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1971 WL 133764 (U.S.)

For opinion see 91 S.Ct. 917, 91 S.Ct. 563, 91 S.Ct. 449, 91 S.Ct. 363, 91 S.Ct. 101

Briefs and Other Related Documents

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Supreme Court of the United States.
BLONDER-TONGUE LABORATORIES, INC., Petitioner,
v.
UNIVERSITY OF ILLINOIS FOUNDATION and JFD Electronics Corporation, Respondents.
No. 338.
October Term, 1970.
February 18, 1971.

Motions of Blumcraft of Pittsburgh Opposing Motion of Kawneer Company, Inc. for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of Blumcraft of Pittsburgh.

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***1** Blumcraft of Pittsburgh respectfully moves the Court to reconsider its Order of January 18, 1971 granting the Motion of Kawneer Company, Inc. for Leave to File Brief Amicus Curiae and to deny said Motion of Kawneer Company, Inc. and in the alternative, Bluncraft respectfully moves for leave to file the attached Brief Amicus Curiae in opposition to the Brief filed by Kawneer Company, Inc.

Kawneer Company, Inc. successfully moved for leave to file Brief Amicus Curiae on the basis that a motion for summary judgment filed by Kawneer Company, Inc. in the pending suit Blumcraft of Pittsburgh v. Kawneer Company, Inc., No. 12,847, Northern District of Georgia "raises the same question presented in the instant case". No ***2** notice was or has been given to Blumcraft or its counsel that such motion had been filed until after it was granted by the Court.

The Georgia action raises a different question than that presented in the present case and Kawneer Company, Inc. was considerably less than candid in contending that the Georgia action involved merely a prior determination of patent invalidity against a different defendant when in fact the patent in the Georgia case had first been held valid and infringed in a first adjudication by the United States Court of Claims respecting the very products of Kawneer involved in the Georgia action.

In the instant case the patent in suit was first held invalid in the Eighth Circuit and was subsequently held valid in a second suit in the Seventh Circuit. The Court of Appeals for the Eighth Circuit was faced only with a single prior adjudication of invalidity. This presents the question of Triplett v. Lowell as evidenced by the Court's request that the parties address themselves to that question. Even assuming that the Court should determine to reverse Triplett v. Lowell in the present case, that would not reach the question presented in the Georgia action, the third suit involving the patent, where the patent is the subject of a prior holding of validity.

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The Brief filed by Kawneer Company, Inc. is the only brief filed in the present action supporting the reversal of Triplett v. Lowell. Kawneer's silence with respect to the prior adjudication of validity of the patent in the Georgia case involving its own products could have resulted in the Court's treating the question of Triplett v. Lowell as though it involved the same question as presented in the Georgia action although this is not the case. The presence of Kawneer Company, Inc. in the present case as amicus curiae upon the false premise that the question in the Georgia action is the same as that in the instant case lends ***3** itself to broadening sub silentio the Court's consideration of Triplett v. Lowell beyond the facts of the present case. In order to avoid the erroneous implication that the present case is the same as the Georgia. action, the Motion of Kawneer Company, Inc. for Leave to File Brief Amicus Cnriac should be reconsidered and denied.

In the alternative, Blumcraft requests permission to file its Brief Amicus Curiae urging that the holding of Triplett v. Lowell be adhered to for the very reason that to do otherwise would lead to intolerable confusion in the administration of the patent system, particularly where, as in the Blumcraft case, the patent has first been held valid.

***1** The question is whether the Court should overrule the holding of Triplett v. Lowell, 297 U. S. 638, 642 (1936) that "neither reason nor authority supports the contention that an adjudication adverse to any or all the claims of a patent precludes another suit upon the same claims against a different defendant."

STATEMENT.

Although invited by the Court to brief and argue the question presented, both petitioner and respondents have urged the Court, for good reasons, to reaffirm the holding of Triplett v. Lowell. Only Kawneer Company, Inc. has urged the Court to reverse it in furtherance of its position in a pending suit between Kawneer and Blumcraft.

***2** The case in which Blumcraft and Kawneer are involved is not the same as the instant case or Triplett v. Lowell, for the reason that in the Blumcraft case the patent was first held valid over prior art in one suit, invalid over the same prior art in a second snit and is now involved in a third suit. It is Blumcraft's position that by overruling the holding of Triplett v. Lowell as stated above the Court could not decide the question involved in the case between Blumcraft and Kawneer. It is further Blumcraft's position that the facts in the Blumeraft case amply demonstrate the soundness of the holding of Triplett v. Lowell.

***3** ARGUMENT.

I. The Holding of Triplett v. Lowell Is Based Upon Reason and Authority to Permit the Orderly Administration of the Patent System.

A suit for patent infringement is an action in personam, not in rem and the cases have long held a patent can only be repealed by an adjudication in a suit by the United States that it was fraudulently obtained. United States v. Bell Telephone Company, 167 U. S. 224 (1896).

Kawneer urges the Court to adopt a rule that the first holding of invalidity of a patent in effect repeals it regardless of prior adjudications of validity. Kawneer would have a patentee litigate his patent against different infringers in different

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circuits, in each case requiring an independent determination of the patent's validity so long as the patent is held valid. The patentee would thus be forced to contest the validity of his patent repeatedly, even against the same prior art. Then, according to Kawneer, if the patent were ultimately held invalid in another circuit, the patent would be dead. Where this would leave the first infringers is not clear. To paraphrase Justice Jackson in Jungersen v. Ostby & Barton Co., Inc., 335 U. S. 560, 572 (1949), the only valid patent would be one that had not been sufficiently litigated.

II. Kawneer Confuses Collateral Estoppel With Res Judicata.

Kawneer contends that mutuality is no longer required in the application of collateral estoppel citing the divided decision in Bruszewski v. United States, 181 F. 2d 419 (3 Cir., 1950). The cases indicate, however, that mutuality is by no means dead in any case. Cansaan Prod ***4** ucts, Inc. v. Edward Don & Company, 388 F. 2d 540 (7 Cir., 1968). Industrial Credit Company v. Berg, 388 F. 2d 835 (8 Cir., 1968). Kawneer also fails, as did the court in the Bruszewski case, to distinguish clearly between collateral estoppel and res judicata. The distinction, however, was clearly drawn by the Court in Lawlor v. National Screen Service, 349 U. S. 332, 330 (1954):

"Compare Bruszewski v. United States, 181 F. 2d 419 (C. A. 3d Cir.), on which both courts below relied. It should also be noted that the Bruszewski decision was an application of collateral estoppel and not res judicata as the term is used here."

The statement in footnote 6 at page 422 of the Bruszewski decision makes clear that the court was limiting its decision to preclude relitigation of "a question of fact." While the term res judicata is used by the court in that opinion, as the court pointed out in the Lawlor case, it was in reality applying collateral estoppel.

The significant point is that collateral estoppel may be used to prevent a litigant from retrying a question of fact which has been established in a prior case even though his opponent was not a party to that case. Res judicata, on the other hand, precludes a litigant from asserting his claim but the prohibition can only benefit the opposing party to the first litigation and his privies. In applying the rationale of Bruszewski in a patent case, the United States Court of Claims properly required that in each case it must first be determined whether the particular question in issue is redundant and therefore need not be relitigated. Technograph Printed Circuits Ltd. v. The United States, U. S. Ct. of Claims, 372 F. 2d 969 (1967).

It has never been questioned that res judicata or collateral estoppel can be waived by the party in a position ***5** to claim it. Neither res judicata nor collateral estoppel operates automatically. Thus, the defendants in the instant case may well have avoided pleading collateral estoppel before the trial in order to make their own record against the patent. The entire matter of limiting needless relitigation is thus left in the hands of the litigant who may employ it to suit its own ends.

Kawneer's basic thesis is in error. It is not mutuality but privity that controls in the application of res judicata and that continues to be the law in all cases. The doctrine of collateral estoppel is available to be used upon factual questions in patent litigation as in all other litigation.

III. The Doctrine of Comity Is the Proper and Available Device to Limit Multiple

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Patent Litigation.

In urging the Court to adopt a rule whereby the doctrine of res judicata would be expanded solely to be used against the patentee, Kawneer ignores the long line of authority going back through Triplett v. Lowell and including Tighlman v. Proctor, 125 U. S. 136 (1888), in which the court made clear that so long as the patent question in issue had not been determined between the parties to the suit, each party is entitled to litigate his claim. Those cases and the court's decision in Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 485, 489 (1899) made clear that the rule of comity may be applied to limit multiple litigation of patent claims; but that doctrine may be used both in favor of the patentee and against him, unlike Kawneer's unilateral res judicata which only works against the patentee.

***6** CONCLUSION.

The circumstances of the Kawnecr-Blumcraft litigation and the decisions of the Court in Triplett v. Lowell, Tighlman v. Proctor, Mast, Foos & Co. v. Stover Mfg. Co. and the Lawlor case make it clear that the holding of Triplett v. Lowell should be sustained as the only basis upon which the patent system can be fairly administered under present legislation.

Kawneer's proposal to overrule Triplett v. Lowell would leave the patent system in the position where, faced with one adjudication of validity and another adjudication of invalidity, the patentee could not take advantage of the prior holding of validity while the infringer would have the full benefit of the prior holding of invalidity.

U.S., 2004.
Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation

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• 1971 WL 133763 (Appellate Brief) Brief for the United States as Amicus Curiae (Jan. 08, 1971)Original Image of this Document (PDF)

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Supreme Court of the United States.
BLONDER-TONGUE LABORATORIES, INC., Petitioner,
v.
UNIVERSITY OF ILLINOIS FOUNDATION and JFD Electronics Corporation, Respondents.
No. 338.
October Term, 1970.
January 8, 1971.
On Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of Kawneer Company, Inc.

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***1** Kawneer Company, Inc. hereby respectfully moves for leave to file the attached brief amicus curiae in this case. The consent of counsel for the petitioner was requested but refused, necessitating the filing of this motion pursuant to Rule 42.3.

***2** The interest of Kawneer Company, Inc. in this case arises from the fact that it is a defendant in a patent infringement action presently pending in the United States District Court for the Northern District of Georgia. Blumcraft of Pittsburgh v. Kawneer Comnpany, Inc., No. 12847, N.D.G-a. That action involves a design patent which has been held invalid by the United States Court of Appeals for the Fourth Circuit in Blumcraft of Pittsburgh v. Citizens and Southern National Bank, 407 F.2d 557 (4th Cir.), cert. denied 395 U.S. 961 (1969). A motion for summary judgment filed by defendants in the Georgia action raises the same question presented in the instant case; namely, whether the holding of Triplett v. Lowell, 297 U.S. 638 (1936), that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, should be adhered to.

In the instant case that question was not raised in the petition for certiorari. The Court subsequently requested the parties to address themselves in their briefs and oral arguments to that question. Perhaps unexpectedly, however, the brief for petitioner argues that the holding of Triplett v. Lowell should be reaffirmed, even though the court below expressed its dissatisfaction with the Triplett rule in concluding that respondents were not bound by a prior final judgment holding invalid one of the patents upon which this action against petitioner was based. Respondents will doubtless agree with and attempt to support petitioner's argument on this point.

The brief which amicus curiae is requesting permission to file will contain argument urging that the holding of Triplett v. Lowell should not be adhered to, and ***3** it appears that no such argument will be presented by the parties.

***1** QUESTION PRESENTED

This brief amicus curiae is addressed exclusively to the question whether the holding of Triplett v. Lowell, 297 U.S. 638 (1936), that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, should be adhered to.

***2** STATEMENT

The principal fact relevant to the question considered in this brief is that United States Patent No. 3,210,767 issued on October 5, 1965 in the name of D. E. Isbell (referred to herein as "the Isbell patent"), which the court below held valid and infringed by the petitioner, was determined to be invalid on the ground of obviousness by a final judgment of a district court in Iowa, affirmed by the Eighth Circuit, prior to the entry of judgment in the court below.

The respondent University of Illinois Foundation brought an action in a. distant

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court in Iowa against the Winegard. Company (referred to herein as "the Winegard litigation") alleging infringement of the Isbell patent. After a full trial on the merits, the district court held that the Isbell patent Was invalid on the ground of obviousness. Uniuersity of Illinois Foundation v. Winegard Co., 271 F. Supp. 412 (S.D. Iowa 1967). The Foundation appealed the decision to the Eighth Circuit, which affirmed the judgment of the district court holding the MO patent invalid, and the Foundation's petition for certiorari was denied. University of Illinois Foundation v. Winegard Co., 402 F.2d 125 (8th Cir. 1968), cert. denied, 394 U.S. 917, (1969).

After the filing of the complaint in the Winegard litigation, the Foundation filed its complaint in the instant case against petitioner Blonder-Tongue Laboratories, Inc. in a distriet court in Illinois, charging Blonder-Tongue with infringement of the Isbell patent and another patent. The respondent JFD Electronics Corporation was inside a party, and Blonder-Tongue asserted counterclaims against the respondents which are Dot relevant to the questions discussed in this brief.

***3** Subsequent to the entry of the district court's judgment in the Winegard litigation holding the Isbell patent invalid, but prior to the affirmance of that judgment by the Eighth Circuit, the district court in the instant case held that the Isbell patent was valid and infringed by Blonder-Tongue. While Blonder-Tongue's appeal to the court below was pending, the judgment in the Winegard litigation declaring the Isbell patent invalid was affirmed by the Eighth Circuit and certiorari was denied. In its opinion, the court below expressly recognized that the Isbell patent had been declared invalid by the final judgment in the Winegard litigation, but relyctantly concluded that the holding of Triplctt v. Lowcll preeluded the application of the principles of res judicata to make that judgment binding upon the Foundation. [FN1] On the record before it, the court below affirmed the district court's judgment holding that the Isbell patent was valid and infringed by Blonder-Tongue. Blonder-Tongue's petition for a writ of certiorari was granted on October 19, 1970.

> FN1. The court said: "It would seem sound judicial policy that the adjudication of that issue against the Foundation in one action where it was a party would provide a defense in any other action by the Foundation for infringement of the same patent. That, however, is not the law in. this field." 422 F.2d at 772 (emphasis added).

SUMMARY OF ARGUMENT

The holding of Triplett v. Lowell, 297 U.S. 638 (1936), that a determination of patent invalidity is not res judicata against the patentee in subsequent litigation against a different defendant was based upon the common law doctrine of mutuality of estoppel, which prohibited any litigant from basing a plea of ***4** res judicata by collateral estoppel on a prior judgment unless the litigant had been either a party or in privity with a party to the action resulting in the prior judgment. The mutuality doctrine has uo rational foundation, and in the thirty-four years since Triplett v. Lowell was decided it has become a dead letter in the federal common law of res judicata, except in the field of patent litigation.

The refusal of the lower courts to extend this salutary development in the federal common law of res judicata to the patent field appears to be based upon the view that in Triplett v. Lowell this Court intended to create a special rule for the application of the principles of res judicata to patent cases. Such a view is not

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well founded. Examination of the Triplett decision shows that the Court was merely applying the general "rules of the common law applicable to successive litigations concerning the same subject matter." In 1936, the mutuality doctrine was entrenched in the common law of res judicata. Today, that irrational doctrine has been discredited and repudiated. This Court should now extend this sound judicial development in the federal common law of res judicata to the patent field, by refusing to adhere to the holding of Triplett v. Lowell.

The suggestion is made in the brief for petitioner that this Court should adhere to the holding of Triplett v. Lowell until the rules of res judicata respecting patent litigation are changed by legislative action. This suggestion is without merit. The common law rules of res judicata are judge-made, not statutory. Those rules are designed to protect the judicial process from the abuse of repetitious litigation over controversies which have been finally resolved by a court ***5** of competent jurisdiction, to the extent that such litigation can be precluded without depriving any litigant of his constitutional right to an opportnuity to be heard in court on any issue affecting his legal interests. The formulation (if rules so fatally important to sound judicial administration is plainly not a matter in which this Court should await action by Congress.

A litigant Who seeks and obtains a judicial determination of an issue in a forum and against a defendant of his choice should be bound by the outcome of the litigation which be institutes. Sound judicial administration dictates that lie be precluded from relitigating an issue again and again by the, simple expedient of choosing different defendants for his succession of days in court.

ARGUMENT

I.

