THE NEW YORK PATENT, TRADEMARK AND COPYRIGHT LAW ASSOCIATION

NYPTC BULLETIN

Volume 29 | September/October 1987 | Number 1

PRESIDENT'S CORNER

PATENT LAW HARMONIZATION

Patent organizations and patent attorneys are giving increasing attention to the harmonization of patent laws throughout the world.

The USPTO has been very active in advancing harmonization as a means to secure more favorable treatment of our inventors in foreign countries. Major efforts have been made through Trilateral Conferences between officials of the U. S., Japanese and European patent offices and through WIPO (World Intellectual Property Organization) which has a Committee of Experts on Harmonization.

At the August 1987 meeting of the American Bar Association, the Section of Patent, Trademark and Copyright Law debated and voted on the first-to-file issue. A resolution in favor of amending our Patent Laws to provide a first-to-file system was defeated. However, approval was given to an alternative resolution in favor ofconsidering a first-to-file system as a part of a harmonization package which included unspecified changes in foreign patent laws beneficial to U. S. applicants.

USPTO PROPOSAL

The latest approach pursued by the U.S. has been its proposal to consider elimination of our practice of granting a patent to the first inventor (as opposed to the applicant who is first-to-file) in exchange for concessions on other issues. Commissioners Quigg recently suggested that as a condition for adopting the "first-to-file" system, the U.S. would expect significant changes in foreign laws, such as:

1) a grace period of reasonable duration permitting disclosure of an invention prior to filing an application.

2) an adequate term of patent protection, such as a 20 year term started from the time the patent application is filed; and

3) the availability of a product patent for all fields of technology.

NYPTCLA'S VIEWS SOUGHT

The next WIPO meeting on harmonization is scheduled for November 1987. The USPTO has asked for the views of this Association in order that they may be taken into account by the U.S. delegation at this meeting. The next meeting of your Board of Directors (October 20, 1987) will focus on this issue and we will prepare a position paper to be sent to the USPTO.

What we need are your views on harmonization. Enclosed with this issue of the Bulletin is a short questionnaire to determine your views in the major changes being considered for the U. S. patent system. Please indicate your views on each one of these proposals. Feel free to indicate anything from a conclusory opposition or agreement to the providing of more detailed comments. We realize that your views on these harmonization questions to some extent may depend on what concessions can be obtained from other countries. Your view on this would also be appreciated.

Major changes in U. S. patent laws appear to be forthcoming. We need your input in order to formulate a position to be taken by the NYPTCLA and then to be heard on this issue.

Paul J. Heller
President

BICENTENNIAL CELEBRATION

On December 15, 1987, Donald J. Quigg, Commissioner of Patents and Trademarks, will address members of the Association and Federal Judiciary at a celebration of the U. S. Constitution's bicentennial. The address is scheduled to take place in Room 110 of the Federal Courthouse in Foley Square at 5:00 p.m. A wine and cheese "festival" and patent exhibit, including models and and displays will follow the address. Additionally, a learned dissertation on the history of patent law will be distributed to all attendees. Further details will be provided in the Association's December meeting notice.

MARK YOUR CALENDAR

Oct. 23, 1987	**Luncheon Meeting***
Nov. 20,1987	**Luncheon Meeting "Rule 68: Offers of Judgement" Speaker: Kevin Palmer**
Dec.15	**Luncheon Meeting***

***Program to Be Announced at Later Date**

COMMITTEES: 1987-1988

COMMITTEE ON ADMISSIONS
Board of Directors Liaison
WILLIAM J. GILBRETH
Chairman
MARTIN E. GOLDSTEIN
Members
EDWARD M. BLOCKER
SETH NATTER
DANIEL J. DONOVAN
ROLF E. SCHNEIDER
MICHAEL J. KELLY
DON STERN
JOHN E. KIDD
WILLIAM J. UNGVARSKY
EDWARD H. LOVEMAN

COMMITTEE ON THE ANNUAL DINNER IN HONOR OF THE FEDERAL JUDICIARY
Board of Director Liaison
DAVID H. T. KANE
Chairman
JOHN B. PEGRAM
Members
BRADFORD S. BREEN
PETER H. PRIEST
JAY M. BROWN
FRANK F. SCHECK
WILLIAM A. DIPPERT

