



BULLETIN

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ASSOCIATION DINNER-DANCE AND GOLF OUTING AT KNOLLWOOD COUNTRY CLUB ON FRIDAY, SEPTEMBER 24, 1982

Our association will hold a golf outing, followed by a dinner-dance, on Friday, September 24, 1982 at Knollwood Country Club, Elmsford, New York.

There will be a reception from 7-8 p.m. followed by a full course dinner in Knollwoods Green Room overlooking the 19th hole. A band will play for your dancing pleasure from 8-12 p.m.

The \$40.00 ticket will include the cost of the dinner, dancing and hors d'oeuvre. There will be a cash bar open from 7-8 p.m. Please complete and return the enclosed reservation form before August 31, 1982.

For those interested in golf, there is enclosed a separate reservation form to be completed and returned before August 31, 1982.

INVENTOR OF THE YEAR — 1982 NOMINATIONS TO CLOSE

Nominations for the Inventor of the Year will soon close. Enclosed is a Nomination Form.

This is an excellent opportunity for you to support your Association, the Patent System, and show any client or clients how well you regard their inventive achievements. All this is brought to you at no cost.

Your Association needs your support to make this program successful.

Be sure to mark your calendar to attend the Inventor of the Year Luncheon in October.

HOUSE APPROVES PTO FEE BILL

The House approved H.R. 6260, the PTO Fee Bill, on June 8, 1982 with no opposition. Congressman Kastensmeir described the Bill as a bipartisan legislation that will save the taxpayers 20 million dollars next year alone. Although Congressman Butler expressed some reservations about the two-tier fee systems, nevertheless he said that the Commerce Department and the PTO had made a convincing case for it. Congressman McClory also supported the Bill and pointed out that if fees had increased over the years at the CPI rate, they would be much higher now than the fees specified in H.R. 6260.

The Bill is now pending before the Senate awaiting action by its Judiciary Committee.

NEW COURT OF APPEALS FOR FEDERAL CIRCUIT PREVIEWED AT NINTH JUDICIAL CONFERENCE OF COURT OF CUSTOMS AND PATENT APPEALS

Over 1300 attorneys attended the Ninth (and last) Judicial Conference of the C.C.P.A. on May 15, 1982 at the Washington Hilton Hotel and got some insights on the newly created U.S. Court of Appeals for the Federal Circuit (CAFC).

CCPA Chief Judge Markey, who will become the chief judge of the CAFC, said that the CAFC will be the "conscience of the government" inasmuch as the federal government will be a party in about 90% of all the cases brought before the CAFC.

Mr. George E. Hutchinson, Clerk of the CCPA, who will also be the clerk of the CAFC, discussed the proposed rules of the CAFC. These rules have not yet been approved but the target date for printing and promulgation is September 15, 1982. The new court is scheduled to convene October 1st.

Senator Robert J. Dole (R-Kan.), chairman of the Senate Subcommittee on Courts, predicted that the CAFC will meet the "special need" for stability and uniformity in the patent laws.

Frank C. Cihlar, Esq., Washington, D.C. and Jack C. Goldstein, Esq., Houston, Texas, pointed out the cases over which CAFC will not have Jurisdiction. They outlined the following likely situations that would give rise to Jurisdictional issues:

A. Patentee's patent infringement action or infringer's declaratory Judgment action in which the plaintiff — whether a patentee or infringer — invokes the court's subject matter Jurisdiction on grounds of diversity.

B. Complaint asserts nonpatent claims with patent issue raised in the answer or with patent claim asserted in the counterclaim.

C. Action in which nonfrivolous patent claims is joined with nonpatent claims and the patent claim is dismissed without appeal.