THE COMMON LAW DOCTRINE OF MUTUALITY OF ESTOPPEL WAS THE SOLE BASIS OF THE HOLDING OF TRIPLETT v. LOWELL THAT AN ADJUDICATION OF PATENT INVALIDITY IS NOT RES JUDICATA AGAINST THE PATENTEE IN SUBSEQUENT LITIGATION AGAINST A DIFFERENT DEFENDANT.

In Triplett v. Lowell, 297 U.S. 638 (1.936), certiorari was granted for the purpose of resolving "questions as to the scope and effect of the disclaimer statute ... raised in a suit brought to enjoin infringement of several patent claims, ,some of which had Previously been held invalid in an infringement suit in another circuit against different defendants." 297 U.-S. at 639. However, the petitioners there extended their arguments far beyond the limited scope of review granted by the Court and contended that:

"[I]f any Claim of a patent is adjudged invalid no further suit can be maintained upon it, or upon ***6** other claims of the patent without disclaimer of the claims previously held invalid." 297 U.S. at 641-42.

In response to this contention, the Court made the following oft-quoted statement:

"Neither reason nor authority supports the contention that an adjudication adverse to any or all the claims of a patent precludes another suit upon the same claims against a different defendant. While the earlier decision may by comity be given great weight in a later litigation and thus persuade the court to render a like decree, it is not res adjudicata and may not be pleaded as a defense. See Mast, Foos & Co. v. Stover Mfg. Co., 177 U.S. 485, 20 S. Ct. 708, 44 L. Ed. 856; Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 35, 50 S. Ct. 9, 74 L. Ed. 147." 297 U.S. at 642. [FN2]

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FN2. Actually, the holdings of the Mast and Winters cases cited by the Court in Triplett do not support the holding that a prior adjudication against a different defendant does not preclude a patentee from bringing a second suit on the same patent. The distinguishing factors were clearly stated in Nickerson v. Pep Boys, 247 F. Supp. 221 (D. Del. 1965):
"Mast held that an adjudication of validity (the converse of the situation in Triplett and at bar) against one defendant does not require a determination of validity in a second suit against a different defendant. This is readily understandable for it would obviously be inequitable to have the defendant in the second suit bound by the validity adjudication in the earlier suit, when he had no opportunity to be heard on the question. See Sutherland Paper Co. v. Grant Paper Box Co., 183 F.2d 926, 936, 86 USPQ 337, 345 cert. denied, 340 U.S. 906, 87 USPQ 432. The situation in the present ease, where the patentee has had an opportunity in a prior suit to fully litigate the issue of validity and has suffered an adverse verdict, is far different. "In Winters the Seventh Circuit Court of Appeals had held a latch patent valid and infringed by one who had used them. The action was defended by counsel employed and paid by the manufacturer of the latehes which had sold them to the defendant. Before final judgment was entered the patentee brought a second suit in the Third Circuit against the manufacturer-vendor. The Court of Appeals for the Third Circuit held that the patent was not infringed. Because of the division on the infringement issue in the two circuits, certiorari was granted by the Supreme Court. The adjudication of infringement in the first suit, under settled principles, would have been res judicata in the second, the plaintiff being the same and the defense of the first action having been controlled by the defendant in the second action. However, since there was nothing in the record in the Third Circuit ease to raise the issne of estoppel by the prior judgment of infringement, the Snpreme Court held that the effect of the decree in the Seventh Circuit was, at most. that which it had under the doctrine of enmity." 247 F. Supp. at 221-22.

***7** The lower federal courts have interpreted the foregoing statement as if it were intended to create a special rule for the application of the principles of res judictata to patent cases, and have therefore reluctantly refused to repudiate the mutuality doctrine in the patent field, [FN3] despite its repudiation in other cases governed by federal law. Such an interpretation is not well founded. In a subsequent portion of the Triplett opinion, the Court expressly indicated that it was simply applying common law principles of res judicata:

FN3. See, e.g., n. 1, supra.

"We conclude that neither the rules of the common law applicablc to suceessive litigations concerning the same subject matter, nor the disclaimer statute, preclndes relitigation of the validity of a patent claim previously held invalid in a suit against a different defendant." 297 U.S. at 644 (emphasis added).

The specific "rule of the common law" upon which the Court based its holding in Triplett was the mutuality ***8** doctrine. As the court pointed out in Nickerson v. Pep Boys, 247 F. Supp. 221 (D. Del. 1965):
"The view that an adjudication of patent invalidity should not be binding upon a patentee in a second suit against a different defendant, undoubtedly has its roots in the theory that in order for a judgment to prevent relitigation of a point once

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decided, the estoppel of the judgment must be mutual. Since an adjudication of validity of a patent in one action would not be binding in a second action against a different defendant not in privity with the defendant in the first action, under the mutuality theory it would follow that a patentee in a second action should not be bound by an adjudication of invalidity in an earlier suit." 247 F. Supp. at 222.

Although Triplett v. Lowell may have accurately reflected the law as it existed in 1936, the mutuality doctrine has been discredited and repudiated since that time, and mutuality of estoppel is no longer a prerequisite to the application of res judicata by collateral estoppel in federal cases outside the field of patent litigation. [FN4] The "rules of the common law applicable to successive litigations concerning the same subject matter" have changed in this respect since 1936, and it is submitted that there is no sound basis for the assumption that the holling of Triplett v. Lowell bars the recognition of this development in the field of patent litigation, but permits its application to other cases governed by federal law.

FN4. See cases cited pp. 9–13, infra.

***9** II.

Judge Friendly, writing for the Second Circuit in 1964, stated that the "doctrine of the need for mutuality of estoppels, critized by Bentham over a century ago as destitute of any semblanee of reason, and as 'a maxim which one would suppose to have found its way from the gaming table to the bench,' ... has been much eroded in recent years." [FN5] Since Justice Traynor's landmark opinion in Bernhard v. Bank of America, 19 Cal. 2d 807, 122 P.2d 892) (1942), the requirement of strict mutUality of estoppel has been subjected to such universal scholarly criticism and such steady judicial erosion that the of Appeals of New York was prompted to announce that "[T]he 'doctrine of mutuality' is a dead letter." DeWitt v. Hall, 225 N.E.2d 195, 19S (1967).

FN5. Zdanok v. Glidden, 327 F.2d 944, 954 (2d Cir. 1964).

The Fifth Circuit hits rejected the mutuality doctrine in three recent decisions. In Seguros Tepegac, S. A. v. Jernigan, 410 F.2d 718 (5th Cir. 1969), a, diversity ease requiring an Erie prediction of how the Texas Supreme Court would rule on the question in the light of current judicial and scholars opinion, the court concluded that the Texas court would reject the outworn and discredited requirement of mutuality:

"We note, to begiu with, that an increasing number of courts have dispensed with the requirements of identity of the parties or mutuality of estoppel in situations auricle the party against ***10** whom the estoppel is applied has already had his 'day in court.' United States v. Webber, 3 Cir. 1968, 396 F.2d 381, 385, Ham v. Aetna Life Insurance 'Company, N.D. Okla. 1968, 283 F. Supp. 153; Musgrave v. Bronx Towing Line, Inc., S.D. N.Y. 1963, 219 F. Supp. 918, 920; Factor v. Pennington Press, Inc., N.D. Ill. 1963, 230 F. Supp. 906; Bernhard v. Bank of America Nat'l Trust & Sav. Ass'n 1942, 19 Cal. 2d 807, 122 P.2d 892. Such estoppel has been applied both 'offensively' and 'defensively.' Cf. United States v. Webber, supra, and Bruszewski v. United States, 3 Cir. 1950, 181 F.2d 419, 422, cert. denied, 340 U.S. 865, 71 S.Ct. 87, 95 L.Ed. 2d 632. See also Currie, Mutuality of Collateral Estoppel: Limits of the Bernhard Doctrine, 9 Stan. L. Rev. 281 (1957) and Currie, The Contributions of Robert J. Traynor–Civil Procedure: The Tempest Brews, 53 Calif. L. Rev. 25 (1965)." 410 F.2d at 727 (emphasis added).

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Subsequently, in Tampa Phosphate R.R. v. Seaboard Coastline R.R., 418 F.2d 387 (5th Cir. 1969), a case controlled by federal law, the Fifth Circuit reaffirmed its opinion that mutuality is not a prerequisite to the application of the doctrine of collateral estoppel under such circumstances:

"The form the issues may take in a subsequent proceeding is not material to the application of collateral estoppel so long as the issues were in fact determined in the original suit. 'In such cases, it is * * * immaterial that the two actions are based on different grounds, or tried on different theories, or instituted for different purposes, and seek different relief. * * *' American Jurisprudence, Judgments, Section 371; Hyman v. Regenstein, supra, at 510. Cf. Meyers v. Famous Realty, Inc., supra; I.C.C. v. Cowan, supra. Complete identity of the parties or mutuality of estoppel ***11** is also not required where the party against whom the estoppel is applied has already had his day in court. Seguros Tepeyac, S. A. Compania Mexicana de Seguros Generales v. Jernigan, 5 Cir. 1969, 410 F.2d 718; United States v. Webber, 3 Cir. 1968, 396 F.2d 381, 385." 418 F.2d at 400 (emphasis added).

Finally, in Rachal v. Hill, No. 29585, 5th Cir., December 3, 1970, another case governed by federal law, the Fifth Circuit said:

"The federal rule comports with the modern trend and thus it is clear that the requirements of mutuality need not be met for collateral estoppel to be applied in an action presenting a federal question in the courts of the United States." Slip Opn., p. 5-7 (footnotes omitted).

Other courts of appeals have also rejected the mutuality requirement in cases governed by federal law outside the patent field. In a leading case, Zdanok v. Glidden, 327 F.2d 944 (2d Cir.), cert. denied, 377 U.S. 934 (1964), involving the construction of a collective bargaining contract, Judge Friendly reviewed at length judicial and scholarly opinion on the question, and concluded that the much eroded doctrine of the need for mutuality of estoppel has no rational basis, and should be abandoned in cases governed by federal law. Judge Friendly said:

"We see no purpose in multiplying citations since it is recognized that the widest breach in the citadel of mutuality was rammed by Justice Traynor's opinion in Bernhard v. Bank of America ... Having explained why 'The criteria for determining who may assert a plea of res judicata differ fundamentally from the criteria for determining against whom a plea of res judicata may be ***12** asserted,' and that there is 'no compelling reason ... for requiring that the party asserting the plea of res judicata must have been a party, or in privity with a party, to the earlier litigation,' he said:

" 'In determiuing the validity of a plea of res judicata three questions are pertinent: Was the issued decided in the prior adjudication identical with the one presented in the action in question? Was there a final judgment on the merits? Was the party against whom the plea is asserted a party or in privity with a party to the prior adjudication?' " 327 F.2d at 954-55.

Similarly, the Third Circuit in Bruszewski v. United States, 181 F.2d 419 (3d Cir. 1950), concluded that the lack of mutuality no longer precludes the application of collateral estoppel. In that case, a longshoreman had suffered a personal injury while working upon a docked ship owned by the United States and serviced by a steamship company. In his first suit against the steamship company, it was decided that the company was not negligent and the ship was seaworthy. Thereafter the longshoreman sued the United States for his injury, predicating his action upon the

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same allegations of negligence and unseaworthiness asserted in the previous action against the steamship company. The court of appeals affirmed the district court's decision that the judgment in the first action was binding upon the plaintiff. The court said:

"The countervailing consideration urged here is lack of mutuality of estoppel. In the present suit Bruszewski would not have been permitted to take advantage of any earlier affirmative finding of negligence, had such finding been made in the Isthmian case. For that reason he argues that he should not be bound by a contrary finding in ***13** that case. But a finding of negligence in the Isthmian case Would not have been binding against the United States because the United States bad no opportunity to contest the issue there. The finding of no negligence on the other hand was made after full opportunty to Bruszewski on his own election to prove the very matter which be now urges a second time. Thus, no unfairness results here from estoppel which is not mutual. In reality the argument of appellant is merely that the application of res judicata in this case makes the law asymmetrical But the achievement of substantial justice rather than symmetry is the leisure of the fairness of the rules of res judicata." 181 F.2d at 421. [FN6]

> FN6. Numerous other cases outside the field of patent litigation decided by the courts of appeals have adopted the modern rule permitting the application of collateral estoppel notwithstanding a lack of mutuality. In United States v. United Air Lives, Inc., 216 F . Supp. 709 (D. Nov. 1962), aff'd as to collateral estoppel sub nom United Air Lines v. Wiener, 335 F.2d 379 (9th Cir. 1964), the district court. rejected the mutuality requirement in a multiple party air accident case, and cited a number of such decisions in the personal injury field:
> "The rule of non-necessity for mutuality has been followed in the Tenth Circuit in People of State of Colorado v. Ohio Casualty Ins. Co. et al. (1956), 232 F.2d 474-477; the First Circuit in Haddad v. Border Express, Inc. (1962), 300 F.2d 885, a personal injnry and wrongful death case; the Sixth Circuit in Davis v. McKinnon et al. (1959), 266 F.2d 870, a personal injury, ease which quoted extensively from Bernhard v. Bank of America, supra; and by the Third Circuit in Gibson v. United States (1954), 211 F.2d. 425, a personal injury suit in admiralty. In the Ninth Circuit in Hurley v. Southern California Edison Co. (1950), 183 F.2d 125 at 134, the Court approved the doctrine of Bernhard v. Bank of America, supra, but held it not applicable in that ease." 216 F. Supp. at 728.

Despite the widespread agreement reflected in the foregoing authorities that the mutuality doctrine has no rational basis and ought to be abandoned, in patent ***14** infringement cases the lower courts have felt constrained by the holding of Triplett v. Lowell to con tinue to apply the doctrine. They have done so reluctantly, however, and with frequent criticism and dissent.

The following excerpt from the concurring opinion of Judge Schnackenberg in Aghnides v. Holden, 226 F.2d 949 (7th Cir. 1955), typifies the criticism lodged against the Triplett rule:

"[The patentee] is entitled under existing law to another day in court where he may relitigate the same issue upon which he lost in the Goodrie case. The law does not require him to justify this indulgence. He is entitled to it because a suit testing the validity of a patent is not a proceeding in rem and hence Aghnides may litigate and relitigate again and again the question of validity of his patent as

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long as he selects a different defendant in each of the infringement suits which he files, thus avoiding the wholesome doctrine of res adjudicata. This queer result is one which we are unable to avoid. It is a. situation which is particularly abhorrent when considered against the backlog of untried cases which clogs our federal courts. The latter are cases where the litigant asks only for his day in court, not a plurality of days in court as Aghnides is entitled to under the existing law." 226 F.2d at 951.

The Third Circuit, which decided twenty years ago in Bruszewski v. United States, supra, that the mutuality doctrine no longer had any place in the law of collateral estoppel as applied to federal maritime litigation, recently labored through two appeals on the question in a patent case to finally conclude (by a vote of 2-1) that it was bound by the precedent of Triplett not to recognize that enlightened development in the ***15** law of collateral estoppel in patent cases. The first appeal was from a summary judgment granted on the basis of defendant's plea of collateral estoppel, notwithstanding the absence of mutuality. After reviewing the mutuality doctrine, the court indicated its agreement with the proposition that "[A] strict requirement of mutuality should not be continued in the field of patent litigation ..." Nickerson v. Kutschera, 390 F.2d 812, 815 (3d Cir. 1968).

The court remanded the case, however, because the plaintiff claimed that it should be permitted to present new evidence which was not presented in the prior litigation. In remanding , the court said:

"But in otherwise indicating our general approval of the opinion below we do more than endorse careful and enlightened decisions by the District Courts in our Circuit, we also affirm the general position of this court in Bruszewski v. United States, supra, that a strict rule of mutuality no longer has a proper place in the doctrine of res judicata." 390 F.2d at 815.

Upon remand, the district court concluded that the claimed new evidence did not establish the validity of the patent there involved, and that the evidence could have been presented at the original trial. Nickerson v. Kutschera, 295 F. Supp. 1 (D. Del. 1969).

On the second appeal, a two-judge majority of the court reversed the judgment of the district court in a per curiam opinion, and indicated that it would follow the rule announced in Triplett until this Court rules that a determination of the invalidity of a patent does not preclude successive suits upon the same patent against different defendants. Nickerson v. Kutschera, 419 F.2d 983 (3d Cir. 1969). In a strong dissent, Chief ***16** Judge Hastie indicated that he would adhere to the view expressed by the court in the first appeal, that:

"[E]xcept for considerations of unfairness shown in a particular ease, a party who as a plaiutiff had asserted a claim and had lost should not be heard again on the merits of that claim even in a second suit which he thereafter has instituted against a stranger to the origina] claim." 419 F.2d at 985.

