THE NEW YORK PATENT LAW ASSOCIATION

VOL. 1 NO. 3 DECEMBER 1961

BULLETIN

Christmas Dinner-Dance

Friday, December 8th is the date of the Association's annual dinner-dance. Richard A. Huettner, who is assisted by Frank A. Sinnock and Alan W. Borst, has engaged the Roof Garden of the Hotel Pierre for this event. The hotel, located at Fifth Avenue and 61st Street, has an enviable reputation and the cuisine will be of the best.

Cocktails will be served starting at 6 o'clock, and dinner and dancing start at 7:30. Music will be provided by Ben Cutler and his orchestra. During the cocktail hour music will be furnished by a trio, and thereafter, until 11:45 p.m., a six piece orchestra will provide music for dancing. The music is to be continuous, Mr. Huettner said.

The price is $10 per person, and $20 per couple. Although dress is optional, the committee feels that the Association's principal social event merits a more formal tone than it has sometimes had.

The greatest problem in arranging such a dinner-dance is in estimating the number of people who will attend. The committee urges all who expect to attend to send in their ticket requests as early as possible.

Trademark Forum in January

A Forum dinner-meeting devoted to trademark problems will be held on Tuesday evening, January 16th.

Albert C. Nolte, Jr., who is in charge of the Forums, has stated that Stewart L. Whitman of the committee will announce the speaker and the subject at a later date.

Cameron K. Wehringer and Joseph D. Garon of the committee have again selected the Hotel Piccadilly for the meeting. There will be an opportunity to socialize with other members over cocktails before the dinner. The usual early adjournment of the meeting, for the convenience of commuters, is anticipated.

ASSOCIATION PUBLISHES TEXT

The **Philadelphia Patent Law Association** has ventured into a new professional area. It has just completed publication of a textbook entitled **"Patents, Research and Management."** The Association will use its royalties to further good public relations in the patent field.

CALENDAR

Dec. 8th	Annual Christmas dinner-dance, Roof Garden of Hotel Pierre, Fifth Avenue at 61st Street. Cocktails at 6 p.m., dinner at 7:30.
Jan. 16th	Forum dinner-meeting on trademarks. Hotel Piccadilly.

Celebration of American Patent System Week

The Washington Program. The celebration of **"American Patent System Week"** was highlighted by a special three-day program in Washington, D.C. The program included lectures and luncheons, an industrial exhibit in the Commerce Building, seminars, discussion groups, and tours of the Patent Office.

Address by Dr. Waterman. The formal reception and dinner on October 19th was attended by many dignitaries from this country and abroad. The Hon. David L. Ladd, Commissioner of Patents, was the master of ceremonies. The principal speaker was Dr. Alan T. Waterman, Director of the National Science Foundation, who spoke on **the patent system and technological revolution.**

He pointed to the fact that the number of patent applications filed between 1930 and 1960 did not keep proportionate pace with the great increase in expenditures for science and basic research. As an explanation for this discrepancy he offered the observation that basic research yields few patents and that a large part of the expenditure for science is in the missile and control system fields in which few patents are issued.

The speaker mentioned that the National Science Foundation reports periodically on progress in documentation, indexing, abstracting, and retrieval in various fields. He made a special plea for an expanded research program dealing with information retrieval, translation and dissemination.

French Commissioner of Patents. At the luncheon on the 19th a speech on **Plans for a Common Market Patent** was delivered by the Hon. Guillaume M. Finniss, the French Commissioner of Patents and also the president of the Common Market Patent Committee. Mr. Finniss, who is perhaps the one individual most responsible for the progress that has been made toward an international patent, told of a report that his committee issued eighteen months ago, which was accepted by all six common market countries as a protocol.

He expects diplomatic conventions covering patents, trade-marks and copyrights to be entered into by about twelve nations within the next two years. He indicated that this would make it possible for other countries, like the United States, which are outside the common market treaty to join in the patent provisions, without subscribing to the common market treaty. He anticipates that national patents will coexist with the international patents, and that the international patents will be more difficult to obtain than national patents.

Indian Counsel a Speaker. Another speaker was Mr. L. S. Davar, Counsel to the Government of India on Patent Matters, who reported on the Indian patent system, as well as on the present plans for industrial developments and investment in India.

DESIGN PROTECTION BILL

Philip T. Dalsimer appeared before the Senate Subcommittee on Patents, Trademarks and Copyrights recently, at the request of the Board of Governors of the NYPLA. He expressed his views in support of the Design Protection Bill, S. 1884. This bill would create a limited protection for original designs and make liable only the deliberate infringer.

