could be expected in the attitude of the various Circuit Courts of Appeal toward patent validity.

## AN INCREASED RELIANCE ON TRADE SECRETS IS INDICATED IN REPORT

**Study by The National Industrial Conference Board.** The National Industrial Conference Board, in a study released December 17, 1965, indicates that companies are increasingly relying on patent and secrecy agreements as a means of protecting their inventions and trade secrets. Thus, 83 of 86 participants in the NICB study require some or all research personnel to sign such agreements.

Although employees are restrained by common law from divulging trade secrets acquired as part of their employment, 71 of the 81 agreements analyzed by NICB contain secrecy provisions. The rationale for spelling out the secrecy requirement is the positive notice given the employee of the extent of his secrecy obligations. (See BULLETIN: Vol. 4, No. 5; Vol. 2, No. 8)

**Agreement May be Held Unenforceable.** The primary difficulty with secrecy provisions in employee agreements is the danger that too stringent limitations will render the agreement unenforceable on the ground that it deprives the inventor of a livelihood on leaving the company. Hence, in drafting secrecy provisions in employment agreements, there is a taut line between those restrictions necessary to the protection of a company's industrial property and those limitations which, a court may rule, mortgage the inventor-employee's brain "without limitation as to time or space."

**Patent Agreements Resisted.** There is a tendency on the part of groups of inventors to seek to restrain companies from requiring employees to sign patent and secrecy agreements as a condition of employment. The Brown bill, pending in Congress, is an example of such an effort proposed by a group of West Coast engineers. Carl E. Barnes in an article in the January/February 1966 issue of *Harvard Business Review* proposes a change in our present patent system whereby after a reasonable period (e.g., 5 years) the title to a patent, if it has not been commercialized, would revert to the "paid-to-invent" employee. Barnes contends that by giving the inventor-employee a conditional reversionary right during the life of the patent, the incentive to make use of the invention by either the employer or the employee is greatly enhanced.

**Position of Employer Companies.** Companies, however, contend that inventions are an inventor's job for which he is paid a salary, provided with costly equipment and confidential data. Companies maintain that exclusive control over inventions and trade secrets developed at the expense of the company is an economic necessity. The NICB study indicates that 60 percent of its participants offer a variety of special awards as incentive to inventors in addition to salary. However, in only 10 of the 86 firms studied is the size of the award related to the worth of the invention.

### THAT ZIP CODE AGAIN

We have received word that the Post Office has directed all federal offices to set a good example by including ZIP codes on *all outgoing mail*. This means that if you do not put your ZIP code on mail requiring an answer from a government agency, a reply may be delayed until someone can check the ZIP directory for the right number.

## THE BOARD OF GOVERNORS

At the Board of Governor's meeting on February 8th the **Treasurer**, Albert C. Nolte, informally reviewed the Association's finances since 1955, pointing out that its normal annual operating expenses had increased over that period by more than \$6,500, due to increased costs and new improved services rendered to the members. He stressed the fact that as a result of such increased expenses the income and expenditures of the NYPLA are now closer to a balance than has been customary in past years. • • • The general status of the **Library** with respect to the life of the Association was discussed briefly and the Library Committee is being asked to turn in an overall policy report on the Library per se. • • • The feasibility of establishing a new **permanent secretary's post** for the Association was further explored and again returned to the committee for continued study. • • • It has been brought to the attention of the NYPLA that it is becoming increasingly difficult for Patent Attorneys to secure **lawyers liability insurance**. The matter was referred to Eben Graves' Committee on Economic Matters Affecting the Profession.

The Board considered at some length with Marcel Deschamps a tentative resolution submitted by the NYPLA Subcommittee on Foreign Trademarks, of which he is chairman, relating to the question of U. S. adherence to the so-called **Madrid Arrangement**. A minority report on the resolution was also reviewed. The resolution was returned to the committee for further consideration in the light of the discussion.