Trial judges have also criticized and expressed dissatisfaction with the Triplett rule. The following excerpts from the transcript of comments by Judge Will made on the hearing of defendants' motion for a stay of the proceedings in Tcchnograph Printed Circuits, Ltd. v. Method Electronics Inc., No. 62 C 1761, N.D. Ill., pending this Court's review of the doctrine of Triplett v. Lowelt are illustrative:

"THE COURT: Let us suppose the Supreme Court were to hold, which it seems to me is quite possible, while that kind of holding is not binding on an alleged infringer

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since he is entitled to his day in court to present his reasons as to why the patent is invalid even though some other court in a suit involving some other alleged infringer has found it to be valid, that as against the patentee a determination of invalidity is the ball game. I always thought that ought to be the rule, incidentally. I don't see why, any reason why a. patent that is declared invalid should be relitigated against other alleged infringers in the hope that some court will end up holding it is valid, when you have got an opportunity to appeal the first declaration of invalidity and get it resolved.

"It is the only situation I know in which you can keep right on going notwithstanding a. declaration that what you own is worthless, you can keep right on going attempting to exploit it. Another one of the irrationalities I find in the Patent Office, which I find along with one or two others ...

***17** "Plus when you are talking about the invalidity of the patent it doesn't make any sense. If the patent holder has had full opportunity to present all of the contentions in support of the validity of the patent, the trial court found it invalid and an appellate court affirmed the declaration of the finding of invalidity, why should some other trial court start all over again attempting to determine whether it is valid or not.

"I can see where somebody says, well, but we didn't get a fair shot at that patent because we were not in that case and the declaration of validity should not be binding on us because we didn't have a chance to present the reasons why we think the patent is invalid. I can see some reasons why relitigation of a patent which had been declared valid, because in that situation the party who would be adversely affected by the estoppel wasn't present, didn't have a chance to make his case, didn't have his day in court; but the patent holder whose patent has been declared invalid had his day in court, had his chance to make his case. I just don't understand why he should have another chance in another court on another day with another defendant." [FN7]

> FN7. Judge Will's unreported comments extracted from certified transcript of proceedings on November 9, 1970 in Civil Action No. 62 C 1761, N.D. Ill. Similarly, in Blumcraft of Pittsburgh v. Kawneer Company, Inc., 166 U.S.P.Q. 265 (N.D. Ga. 1970), Judge Henderson stated:
> "Certainly with the heavy caseload in this district, it would he preferable not to have to relitigate the validity of the patent, which has been declared invalid by a circuit court, simply because a plaintiff-patentee later sues defendants not parties to the earlier action. As indicated by defendants, an impressive body of respected legal scholars have urged the solution to this problem is to apply the doctrine of res judicata, eliminating from this doctrine the requirements of mutuality.
> "However, the issue raised by defendants' motion for summary judgment is not a new one. Past authority compels that defendants' motion be denied." 166 U.S.P.Q. at 266.

***18** It is submitted that no logical reason supports the distinction which has been drawn between patent cases and other cases with respect to the continuing validity of the doctrine of mutuality of estoppel. In the years since Triplett was decided, the mutuality doctrine has been discredited by the lower federal courts in decisions which would be just as much in conflict with Triplett as a decision in a patent case rejecting that doctrine would be. It is perfectly clear that in Triplett the Court was merely expressing the general "rules of the common law applicable to successive litigations concerning the same subject matter" as they existed in 1936. At the time

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Triplett was decided, the doctrine of mutuality of estoppel was entrenched in the common law principles of res judicata. As Judge Friendly stated when holding the doctrine unsound in Zdanok v. Glidden in 1964, "We recognize that such a holding would have seemed impossible fifty years ago." 327 F.2d at 954. Today, however, as the authorities discussed above demonstrate, the doctrine of mutuality is a dead letter in all other cases governed by federal law, and this Court should now recognize that development in the field of patent litigation. [FN8]

> FN8. That the judge-made rules of law applicable to patent con troversies are equally as subject to continuing re-examination and change as those in any other area is well illustrated by the recent decision of this Court in Lear v. Adkins, 395 U.S. 653 (1969), in which the rule that a patent licensee may not challenge the validity of the licensed patent, established a mere 20 years ago in Automatic Radio Manufacturing Co. v. Hazeltine Research, Inc., 339 U.S. 827 (1950), was expressly overruled.

CONCLUSION

For the reasons stated it is respectfully submitted that the holding of Triplett v. Lowell that a determination of patent invalidity is not res judicata as against ***19** the patentee in subsequent litigation against a different defendant should no longer be adhered to.

U.S., 2004.
Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation

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For opinion see 91 S.Ct. 917, 91 S.Ct. 563, 91 S.Ct. 449, 91 S.Ct. 363, 91 S.Ct. 101

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Supreme Court of the United States.
BLONDER-TONGUE LABORATORIES, INC., Petitioner,
v.
UNIVERSITY OF ILLINOIS FOUNDATION, And JFD Electronics Corporation, Respondents.
No. 338.
October Term, 1970.
January 8, 1971.
On Writ of Certioriri to the United States Court of Appeals for the Seventh Circuit

Brief for the United States as Amicus Curiae

ERWIN N. GRISWOLD, Solicitor General, RICHARD W. McLAREN, Assistant Attorney General, L. PATRICK GRAY III, Assistant Attorney General, PETER L. STRAUSS, Assistant to the Solicitor General, HOWARD E. SHAPIRO, WALTER H. FLEISCHER, Attorneys, Department of Justice, Washington, D.O. 20530.

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***1** OPINIONS BELOW

The opinion of the court of appeals (App. 54-71) is reported at 422 F. 2d 769. The opinion of the district court (App. 71-90) is not reported.

JURISDICTION

The modified judgment of the court of appeals was entered on April 2, 1970. The petition for a writ of certiorari was filed on June 30, 1970 and was granted on October 19, 1970. Subsequently this Court requested the parties to discuss the following additional issues not raised in the petition for certiorari:

***2** "1. Should the holding of Triplctt v. Lowell, 297 U.S. 638, that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, be adhered to?

2. If not, does the determination of invalidity in the Winegard litigation bind the respondents in this case?"

The jurisdiction of this Court rests on 28 U.S.C. 1254(1).

QUESTIONS PRESENTED

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The United States will discuss the following question:

Whether Triplett v. Lowell, 297 U.S. 638, holding that a determination of patent invalidity does not bind the patentee in subsequent litigation against a different defendant, should be overruled or limited.

INTEREST OF THE UNITED STATES

The United States submits this brief amicus curiae because of its interest in the questions which this Court asked the parties to discnss, namely, whether and to what extent Triplett v. Lowell, 297 U.S. 638, should be adhered to. That case held that the defendant in an action for patent infringement may not plead as a defense that the patent he is charged with infringing was found invalid in prior litigation to which he was not a party, but must establish invalidity again, if he can, in his own right.

The suggestion that a final adjudication of patent invalidity may estop the patent holder from asserting his patent against any defendant raises issues of publie ***3** importance. On the one hand, through the constitutional provision for a patent system and the implementing statutes, the United States is committed to the preservation and enforcement of a system which rewards invention by conferring a legal monopoly over its exploitation for 17 years. On the other hand, it is of paramount public importance to prevent and correct the existence and exercise of unprivileged economic monopoly power. Graham v. John Dcere & Co. 383 U.S. 1. Both policies bear on the Triplett issue. As this Court itself has held, the public should not be denied access to unpatentable ideas through improper assertions of patent monopoly power. Sears, Roebuck & Co. v. Stiffel, 376 U.S. 225; Compco Corp. v. Day-Brite Lighting, 376 U.S. 234. Yet there are many who have concluded that patent litigation presents issues so complex and difficult of understanding to the nontechnical mind, e.g. Nyyissonen v. Bendix Corp., 342 F. 2d 531, 532 (C.A. 1), certiorari denied 382 U.S. 847, that a single judicial declaration of patent invalidity is insufficient to conclude the issue. E.g., Technograph Printed Circuits v. United States, 372 F. 2d 969, 977-978 (Ct. Cl.). Issues of fairness to the patent holder and of judicial economy are also at stake.

Various legislative solutions to this complex and difficult question have been suggested over the yearssome by those responsible for the administration of the patent system and some by those responsible for the administration of the antitrust statutes--but no unified legislative policy has yet emerged. We do not suggest, however, that for this reason the Court should ***4** withhold decision, or avoid any modification of Triplett pending legislative action. To the contrary, Triplett follows the doctrine of mutual estoppel, a common law creation subject to judicial change and, as we show in our argument, there has been no legislative action which should deter the Court from deciding the questions which it posed to the parties in this case.

STATEMENT

The Respondent University of Illinois Foundation instituted actions, against different defendants, in two separate United States District Courts, claiming infringement of patents for home television antennae. On June 23, 1967, the United States District Court for the Southern District of Iowa rendered a detailed and comprehensive opinion (A. 101-124) holding the so-called "Isbell Patent" invalid. University of Ill. Foundation v. Winegard Co., 271 F. Supp. 412 (S.D. Iowa). In an

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opinion revealing careful attention to the technical issues raised, the Court of Appeals for the Eighth Circuit affirmed. 402 F. 2d 125. Certiorari was denied on March 24, 1969. 394 U.S. 917.

The present suit, brought by the Foundation in the United States District Court for the Northern District of Illinois, claimed infringement by petitioner Blonder-Tongue Laboratories, Inc., of two patents: the "Isbell" patent which had been the subject of the Iowa litigation, and the "Mayes" patent. On June 27, 1968, the district court held that both the Isbell and Mayes patents were valid and infringed by petitioner (A. 71-90). Citing the decision of this Court in Triplett v. Lowell, supra, it expressly declined to follow the ruling of the District Court for the Southern District ***5** of Iowa in Winegard holding the Isbell patent invalid (A. 73). [FN1] On appeal, the Court of Appeals for the Seventh Circuit affirmed the district court's ruling with respect to the Isbell patent, but held that the Mayes patent was invalid for obviousness, 422 F. 2d 769. The Seventh Circuit, noting the inconsistency of its holding with the Eighth Circuit's ruling, stated that "It would seem sound judicial policy that the adjudication of that issue against the Foundation in one action where it was a party would provide a defense in any other action by the Foundation for infringement of the same patent." The Seventh Circuit added: "That, however, is not the law in this field," citing Triplett, 422 F. 2d at 772.

FN1. The decision of the Eighth Circuit in the Winegard case had not yet been rendered.

ARGUMENT

I. INTRODUCTION AND SUMMARY

The ruling in Triplett v. Lowell, 297 U.S. 638, that a determination of patent invalidity does not bind the patentee in subsequent litigation against the different defendant, rested primarily upon a legal doctrine of "mutuality of estoppel," which holds that a party to litigation may not assert that a prior judgment is binding upon his adversary unless the party asserting the judgment also is bound by it. That doctrine has been the subject of criticism and limitation in recent years. There is increasing recognition that there are circumstances in which no unfairness results from estoppel which is not mutual. E.g., Zdanok v. Glidden Co., 327 F. 2d 944 (C.A. 2); Graves v. Associated ***6** Transport, Inc., 344 F. 2d 894 (C.A. 4); Bruszewski v. United States, 181 F. 2d 419 (C.A. 3), certiorari denied, 340 U.S. 865; Bernhard v. Bank of America Natl. Trust & Savings Assn., 19 Cal. 2d 807, 122 P. 2d 892. In particular, it is held, there is normally no unfairness where no new facts appear; where the party asserting the estoppel is the defendant; where the plaintiff, being also plaintiff in the action asserted as estopping, had the incentive and opportunity fully to present his case; and where the threat of estoppel may serve to promote a joinder of parties which the potentially estopped party might otherwise find it in his interest to resist.

More controversial issues are presented by the question whether this development in the law generally ought to have application in patent cases. This question presents a public policy issue in addition to the usual questions of judicial economy and fairness to parties thought to be involved in the estoppel question. The public interest in limiting monopolies, on the one hand, and its interest in rewarding invention, on the other, have at least a potential for conflict. The highly technical nature of some patent litigation, often taxing the capacity of lay courts to decide with confidence, Nyyssoncn v. Bendix Corp., supra, suggests a particular

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need for caution and care in developing estoppel rules in the patent context. Nonetheless, we conclude that the difficulty of these issues is insufficient to warrant an uncritical continuing adherence to Triplett, particularly in the face of ***7** the changes in estoppel doctrine generally. Instead, claims of estoppel in patent cases should be considered on a case by case basis, giving due weight to any factors which would point to an unfair or anomalous result from their allowance. [FN2] In this case, the facts appear to indicate that an estoppel would not he unfair, and we suggest that the case be remanded to the lower court to determine, under the guidance of this Court's opinion, whether that is so.

> FN2. "From the course of decisions since Bernhard in 1942 it is clear * * * that the courts have been moving cautiously, attending closely to the circumstances and needs of the particular case and type of litigation, rather than applying sweeping generalizations or the broad principle that 'one clay in court' is always enough. If appraisal of the factors pertinent to the concrete case plainly teaches that the prior judgment should be conclusive mutuality may well be held unnecessary; but if that road is not the one clearly marked, relitigation will still be allowed." Technograph. Printed Circuits Ltd. v. United States, 372 F. 2d 969, 976 (Ct. Cl.).

Finally, we address the contention that Triplett has been adopted by legislative action, or is so uniquely a matter for legislative consideration that this Court ought not now to disturb it. Neither contention, in our view, is valid. The rules of estoppel are uniquely judicial in character, and Triplett never pretended to be more than a particular application of those rules to patent litigation. The legislative consideration of the estoppel rule in patent cases has been inconclusive, and has never reached such a stage as to amount to legislative adoption. It is thus entirely appropriate for the Court to act in the matter.

***8** II. THE DOCTRINE OF MUTUALITY OF ESTOPPEL HAS PROPERLY BEEN REJECTED IN THOSE CLASSES OF CASES WHERE IT PROMOTES NEITHER FAIRNESS TO THE PARTIES NOR JUDICIAL CONVENIENCE

At the time of the unanimous decision in Triplett, it was unquestioned that "the common law applicable to successive litigations concerning the same subject matter," 297 U.S. at 644, allowed a party to rely upon a Prior judgment as res judicata or collateral estoppel only if both he and the party against whom the plea was asserted were bound by the prior judgment. Bigelow v. Old Dowinion Copper Co., 225 U.S. 111, 131; Restatement, Judgments, § 93 (1942). This was the doctrine of "mutuality of estoppel," and it formed the basis of this Court's conclusion in Triplett that "an adjudication adverse to any or all the claims of a patent * * * is not res adjudicate and may not be pleaded as a defense" by a person who was not a party to the prior litigation. 297 U.S. at 642. For sound reasons, the doctrine of mutuality is now being sharply curtailed. In this section of the brief we examine that development without reference to the special considerations applicable to patent litigation, seeking to identify the factors promoting change and the factors contributing to the continuing application of the doctrine.

A. JUDICIAL LIMITATION OF THE DOCTRINE OF MUTUALITY OF ESTOPPEL

As early as 1843, the mutuality doctrine had been criticized by Bentham as destitute of any semblance ***9** of reason, and as "a maxim which one would suppose to have found its way from the ganming table to the bench." Bentham, Rationale of

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Judicial Evidence, in 7 Works of Jeremy Bentham 171 (Browning ed. 1843), quoted in Zdanok v. Glidden Co., 327 F. 2d 944, 954 (C.A. 2), certiorari denied, 377 U.S. 934. In 1942, the Supreme Court of California rendered a landmark decision rejecting the rule. Justice Traynor stated:

> The criteria for determining who may assert a plea of res judicata differ fundamentally from the criteria for determining against whom a plea of res judicata may he asserted. The requirements of due process of law forbid the assertion of a plea of res judicata against a party unless he was bound by the earlier litigation in which the matter was decided. * * * He is bound by that litigation only if he has been a party thereto or in privity with a party thereto. * * * There is no compelling reason, however, for requiring that the party asserting the plea of res judicata must have been a party, or in privity with a party, to the earlier litigation.
>
> No satisfactory rationalization has been advanced for the requirement of mutuality. Just why a party who was not bound by a previous action should be precluded from asserting it as res judicata against a party who was bound by it is difficult to comprehend.