Legal Protection Inadequate. Mr. Dalsimer pointed out that at the present time the available forms of legal protection for creative designs of useful articles are totally inadequate. This becomes critical since the modern techniques of copying make instantaneous destruction of the creator's market by a copier an ever-present possibility.

He conceded that "copying" is a well developed and important industry and recognized the importance of being able to make copies quickly and inexpensively. He contended, however, that the unauthorized copying of original, creative designs of useful products should not be permitted during the years immediately after the creation of the design.

Copyright Protection Limited. Mr. Dalsimer stated that while copyright protection has been useful in connection with certain types of products, the great bulk of designs and useful articles do not come within the orbit of copyright.

He expressed the view that the proposed legislation with its more carefully thought out provisions tailored to the field of useful articles may give the needed protection, even for those who now have the right to come within the copyright law.

LINDSAY BILL ON UNFAIR COMPETITION

Lindsay Bill H.R. 7833. This bill is being considered further by the Subcommittee on Unfair Competition, which is under the chairmanship of Bert A. Collison. Its purpose is to codify the common law and to provide civil remedies for unfair competition.

Revised Bill Drafted. A revised form of the Lindsay bill was drafted by the predecessor of the present subcommittee acting in conjunction with committees from the U. S. Trademark Association, the American Patent Law Association, the Association of the Bar of the City of New York, and the American Bar Association. Mr. Collison expects his subcommittee to join in further discussions of this bill in the next few weeks. The legislative committee of the Association of the Bar of the City of New York has asked the subcommittee to give its comments on the proposed bill.

Comments Invited. The subcommittee would be interested in receiving comments from the members on this proposed legislation.

PRACTICE & PROCEDURE IN COURTS

Senate Bill 1235. The Subcommittee on Practice and Procedure in the Courts, under the chairmanship of Lorimer P. Brooks, is now considering the question of a new bill, S. 1235. It relates to the Court of Claims and, in particular, to an amendment to reorganize the Court of Claims and amend Title 28 USC.

Pre-trial Procedures. Also under discussion by the subcommittee is the question of the ninety-day rule with respect to pre-trial procedures in the Eastern District Court of New York.

FOUNDATION REPORTS ON FEDERAL PATENT POLICY

The question of **government versus private ownership of patents** resulting from research supported by federal funds is the subject of a report which has been issued by the **Patent, Trademark and Copyright Foundation of George Washington University.** One significant conclusion reached in this 50,000 word report is that the value of these patented inventions has been much exaggerated.

Need for Uniform Policy Questioned. Three faculty members, two professors of economics and one professor of statistics, prepared the report. It is their conclusion that the present mixed system, under which one agency demands title and another asks only a license, is working reasonably well. They see no urgent reason for the adoption of a uniform policy for all government agencies.

Use of Inventions. In the fourteen-year post war period (1946-59), only about 6 percent of the total inventions patented resulted from federally financed research and development. Of the government financed inventions left in private ownership, only 13 percent were placed in commercial use. In contrast, between 55 and 65 percent of the inventions resulting from privately financed research and development were used.

Conclusions Tentative. The investigators indicated that the study was made within a period of one year and with limited resources, and that some of the findings and conclusions therefore must be regarded as preliminary and tentative, rather than final and definitive. A further study is being planned to determine why so few patents result from the large volume of government contract work.

COMMITTEE ON EMPLOYMENT ACTIVE

Scope of Services. More than 300 transactions at the professional level were initiated by the Committee on Employment last year. This makes it one of the most active of the Association's committees. The committee not only assists in professional placement of members of the Association but also places legal secretaries and stenographers.

Members Not Aware of Services. Despite the fact that the committee has been in operation for many years, it frequently learns of members who did not realize that its services were available to them without charge and who, therefore, did not seek its assistance. For this reason the chairman, Albert R. Hodges, is stressing the fact that the committee stands ready to be of assistance to members seeking employment and to those seeking professional associates.

Demand for Attorneys High. The employment market for attorneys is reported as firm. Openings for patent attorneys listed with the committee outnumber available applicants by eight percent. It is pointed out, however, that highly selective requirements on both sides give this statistic only the most casual value.

Office Space. The committee also provides a "clearance" service for office space requirements and offers by patent attorneys in the area. The committee reports that this service has been used infrequently in recent months. The volume of requests has been so low, in fact, that it has not been successful in matching requirements with offers to the mutual advantage of the applicants.

NEW CHANGES IN MANUAL DISCLOSED AT FORUM

The first Forum dinner of the season was held on November 8th at the Hotel Piccadilly. **Ernest A. Faller** of the Patent Office discussed the changes in the **Manual of Patent Examining Procedure** which will be included in the third edition of the manual. The third edition is scheduled for publication at the end of January, and will be priced at $4.

