
BOOK REVIEW

DYNAMICS OF THE PATENT SYSTEM. Discussions of the Ten Critical Areas of Contemporary Patent Law, The Patent Law Seminar, Villanova University School of Law, Villanova, Pennsylvania. Edited by William B. Ball, Professor of Law, Villanova University Law School. Central Book Company, Inc., 850 DeKalb Avenue, Brooklyn 21, New York. 448 pp. \$12.50.

Reviewed by JOSEPH ROSSMAN*

THIS VOLUME CONTAINS THE PROVOCATIVE PAPERS and discussions presented during a seminar of ten sessions in the fall of 1957 at the School of Law of Villanova University. These sessions were arranged with the cooperation of Mr. Virgil E. Woodcock and Mr. Joseph Gray Jackson, well-known attorneys of the Philadelphia Patent Bar, which has held for many years so-called "Junto" patent law meetings. The meetings are patterned on Benjamin Franklin's "The Junto" which he started in 1727 as a club of bright young men who met in the warmest of good fellowship to discuss topics of the day. Franklin describes the rules of the club in his *Autobiography*. Each member was to present a paper once in three months that was to be discussed. "Our debates were to be under the direction of a president, and to be conducted in the sincere spirit of inquiry after truth, without fondness for dispute, or desire of victory; and, to prevent warmth, all expressions of positiveness in opinion, or direct contradiction, were after some time made contraband, and prohibited under small pecuniary penalties."

There is a brief foreword by Federal Judge John Biggs, Jr., who states that he hopes the papers will be the starting point for constructive action and the formulation of needed changes in patent law and procedure.

The first paper (pages 1-33) by Mr. Edwin L. Reynolds, Chief Technical Advisor, U. S. Court of Customs and Patent Appeals, discusses the standard of invention followed by the Patent Office. He concludes that the overall standard of invention applied by the Patent Office is now substantially lower than that applied by the courts which pass upon the validity of patents and steps should be taken to reduce this discrepancy. Mr. Reynolds gives no statistical data to support his conclusions. The available statistics of court decisions do show a high percentage of decisions invalidating patents in litigation. But since only a tiny fraction of all issued patents is ever litigated, it is this reviewer's opinion that such

* Dr. Rossman is a member of the Research Staff.

court statistics do not necessarily reflect the same proportion of invalidity of all issued patents. It is usually the borderline patent that gets into court and no statistics are presently available on the total number of patents which are recognized as being valid and are therefore never contested. Also, who is to judge at the outset whether a gadget invention is not worthy of a patent? The telephone, telegraph, movie, radio and television were regarded as mere "gadgets" in their early stages. In fact, nearly all basic inventions must necessarily go through the "gadget" stage. The Patent Office policy of resolving doubts in favor of the inventor is thus sound. It encourages investment which promotes industrial progress. As expected, a lively discussion followed, led by Mr. Arvid Lyden, Patent Department, Pennsalt Chemicals Corporation, and nine other attorneys, which touched on various possible remedies, such as opposition proceedings, spot checks on the work of examiners, additional supervisory examiners, rigorous proof in pharmaceutical and chemical cases, etc.

Mr. Thomas Cooch, of the Wilmington, Delaware Bar, presents a paper (pages 34-72) on the standard of invention in the courts, which is a refreshingly frank discussion by an experienced trial lawyer. He believes that the question of "invention" is a question of "fact" even though it cannot be proven by an eye-witness. He discusses the methodology which should be followed in court to establish "invention." He also points out why patent statistics of court decisions do not shock him, since the sample is too small and there are good reasons for invalidity holdings not always attributable to Patent Office procedures. Mr. C. Marshall Dann, Assistant Manager, Patent Division of E. I. du Pont de Nemours & Company, led the discussion of this paper. He presented patent statistics to show how patents fared in the courts during the last 30 years. Discussions by Mr. George L. Church, Patent Department, Sun Oil Company, and Mr. W. Wycliff Walton contributed further light on the subject of whether invention is a question of fact and not of law.

Mr. Joseph Gray Jackson's scholarly paper "Patent Claims Before The Patent Office" (pages 73-127) covers many problems which frequently arise in prosecution of patent applications and includes valuable pointers to practicing attorneys. The paper is profusely annotated with recent decisions. Mr. Jackson gives a very concise statement of the function of claims and then goes on to give an excellent analysis of process claims. He then discusses the problems of claiming new uses under Section 100 of the 1952 Patent Act. Other topics covered are introductory clauses in claims, mathematical expressions in claims, completeness of definition, definiteness, and "means" claims. An interesting discussion follows, led by Mr. Francis J. Bouda, Patent Counsel of Scott Paper Company, which includes current experiences with claim problems.