Bernhard v. Bank of America Natl. Trust & Savings Assn., 19 Cal. 2d 807, 811–812, 122 P. 892, 894–95.

In the 28 years that have followed, federal and state courts have increasingly rejected the requirement ***10** of mutuality, and this has especially been the case where the prior decision is invoked defensively, against the plantiff bringing a suit which depends on an issue lie lost in a prior action in which he also was the plantiff. The Court of Appeals for the Fifth Circuit recently stated:

> Although many states still honor the rule of mutuality of estoppel, the modern trend has been to discard the rule and preclude a party from relitigating an issue decided against him in a prior action, even if the party asserting the estoppel was a stranger to the prior action. See DeWitt v. Hall, 19 N.Y. 2d 141. 278 N.Y.S. 2d 596, 225 N.E. 2d 195, 31 A.L.R. 3d 1035 (1967). The federal rule comports with the modern trend and thus it is clear that the requiremensts of mutuality need not be met for collateral estoppel to be applied in an action presenting a federal question in the courts of the United States.

Rachal v. Hill, C.A. 5, No. 29585, decided December 3, 1970, st. op. p. 5 (emphasis added).

The quoted statement accurately reflects the current state of the law in the lower federal courts; in wellreasoned decisions, several circuits have followed the Bernhard holding. See, e.g., Bruszewski v. United States, 181 F. 2d 419, 421 (C.A. 3) (per Hastie, J.), certiorari denied, 340 U.S. 865:

> This second effort to prove negligence is comprehended by the generally accepted precept that a party who has had one fair and full opportunity to prove a claim and has failed in that effort, should not be permitted to go to trial on the merits of that claim a second time. ***11** Both orderliness and reasonable the saving in judicial administration require that this be so unless some overriding consideration of fairuess to a litigant dictates a different result in the circumstances of a particular case.
>
> The countervailing consideration urged here is lack of mutuality of estoppel. In the present suit Bruszewski would not have been permitted to take advantage of an earlier affirmative finding of negligence, had such finding been made in the Isthmian case * * *. The finding of no negligence * * * was made after full opportunity to Bruszewski on his own election to prove the very matter which he now

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urges a second time. Thus, no unfairness results here from estoppel which is not mutual. In reality the argument of appellant is merely that the application of res judicata in this case makes the law asymmetrical. But the achievement of substantial justice rather than symmetry is the measure of the fairness of the rules of res judicata. [FN3]

FN3. Accord: Zdanok v. Glidden Co., 327 F.2d 944, 954-56 (C.A. 2), certiorari denied, 377 U.S. 934; Graves v. Associated Transport, Inc., 344 F.2d 894 (C.A. 4); Lober v. Moore, 417 F.2d 714, 717 (C.A.D.C.); Seguros Tepeyac, S.A. Compania Mexicana v. Jernigan, 410 F.2d 718 (C.A. 5), certiorari denied, 396 U.S. 905; Cauefield v. Fidelity & Cas. Co. of New York, 378 F.2d 876, 879 (C.A. 5), certiortari denied, 389 U.S. 1009; United States v. United Air Lines, 216 F. Supp. 709, 725-720, aflirmed as to res judicata, sub. nom. United Airlines v. Wiener, 335 F.2d 378, 404-405 (C.A. 9), certiorari dismissed, 379 U.S. 951; People v. Ohio Cas. Ins. Co., 232 F.2d 474 (C.A. 10); Davis v. McKinnon & Mooney, 266 F.2d 870 (C.A. 6); but ef. Mackris v. Murray, 397 F.2d 74 (C.A. 6) (no use of prior judgment against defendant in former action, under Bernhard rule, by plaintiff in second action); Falk v. United States, 375 F.2d 561 (C.A. 6) (reciting the mutuality rule while holding that the issues were not. the same in the two suits). On the basis of its unfavorable commentary upon the Triplett rule in the opinion now under review, it seems safe to assume that the Court of Appeals for the Seventh Circuit would join the courts rejecting the mutuality doctrine.

***12** There is also an unmistakable trend in the state courts toward abandoning the "mutuality" requirement; [FN4] of the state courts of last resort squarely faced with the issue in recent years, most have followed the Bcrnhard decision, at least where a plaintiff is suing twice on the same clain, and a decision against himn in the first suit is invoked as a defense. [FN5]

FN4. One of the few commentators to defend the mutuality doctrine previously stated that "Most state courts recognize and apply the doctrine of mutuality, subject to certain exceptions subsequently discused. And the same is true of federal courts, when free to apply their own doctrine". IB Moore's Federal Practice, ¶ 412, pp. 1803-1804. Bunt in the 1970 Supplement to his work, Professor Moore recognized that "Admittedly, the trend in the federal courts is away from the rigid requirements of mutuality advocated herein." Id., 1970 Cum. Supplement, p. 53. The same trend is evident in state courts; it no longer can be stated safely that most state courts adhere to the mutuality doctrine.

FN5. The Supreme Court of Oregon, in a well-reasoned opinion, was the most recent state court to adopt. Bernhard. Bahler v. Fletcher. 474 P.2d 329 (Ore. 1970); see also Pennington v. Snow, 471 P.2d 370, 376-77 (Alaska 1970); Ellis v. Crockett, 451 P.2d S14, 822 (Hawaii 1969); Pat Perusse Realty Co. v. Linqo, 249 Md. 33, 238 A.2d 100 (1968); Sanderson v. Balfour, 109 N.H. 213, 247 A.2d 185 (1968); Home Owners Fed. Savings & Loan Assn. v. Northwestern. Fire & Marine Ins. Co., 354 Mass. 448, 238 N.E. 2d 55, 57-59 (1968) (approving use of Bernhard by a defendant against a previously losing plaintiff); DeWitt v. Hall, 19 N.Y. 2d 141, 225 N.E. 2d 195 (1967) ("In New York "the 'doctrine of mutuality' is a dead letter"); Lustik v. Runkila, 269 Minn. 515, 131 N.W. 2d 741 (1964) Teitelbaum Furs, Inc. v. Dominion Ins. Co., 58 Cal. 2d 601, 375

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P.2d 439 (1962); Lucas v. Velikanlje, 471 P.2d 103 (Wash. App. 1970) (lower state appellate court held that State Supreme Court, would follow Bernhard in an appropriaitc casee; Howell v. Vito's Truckling & Exeacating Co., 20 Mich. App. 140, 173 N.W. 2d 777 (1969); Desmond v. Kramer, 96 N.J. Super. 96, 232 A.2d 470 (1967); Lynch. v. Chicago Tracnsit Authority, 62 Ill. App. 2d 220, 210 N.E. 2d 792 (1965); Coca-Cola Co. v. Pepsi-Cola Co., 36 Del. 124, 172 Atl. 260, 263 (Del. Super. 1934); Contra, Adamson v. Hill, 202 Kan. 482, 449 P.2d 536 (1969); Kayler v. Gallimore 269 N.C. 405, 152 S.E. 2d 518 (1967) (compare, however, Oroslan-Cullen Co. v. Crosland, 249 N.C. 167, 105 S.E. 2d 655); Suggs v. Alabama Power Co., 271 Ala. 168, 123 So. 2d 4 (1960); cf. Feinstein v. Edward Livingston. & Sons, Inc., 457 S.W. 2d 789 (Mo. 1970) (dictum; compare Taylor v. Sartorious, 130 Mo. App. 23, 108 S.W. 1089, 1094); Stillpass v. Kenton County Airport Bd., Inc., 403 S.W. 2d 46, 47 (Ky. 1966) (dictum). The vitality of the mutuality doctrine is uncertain in several other states. E.g., First Nat'l Bk of Cincinnati v. Berkshire Life Ins. Co., 176 Ohio St. 395, 199 N.E. 2d 863 (expressly leaving the question open).

***13** B. FAOTORS CONTRIBUTING TO THE JUDICIAL. LIMITATION

The basic force behind these judicial developments appears to be the desire, consistent with considerations of fairness, to limit relitigation of issues, particularly in an era of crowded dockets and long pre-trial delays. While due process would preclude use of an estoppel against a party who never had an opportunity to contest the issue, no such fundamental consideration forbids its use against one who has already lost the issue, albeit in another forum and against another party. It is true, as some have pointed out, that where the party asserting the estoppel is involved in the litigation for the first time, the litigation against him is not "harrassment," an "additional" expense, or the perpetuation of a controversy which he had previously thought to have settled; even without an estoppel, he has the advantages of knowing what his opponent's ***14** case will be and of arguing for a result in comity with the prior litigation. Technograph Printed Circuits, Ltd. v. United States, 372 F. 2d 969, 977 (Ct.Cl.); Moore & Currier, Mutuality and Conclusiveness of Judgements, 35 Tul. L. Rev. 301 (1960).

Nonetheless, litigation is expensive under any circumstances, not only to the parties but also to others who must wait their turn; and the expense itself makes it possible that at least potential defendants could be harassed by previously losing plaintiffs into making settlements to avoid lawsuits which perhaps they could not afford to defend. Where an issue has been decided in one case after a full and fair trial, the effort of a party to that litigation to secure the opposite result in subsequent litigation does suggest the logic of the gaming table, or else "a lack of discipline and of disinterestedness on the part of the lower courts, hardly a worthy or wise basis for fashioning rules of procedure." Kerotest Manufacturing Co. v. C-O-Two Co., 342 U.S. 180, 185. Particularly is this true if the multiple trials could have been avoided by the party against whom estoppel may be asserted, through joinder in a single trial. Semmel, Collateral Estoppel, Mutuality and Joinder of Parties, 68 Colum. L. Rev. 1457, 1475. In at least some circumstances, then, rejection of the mutuality requirement appears warranted.

1. "Offensive" v. "Defensive" use of estoppel

From the beginning, courts and commentators have appeared more willing to endorse rejection of the mutuality requirement where the party sought to be ***15** estopped was a repeating plaintiff, or at least plaintiff in the action claimed as stopping, than

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where he was a repeating defendant or defendant in the action first decided against him. Semmel, op. cit. supra at 1462; Currie, Mutuality of Collateral Estoppel, 9 Stan. L. Rev. 281 (1957); Note, 35 Geo. Wash. L. Rev. 1010 (1967); Mackris v. Murray, supra; Spettigue v. Mahoney, 8 Ariz. App. 281, 445 P. 2d 557. The plaintiff has the initiative and a choice of forum, of defendant, and, at least so far as service of process and venue permit, of joinder. In such circumstances, there is no worthy basis for an assumption that the first trial will not be a full or a fair one, in which part of the plaintiff's case must or may be withheld. No concept of fairness requires that a plaintiff be allowed to litigate the same claim over and over again so long as he can find new defendants. Indeed, permitting such behavior may encourage plaintiffs to avoid joinder of claims, with consequent wasting of judicial effort and time.

It does not follow that mutuality of estoppel must be required where the party sought to be estopped was the defendant in the action claimed as estopping. Professor Currie, who initially inclined to the view that mutuality should be insisted upon in such circumstances, op. cit. supra, has since acknowledged that that view was the product of concerns which can be accommodated in less sweeping fashion. Currie, Civil Procedure: The Tempest Brews, 53 Cal. L. Rev. 25 (1965). The central concerns is one of fairness--whether tie prior litigant had a full and fair opportnnity to present his case, and whether the application (or denial) ***16** of an estoppel may tend to promote a "wait-and-see" attitude on the part of persons who might have participated in the initial adjudication. In a number of important cases, courts have concluded that use of an estoppel against a former defendant was appropriate. E.g., Zdanok v. Glidden, supra; Graves v. Associated Transport, Inc., supra; United States v. United Air Lines, 216 F. Supp. 709, 725-729, affirmed as to collateral estoppel sub nom. United Air Lines v. Wiener, 335 F. 2d 379, 404-405 (C.A. 9), certiorari dismissed, 379 U.S. 951. Some of the factors involved in those cases bear examination.

2. Control over the circumstances of litigation

One of the factors referred to by those who would limit estoppel to use against repeating plaintiffs is the plaintiff's greater control over where and whom and whether he sues. However, a defendant subject to multiple suits may find that the first action against it is brought in an inconvenient forum, or one where it may seem that juries or courts are particularly receptive to claims of the nature being made. Especially if the potential plaintiffs share some commonality of interest, there may be a risk that a strategy of successive suits will be adopted.

* * * If the cases ultimately permit use of the doctrine offensively, then collateral estoppel would give non-party members of a plaintiff or defendant class all the advantages of a class action without the disadvantage of being bound by an adverse decision. [Weinstein, Revision of Procedure, Some Problems in Class Actions, 9 Buff. L. Rev. 433, 454 (1960)].

***17** But it is evident that these factors are not present in all cases, and where they are not, estoppel is appropriate.

Thus, in Zdanok, supra, there was essentially only one forum where the dispute--the meaning of a collective bargaining agreement-could be resolved. Although the defendant employer faced suit by a large number of its employees, it had acquiesced in the designation of one of the proceedings against it as a "test case." In these circumstances, the Company, although defendant, had assumed meaningful control over the course of litigation against it; it had chosen, and obtained, a full and fair

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judicial determination in one of the cases against it, and was properly bound by that decision in subsequent actions. Similarly, the United Air Lines litigation, supra, involved multiple suits against a carrier for injuries resulting from a crash. The main trial was in a United States District Court in California; others had hrought suit in Nevada. The latter volunteered to join the California litigation, and the defendant air line objected. Again, it had assumed a responsibility for non-joinder which warranted application of an estoppel on the issue of liability against it.

3. The fullness of the prior trial; the absence of new evidence

One of the frequent criticisms in the commentaries regarding rejection of the doctrine of mutuality is that it fails to recognize that parties may not present their entire case in litigation against a particular opponent, and thus cannot fairly be bound in subsequent litigation by the outcome. Indeed, it is claimed, by making ***18** each trial a possibly final one for the party faced with multiple litigation, an estoppel rule could increase as well as reduce the burden on the courts. The party will, of necessity, have to present his entire base each time around, however trivial the outcome of that particular litigation. Moore. & Currier, op. cit. supra, at 309-310.

The criticism has no validity as applied to plaintiffs bringing multiple litigation against a number of parties; it must be assumed that if a plaintiff feels strongly enough to bring suit, he will do whatever is required to win, and a contrary conclusion might only encourage the bringing of multiple litigation where it can be avoided by joinder. As to defendants against multiple plaintiffs, however, the criticism may be valid. The first plaintiff may present a claim which is particularly appealing for some special reason, or which involves so little money as not to warrant a full defense. Again, it would seem harsh to insist on such a defense from one who may know that other potential plaintiffs against him are waiting in the wings--plaintiffs who will continue to have a cause of action against him if he prevails, since they will not yet have had their "day in court." See Pennington v. Snow, 471 P. 2d 370, 377-78 (Alaska 1.970); Berner v. British Commonwealth Pac. Airlines, Ltd., 346 F. 2d 532 (C.A. 2), certiorari denied, 382 U.S. 983; Reardon v. Allen, 88 N.J. Super 560, 213 A. 2d 26 (1965) (no collateral estoppel where first judgment was for $657); compare Desmond v. Kramer, 96 N.J. Super. 96, 323 A. 2d 470 (1967).

***19** It is evident, however, that there are cases to which the criticism does not apply. The first suit may be of an importance that makes clear that a full defense was in fact made; the defendant may be unable to state any new evidence or contentions which it might make in a subsequent suit against it by other plaintiffs. In the United Air Lines litigation, for example, the first trial consumed fifteen weeks, and the air line conceded that it would have no new evidence to present on retrial. 216 F. Supp. at 728; see also, Nickerson v. Kutschera, 309 F. 2d 812 (C.A. 3), on remand, 295 F. Supp. 1, reversed 419 F. 2d 983; Note, 35 Geo. Wash. L. Rev. 1010, 1042 (1967). In Triplett itself the Court observed that on remand "the court must decide whether the issues of law and fact in the two cases are the same and, if they are not, it is not bound by the earlier decision." 297 U.S. at 648 (emphasis added); see Aghnides v. Holden, 226 F. 2d 949, 950 (C.A. 3); Technograph Printed Circuits, supra, 372 F. 2d at 979. There remains the possibility, of course, that a different court might interpret the same body of evidence differently; but that consideration returns us to the gaming table and is insufficient to preclude

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estoppel.