D. Action by patentee for a declaratory judgment that his patent is valid and infringed.

E. Action by patentee against contributory infringer for interference with prospective economic advantage.

F. Nonpatent action by infringer against patentee raising patent issues.

G. Action by licensee for a declaratory judgment that the licensed patent is invalid.

H. Patentees action against the Tennessee Valley Authority for reasonable compensation for patent infringement.

James F. Davis, Esq., Washington, D.C. and Laurence H. Pretty, Esq., Los Angeles, California, speculated on the substantive direction the CAFC is likely to move and Mr. Pretty outlined some of the specific differences be-

Continued on Page 2

tween the holdings of the CCPA and those of the various circuits in such matters as on sale bar, synergism, invention in old elements, secondary considerations, reformation of inventorship, fraud test, presumption of validity, obviousness as fact or law question and file wrapper estoppel.

**FROM MINUTES OF THE
BOARD OF DIRECTORS MEETING
OF THE NEW YORK PATENT
LAW ASSOCIATION, INC.
APRIL 20, 1982**

Alfred L. Haffner, the Association's representative to the National Council of Patent Law Associations, attended as a guest.

The minutes of the last Board meeting were approved.

Mr. Tenser gave the Treasurer's report, which was approved.

Mr. Robin also stated that Mr. Wyatt had reported that three hotels were under consideration for a fall 1982 Continuing Education Program.

The Board had a general discussion of pending federal legislation and ways in which the patent and trademark bar can influence legislation.

Mr. Robin noted the proposal for a new type of government patent, a defensive patent to be issued without examination, proposed by Commissioner Mossinghoff in his April 14, 1982 speech.

Mr. Haffner reported on the activities of the National Council of Patent Law Associations, suggesting ways in which our Association could make better use of the Council. He noted that the Council is not a spokesman for the patent bar, except in areas where there is no objection from any member association. These include sponsorship of the National Inventors Day and the National Inventors Hall of Fame. Mr. Haffner pointed out that the Council is of particular value in obtaining immediate contact with other associations and in obtaining support from other associations on matters of common interest.

The Kastenmeier and Weicker fee bills were discussed. Mr. Robin raised the question of whether or not there should be a two level fee system, as proposed in the Weicker bill. Several members of the Board expressed their beliefs that a two level system would be difficult to administer and subject to abuse. The Board's understanding was that the lower level fees for individuals and small businesses would have to be available to foreign applicants. The APLA, NYPLA and USTA positions on the fee bills were reviewed.

Mr. Adams reported on a meeting he had attended in Brussels regarding revision of the Paris Convention. He reminded the Board that the United States had stood practically alone in opposing the end of unanimous voting and a compulsory exclusive licensing proposal at the most recent conferences of the Paris Union. The Brussels meeting was of representatives from the Union of Industries of the European Community, the Keidan Ren (Japanese industries association) and the United States Chamber of Commerce. The object of the meeting was to get industry of the "B" group (Western developed nations) to speak with a common voice. Although Mr. Adams was not free to report all of the details, he said that a satisfactory, unified position had been reached. It was learned during the meeting that the position of European countries accepting the compulsory exclusive licensing proposal at

the Nairobi meeting of the Paris Union was ordered by the Council of Ministers of the European Community, and that an effort was to be made to discuss the issues with the ministers. The next step is a Group B governmental meeting in Geneva in May.

**FROM MINUTES OF THE
BOARD OF DIRECTORS MEETING
OF THE NEW YORK PATENT
LAW ASSOCIATION, INC.
MAY 18, 1982**

Charles E. McKenney, Chairman of the Committee on License to Practice Requirements, attended as a guest.

Mr. Tenser gave the Treasurer's report. He pointed out that the Association had approximately nine thousand dollars in interest income during 1981-82, which had permitted us to avoid raising the dues. Dues were last raised in 1977. The hope was expressed that our relatively low dues rate could be maintained by increasing membership. The Treasurer's report was then unanimously approved.

The minutes of the last Board meeting were unanimously approved.

Mr. Robin led a discussion of the status of the current fee bill, HR 6260. Mr. Robin suggested that about all that could be done at this time was to hold the PTO accountable to its promise of a first class office.

Mr. Jorda reported on Deputy Commissioner Quigg's solicitation of funds from corporations in order to provide one field trip every three years for each examiner. Mr. Quigg is seeking on the order of three hundred thousand dollars per year for this purpose.