COMMITTEE ON THE ANNUAL MEETING OF THE ASSOCIATION
Board of Directors Liaison
JOHN B. PEGRAM
Chairman
FRANK F. SCHECK
Members
WILLIAM A. DIPPERT
PHILIP T. SHANNON
JULIUS FISHER
STANLEY J. SILVERBERG
CHARLES E. MILLER

COMMITTEE ON ARBITRATION
Board of Directors Liaison
JOHN B. PEGRAM
Chairman
THOMAS L. CREEL
Members
CHARLES P. BAKER
EDWARD HALLE
THOMAS R. BREMER
JAMES M. HEILMAN
DANIEL P. BURKE
RUSSELL J. JUTEN
MICHAEL I. CHAKANSKY
THOMAS LANGER
BERNARD F. CROWE
RICHARD M. ROSATI
DANIEL J. DONOVAN
NORMAN ST. LANDAU
J. HART EVANS
HOWARD I. SCHULDENENFREI
ROBERT H. FISCHER
PHILIP T. SHANNON
MARVIN C. SOFFEN

COMMITTEE ON CONTINUING LEGAL EDUCATION
Board of Directors Liaison
DAVID H. T. KANE
Chairman
DALE L. CARLSON
Members
JAMES W. BADIE
HENRY J. RENK
JOSEPH J. BRINDISI
JAMES E. ROSINI
EDWARD V. FILARDI
JOHN F. SWEENEY
SIEGRUM D. KANE

COMMITTEE ON COPYRIGHTS
Board of Director Liaison
Chairman
STEVE H. HARTMAN

COPYRIGHT LEGISLATION AND COPYRIGHT OFFICE AFFAIRS SUBCOMMITTEE
JOSEPH B. TAPHORN

INTERNATIONAL COPYRIGHT TREATIES AND FOREIGN LAWS SUBCOMMITTEE
TERESE R. COHEN

COURT PROCEDURE AND PRACTICE SUBCOMMITTEE
VIRGINIA R. RICHARD
Members
MARSHA G. AJHAR
WILLIAM D. LUCAS
RICHARD N. BROWN
GERARD J. MCGOWN, JR.
RICHARD DANNAY
HOWARD C. MISKIN
JOSEPH DIAMENTE
ROGER S. THOMPSON
ELIOT GERBER
DONALD F. WOHLERS
THEODORE R. KUPFERMAN

COMMITTEE ON ECONOMIC MATTERS AFFECTING THE PROFESSION
Board of Directors Liaison
ELSIE M. QUINLAN
Chairman
ERIC C. WOGLOM
Members
MEYER A. GROSS
FRANCES OLMSTED
RICHARD T. LAUGHLIN
EDMUND R. PAPAZIAN
STANLEY H. LIEBERSTEIN
DAYTON R. STEMPLE
RICHARD J. MAZZA

COMMITTEE ON EMPLOYMENT
Board of Directors Liaison
ELSIE M. QUINLAN
Chairman
PATRICK J. WALSH
Members
JOSEPH J. BRINDISI
THOMAS A. O'ROURKE
ANTHONY H. HANDAL
LEONARD PRUSAK
GABRIEL P. KATONA
HOWARD P. TERRY

COMMITTEE ON FOREIGN PATENT LAW AND PRACTICE
Board of Directors Liaison
SAMSON HELFGOTT
Chairman
JAY L. CHASKIN
Members
EDGAR W. ADAMS , JR.
FERDINAND F. E. KOPECKY
WALTER J. BAUM
MARIA C. H. LIN
MURRAY J. ELLMAN
ANGELO NOTARO
FRANCIS C. HAND
JEFFREY A. SCHWAB
GEZINA HOLTRUST
JOHN P. SINNOTT

COMMITTEE ON FOREIGN TRADEMARK LAW AND PRACTICE
Board of Directors Liaison
ALFRED P. EWERT
Chairman
GABRIEL M. FRAYNE
Members
GEORGE W. COOPER
JAMES N. PALIK
CLARK W. LACKERT
GARO A. PARTOYAN
ERIC D. OFFNER
VIRGINIA R. RICHARD
JOHN R. OLSEN
DAVID WEILD, III

SPECIAL COMMITTEE ON INCENTIVES FOR INNOVATION
Board of Directors Liaison
PHILIP FURGANG
Chairman
KENNETH B. HERMAN
Members
BURTON P. BEATTY
J. HART EVANS
E. JANET BERRY
ALLEN P. KIPNES
CURTIS W. CARLSON
RORY J. RADDING
MANETTE DENNIS