4. Settlement and compromise

Whenever a plaintiff obtains a judgment on all claims, whatever its size, the question of estoppel against him in a subsequent action is moot. But it does not follow that the question of estoppel against his defendant is settled, should the defendant face further suits. The judgment may be in the form of a ***20** consent decree, or so obviously a compromise resolving no issues that it would be improper to ascribe to it any estopping effect. United States v. International Bldg. Co., 345 U.S. 502, 504–505; cf. Lawlor v. National Screen Service, 349 U.S. 322.

It is improper to argue that all estoppel rule would inhibit settlements or consent judgments. Collateral estoppel bars relitigation only of issues actually litigated to final judgment. Lawlor v. National Screen Service, supra; see Developments in the Law--Res Judicata, 65 Harv. L. Rev. 818, 840 (1952). Even in the ease of a settlement after judgment, in lieu of appeal (when the justification for subsequent retrials is substantially less), a settlement may in terms or effect operate as a vacation of judgment. A consent decree, too, is between the paities only, and ordinarily admits no liability to the world at large. Cf. City of New York v. United States, 390 U.S. 715.

The problem of compromise verdicts, in which a jury discounts its doubts as to liability by reducing damages, is more difficult. Like the defendant who does not fully defend a case of minor importance, p. 18 supra, a defendant who is subject to an apparent compromise verdict cannot fairly be held bound by that result in all circumstances, against all corners. But such verdicts can often be identified; more important for the question here, perhaps, they are likely to be delivered only in a limited class of cases, such as negligence actions. "Compromise" over the meaning of a contract clause is not a likely outcome; other issues, like patent validity, are more often tried to the ***21** court than to a jury. It would be excessive to foreclose the use of estoppel against all repenting defendants merely on the chance that particular verdicts might constitute compromise.

5. Inconsistent verdicts and the encouragement of piecemeal litigation

Making the estoppel rule applicable to defendants might be thought to encourage piecemeal litigation and a wait-and-see attitude on the part of potential plaintiffs in still another respect. Even though the defendant might be successful in the first few suits against it, those outcomes do not bind persons not yet associated with the suit. There remains the chance that the defendant will lose and, at that point, an assertion of estoppel will become available against it. The problem is a real one. Rules should perhaps be developed that would compel joinder of plaintiffs in such a way as to avoid such tactics. See Semmel, op. cit. supra at 1475. As in the case of the issue of control over the course of litigation--perhaps more so, since an inconsistency of verdict has already occurred--an estoppel ought not to be found it this factor suggests it unfair to do so. But the possibility is a hypothetical one, hardly sufficient to war rant foreclosing estoppel in all cases against once-defeated defendants. Zdanok, supra, 327 F. 2d at 954–956.

6. Full and fair opportunity to defend

Another criticism sometimes made of the estoppel rule is that it will not reduce litigation, but simply change the issues. Rather than the substantive question ***22** between the parties then on trial, it is said, the emphasis will be on the prior

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judicial proceedings relied on as estopping. Moore & Currier, op. cit. supra. The potentially estopped party will devote all his energy to showing why the former judgment was not reached after a full opportunity to litigate, or is otherwise unfairly viewed as estopping.

It is because there are so many more such issues where multiple-occasion defendants are concerned that Currie initially suggested that only "defensive" use of estoppel, against multiple-occasion plaintiffs, be permitted. 9 Stan. L. Rev. at 322. He withdrew that suggestion, however, when experience showed this not to be a substantial problem, 53 Cal. L. Rev. at 37, and in fact those courts permitting estoppel have experienced no such difficulty. Zdanok, suapra; United Air Lines, supra; Nickerson, supra, 295 F. Supp. 1. It is not a question of collateral review of the prior proceedings, for it is not the fairness of the trial which is in question. Rather it is the fullness of the opportunity for determination of the issue as to which estoppel is sought. Whether there was such an opportunity can fairly readily be determined, with considerably greater economy than retrial of the issue.

The factors discussed are not thought to he exhaustive. [FN6] An estoppel will not be applied even in circumstanees ***23** of mutality "if injustice would result." Restatement, Judgments § 70 (1942); Commissioner v. Sunnen, 333 U.S. 591, 600; Technograph Printed Circuits, supra, 372 F. 2d at 977. These factors do suggest, we believe, that limitation of the doctrine of mutuality of estoppel even as to those who face multiple suits as defendant could be brought about. without eliminating "the principles of justice and equity inherent in deternining whether collateral estoppel should bar a party from relitigating" issues in a particular situation. Howell v. Tito's Trucking and Excavating Co., 20. Mich. App. 140, 173 N.W. 2d 777. It is particularly hard to see how an inflexible rule allowing relitigation of issues by a plaintiff so long as new defendants can be found is in any way a just or desirable rule. Ahnost inevitably, because the choice to litigate is his, it must be concluded that he has had a full and fair opportunity at trial; refusing estoppel encourages the wasteful and potentially oppressive practice of piecemeal litigation; and relatively few cases can be imagined in which equitable considerations would warrant overriding an estoppel rule. If the prior litigation necessarily decided an issue he seeks to relitigate, save for extraordinary circumstances an estoppel would be proper. While the case of the multipleoccasion***24** defendant is more difficult, it is not in our view insuperable; it is in any event not presented here.

> FN6. In one case, for example, an estoppel was denied against a defendant whose first loss had been in an action for injunetion, in which he had no right to a. jury trial. Rachal v. Hill, supra. Similarly, one can imagine cases in which even a plaintiff ought not to be found estopped by an initial defeat-for example, as petitioner urges on another point here, if he was deprived of key testimony by the refusal of a trial court to grant a continuance during the unavoidable absence of a witness. While that refusal might not warrant reversal of an adverse judgment in the particular. action, it could nonctheless raise questions about the fullness of the opportunity for trial, and hence the justice of an estoppel in a suit against strangers to that proceeding.

III. AWHILE MANY OF THE SAME FACTORS WHICH HAVE CAUSED MODIFICATION OF THE DOCTRINE OF MUTUALITY OF ESTOPPEL, ARE PRESENT IN PATENT LITIGATION, PUBLIC POLICY

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CONSIDERATIONS SUGGEST THE NEED FOR CARE IN EXTENDING THE MODIFICATION TO SUCH LITIGATION

The discussion above makes plain that Triplett no longer reflects estoppel law in general. [FN7] The issue ***25** which remains is whether patent law ought to be an area of special treatment, in which for reasons of publie policy the general modifications of the mutuality doctrine should not be made. The general practice in lower federal courts has been to continue to follow Triplctt, [FN8] usually without any considered discussion of the function of mutuality of estoppel in patent law. But see Technograph Printed Circuits, supra, 372 F. 2d at 977-978. One judge has gone so far as to characterize the Triplett rule as "queer" and "particularly abhorrent when considered against the backlog of untried cases which clog our federal courts." Aghnides v. Holden, 226 F. 2d 949, 951 (C.A. 7) (concurring opinion). But most appear to have concluded that "such change as may be desirable in this exception in patent cases to the general rule of collateral estoppel should be made by the Supreme Court itself or by Congress, which so far has refused to change the rule in Triplett." Nickerson v. Kutschera, 419 F. 2d 983, 984 (C.A. 3) (Hastie, J. dissenting).

> FN7. One district court has persuasively shown that, even at the time. the decision was broader than required by the two principal cases on which it relied, Mast, Foos & Co. v. Stover Manufacturing Co., 177 U.S. 485 and Sanitary Refrigerator Co. v. Winters, 280 U.S. 30. Nickerson v. Pep Boys--Manny, Moe & Jack, 247 F. Supp. 221, 221-222 (D.Del.). Another decision relied on in Triplett, United States v. Bell Tel. Co., 128 U.S. 315, 372, recited the difficulties caused by the mutuality doctrine, as a justification for permitting the United States to sue to void patents obtained by fraud:
> "* * * [T]he right given to the infringer to make this defense is a right given to him personally, and to him alone, and the effect of a successful defense of this character by one infringer is simply to establish the fact that, as between him and the patentee, no right of action exists for the reasons set up in snch defense. But the patentee is not prevented by any such decision from suing a hundred other infringers, if so many there may be, and putting each of them to an expensive defense, in which they all, or some of them, may be defeated and compelled to pay because they are not in possession of the evidence on which the other infringer succeeded in establishing his defense. On the other hand, the suit of the government, if successful, declares the patent void, sets it aside as of no force, vacates it or recalls it and puts an end to all suits which the patentee can bring against anybody. It opens to the entire world the use of the invention or discovery in regard to which tho patentee had asserted a monopoly.
> This broad and conclusive effect of a decree of the court, in a suit of that character brought by the United States, is * * * so much more beneficial, and is pursued under circumstances so much more likely to secure complete justice * * * that it is impossible to suppose that Congress, in granting this right. to the individual, intended to supersede or take away the more enlarged remedy of the government."

> FN8. Patent cases following Triplett are listed in Technograph Printed Circudit, Ltd. v. United States, 372 F. 2d 969, 973-974 (Ct. C.).

We discuss below the question of congressional action. ***26** Here, we set out the

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policy considerations which, in our view, suggest the need for caution and for avoiding sweeping generalities in extending the general modification of collateral estoppel doctrine to the question of patent validity.

A. CONSIDERATIONS SUPPORTING ESTOPPEL OF A PATENT HOLDER ONCE HIS PATENT HAS BEEN HELD INVALID

A patent is a legal monopoly. Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225, 229-30. It is anomalous that once it has been found invalid after a full and fair judicial proceeding, its holder may continue to reap the benefits of the monopoly, and thus to deter both the free use of his device and future invention in the field. Ibid; Compco Corp. v. Day-Brite Lighting, 376 U.S. 234. Yet the economics of patent litigation and the allocation of burden on the invalidity question are such that the ability to continue bringing infringement suits, after a declaration of invalidity, assures that many holders of a patent held invalid will continue to benefit from the patent.

The costs of infringement litigation are well known. See Hearings before Subcomm. on Patents, Trademarks, and Copyrights of Sen. Comm. on the Judiciary, on Patent Law Revision, 90th Cong., 1st Sess. (1967), p. 103:

> Another problem that faces the businessman today is the matter of the high cost of prosecuting applications and asserting them against infringers. The businessman can be subjected to considerable harassment as an alleged infringer. Even in cases where he feels strongly that the ***27** patent would ultimately be held hivalid, when he considers the hundreds of thousands of dollars in complex cases that could be involved in defending a suit, he may conclude that the best course of action is to settle for less to get rid of the problem. These nuisance settlements, although distasteful, are often, under the present system, justified on pure economics.

Another witness at these hearings estimated that the average cost of litigating a patent suit was $50,000. Id., at 616. See also Lear, Inc. v. Adkins, 395 U.S. 653, 669; Picard v. United Aircraft Corp., 128 F. 2d 632, 641 (C.A. 2) (concurring opinion).

These costs often preclude effective defense by alleged infringers. As Judge Hastie said in dissent in Nickerson v. Kutschera, 419 F. 2d 983, at 988 n. 4:

> Unless holdings of invalidity are given some preclusive force, the expensive prospect of defending an action for infringement brought under even an invalidated patent may suffice to force alleged infringers to pay royalties rather than challenge the patent as a defense * * *. The result is that invalidated patents may have nearly as much force as valid ones, and the publie may have to pay "tribute to would-be monopolists" even after a holding of invalidity. [FN9]

> FN9. One study found that previously invalidated patents were reasserted in 62 suits between 1949 and 1958. It also reported that most suits of this kind were terminated without a second adjudication, "An Analysis of Patent Litigation Statisties," Staff Report of the Subcom. on Patents, Trademarks, and Copyrights of the Sen. Com. on the Judiciary, 86th Cong., 2d Sess., S. Res. 240, p. 19. Apparently, the defendant accepted a license under the previously invalidated patent rather than bear the cost of litigation.

***28** Not only must the public pay royalties; competitors in the same field of endeavor may have to meet on an unequal basis. Some may have obtained a determination of patent invalidity; others may have failed to do so; still a third

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may have been forced to settle. The three groups incur substantially different costs for using the same device.

While such results cannot always be avoided, as where the challenged patent is at first upheld, uncritical adherence to Triplett tends to promote them. For the expense of defencding infringment actions may make it as likely that an invalid patent will continue to pay economic dividends as that an erroneous holding of invalidity will subsequently be overcome. The Technograph Printed Circuits litigation is a good example. The patent in question was ruled invalid by the Court of Appeals for the Fourth Circuit, Technograph Printed Circuits, Ltd. v. Bendix Aviation Corp., 327 F.2d 497, affirming 218 F. Supp. 1 (D.Md.), certiorari denied, 379 U.S. 826, and a similar recommendation has been made by the Comnmissioner in the pending Court of Claims litigation, which has been on that court's docket for more than eight years. Yet at least ten other suits on the patent are now pending in other district courts, see 372 F.2d at 971, including a class action in the Northern District of Illinois involving some 225 defendants. Technograph Printed Circuits, Ltd. v. Method Electronics, Inc., et al., Civ. No. 62 C 1761; see id., 356 F.2d 442 (C.A. 7), certiorari denied, 384 U.S. 950.

The factors which brought about modification of ***29** the mutuality doctrine are particularly strong as applied to the typical infringement suit. In such suits, the patent holder is plaintiff, with attendant choice of whether, when, where, and whom to sue. The issues presented, technical as they are, involve few risks of the considerations which have sometimes been thought to warrant caution in recognizing an estoppel against a prior defendant. The patent holder could be said to have something of a head start in defending the validity of the patent, since lie has already had to establish patentability to the satisfaction of the Patent Office. The breadth of interpretation he places on his claims in the course of seeking to show infringement is also a matter subject to his control.

Perhaps the strongest argument for estoppel arises, however, from the statutory presumption that the patent is valid. 35 U.S.C. 282. [FN10] The estoppel of former plaintiffs from relitigating in non-patent suits is closely associated with their initiative in bringing suit; they nonetheless have the burden of establishing their right in those suits, and the estoppel is recognized even though the former judgmnent might be said to be only that the plaintiff failed to carry his burden--not that he had no right. In infringement actions, the patent holder not only has the initiative, but ***30** the comfort of knowing that, on the validity issue, it is his opponent who hears the burden of proof. [FN11]

FN10. The statutory presumption applies in all contexts in which the issue of validity may arise: an infringement action under 35 U.S.C. 281; a suit for royalties, Lear, Inc. v. Adkins, 395 U.S. 653; a declaratory judgment action by one fearing an infringement suit, Kerotest Mfg. Co., supra; and, conceivably, an anti-trust suit charging monopolization through assertion of a patent known to be invalid, cf. Walker, Inc. v. Food Machincry, 382 U.S. 172.

FN11. Although the patent holder does not have the initiative in a suit for declaratory judgment, Kerotest Mfg. Co., supra, such a suit could be brought only on a showing of the basis for fearing suit, and if the patent holder had earlier begun infringement actions his choice of venue would control. Ibid.

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Moreover, this presumption is effectively reinforced if the patent holder has prevailed in previous challenges to the patent's validity. Supported by such decisions, and the presumption of Section 282, he can move at the close of the defendant's evidence to strike the defense of invalidity for failure to carry the burden. The previous adjudication would seem to make success on such a motion likely in most cases. Thus, armed both with the initiative of suit and the placing of the burden of proof on the opposing party, the patent holder is poorly situated to complain that the first suit he chooses to prosecute involves an insufficient record or presentation.

B. CONSIDERATIONS ARUING AGAINST ESTOPPEL OF A PATENT HOLDER ONCE HIS PATENT HAS BEEN HELD INVALID

The principal considerations which have been thought to counsel against estoppel in patent validity litigation are summaried in the Court of Claims' Technograph Printed Circuits decision--a decision which nonetheless sees to recognize a flexibility in application of the Triplett doctrine to permit the avoidance of inequities or abuses, supra, n. 2:

For patent litigation there is a special reason why relitigation is not automatically banned ***31** as needless or redundant, and why error should not be perpetuated without inquiry. Patent validity raises issues significant to the public as well as to the named parties. Sinclair & Carroll Co. v. Interchemical Corp., 325 U.S. 327, 330 * * *. It is just as important that a good patent be ultimately upheld as that a bad one be definitively stricken. At the same time it must be remembered that the issue of patent validity is often "as fugitive, impalpable, wayward, and vague a phantom as exists in the whole paraphanalia of legal concepts * * *. If there be an issue more troublesome, or more apt for litigation than this, we are not aware of it." Harries v. Air King Products Co., supra, 183 F. 2d at 162 (per L. Hand, C.J.). Because of the intrinsic nature of the subject, the first decision can be quite wrong, or derived from an insufficient record or presentation. [372 F. 2d at 977-978]

For the reasons set out above, pp. 17-19, we believe that the question of "insufficient record or presentation" is no proper basis for withholding estoppel in infringement actions, brought on the patent holder's initiative, save in the most unusual circumstances, n. 6 Supra. The remaining considerations, however, warrant more careful attention.