A paper "Patent Claims and Infringement" by Mr. Floyd H. Crews of the New York Bar (pages 128-154), after reviewing a few court decisions, concludes that it is the attorney's job "to sell the judge a bill of goods" on the merits of the invention covered by the patent and "the court will find the rules of law to fit your case." The paper presents a pragmatic approach to litigation problems. For example, Mr. Crews points out that in appeal cases it is better to appeal on ques-

tions of law rather than on the findings to get a reversal. The floor discussion of this paper was led by Mr. Robert B. Frailey of the Philadelphia Bar.

The paper by Mr. Zachary T. Wobensmith, II, of the Philadelphia Bar, "Who Is The First Inventor?" (pages 155-187), discusses some special problems in patent interferences. He discusses the *Mason v. Hepburn* doctrine, the abandoned experiment, corroboration, and estoppel in interferences. Mr. Wobensmith cites numerous decisions and gives some sound practical advice based on his own rich experience as a practicing attorney. A lively discussion of the paper led by Mr. Robert J. Mawhinney, Houdry Process Corporation, is included.

Dr. Howard I. Forman, Patent Attorney, Rohm & Haas Company, contributes a paper entitled "Inventors and Their Relations With Others" (pages 188-237). He discusses the problems of employee agreements to assign inventions; the problems of the individual inventor in exploiting his patent rights; confidential disclosures; types of patent licensing, royalty provisions and methods of arriving at suitable royalty rates; and foreign patents. Dr. Forman presents a very clear and concise review of these widely ranging topics in his usual scholarly manner with numerous supporting authorities which should be valuable to the practitioner. A discussion led by Mr. H. Gordon Dyke, Manager of Patent Department, International Latex Corporation, adds to the value of this paper.

A paper on design patents by Mr. Henry N. Paul, Jr., (pages 238-262) and discussion led by Mr. Kennard N. Ware, both of the Philadelphia Bar, covers questions of patentability of designs and infringement. The current severity of the courts in regard to design patents is touched upon and proposed design legislation is discussed.

Mr. Virgil E. Woodcock, of the Philadelphia Bar, in a paper entitled "What Is Prior Art?" (pages 263-332) gives a very comprehensive and scholarly discussion of current problems of assessing prior art as a statutory bar under the present Patent Act and court decisions. He discusses the effect of prior inventions of another; prior knowledge and use; prior patenting; prior description in a printed publication; Alien Custodian publications; published abstracts of U. S. applications; manuals and instruction books; prior filing by another; publication, public use, and sale under Section 102; prior public use and experimental use; experimental use: field trials, durability tests, in secret or in public; changes made during experimental use; abandonment; propriety of combining patents issued after applicant's filing date. This paper is virtually a treatise in miniature and is one of the best surveys which has yet appeared in print on this important and complex topic. The numerous citations make it valuable reference material for patent attorneys. A discussion led by Mr. Robert I. Staples, Patent Attorney, The Electric Storage Battery Company, touches on a number of interesting questions relating to prior art. A short memorandum by Mr. Jacob C. Kellem, of the Wilmington, Delaware Bar, is included entitled: "Can Damages Be Collected For Infringement Occurring Upon the Last Day Before the Patent Expires?" and "Can A Patent Be Sued Upon The Day It Issues?"

Judge Giles S. Rich, U. S. Court of Customs and Patent Appeals, presents a paper "Contributory Infringement," (pages 333-364) which gives a lucid discus-

sion of the doctrine of contributory infringement, its historical development by court adjudication, a history of proposed legislation efforts and final codification of the doctrine in Section 271 of the present Patent Act for which Judge Rich deserves much of the credit in drafting same and having it enacted by Congress. Judge Rich has previously published several articles on this topic. The present paper represents his current thinking five years after Section 271 was enacted, in the light of recent cases. He believes that Section 271 has restored balance in the relation between the patent system and the antitrust laws. A discussion of the paper was led by Maurice A. Crews, Assistant Commissioner of Patents, U. S. Patent Office. Mr. P. J. Federico, Member of the Board of Appeals of the Patent Office, also participated in this discussion.

Mr. John Hoxie, of the New York Bar, presents a paper on "Misuse of Patents" (page 365-392) followed by a discussion led by Mr. William P. Cole, of the Philadelphia Bar. The development of the doctrine of misuse is traced and practical problems of meeting such situations are discussed.

The volume contains a very detailed subject index which serves to locate the topics discussed. A table of cases is also included.

The patent profession should be greatly indebted to Professor William B. Ball, of the Villanova University School of Law, for his creative efforts in sponsoring this unique symposium and also for his arduous work in editing the papers and discussions and getting them into print in a very handsome volume.