Mr. Faller distributed to those at the meeting a **list of revisions in the Manual** to which he called special attention. This list was of such interest that it is reproduced below, together with Mr. Faller's **citations.** The footnotes indicated were not part of his text, but cover explanatory comments which he made during his talk.

608.01 "Easily Erasable" paper.[1]

608.01(m) Permissible to present claims subdivided into clauses or subparagraphs. Patent copies similarly printed.

608.01(v) Do not use trademarks as common nouns.

608.02(l) Mention Rule 88, if applicable, in requesting transfer of drawings.[2]

608.04(a) Adding inherent characteristics may be new matter.

Ex parte Ayers et al., 108 USPQ 444 (new use);
Ex parte Fox, 1960 CD 28; 761 OG 906 (new formula);
Ex parte Vander Wal et al., 1956 CD 11; 705 OG 5 (physical properties).[3]

706 Constructive suggestions by examiners encouraged.

706.03(l) Multiplicity rejection—Applicant **must** select claims not to exceed number indicated by examiner for action on merits. Board to review propriety of multiplicity rejection, if appeal taken.[4]

706.03(s) Rejection based on filing abroad prior to six months after U. S. filing, if no license obtained. 35 USC 184, 185.

706.03(x) Broadened reissue application filed within two years of original patent—Examiner does not go into question of undue delay.[5] See 35 USC 251.

707.07(f) Record to indicate examiner's opinion on asserted advantages. See In re Hermann et al., 1959 CD 159; 739 OG 549.

708.01 Third (and subsequent) action cases treated as special. If not finally rejected, three month shortened statutory for response set. Extension of time for response granted only on showing of "real hardship." 771 OG 896.

713.04 Examiner to check "Remarks" in amendment filed after interview with respect to statements attributed to examiner.

714.02 How language of **claims** distinguishes from references must be pointed out. Rule 111 (b).

714.13 Second amendment after final need not be responded to if claims are not thereby made allowable or obviously in better form for appeal.

715.01(a) Swearing back of earlier patent involving applicant and another joint inventor. In re Strain, 1951 CD 252; 648 OG 5.

715.01(b) Swearing back of earlier patent "to another" with common assignment. In re Beck et al., 1946 CD 398; 590 OG 357; Pierce v. Watson, 124 USPQ 356.

715.01(c) Overcoming own earlier publication without swearing back. If a co-author, see Ex parte Hirschler, 110 USPQ 384.

716 Rule 132 affidavits—Primary to review personally.

Timeliness
In re Rothermel et al., 1960 CD 204; 755 OG 621;
See Rule 195.

Facts, Not Conclusions
In re Pike et al., 1950 CD 105; 633 OG 680;
In re Renstrom, 1949 CD 306; 624 OG 5.

Scrutinized Carefully
In re McKenna et al., 1953 CD 251; 674 OG 9;
Bullard v. Coe, 1945 CD 13; 573 OG 547.

Comparative Tests or Results
Blanchard v. Ooms, 1946 CD 22; 585 OG 175;
In re Tatincloux, 1956 CD 102; 702 OG 964;
In re Finley, 1949 CD 284; 624 OG 262;
In re Armstrong, 1960 CD 422; 759 OG 4;
Abbot v. Coe, 1940 CD 13; 512 OG 3;
In re Rossi, 1957 CD 130; 717 OG 214;
In re Henrich, 1959 CD 353; 747 OG 793.

Operability of Applicant's Disclosure
In re Quattlebaum, 84 USPQ 383;
In re Perrigo, 1931 CD 512; 411 OG 544;
Buck v. Ooms, 1947 CD 33; 602 OG 177;
In re Chilowsky, 1956 CD 155; 704 OG 213.

Inoperability of References
Metropolitan v. Coe, 1935 CD 54; 455 OG 3;
In re Lurelle Guild, 1953 CD 310; 677 OG 5;
In re Pappos et al., 1954 CD 278; 687 OG 451;
In re Pierce, 1930 CD 34; 390 OG 265;
In re Ried, 1950 CD 194; 635 OG 694;
In re Wagner, 1939 CD 581; 407 OG 1041;
In re Attwood, 1958 CD 204; 730 OG 790;
In re Crecilius, 1937 CD 112; 474 OG 465;
In re Perrine, 1940 CD 465; 519 OG 520;
In re Crosby, 1947 CD 35; 595 OG 5;
In re Pio, 1955 CD 59; 691 OG 454.

Commercial Success
In re Jewett et al., 1957 CD 420; 724 OG 225;
In re Troutman, 1960 CD 308; 757 OG 556;
In re Kulieke, 1960 CD 281; 756 OG 288;
In re Hollingsworth, 1958 CD 210, 730 OG 282.