The constitutional provision for a patent system argues against the adoption of a rule which in some sense rests on a presumption that patents are aberrant, or usually invalid. The patent system embodies an affirmative policy to reward invention. That is reflected in the statutory presumption of patent validity; it ought also to be reflected, it may be contended, in a care that the law not seem to favor the invalidation of ***32** patents generally. It is as important that sound patents and invention be rewarded as that the public be protected against patent monopolies based on insufficient invention. Both are strong public policies.

From this it would not necessarily follow that because a declaration of patent validity is not binding against persons not party to the litigation, a declaration of invalidity ought not to be. But there is at least reason to be sure that any declaration of invalidity is fully warranted before it is given conclusive effect in other litigation. For the fact is that courts do disagree regarding the validity of particular patents. [FN12] And in ***33** light of the public policy involved, the mere convenience of an estoppel rule in ending litigation is not sufficient in itself to

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warrant the conclusion that a declaration of invalidity in the first litigation involving a patent [FN13] ought to be conclusive.

> FN12. Litigation on the log-periodie antenna involved in the instant litigation is a good example. Litigation on the Aghnides patent No. 2,210,846 is another. In the four suits involving the Aghnides patent, it was twice held valid in North Carolina courts, Aghnides v. The Meyer Co., 117 F. Supp. 839 (M.D.N.C. 1954); S. H. Kress & Co. v. Aghnides. et al, 246 F. 2d 718 (4th Cir. 1957), cert. denied, 355 U.S. 889 (1957), and twice invalid in Illinois courts, Aghnides v. Goodrie et al, 210 F. 2d 859 (7th Cir. 1954), Aghnides et al v. Holden et al, 226 F. 2d 949 (7th Cir. 1955), once in the latter count over the same prior art evidence considered by the Patent Office Board of Appeals and the North Carolina courts.
> The Tatko patent No. 2,693,926 was held invalid by a New York district court, 134 F. Supp. 4 (1955), the judge stating that the patent was unbelievably simple. The Court of Appeals affirmed the holding of invalidity, 233 F. 2d 9 (2d Cir. 1956), cert. denied 352 U.S. 917 (1956). Tatko then sued a different defendant in Vermont, and the District Court found the patent valid and infringed, 157 F. Supp. 277 (1957), although the Court of Appeals reversed by a divided vote, 270 F. 2d 571 (2d Cir. 1959).
> Patent No. 2,133,642 was held invalid by the District Court, 159 F. Supp. 944 (1958) and affirmed by the Court of Appeals, 280 F. 2d 278 (1st Cir. 1960). The patent was subsequently held valid by the 5th Circuit Court of Appeals, 307 F. 2d 790 (5th Cir. 1962). The patent was then sued upon in a Delaware district court and found invalid, 297 F. 2d 323 (3d Cir. 1961).
>
> FN13. The case were a patent is at first upheld, and then declared invalid, is more complex. See p. 21 supra.

One reason for the courts' disagreement is undoubtedly the technical nature of many patent questions. Although this Court stated in Graham v. John Deere Co., 383 U.S. 1, 18, that patent questions are no more difficult than "those encountered daily by the courts in such frames of reference as negligence and scienter," questions of reasonable care and intention present issues of human experience, regarding which the fact-finder can draw on his own experience. To decide a question of obviousness, on the other hand, may require a technical understanding that few ordinarily achieve. American trial judges are not usually scientists or engineers-qualifications that are widely believed necessary for practice at the patent bar. Indeed, it is not unknown for a court to admit its bewilderment with technical issues, and rest its decision fundamentally on issues of credibility and the like--a dubious ground on which to base a finding of invalidity that is to be binding in all contexts. Nyyssonen v. Bendix Corp., 342 F. 2d 531, 532 (C.A. 1), certiorari denied, 382 U.S. 847. All courts may not be so frank, but inevitably in an era of growing technological complexity many face the same difficulty. In some cases, a ***34** careful and complete consideration of the issues, marked by apparent understanding of technical questions, may be ample to warrant attributing estopping effect to an adjudication of invalidity. Cf. Nickerson v. Kutschera, supra, 419 F. 2d at 986 (Hastie, C. J., dissenting). In view of these difficulties, however, a flat rule of estoppel would not be warranted.

Objection is also made to general revision of the Triplett rule on the ground that it would be largely unnecessary. [FN14] The patent code already embodies provisions

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which arguably reduce the possibilities of harrassment through successive litigation. Section 285 allows a court to allow reasonable attorney fees to a prevailing party "in exceptional circumstances," which would include suit on a patent previously held invalid and as to which the second court can find no reasonable argument for validity. Tidewater Patent Devel. Co. v. Kitchen, 371 F. 2d 1004, 1013 (C.A. 4). Under 35 U.S.C. 288, a patentee forfeits his right to recover his costs even as to valid claims of a patent if he does not disclaim any invalid claims before bringing ***35** suits. The expense of patent litigation it is said, renders both of these provisions inhibitors of worthless suits.

> FN14. Those who oppose revision of the Triplett doctrine also suggest another source of conflict: the varying attitudes among different courts towards validity questions. See Calrert, The Encyclopedia of Patent Practice and Invention Management, 20–25; Hearings on the American Patent System before the Subcommittee on Patents, Trademarks and Copyrights of the Senate Committee on the Judiciary, 84th Gong., 1st Sess., 176–185; Staff Report, id., 86th Cong., 2d Sess., "An Analysis of Patent Litigation Statistics"; and see Kayton, "The Crisis of Law in Patents" (Patent Resolrces Group, Washington, D.C., 1970). This is an argument of which this Court has previously refused to take cognizance. Kerotest Mfg. Co. v. C–O–Two Co., 342 U.S. 180.

In addition to these general considerations, there is reason to be concerned in particular cases as to the proper scope of an asserted estoppel. It is common for the scope of litigated claim to be limited or expanded by the patentee in light of the prior art and, appropriately or inappropriately, the nature of the infringing device. A claim could be interpreted so broadly against a first infringer that it is held invalid, and yet it might be agreed that a narrower interpretation, for example application against a pure copier, would be sustained. Even though it might be agreed that the patentee should be estopped from asserting the overbroad interpretation of his claim, that estoppel ought not to run against all interpretations of the claim. In such a ease, perhaps it can be said that the issues are not identical to those previously adjudicated, and hence collateral estoppel would not apply irrespective of the mutuality doctrine; the patentee who loses his first suit may attempt to show that a second presents narrower issues and thus escape an estoppel that would otherwise apply. [FN15]

> FN15. The problem may also be alleviated to some degree by the reissue provision, 33 U.S.C. 251.

C. CONCLUSION

Since a unified legislative policy on patent estoppel has not yet emerged, we do not suggest any final resolution to the Triplett issue here. As a general matter, ***36** however, we support the modification of the doctrine of "mutuality of estoppel" which began with the Bernhard decision. While the application of that modification to patent questions is not without difficulty, we submit that it is at least appropriate to hold that the Triplett doctrine is sufficiently flexible to deal with the obvious waste motion of cases which present identical issues of law and fact 297 U.S. at 648; cf. Technograph Printed Circuit, supra 372 F. 2d at 976. And even that limited principle suggests that the present case may be an appropriate one for an estoppel.

Here, the respondent was twice the plaintiff in infringement actions; it chose the

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forum and the defendant; it had the initiative to sue. The first proceedings were evidently extensive; nothing in the record of which we are aware suggests any discovery by respoudent of new evidence, or improper exclusion of evidence by the court. Those proceedings resulted in a thorough and well-reasoned opinion, revealing evident grasp of teclmical detail; on review in the court of appeals, the same competence and care were evident.

In these circumstances, few if any of the considerations arguing against estoppel come to bear; those which argue for it are particularly strong. Whatever the resolution of the estoppel question in more difficult cases, here there appears to be little doubt. While it might be appropriate to remand the case to permit the respondent to supplement the record to show how estoppel would be inequitable-for example, whether there had been any narrowing of claim, or whether ***37** it could establish some equitable reliance on the existing Triplett rule--we believe that this case should be reversed. [FN16]

> FN16. Res Judicata and collateral estoppel are affirmative defenses that ordinarily must be pleaded, which defendant did not do here. See F.R. Civ. P. 8(c). However, the purpose of that requirement is to give the plaintiff notice of the defense so that he can meet it. Accordingly, where the defense necessarily would have failed because of a controlling decision of this Court, and where the facts giving rise to such a defense-- the presence of two suits upon the same patent--are readily noticed by the Court, the requirement of a pleading should not be viewed as precluding this Court from passing upon the issue. Cf. W. E. Hedger Transp. Corp. v. Ira. S. Bushey & Sons, Inc., 186 F. 2d 236, 237 (C.A. 2).

IV. THE RULE OF TRIPLETT V. LOWELL HAS NOT BEEN ADOPTED BY CONGRESS, AND THIS COURT SHOULD DECIDE ITS CONTINUED VALIDITY

A. It might be argued that because. Congress has not modified Triplett v. Lowell in the 35 years it has been on the books, it has in effect sanctioned successive suits to enforce patents previously held invalid. But our review of the available legislative materials, in connection with both the 1952 revision of the Patent Code and recent legislative proposals for in rem determinations of patent validity, shows that Congress has never made a legislative determination in this area. This Court has often pointed out that Congressional silence is an extremely weak reed on which to rest an inference of legislative approval. Boys Market v. Clerks Union, 398 U.S. 235, 241-242. "The silence of Congress and its inaction are as consistent with a desire to leave the problem fluid as they ***38** are with an adoption by silence of the rule of [previously decided] cases." Girouard v. United States, 328 U.S. 61, 70.

In Girouard the Court concluded that three previous decisions construing the citizenship oath in the Naturalization Act did not state the correct rule of law. The government argued, however, that the Court could not overrule those decisions because Congress had adopted them. It pointed to the many legislative proposals to change the principle of the decisions, all of which had died in committee, and to the fact that Congress had re-enacted the oath without change even though it generally revised the naturalization laws. The Court held, however, that such legislative history did not constitute approval by Congress of the questioned decisions and that its silence could therefore not be taken as an adoption. Accord, Helvering v. Hallock, 309 U.S. 106, 119-120; Boys Market v. Clerks Union, supra.

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There is a striking parallel between Girouard and this case, particularly as reflected in the history of the 1952 revision of the Patent Code. There the rule permitting successive enforcement of patent claims previously held invalid was adverted to in connection with changes proposed in disclaimer procedure. [FN17] But no action amounting to legislative adoption was taken.

> FN17. Disclaimer is the practice by which a holder of a multiclaim patent may file with the Patent Office a disavowal of one of the claims upon learning that it is invalid. At common law, if one of several claims was invalid, the entire patent was unenforceable. To relieve patent holders from this harsh rule Congress in 1837 created a patent disclaimer procedure. 5 Stat. 117, R.S. 4917, 4922. Under this procedure a patentee who had innocently and without fraudulent intent claimed more than he should have could without unreasonable delay formally disclaim the invalid portion of his patent upon learning of its invalidity. Thereafter the remainder of his patent could be enforced by the courts notwithstanding the common law rule. Triplett v. Lowell, supra, was a disclaimer case. The procedure was quite complex because of difficulties in determining when the patentee could be said to have learned that lie had claimed too much; and what constituted unreasonable delay. In addition, administrative problems resulted from attempts to disclaim less than an entire claim. These problems continued to plague the courts, patentees and the Patent Office until the disclaimer statute was revised in 1952, as explained within.

***39** For many years proposals had been submitted to Congress to eliminate the unfairness and complexities Which had developed in disclaimer practice under the Patent Code. Indeed, in 1933 the American Bar Association suggested a statute to relieve these complexities which would have provided that a patentee's rights under a claim held invalid would not be affected or prejudiced except as to the parties to the suit or their privies. [FN18] Such a statute, of course, would have definitively codified the doctrine of mutuality of estoppel as applied to patents. The contemporary judicial acceptance of the mutuality principle, however, as reflected in this Court's decision in Triplett v. Lowell, apparently reduced pressures for this solution. But continued confusion over disclaimer practice finally resulted in incorporation of proposals for its improvement into the comprehensive revision of the ***40** patent laws which culminated in the present Patent Code of 1952. 66 Stat. 792, 35 U.S.C. 1-293.

> FN18. 15 J.P.O.S. 798: "A judgment or decree holding one or more claims of a patent invalid shall not affect the validity of, nor prejudice any rights under, any other claims of said patent; and shall not affect the validity of, nor prejudice any rights under the claims held invalid except as to the parties to the suit in which such decree is entered, or their privies."

In testimony on the bill which became the 1952 law, H.R. 3760, 82d Cong., 1st Sess., Mr. P. J. Federico, Patent Examiner-in-Chief, gave a comprehensive explanation of the proposed revision, including changes in disclaimer procedure. The bill proposed in Sections 203 and 204 that only a whole claim could be disclaimed, and that the invalidity of one claim would not bar enforcement of the other claims, even if the bad claim had not been formally disclaimed. [FN19] Mr. Federico then went on to make the only reference to the practice of relitigating claims previously adjudicated invalid which we have been able to find in the history of the 1952

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legislation. He stated (1951 Hearings, p. 103):

> FN19. Patent Law Codification and Revision, Hearings Before the House Judiciary Committee on H.R. 3760, 82d Cong., 1st Sess. (hereinafter, "1951 Hearings"), at pp. 102–104.

Other provisions of the bill perhaps take care as well as is done in the present law of the possibility of a patentee suing again after his patent has been held invalid. That can be done today and the bill makes no change in that situation, except that certain provisions might tend to deter doing such a thing.

Apparently the provisions which "might tend to deter doing such a thing" were Sections 248, which proposed to bar recovery of costs unless a disclaimer of an invalid claim has been filed prior to suit; and Section 245, which proposed that the court in exceptional cases may award reasonable attorneys fees to the prevailing ***41** party. [FN20] See 1951 Hearings, pp. 108–109. Mr. Federico's testimony was incorporated into both the House and Senate Reports on the revision (H. Rep. No. 1923, 82d Cong., 2d Sess., p. 8; S. Rep. No. 1979, 82d Cong., 2d Sess., p. 7); and the disclaimer and other provisions proposed, renumbered because of other changes in the bill, were enacted into law. 35 U.S.C. 253, 288 (disclaimer); 35 U.S.C. 285 (attorneys fees).

> FN20. The attorneys fee provisions in Section 248 were adopted from a 1946 statute which permitted reasonable attorneys fees to the prevailing party in an infringement suit. 60 Stat. 778. Mr. Federico testified that the statute was intended to give the courts discretion to award fees only in exceptional cases. 1951 Hearings at 108–109. Nothing in the history of that statute referred to the rule in Triplett. See H.R. Rep. No. 1587, Part 2, 79th Cong., S. Rep. No. 1503, 79th Cong., 2d Sess. Recovery in Patent Infringement Suits, Hearings Before H. Comm. on Patents, on H.R. 5311, 79th Cong., 2d Sess.

The foregoing passing reference to "present law", in the course of a comprehensive revision of the Code, presents substantially the same circumstances as were involved in Giroutard, and for the same reasons Congress cannot be said to have re-enacted the rule of Triplett.

B. Congress' failure to act on various legislative proposals which have recently been introduced either to overrule Triplett or to alleviate its consequences, are also without significance.

In 1966 the President's Commission on the Patent System .formally recommended that the rule permitting subsequent suits on patent claims previously held invalid be abolished by legislation providing that a final federal judicial determination declaring a patent ***42** claim invalid should be in rein. Report of the President's Commission on the Patent System, Recommendation No. XXIII, p. 38–39. A bill to implement this and other recommendations sponsored by the administration then in office, was introduced (H.R. 5924, 90th Cong., 1st Sess.). With other patent revision bills, it was the subject of extensive hearings. [FN21]

> FN21. General Revision of the Patent Laws, Hearings Before the House Judiciary Committee, 90th Cong., on H.R. 5924, 90th Cong., 1st Sess. (hereinafter "1967–68 Hearings").