Two resolutions proposed by the Committee on Foreign Patent Law and Practice were discussed. Mr. Adams advised that the proposed Law of the Sea resolution was moot; that the question now was what the official text of the proposed treaty would say and what action the United States would take between now and December 1982. The Board concurred and no action was taken on the resolution.

Mr. Adams also advised that the proposed Paris Convention resolution was outdated. He expressed the belief that resolutions supporting the principle of universality were unlikely to affect anyone. He suggested that the Board wait until after the meeting of "B" group countries in June before taking any action on the Paris Convention. He also questioned whether or not the Association should adopt resolutions, like the ones suggested by the Committee, which were identical to those before the ABA-PTC section. No action was taken on the Paris Convention resolution.

Charles E. McKenney, Chairman of the Committee on License to Practice Requirements reported on the ABA specialization study. The ABA Committee has identified twenty eight specialties, including four in our area: patent, trademark, copyright and unfair trade practices. In order to qualify as a specialist, one would have to have experience, devote a specified percentage of time to practice in the area, attend continuing legal education programs and be subject to peer review.

It was agreed that specialization may raise several questions and that the Association should watch and participate in developments in this area. Current questions of interest include the standards of experience for specialization in each category and whether or not a firm can be identified as specialists in an area.

The Board unanimously adopted the following resolution.

RESOLVED, that the Association expresses its thanks to the retiring officers, Messrs. Robin and Tenser, and to the retiring directors, Messrs. Adams, Lee, Lieberstein and Scinto, for their service to the Association.

**FROM MINUTES OF THE
BOARD OF DIRECTORS MEETING
OF THE NEW YORK PATENT
LAW ASSOCIATION, INC.
JUNE 22, 1982**

James Badie attended as a guest.

The minutes of the Board meetings on May 18 and May 20, 1982 were unanimously accepted.

The Treasurer's report was unanimously accepted.

Mr. Enlow submitted his list of proposed committee chairmen and Board liaison assignments. Mr. Robin was added as liaison to the Committee of Past Presidents, Mr. Robinson was added as chairman of the Judges Dinner Committee, and the assignments were approved.

Mr. Badie reported that Mr. Wyatt proposed a golf outing and dinner at the Knollwood Country Club in Westchester County on September 17th, and asked the Board's approval, which was given. The first notice will be in the July bulletin.

The status of proposed specialization requirements was discussed. Mr. Robin noted that the ABA PTC Section Committee Reports (Grey Book) contained interesting material on this subject. Charles McKenney and the Committee on License to Practice Requirements will continue to report on developments in this area.

Mr. Pegram noted that the Patent and Trademark Office was due to publish proposed trademark rules during the summer. This association has made extensive suggestions to the Patent and Trademark Office for the proposed rules. Mr. Robin pointed out that the rules setting trademark fees would have to be published when Congress completes action on the new fee bill. It was agreed that Mr. Pegram would inform the Board members and the Committee on U.S. Trademark Law and Practice when the proposals are published. After that committee has had time to consider the matter, any proposed action will be circulated to the Board members for a telephone vote.

Mr. Tramontine noted that the latest version of the fee bill in Congress expressly permits agreements to arbitrate existing and future patent validity and infringement disputes. He questioned, on policy grounds, whether a patent owner should be free to require arbitration of future disputes, particularly as to validity. Mr. Pegram supported the availability of license clauses requiring arbitration of future disputes, saying that this should be a matter of bargaining. There was no agreement on a position favoring or opposing the pending legislation. It was generally agreed that a standard American Arbitration Association arbitration clause might lead to unsatisfactory arbitrators. The possibilities of reviving the Committee on Arbitration or studying patent arbitration in the Committee on U.S. Patent Law and Practice were discussed.

Other pending legislation in Congress was discussed. Hearings are likely in the fall on the employed inventors' rights bill sponsored by the IEEE. Mr. Enlow will investigate its status.

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&
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1982 — 83**

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Continued on Page 4

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