## DISTAFF PATENT EXAMINERS SOUGHT

**NJPLA Meeting.** At a meeting of The New Jersey Patent Law Association on Thursday, January 20, 1966, Miss Helen McCarthy, a Patent Examiner and Deputy Chairman of the Operations Program for the 175th Anniversary of the United States Patent System, spoke about opportunities for women in the United States Patent Office.

Miss McCarthy pointed out that the Patent Office provides the same opportunities for a woman as a man. Upon entering as a new examiner, she receives two weeks intensive training and later, the fuller, more formal program in the Patent Office Academy. Women examiners handle all arts and are not confined to fields such as cosmetics, etc. As an aside, Miss McCarthy noted that Clara Barton was the first woman Patent Office employee and Daphne Leeds the first woman Commissioner (Assistant Commissioner for Trademarks).

**Patent Aid Program.** The speaker also discussed the Patent Aid Program under which high school graduates as young as sixteen years old may have their college education paid for while assisting examiners, doing preliminary searching, etc. A young person interested in the Patent Aid Program should write to the Executive Secretary, Civil Service Commission Board of Examiners, Army Map Service, Washington, D. C. and ask for examination 360 B.

The New Jersey Patent Law Association will have its Jefferson Medal Dinner on April 19, 1966, at the Robert Treat Hotel in Newark. Although there will be no Jefferson medalist this year, all former Jefferson medalists have been invited to attend. Dr. Harry Hunt Ransom, Chairman of the President's Commission on the Patent System, will be guest speaker.

## RECENT CASES OF SPECIAL INTEREST

**Patents—Effective Date of Reference.** Where a foreign inventor has been granted a U. S. patent on a U. S. application which under 35 U. S. C. 119 is entitled to the benefit of an earlier application filing date in a foreign country, the U. S. patent is available as a reference under Secs. 102 and 103 for all disclosed subject matter, claimed or unclaimed, as of the filing date of the earlier foreign application, to the extent that the disclosure of the foreign application is brought forward and included in the U. S. application and the U. S. patent granted thereon, **Eli Lilly & Co. v. Brenner**, 147 USPQ 442 (D. D.C. 1965). An inventor who proves a date of invention in this country during the time interval between the foreign filing date and the actual U. S. filing date of a foreign inventor's patent applications, the U. S. application being entitled to the benefit of the foreign filing date, can not thereby remove the foreign inventor's U. S. reference as to common subject matter in the U. S. patent and the foreign application.

**Patents—Declaratory Judgment.** An actual controversy sufficient to support suit under the Declaratory Judgment Act exists where a patent owner charges another with inducing infringement or contributory infringement, but there must be actual charges made, **Walker Process Equipment, Inc. v. FMC Corp.**, 148 USPQ 308 (7th Cir. 1966). Walker manufactured and sold stirrers for use in a sewage digestion process. FMC competes with Walker and owns a patent for a sewage digestion process. Walker's equipment may be used in FMC's process, but has other uses as well. Walker's complaint alleged that FMC attempted to persuade customers to use FMC equipment, or if they used Walker's equipment, to take a license under FMC's patent. As a result, Walker alleged, some customers refused to buy Walker's equipment while others who purchased Walker's equipment, demanded an indemnity agreement from Walker. The Court held that the foregoing circumstances do not amount to viable, actual charges of infringement. Walker's interest is economic and not legally recognized. A patent owner's action in cautioning possible infringers and offering them licenses is not the equivalent of a charge of infringement.

**Unfair Competition.** Representatives of the Estate of Grace Metalious, deceased author of "Peyton Place" and "Return to Peyton Place" applied for a preliminary injunction to prevent a publisher from manufacturing a book entitled "The Girl from 'Peyton Place'". The Court noted that the name "Peyton Place" was a property interest which might be vindicated by the Estate. The defendant's work was a biography of Grace Metalious written with the aid of her husband, and the defendant contended that the title accurately reflected the content of the book. It was also pointed out that the title of a work by an artist was often placed into the title of a work about the artist. (e.g. "The Man from Main Street", a critique of the works of Sinclair Lewis). Held, proof of irreparable injury is totally inadequate and the injunction is denied. The Court stated that although appropriation must be conceded, such appropriation was not automatically misappropriation. **Pocket Books, Inc. et al. v. Dell Publishing Company, Inc.**, 148 USPQ 239 (N. Y. Sup. Ct. 1966).