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Section 294 of this bill proposed that a final adjudication limiting the scope of a claim or holding it invalid, should constitute an estoppel against the patentee in any subsequent federal action. There was testimony both in favor of and in opposition to this provision. For example, the American Bar Association strongly opposed the change. 1967-68 Hearings at 464-465. The Department of Justice favored it. Id. at 622. The Judicial Conference of the United States approved it in principle. Report of the Proceedings of the Judicial Conference of the United States, Feb.-Sept. 1968, p. 81. A parallel bill, S. 2, 90th Cong., was also introduced in the Senate and hearings were held in which the same range of views were expressed. [FN22]

FN22. Patent Law Revision, Hearings Before the Subcommittee on Patents, Trademarks and Copyrights, Senate Committee on the Judiciary, 90th Cong., 1st Sess., on S. 2, S. 1042, S. 1377 and S. 1691.

However, the committees which heard testimony on the various proposed revisions, including the estoppel provision, made no report; no other legislative action was undertaken; and all bills died in committee. ***43** Thus neither house of the Congress acted one way or the other with respect to the rule in Triplett.

Since that time a number of other patent revision bills have been introduced. Two of these introduced in the 91st Congress, S. 1246 and S. 2756, would, at least by implication, recognize the rule of Triplett v. Lowell by amending the provision for the award of attorneys' fees in exceptional cases. The proposal would permit award of such fees where a claim had been previously held invalid and is again held invalid, if the court found there was no reasonable grounds for the subsequent suit. Sec. 285, S. 1246, 91st Cong.; Sec. 285, S. 2756, 91st Cong. There have been no hearings or other action and the bills expired with the 91st Congress.

C. Finally, it might be argued, particularly in the light of recent legislative attention to the estoppel problem, as outlined above, that if the Triplett principle is to be changed, Congress rather than this Court should do so.

Congress may of course ultimately adopt legislation making patent litigation an exception to the general rules of estoppel that obtain in the courts; it may determine, as proposed in 1967, that some form of in rem procedure, with published notice and formal cancellation by the Patent Office, should be adopted in place of existing practice. Or it may wish to permit successive litigation subject to some form of sanction to bar unreasonable conduct. There are a wide range of possible legislative choices. The question here, however, does not involve a legislative choice. It is a question ***44** of the general law of estoppel whose development, in the absence of legislation, is peculiarly a responsibility of the judicial process. This Court created the Triplett rule on the basis of the law of mutuality of estoppel as it then stood, and this Court appropriately may modify the rule to reflect the changes in that law that have since taken place.

CONCLUSION

For the reasons stated, the judgment of the court of appeals should be reversed, and the case remanlded for further proceedings in accordance with this Court's opinion.

U.S., 2004.

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For opinion see 91 S.Ct. 917, 91 S.Ct. 563, 91 S.Ct. 449, 91 S.Ct. 363, 91 S.Ct. 101

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Supreme Court of the United States.
BLONDER-TONGUE LABORATORIES, INC., Petitioner,
v.
UNIVERSITY OF ILLINOIS FOUNDATION, and JFD Electronics Corporation, Respondents.
No. 338.
October Term, 1970.
January 4, 1971.
On Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

Brief of Respondent JFD Electronics Corporation

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***1** Counterstatement of the Case and Summary of Argument

INTRODUCTION

The University of Illinois Foundation (hereinafter Foundation) brought suit for infringement of two of its patents in the home television receiving antenna field, against Petitioner, Blonder-Tongue Laboratories Inc. (hereinafter BT) and a customer of BT. After BT had subjected itself to the jurisdiction of the Court, the customer was dropped as a party defendant.

In addition to answering the Foundation's Complaint and counterclaiming against the Foundation, BT counterclaimed against the Foundation and your Respondent, JFD ***2** Electronics Corporation (hereinafter JFD). JFD is a licensee under the Foundation patents involved herein. Its license is non-exclusive. Channel Master Corp. v. JFD Electronics Corp., 260 F. Supp. 568 (E.D.N.Y. 1966); reargument denied, 262 F. Supp. 292 (E.D.N.Y. 1967). BT accused JFD of unfairly competing against BT and charged JFD with violating the anti-trust laws. In addition, BT accused JFD of infringing one of BT's own patents.

With respect to JFD, the District Court dismissed all of BT's counterclaims, and this was sustained by the United States Court of Appeals for the Seventh Circuit.

QUESTION NO. 1 -- (Re: Triplett v. Lowell)

This Court requested the parties to present arguments as to whether Triplett v. Lowell should be adhered to. Triplett should stand; patents in general, and in rem invalidity in particular, are subjects which the Congress of the United States has pre-empted, Nickerson v. Kutschera, 390 F.2d 812 (3 Cir. 1958). Furthermore, the legislative history of the Patent Act requires that Triplett be upheld. United States v. Public Utility Comm. of Calif., 345 U.S. 295, 313 (1953).

QUESTION NO. 2

In view of our position on Question No. 1, Question No. 2 is moot.

QUESTION NO. 3-- (Re: Isbell patent)

This Question concerns a conflict in decisions between two United States Circuit

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Courts of Appeals, involving the validity of the Foundation's patent. JFD is a non-exclusive licensee under the patent and relies upon and refers to the argument of the Foundation in support of the validity of the patent.

***3** BT also attempts to draw an alleged deprivation of due process at trial into the language of Question No. 3, although the language of the Question will not support this. BT complains about the trial being conducted without an allegedly important expert witness being present. Yet, BT made no offer of proof as to the damage it suffered and cannot now be heard to complain. Cash v. Murphy, 339 F.2d 757, 758 (5 Cir. 1964). BT did actually have a substitute expert, Blonder, who was qualified as an expert during the testimony. Also, BT draws into this question and charges that the Court excluded testimony, which BT was not entitled in any event to elicit.

QUESTION NO. 4 -- (Fraud in the Patent Office)

This Question relates only to the effect of an alleged fraud in the Patent Office with respect to the Foundation's patent. BT's Brief extensively expands the scope of this question. However, such expansion is improper. See, Supreme Court Rule 40(d)(2); General Talking Pictures Corp. v. Western Electric Co., 304 U.S. 175, 179 (1938).

With respect to the alleged fraud, JFD had no involvement in the preparation or prosecution of the Foundation's patent application in the U.S. Patent Office, had no reason to challenge the patent, and it had no knowledge, notice or reason to inquire as to the manner in which the patent had been acquired.

The Question presented by Petitioner to this Court is one of fraud by the Foundation in procuring this patent. BT, under the guise of this Question drags in an extensive review of evidence which purports to show that JFD is guilty of unfair competition and which is wholly unrelated to the alleged fraud that is the subject of this Question.

Both levels of Courts below found that JFD had not committed any acts of unfair competition or violations of ***4** the antitrust laws. Since BT has presented no basis for finding the decisions of both of these levels of Courts clearly erroneous, their decisions should be affirmed. Faulkner v. Gibbs, 338 U.S. 267, 268 (1949); Graver Tauk & Mfg. Co. v. Linde Air Products Co., 336 U.S. 271, 275 (1949).

Furthermore, BT presented virtually no evidence to support its claim of violation of the anti-trust laws and failed to even make a prima facie showing of a violation.

QUESTION NO. 5 -- (Re: Petitioner's Blonder-Schenfeld Patent)

BT charges that the failure of the District Court to make specific findings as to the prior art requires that there be a completely new trial of the issue of the invalidity of its Blonder-Schenfeld patent or that this Court review the prior art and hold that the patent is valid. Since BT's only charge here relates to the District Court's having failed to make the required findings, and since the Court of Appeals treated the District Court's findings as sufficient to enable that Court to affirm the District Court, and since the Court of Appeals reviewed the patent and itself made findings which cured any defects if they existed in the District Court's Opinion, and since two Courts have reviewed the facts and found that BT's patent is invalid over the prior art. The decision below should be affirmed.

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ARGUMENT

QUESTION NO. 1

Triplett v. Lowell should be upheld.

JFD, a non-exclusive licensee of the Foundation, which owns the Isbell patent involved in this Appeal, relies upon the argument of the Foundation with respect to validity of its patent. However, pursuant to the Court's request JFD ***5** has the following additional comments with respect to the holding in Triplett v. Lowell, 297 U.S. 638 (1936).

Triplett permits a patent owner, whose patent has been declared invalid in prior litigation with one party, to relitigate the validity issue in an action against a different party. This is in conformity with the rule of mutuality of estoppel, which is an important adjunct of the doctrines of res adjudicata and collateral estoppel. Since the patent owner's opponent in the second action would not be bound by a holding in the first action that the patent was valid, he should not be able to take advantage of a holding in the first action that the patent was invalid. If a patent owner were hereafter to be bound by the first judicial holding of invalidity of his patent, as an overruling of Triplett would require, his patent would always thereafter be invalid. The patent would be invalid, in rem.

In the context of the law on res adjudicata at the time of the enactment of the various patent acts and in the context of the presentation at various times to Congress of proposed in rem legislation which Congress has failed to enact but is presently considering, the reversal of Triplett would amount to enactment of new legislation, a congressional rather than a judicial function.

This Court stated in Triplett, at 297 U.S., p. 643, that forbidding the patent owner to bring a further action against another party, based upon a patent previously declared invalid, would require a "legislative command".

Under Article I, Section 8, Clause 8, of the Constitution, [FN1] Congress is empowered to establish the patent system. Pursuant to that authorization, Congress has passed many Patent Acts, the most recent of which is Title 35 of the United States Code, 66 Stat. 792, enacted July 19, 1952.

> FN1. ... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries; ...

***6** The patent system is a creature of statute law and has no root in the common law. Congress, which created the right and the remedy (action for infringement) in the same statute, may of course change the statute to apply a rule of law with respect to res adjudicata different from that which attached to the statute at the time it was enacted and reenacted. It has not chosen to do so, although it has been presented with the opportunity.

The legislative history of the present Patent Act, 35 U.S.C., shows that Triplett must be affirmed. The only section in the version of the Patent Act that existed when Triplett was decided, and that dealt with the patent owner's right to relitigate a patent declared invalid, namely R.S. 4917, Act of 1870, c.230, Sec. 54, 16 Stat. 206, permitted relitigation of a patent that had been previously declared invalid. See Triplett, at 297 U.S., p. 643.

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When the present version of the Patent Act, now 35 U.S.C., which succeeded the Act of 1870, was under consideration, Congress specifically considered the problem of relitigation of patents that had been declared invalid, and reconsidered the principle in Triplett, and enacted Sections 253 [FN2] and 288 [FN3] , which advise a patent owner to disclaim those claims of his patent that had been declared invalid, under certain penalties if he fails to do so, but which do not forbid him from relitigating the same patent.

> FN2. DISCLAIMER
> Whenever. without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent Office: and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.
> In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted. July 19, 1952, c. 950, § 1, 66 Stat. 809.
>
> FN3. § ACTION FOR INFRINGEMENT OF A PATENT CONTAINING AN INVALID CLAIM
> Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid. The patentee shall recover no costs unless a disclaimer of the invalid claim has been entered at the Patent Office before the commencement of the suit. July 19, 1952, c. 950, § 1, 66 Stat. 813.

The Patent Subcommittee of the Judiciary Committee of the House of Representatives specifically considered enacting in rem invalidity, i.e., prohibiting a patent owner ***7** from reasserting a patent that had been declared invalid, and specifically decided that such a penalty should not be inflicted upon a patent owner. In Report of the House of Representatives, No. 1923, 82d Cong., 2d Sess., May 12, 1952, the relevant portions of which are quoted in Federico, "Commentary on the New Patent Act", Title 35 of the United States Code Annotated, Vol. I, at pp. 47–49, the Subcommittee stated, with respect to the disclaimer sections 35 U.S.C. Secs. 253, 288:

"Other provisions [Sees. 253, 288] of the bill [which was enacted as 35 U.S.C.] take care at least as well as is done in the present law [Act of 1870] of the possibility of a patentee suing again after his patent has been held invalid. That can be done today and no change is made in that situation, except that certain provisions [Secs. 253, 288] tend to deter doing such a thing." (Emphasis supplied)

It was the intent of Congress at the time that the present Patent Act was enacted, that Triplett not be overruled, and such a clear legislative intent should be adhered to. United States v. Public Utility Com. of Calif. 345 U.S. 295, 313 (1953); U.S. v. Spelar, 338 U.S. 217, 219–221 (1949); Takao Ozawa v. United States, 260 U.S. 178, 194 (1922). Congress must be presumed to have wanted Triplett to stand. Toilet Goods Assn. v. Finch, 419 F. 2d 21, 27 (2 Cir. 1969).

***8** The Act of 1870 did not provide for in rein invalidity of a patent. After Triplett, the Congress, with awareness of the holding in Triplett, as shown by the

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excerpt from the Committee Report, supra, enacted a statute, which repeated the earlier statute with respect to in rem invalidity and acquiesced in and did not overrule Triplett. See Takao Ozawa v. United States, 260 U.S. 178, 194 (1922). A reversal of Triplett would now be judicial legislation rather than judicial construction. The present Patent Act must be deemed to incorporate the judicial construction that in rem invalidity does not apply to patents. Charles H. Demarest, Inc. v. United States, 174 F. Supp. 380, 392 (U.S. Customs Ct. 1959); Mustard v. Elwood, 223 Fed. 225, 227 (9 Cir. 1915); Mrugala v. City of Boston, 330 Mass. 707, 115 N.E. 2d 148 (1953).

Such reversal of Triplett is not required by any of the protective clauses of the constitution such as the Bill of Rights. There is nothing about the present patent statute and the prior Triplett holding applicable thereto which raises any question of due process or equal protection of the laws.

The President of the United States appointed a Commission on the Patent System to propose improvements in that system. In Recommendation XXIII of its Report, "To Promote The Progress of ... Useful Art", Report of the President's Commission on the Patent System (U.S. Govt. Printing Office, Washington, 1966), p. 38, the Commission recommended adoption of in rem invalidity of a patent. [FN4] Pursuant thereto, Bills were introduced into both Houses of the Congress during both of the 90th and 91st ***9** Congresses. [FN5] Some of these Bills contained a new Sec. 294, specifically instituting in rem invalidity of patents. See S 1042, 90th Cong., 2d Sess. (1967), Sec. 294; [FN6] HR 5924, ***10** 90th Cong., 2d Sess. (1967), Sec. 294; [FN6] and S 3892, 90th Cong., 2d Sess. (1968) Sec. 294. [FN7]

FN4. XXIII
A final federal judicial determination declaring a patent claim invalid shall be in rem, and the cancellation of such claim shall be indicated on all patent copies subsequently distributed by the Patent Office ...

FN5. During the 90th Congress, 1st Session, in 1967. the following Bills to revise the Patent Act were introduced: S 1042; S 1691; S 2164; S 2957: HR 5924; HR 6043; HR 6975: HR 7454; HR 11447 and HR 13951.
In the 90th Congress, 2nd Session 1968, one Bill to revise the Patent Act was introduced: S 3892.
In the 91st Congress, 1st Session, in 1969. the following Bills to revise the Patent Act were introduced: S 1246; S 1569; S 2756 and HR 12280.

FN6. "§ ESTOPPEL AND CANCELLATION
"(a) In any action in a Federal court in which the issue of the validity or scope of a claim of a patent is properly before the court, and the owner of the patent as shown by the records of the Patent Office is a party or has been given notice as provided in subsection (c) of this section, a final adjudication, from which no appeal has been or can be taken, limiting the scope of the claim or holding it to be invalid, shall constitute an estoppel against the patentee, and those in privity with him, in any subsequent Federal action, and may constitute an estoppel in such other Federal actions as the latter court may determine, involving such patent. Within thirty days of such adjudication the clerk of the court shall transmit notice thereof to the Commissioner, who shall place the same in the public records of the Patent Office pertaining to such patent, and endorse notice on all copies of the

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patent thereafter distributed by the Patent Office that the patent is subject to such adjudication.
"(b) In any action as set forth in subsection (a) of this section, upon a final adjudication from which no appeal has been or can be taken that a claim of the patent is invalid, the court may order cancellation of such claim from the patent. Such order shall be included in the notice to the Commissioner specified in subsection (a) of this section, and the notice of cancellation of a claim shall be published by the Commissioner and endorsed on all copies of the patent thereafter distributed by the Patent Office. "(c) In any action in a Federal court in which the validity or scope of a claim of a patent is drawn into question, the owner of the patent, as shown by the records of the Patent Office, shall have the unconditional right to intervene to defend the validity or scope of such claim. The party challenging the validity or scope of the claim shall serve upon the patent owner a copy of the earliest pleadings asserting such invalidity. If such owner cannot be served with such pleadings, after reasonable diligence is exercised, service may be made as provided for in the Federal Rules of Civil Procedure and, in addition, notice shall be transmitted to the Patent Office and shall be published in the Official Gazette."