COMMITTEE ON LEGAL AID
Board of Directors Liaison
PASQUALE A. RAZZANO
Chairman
LAWRENCE ALABURDA
Members
STEVEN J. BARON
TERESE R. COEHN
EDWARD M. BLOCKER
ALAN H. LEVINE
JOSEPH J. BRINSISI
C. DOUGLAS WINGATE

COMMITTEE ON LICENSE TO PRACTICE REQUIREMENTS
Board of Directors Liaison
PASQUALE A. RAZZANO
Chairman
THOMAS M. GIBSON
Members
STEPHEN H. FRISHAUF
DAVID J. MUGFORD
JOHN KURUCK
ERIC Y. MUNSON
CHARLES E. MCKENNEY
FRANK F. SCHECK

COMMITTEE ON MEETINGS AND FORUMS
Board of Directors Liaison
M. ANDREA RYAN
Chairman
WILLIAM H. DIPPERT
Members
W. EDWARD BAILEY
WILLIAM F. LAWRENCE
JOHN E. DANIEL
RICHARD MAZZA
CHARLES W. GRIMES
SETH NATTER
HAROLD HAIDT
VINCENT J. VASTA, JR.
GARY L. KOSDAN

NOMINATING COMMITTEE
Board of Directors Liaison
KARL F. JORDA
Chairman
KARL F. JORDA
Members
WILLIAM H. DIPPERT
EVELYN M. SOMMER
THOMAS M. GIBSON
JOHN O. TRAMONTINE

COMMITTEE ON PAST PRESIDENTS
Board of Directors Liaison
KARL F. JORDA
Chairman
JOHN O. TRAMONTINE
Members
LORIMER P. BROOKS
JOHN T. KELTON
GRANVILLE M. BRUMBAUGH
W. HOUSTON KENYON, JR.
HUGH A. CHAPIN
STANTON T. LAWRENCE, JR.
BERT A. COLLISON
JEROME G. LEE
WILLIAM C. CONNER
HARRY R. PUGH, JR.
JOHN C. COOPER
JOSEPH J. PREVITO
WILLIAM F. EBERLE
JOHN A. REILLY
PAUL M. ENLOW
MORRIS RELSON
FRANK W. FORD, JR.
GILES S. RICH
ALFRED L. HAFFNER, JR.
ALBERT ROBIN
EDWARD HALLE
LEE C. ROBINSON, JR.
ALBERT C. JOHNSON
DOUGLAS W. WYATT
DAVID S. KANE

COMMITTEE ON PROFESSIONAL ETHICS AND GRIEVANCES
Board of Directors Liaison
PETER SAXON
Chairman
ARTHUR S. TENSER
Members
JAMES W. BADIE
KENNETH E. MADSEN
BARRY EVANS
JOSEPH J. PREVITO
STANLEY H. LIEBERSTEIN
LAWRENCE F. SCINTO

PUBLICATIONS COMMITTEE
Board of Directors Liaison
HOWARD B. BARNABY
Chairman
GREGORY J. BATTERSBY
Members
PATRICK J. BIRDE
JEFFREY LEWIS, I.D.
S. BREEN BRADFORD
THOMAS A. O'ROURKE
TERESE R. COHEN
SUSAN H. RAUCH
GARY GITTELSOHN
CHARLES N.J. RUGGIERO
RICHARD B. KLAR
CHARLES J. ZELLER
DAVID J. LEE

COMMITTEE ON PUBLIC INFORMATION AND EDUCATION
Board of Directors Liaison
PHILIP FURGANG
Chairman
JULIUS FISHER
Members
E. JANET BERRY
MARK C. JACOBS
JAY M. BROWN
STANLEY J. SILVERBERG
CURTIS W. CARLSON
PETER K. TRZYNA
CHRISTOPHER B. GARVEY

COMMITTEE ON PUBLIC AND JUDICIAL PERSONNEL
Board of Directors Liaison
ANDREA M. RYAN
Chairman
EVELYN M. SOMMER
Members
WILLIAM S. FEILER
EARL L. SCOTT
GEORGE P. HOARE, JR.
STEPHEN B. SHEAR
HERBERT F. SCHWARTZ
JOHN C. VASSIL
LAWRENCE F. SCINTO

COMMITTEE ON UNITED STATES PATENT LAW AND PRACTICE
Board of Directors Liaison
LEONARD B. MACKEY
Chairman
ROBERT L. BAECHTOLD