## Comments from Members

Editor, NYPLA BULLETIN:

In connection with objections to PL 89-83, it is noted that the Commissioner of Patents has recently issued a decision with respect to the effectiveness of the new final fees on cases allowed after October 25, 1965, and it seems that we should have to live with this decision on the ground that the mailing of the notice of allowance sets the time within which to pay the final fee so that this phase of the prosecution can logically be held to come within PL 89-83.

It is submitted however that this rationale cannot be applied to the new brief fee where the notice of appeal was filed prior to October 25, 1965. Where the notice of appeal has been filed under the previous act and the appeal fee pertaining thereto has been paid, namely \$25, I believe it can be logically argued that the filing of the brief merely completes an appeal which was already running. All steps in connection with that appeal should be governed by the law and rules in effect at the time the appeal was initiated. It would not be at all surprising if there were cases in the Patent Office where a notice of appeal had been filed with the pertinent \$25 fee even before the proposed bill was published, and there is no reason at all why the completion of that appeal by filing a brief should be subject to a \$50 fee, where one or more extensions of time may have been granted or the appeal suspended for one reason or another so that the notice of appeal and the brief itself may bracket the completion of the bill and the coming into effect of PL 89-83.

—H. L. RODITI

Editor, NYPLA BULLETIN:

If any of the lower order creatures were chosen by the Judiciary as the emblem of the Patent Bar, I am afraid it would be the ant. The late Judge Learned Hand began things forty years ago with a critical nominating statement:

"... but the antlike persistency of [patent] solicitors has overcome, and I suppose will continue to overcome, the patience of the Examiner, and there is apparently always but one outcome." *Lyon v. Boh*, 1 F. 2d 48, 50 (S. D. N. Y. 1924).

Attorneys in other fields of law who display equal or greater tenacity have avoided any comparison to these little people. The Patent Bar has the dubious claim for continuous and exclusive use.

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## Member's Activities

**John R. Shipman**, Director of International Patent Operation, International Business Machines Corp., and a member of this Association, has recently been named as a member of the new Advisory Committee to the Patent Office.

**Theodore R. Kupferman**, an active member of the NYPLA and a contributor to the BULLETIN, has been elected to the seat in the House of Representatives vacated by Mayor John Lindsay.

**William R. Woodward** of the Board of Governors of the NYPLA is serving this year as a member of the Council of the American Bar Association Section on Patent, Trademark and Copyright Law.

**Eben M. Graves** and **John Schulman** (an NYPLA Governor) are serving as 1st and 2nd Vice Presidents, respectively, of the American Patent Law Association.

**Harry R. Mayers** and **John T. Kelton** are both on the Board of Managers of the APLA.

Fortunately, other high authority has noted the redeeming qualities of the ant:

"Go to the ant, thou sluggard; consider her ways, and be wise." (*Proverbs 6:6*)

The ant is "little upon the earth," but she is "exceeding wise." (*Proverbs 30:24*)

Recently the Fifth circuit added its vote, and in a kindlier voice, extended the ant's representation to the Patent Trial Bar:

"... this case, coming to us for the fourth time and two intervening trips to the 6th Circuit and one to the 8th, is a tribute to . . . the antlike persistency of [patent] solicitors . . . and their courtroom advocate counterparts as so much grist is made out of one patent." *Bros. Inc. v. W. E. Grace Mfg. Co.*, 147 USPQ 2, 3 (5th Cir. 1965).

Fortified with the knowledge that the ant is considered a wise creature in the Holy Book, that persistency for a client's cause is a virtue long recognized by the Bar and has been rewarded at least in the Fifth Circuit, one may conclude that the ant may not be so bad after all—however, one may question the fairness of Judge Hand's criticism.

—PAUL H. BLAUSTEIN