Sufficiency of Disclosure
In re Smyth, 1951 CD 449; 651 OG 5;
In re Oppenauer, 1955 CD 587; 568 OG 393.

901.06(a) Detailed explanation of services of Scientific Library.[6]

1701 Examiners not to express opinion on validity of any patent, whether a given reference was considered, or similar questions.

NOTES:

(1) Easily erasable paper should not be used. It should be possible to erase pencil marks without erasing typed letters.

(2) An application containing the drawings will not be abandoned until the new application is granted a filing date.

(3) A new use is no longer held to be inherent.

(4) The examiner alone (not the Board) determines the maximum number of claims an application should contain for examination.

(5) In view of the 2 years allowed by the statute.

(6) Lists of foreign patents in subclasses are now available.

H.R. 10 PASSAGE LOOMS

The newest version of H.R. 10, the **"Self-Employed Individuals Retirement Act,"** has reached another milestone in its long and tortuous journey through the legislative mill. Having passed the House of Representatives in June, 1961, H.R. 10 was approved by the Senate Finance Committee in August, 1961, by a 14 to 3 vote.

Operation of Plan. If H.R. 10 becomes law, a self-employed person would be permitted to contribute 10 percent of his earned income (or $2,500, whichever is less) to a retirement plan and deduct 100 percent of the first $1,000 contributed and 50 percent of the remaining $1,500 for income tax purposes. If such self-employed person has more than three employees, he must provide vested benefits for those employees who have 3 or more years of service.

Legislative History. Toward the recent end of the 1st session of the 87th Congress, a small group of opposition senators threatened a lengthy debate on H.R. 10, but the advances which this bill has made now leads seasoned observers to believe that major roadblocks to the enactment of some form of legislation in this area have been largely overcome.

The movement to obtain tax benefits for the self-employed consistent with those of corporate employees had its beginning in 1945 shortly after the 77th Congress provided the impetus for the steady growth in corporate coverage, but gained its first real momentum in 1951.

Senate Finance Committee Support. In both the 85th and 86th Congresses and again in the first session of the 87th Congress the House of Representatives passed bills which seem to indicate that the principle back of this legislation is sound. Certainly the members of the Senate Finance Committee in the 86th Congress must have recognized this when H.R. 10 was approved then by a 12 to 5 vote, and now in the 1st session of the 87th Congress, the Senate Finance Committee has ordered H.R. 10 favorably reported by a 14 to 3 vote.

The efforts of the self-employed to secure equal treatment with corporate employees in the matter of pensions seems to be nearing fruition. Any bill which is enacted in their behalf may not be perfect, but at least it will be a beginning.

BULLETIN

of The New York Patent Law Association

90 Broad Street, New York 4, New York

Volume 1. December 1961 Number 3.

Application to Mail at Second Class Postage Rates Pending at New York, N. Y.

The BULLETIN is published monthly (except in July, August, and September) for the members of The New York Patent Law Association.

CHANGE IN RULE 14(b) PROTESTED

President Donohue, acting under instructions from the Board of Governors, has filed with Commissioner Ladd an objection to the proposed amendment to Rule 14(b) of the Rules of Practice. The Association recommended modification of the proposed amendment to permit publication of decisions of the Board of Appeals in abandoned cases only (1) where the applicant has given express consent, or (2) where it is apparent that the invention is publicly known, and the applicant fails (after notice) to present sufficient reasons for withholding publication. This modification, Mr. Donohue stated, would adequately protect and preserve the rights of applicants.

PROPOSED BERMUDA WEEKEND

The Committee on Meetings has invited all members to comment on its suggestion for a Bermuda outing. The Bermuda weekend would combine pleasure with professional education. It would replace the golfing, dinner-dance affair which for a number of years past has been held in June within the Metropolitan area.

George W. Whitney, chairman of the committee, reports that a number of members have already replied. On the affirmative side, one member asked why the outing could not include Friday and Monday, making a four day trip of it. On the negative side, a member pointed out that the annual golf outing made it possible for his clients to join him, but that this would not be practical on the proposed Bermuda trip.

In order to make a fair evaluation of membership reaction to the proposed Bermuda weekend, the committee will need a substantial number of replies. It is for this reason that the plan has been disclosed this early in the Association year. Don't delay in making your views known.

OFFICES MOVED TO DISC BUILDING

We have been asked to remind our members that the following units of the Patent Office now are located in the **Disc Building**, 1801 K Street, N.W., Washington, D.C.: Board of Appeals; Board of Patent Interferences; Trademark Examining Operation; Trademark Search

Application to Mail at Second Class Postage Rates Is Pending at New York, N. Y.