ANTITRUST, FOIA AND TRADE SECRETS SUBCOMMITTEE
Chairman
JORDAN B. BIERMAN
Members
ALBERT F. BOWER
MARIA E. MCCORMACK
NICHOLAS L. COCH
ROBERT J. PEARLMAN
FREDERICK J. DORCHAK
JEROME ROSENSTOCK
ROBERT M. FREEMAN
WILLIAM J. THOMASHOWER

PATENT LEGISLATION SUBCOMMITTEE
Chairman
DAVID J. MUGFORD
Members
SIDNEY R. BRESNICK
DAVID H. PFEFFER
J. BRADLEY COHN
DEBORAH S. RITTMAN
MILTON L. HONIG
ALLEN I. RUBENSTEIN
GEORGE W. JOHNSTON
JON SHELDON SAXE
WILLIAM F. KILGANNON
TIBERIU WEISZ

PATENT AND TRADEMARK OFFICE AFFAIRS SUBCOMMITTEE
Chairman
THERESA M. GILLIS
Members
PETER G. DILWORTH
EDWARD A. MEILMAN
NORBERT EDERER
JAY H. MAIOLI
WILLIAM S. FROMMER
HAROLD NISSEN
HALLIE LEVIE
STANLEY ROSEN
ALAN H. LEVINE
JOHN P. WHITE
ERNEST F. MARMOREK

COURT PROCEDURE AND PRACTICE SUBCOMMITTEE
Chairman
PHILIP T. SHANNON
Members
ANTHONY AMARAL, JR
WAYNE M. KENNARD
GEORGE E. BADENOCH
FRANK MORRIS
STEVAN J. BOSSES
LEONARD J. SANTISI
MYRON GREENSPAN
ROBERT C. SCHEINFELD
ALBERT L. JACOBS, JR.
BERJ A. TERZIAN

INTERFERENCE LAW AND PRACTICE SUBCOMMITTEE
Chairman
BRUCE M. COLLINS
Members
JAMES W. BADIE
HERBERT GOODMAN
ISRAEL BLUM
ALLEN R. KIPNESS
STEPHEN H. FRISHAUF
CHARLES A. MUSERLIAN

TRADEMARK LEGISLATION SUBCOMMITTEE
Chairman
PAUL FIELDS
Members
STEVEN BAZERMAN
GLENN OSTRAGER
ROBERT FIDDLER
ROBERT C. SCHEINFELD
STEWART J. FRIED
MILTON SPRINGUT
MARTIN A. LEVITIN

PATENT AND TRADEMARK OFFICE AFFAIRS SUBCOMMITTEE
Chairman
PEGGY RANFT
Members
KENNETH FISHMAN
ROBERT W. HOLLWEG
WILLIAM K. GUILD
SIEGRUN KANE
C. BRUCE HAMBURG
MARK H. SPARROW

COURT PROCEDURE AND PRACTICE SUBCOMMITTEE
Chairman
FRANK J. COLUCCI
Members
MARTIN J. BERAN
PETER LYNFIELD
ARMAND CIFELLI
SUSAN RUTTER
RUSSELL FALCONER
RONALD R. SANTUCCI
LAURENCE R. HEFTER

SPECIAL COMMITTEE ON HARMONIZATION OF PATENT LAWS
Board of Directors Liaison
SAMSON HELFGOTT
Chairman
KARL F. JORDA
Members
ROBERT L. BAECHTOLD
LEE C. ROBINSON, JR.
WALTER BAUM
JOHN P. SINNOTT
JAY L. CHASKIN
JOHN O. TRAMONTINE
MICHAEL N. MELLER

SPECIAL COMMITTEE ON THE BICENTENNIAL OF THE CONSTITUTION
Board of Directors Liaison
PAUL H. HELLER
Chairman
DOUGLAS W. WYATT
Members
GREGORY J. BATTERSBY
S. DELVALLE GOLDSMITH
HERBERT BLECKER
ANDREA M. RYAN
PHILIP FURGANG
FRANK F. SCHECK

HARMONIZATION SURVEY

The United States Patent Office has proposed a possible "harmonized" patent system for consideration by the three major patent offices (United States, Japanese and European) and possible future adherence by other patent offices. The system would include many features of our present U. S. patent law, e.g., grace period, an objective test for obviousness, "means plus function" claims, peripheral claiming practice, and no compulsory licenses. At the same time, the proposal would also require basic changes in the U.S. patent law.

Listed are some of the changes proposed for U.S. law. Kindly provide us with your comments on these changes, including an indication whether you believe the U. S. should accept these changes as part of an overall "package" of an internationally accepted "harmonized" patent system. (Note: many of these proposals will require detailed implementary regulations.)

I. A "first-to-file" system (eliminating interference and 35 USC 104)
II. A provision under the "first-to-file" system guaranteeing a personal right to prior user.
III. Extending the effective prior art date of a previously filed, subsequently published application, back to its priority date (eliminating In re Hilmer Rule).
IV. Previously filed, subsequently published applications can only be used for novelty-defeating purposes, not for judging obviousness(eliminating 102(e) from 103).
V. The Duration of a Patent shall be 20 years from its filing date.
VI. Publication of patent applications 18 months from filing or priority date.
VII. Provisional rights for damages from infringement, from publication (18 months after filing) until a patent issues.
VIII. Filing by the Assignee.
IX. A one year grace period from the priority date and only for publications or acts by, or derived from, the inventor.
X. No requirement to include the best mode.
XI. Miscellaneous comments.
XII. Name, employment affiliation and nature of your patent practices.

Please return your comments to:
Paul H. Heller, Esq.
President, NYPTCLA
One Broadway
New York, NY 10004

RECENT DECISIONS

BY THOMAS A. O'ROUKE

PATENTS - ANTICIPATION

One of the axioms of patent law is the saying "That which will infringe, if later, will anticipate, if earlier." The Court of Appeals for the Federal Circuit recently examined the accuracy of this test in *Lewmar Marine, Inc. v. Barient*, 34 BNA J 461 (Fed. Cir., September 3, 1987).

The CAFC in *Lewmar* examined the history of the axiom and concluded that in view of the amendments to the Patent Laws incorporated in the 1952 Patent Act the test for anticipation should actually read:

> "That which would *literally* infringe if later in time anticipates if earlier than the date of invention."

The CAFC based its conclusion on the narrowing of the definition of anticipation under the 1952 Act. Prior to 1952 anticipation meant either subject matter that was either found exactly in the prior art of that which, although different from the prior art, was not inventive over the prior art. The 1952 Act separates the two prior definitions of anticipation into Section 102 and Section 103. Under the present law "anticipation" only refers to situations where the subject matter of a claim is found exactly in the prior art. Accordingly, anticipation is a restricted term of art and as a result, "[A]ll infringement of a device do not 'anticipate.'"

PATENTS -REPAIR AND RECONSTRUCTION

In the Supreme Court decision *Aro Mfg. Co. vs. Convertible Top Replacement Co.*, 365 U. S. 336 (1961) (Aro I), the Supreme Court held that a reconstruction of a patented article which would infringe a patent "is limited to such a true reconstruction of the entity as to in fact make a new article... after the entity viewed as a whole, had become spent" and that "mere replacement of individual unpatented parts, one at a time, whether the same part repeatedly of different parts successively, is no more than the lawful right of an owner to repair his property."

In *Dana Corp. vs. American Precision Co.*, 34 BNA 456 (Fed.Cir. September 3 1987), the plaintiff patent owner contended that defendants, production rebuilders, directly and contributorily infringed plaintiff's patent. Defendant disassembled clutch cores, cleaned and sorted the individual parts, salvaging those that can be reused and placed them in bins. Defendant then used a production line technique to reassemble clutches using as many parts from the bins as possible. When there are insufficient parts in the bins production builders purchase new parts.

Plaintiff contended that defendant's production line rebuilding was an impermissible reconstruction of the patented article. Plaintiff argued that the test whether a patented product is spent should be when a user making an objective economic decision would replace the product rather than repair it because it has no value to the owner except as scrap.

The CAFC rejected Dana's argument and held that disassembly by the production rebuilders did not constitute a voluntary destruction of the patented clutch that would constitute an infringement.

The New York Patent, Trademark and Copyright Law Association,Inc.
September/October1987
Volume 29 Number 1

The BULLETIN is published periodically for the members of the New York Patent, Trademark and Copyright Law Association. Annual Non-Member Subscription is $15.00/yr. Single copies $2.00. Correspondence may be directed to the Bulletin Editor, Gregory J. Battersby, P.O. Box 1311, 184 Atlantic Street, Stamford, CT 06904-1311. Telephone No. (203) 324-2828.