FN7. "§ CANCELLATION BY COURT
"(a) In any action in a Federal court in which the issue of the validity of a claim of a patent is drawn into question, and the owner of the patent is shown by the records of the Patent Office is a party or has been given notice as provided in subsection (b) of this section, the court may, upon final adjudication, from which no appeal has been or can be taken, holding the claim to be invalid, after such claim has previously been held invalid on the same ground by a court of competent jurisdiction from which no appeal has been or can be taken, order cancellation of such claim from the patent. Within thirty days of such order the clerk of the court shall transmit notice thereof to the Commissioner, who shall place the same in the public records of the Patent Office pertaining to such patent, and notice of cancellation of the claim shall be published by the Commissioner and endorsed on all copies of the patent thereafter distributed by the Patent Office.
"(b) In any action in a Federal court in which the validity of a claim of a patent is drawn into question, the owner of the patent, as shown by the records of the Patent Office, shall have the unconditional right to intervene to defend the validity of such claim. The party challenging the validity of the claim shall serve upon the patent owner a copy of the earliest pleadings asserting such invalidity. If such owner cannot be served with such pleadings, after reasonable diligence is exercised, service may be made as provided for in the Federal Rules of Civil Procedure and. in addition, notice shall be transmitted to the Patent Office and shall be published in the Official Gazette."

A new Patent Act is still under consideration. Because a number of already proposed revisions of the Patent Act ***11** cover in rem invalidity, this feature is presently still under consideration by the Congress. This Court should not rule on this issue, which has for the present, been preempted by the Congress, at least until Congress makes a new enactment relating to in rem invalidity. Nickerson v. Kutschera, 390 F.2d 812, 815 (3 Cir. 1958).

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The United States Patent Office, an agency in the United States Department of Commerce, has also recognized that in rem invalidity is properly the subject of a legislative enactment and, therefore, should be left in the hands of Congress. [FN8] The Executive Branch of the Government sought a holding with respect to in rem invalidity from the Legislature, not the Courts.

> FN8. In an undated letter, apparently sent in the later part of 1967 or the earlier part of 1968, by Maurice A. Crews, Acting Director. Office of Legislative Planning, of the United States Patent Office, to the Chairman, Committee on the Judiciary. United States Senate, at page 23, and commenting upon both S 2597 and S 1042, which were then before the 90th Congress, Mr. Crews wrote:
> "RECOMMENDATION No. XXIII: IN REM INVALIDITY
> Under existing law, a court decision holding a patent claim invalid does not necessarily preclude later action based on the infringement of the claim. Adopting the Commission's recommendation for In rem invalidity, the Patent Reform bill provides that a final federal judicial determination 'limiting the scope of a claim or holding it to be invalid, shall constitute an estoppel' against the patentee, and further provides that a court may order cancellation from the patent of any claim finally held invalid (§ 294).
> S. 2597 has no comparable provision.
> The Department is in complete agreement with the reasoning of the Commission that once a patentee has had his day in court, he should not be allowed to harass others on the basis of an invalid claim. Thus. we support the estoppel and cancellation provisions of S. 1042."

Similarly, the American Bar Association, Section of Patent, Trademark and Copyright Law, in the Report of its Committee 101, which was issued in 1968, Subject 24, ***12** Proposed Resolution 22, all on p. 33 of the Report, reviewed S 1042 as it relates to in rem invalidity and recommended against adoption of such a statute. [FN9] It thus recognizes that in rem invalidity is properly the subject of legislation.

> FN9. SUBJECT 24: IN REM INVALIDITY AND PATENT SCOPE PROPOSED RESOLUTION 22
> RESOLVED, that the Section disapproves legislation which would create an estoppel against the patentee, and those in privity with him, arising out of an adjudication limiting the scope of any patent claim or holding it invalid, and
> FURTHER RESOLVED, that the Section is opposed to Section 294 of S. 1042.
> Past Action: None

There is no compelling reason for disregarding the clear Congressional rejection of in rem invalidity nor for disregarding the Congressional preemption of this presently actively considered issue.

Furthermore, the whole problem of in rem invalidity can be considered de minimis in the context of administration of the Federal Court system. Currently the present rule on in rem invalidity affects less than three percent of all patent cases, and patent cases constitute about 1.2% of all civil cases filed. This problem, therefore, affects less than one case in 1,000, of which less than half are carried through to a decision on the merits. [FN10]

> FN10. From 1949 to 1958, only 2.7% of all patent cases involved patents

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previously held invalid. An Analysis of Patent Litigation Statistics, Staff Report of the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary (1961). If the 2.7% is assumed to be constant, only about 0.03% of all civil cases involve such patents since patent cases comprise about 1.2% of all civil cases filed in the last decade. Annual Reports, 1969 Administrative Office of the United States Courts. Moreover, less than half of the 2.7% are carried through to a decision on the merits and of those which were, more than 25% were held valid. Rollins, In Rem Invalidity: A Solution In Scarch Of A Problem, 52 J.P.O.S. 561, 569 (1970).

***13** A further exposition of reasons for not overruling Triplett appears in Technograph Printed Circuits Ltd. v. United States, 372 F.2d 969, 977 (Ct. Cl. 1967).

In light of the foregoing, it is submitted that the holding in Triplett should be upheld.

QUESTION NO. 2

In view of the discussion of Question No. 1, no discussion of Question No. 2 is required.

QUESTION NO. 3 -- The Isbell Patent is Valid.

JFD is the nonexclusive licensee of the Foundation under the Isbell patent and relies on the Foundation's argument in support of the validity of the patent. However, JFD has the following comments concerning some of the points raised by BT.

Petitioner Was Not Deprived of Due Process at the Trial of this Action.

The text of Question 3, which appears on Page 4 of BT's Brief, does not relate to or even mention any deprivation of due process at the trial of this action. Thus, this Court should not even consider that matter. See, Supreme Court Rule 40(d) (2); General Talking Pictures Corp. v. Western Electric Co., 304 U.S. 175, 179 (1938); Dickinson Industrial Site v. Cowan, 309 U.S. 382, 389 (1940); Trailmobile Co. v. Whirls, 331 U.S. 40, 50 (1947). However, because BT briefed the matter, JFD has the following comments:

After several postponements of the trial date, trial of this action began on December 28, 1967. BT maintains that the refusal of the District Court to grant a further adjournment of the trial date denied BT due process.

The Court of Appeals considered substantially the identical arguments that BT is making in this Court and held ***14** that there had been "no abuse of discretion in proceeding with the trial." (A. 55) [FN11]

FN11. (A.) is a page reference to the Appendix.
(JA.) is a page reference to JFD's Supplemental Appendix.

Turning to the merits of BT's argument, BT complains that as a result of the postponements of the trial date to December 28, it was unable to have all its witnesses present at trial. Yet, the only witness BT has shown was unavailable was its proposed expert, Dr. Chu. (A. 135, 137-39). The Record does not show that any other expert witnesses were unavailable to BT. Blonder, an expert (A. 333-35) did

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testify as an expert for BT.

With respect to the only witness, whose absence BT deemed sufficiently relevant to even mention at trial, Dr. Chu, BT has made no showing of how the results at the trial of this action would have been different, had Dr. Chu been present. Cash v. Murphy, 339 F.2d 757, 758 (5 Cir., 1964). See, American Pacific Dairy Products v. Siciliano, 235 F.2d 74, 79 (9 Cir., 1956). Thus, BT has not shown how it was harmed by his absence.

BT made no offer of proof at trial as to the substance of testimony to be expected from Dr. Chu. Even at the Court of Appeals level, BT failed to make any offer of proof. BT now complains about the actions of the two Courts below, and incredibly, again fails to make any offer of proof. General and unsubstantiated allegations as to the qualifications of Dr. Chu in the antenna field are no substitute for an offer of proof as to the anticipated contents of Dr. Chu's testimony.

BT's failure to make any offer of proof as to the substance of the testimony expected from Dr. Chu, and the absence of any showing as to why his testimony was otherwise unavailable is one of the main bases of the decision of the Court of Appeals (A. 55) and it is quite applicable in this Court.

***15** Knowing that Dr. Chu might not be able to be present at trial, BT did not adequately prepare for this eventuality. See, Davis v. United Fruit Co., 402 F.2d 328, 330-31 (2 Cir. 1968); cert. den., 393 U.S. 1085 (1969).

The first relevant postponement of the trial date is embodied in an Order of the District Court, dated October 23, 1967, and setting December 18, 1967 for trial (A. 131-32. This delay was at BT's request (A. 131). BT could, therefore, be certain that between October 23 and December 18, a period of almost two months, there would be no hearings or trials at which its witnesses and its experts would have to testify. This two-month period was sufficient for BT's attorneys to ensure that all proposed witnesses, including its expert, Dr. Chu, took care of personal matters so they could be present at trial.

On December 18, the rescheduled trial date, the Court below, not having completed the trial preceding trial of the present action (A. 145-48), ordered the present case held for trial on December 20. On December 20, the trial was scheduled after the Christmas recess for December 26. With the motion by BT to delay the trial of this action even further (A. 134), the trial in fact began on December 28 (A. 149), a mere ten days (including the Christmas recess) after the originally scheduled December 18 date. BT's attorneys knew or should have known that trial judges take cases on the trial calendar in order (A. 145-47), Davis v. United Fruit Co., supra, whereby there are bound to be Court imposed delays of trial dates as the lengths of trials are unpredictable. Furthermore, the attorneys knew the present case was complex and would require many trial days. Since BT was ready on December 18, after having two months for its witnesses to complete personal matters, BT's attorneys should have taken such steps as were necessary to ensure that BT was able to remain ready a mere ten days more.

***16** Furthermore, the other parties were ready for trial and had their witnesses present in Court (A. 147), whereby if the trial had been delayed, they would have been penalized for being prepared and BT would have been rewarded for being

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unprepared.

In moving on December 22, 1967 for a further adjournment of the trial of this action (A. 135-39), BT's attorneys referred to the unavailability only of Mr. Blonder and Dr. Chu as witnesses. In fact, Blonder was present at trial and was dismissed on January 12, 1968. (JA. 20, 29). Blonder was qualified as a technical expert by BT's attorneys. (See, A. 333-35 where BT's attorney qualified Mr. Blonder). BT, therefore, had its expert on antennas. If BT feels it was without an expert, only it is to blame.

Furthermore, the first day of trial was December 28, 1967, a date which BT knew about since December 20. The Plaintiff Foundation did not rest its affirmative case until January 2, 1968 (JA. 3, A. 196, 208) six calendar, or four trial days later. From December 20, BT had thirteen days to prepare another expert to testify with respect to its own case. Its failure to obtain an expert was its own fault.

Complaints as to the unavailability of BT's president, Mr. Blonder, as a witness for BT in this trial, are ridiculous. Mr. Blonder was present at trial and provided extensive testimony on many matters relating to BT's case. (At A. 333, page 703 of the Trial Transcript, Mr. Blonder's trial testimony began and the testimony continued to A. 363, page 1020 of the Trial Transcript.)

The Denial by the Court Below of BT's Motion for a Continuance of the Trial of this Action to a Future Date was Proper.

"A motion to stay [the trial of an action] is addressed to the sound discretion of the Court, and the denial or grant of a stay is predicated upon the inherent power of a Court to control its docket." Childers Food Inc. v. ***17** Rockingham Paultry Marketing Coop., 203 F. Supp. 794, 796 (W.D. Va., 1962); Scholl v. Felmont Oil Corp., 327 F.2d 697, 700 (2 Cir., 1964); Davis v. United Fruit Co., 402 F.2d 328 (2 Cir., 1968); cert. den. 393 U.S. 1085 (1969); Cash v. Murphy, 339 F.2d 757 (5 Cir., 1964); Zach Metal Co., v. The S.S. Birmingham City, 291 F.2d 451, 455 (2 Cir. 1961).

Mr. Rines, BT's chief counsel, who stated (JA. 7) that he is a very experienced trial attorney, having tried "hundreds of cases," complains that the supposed "hostility" of the trial judge toward him prevented BT's obtaining a fair trial.

The Record does not indicate that BT was hindered by the trial Judge from presenting all of the evidence available to it. Certainly, none of the episodes, to which BT makes reference on p. 22 of its Brief, shows any deprivation of due process at trial. In none of these episodes was BT precluded from presenting necessary proof. The fact that the trial Judge may have expressed annoyance at certain actions of BT's counsel did not prejudice BT, because the case was tried before a Judge, not a jury, who might be prejudiced by a Judge's remarks.

The Judge also expressed annoyance at actions of counsel for both the Foundation and JFD (JA. 1-7, 9, 11-12), and thus showed no partiality toward BT's counsel.

There is no evidence that the trial Judge was unable to render a just decision on the facts and merits of the case.

BT also complains about the exclusion of certain documents, testimony and evidence

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which it sought to introduce. The specific items are now considered.

As noted at A. 208, and as admitted on p. 22 of the BT Brief, BT called Prof. Mayes of the University of Illinois as its own expert witness. Prof. Mayes had not previously been called to give testimony at this trial. BT maintains that certain testimony, which it was prevented by the Court ***18** from eliciting from Prof. Mayes, should have been permitted. At A. 214-16, and particularly at A. 222-223, BT's attorney asked Prof. Mayes about a report, DX-7, and asked Prof. Mayes to compare this report with work done by Dwight Isbell, another pioneer inventor in the log periodic antenna field. These questions were indefinite because they asked Prof. Mayes for his opinion as to what another person, Isbell, had done, without defining the work of Isbell on which the witness was to comment, and they were improper because they asked the witness to make a comparison, and draw a conclusion, which invaded the province of the trial Judge. Furthermore, the words speak for themselves, without requiring Prof. Mayes' interpretive facilities. The Court of Appeals did not believe that the trial Judge was in error in excluding such testimony.

At A. 223-24, BT's attorney asked Mayes to indicate on the drawings of his own patent a particular element, which is referred to in the specification portion of the patent. This was objectionable because a patent is a legal document and the trial Judge is certainly able to interpret a legal document. The document speaks for itself. The Court of Appeals did not believe such holding to be incorrect.

BT's attorney, at A. 225, asked Prof. Mayes whether he or the University of Illinois derived financial benefit from Mayes' patent. The University is not a party to this action and the questions concerning it are irrelevant. Prof. Mayes was not an Officer of the University (A. 235), whereby he could not make any binding statements for the University. The only purpose of the question as to Prof. Mayes' own financial interest was to impeach him. Prof. Mayes had been called by and was testifying for BT as its own witness. A party is not permitted to impeach its own witness unless he is hostile. The Court below found, as a matter of fact, that Prof. Mayes was not a hostile witness (A. 230), and that BT could not impeach him. BT ***19** obtained the desired testimony from Prof. Mayes at A. 317-18 anyhow, whereby its exclusion at A. 225 was harmless.

At A. 226, BT's attorney asked Prof. Mayes whether he had any relationship with JFD. The question was out of the order in which proof was to be presented. The order of proof had been set by a Court Order filed April 21, 1967 (JA. 36- 37). At that part of the trial, BT was presenting its defense to the Foundation's claim of patent infringement. The JFD-Mayes relationship is irrelevant to the patent infringement issue.

At A. 228-30, BT was precluded by the Court from eliciting testimony from Prof. Mayes concerning alleged fraud in the Patent Office in obtaining Mayes' patent. At this time, Mayes was BT's own witness and BT's purpose in obtaining this evidence was to impeach both Mayes and his patent. BT could not then impeach Mayes because the Court found him not to be a hostile witness (A. 230).

At A. 336-41, JA. 10-11, BT attempts to gain admission into evidence of DX-35, an advertisement of JFD. DX-35 is dated prior to the issuance of BT's own patent (A. 337-38, 340), which patent is the subject of the patent infringement Counterclaim by

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BT against JFD. DX-35 is thus irrelevant to that Counterclaim since BT then had no patent rights, which might have been violated by DX-35 or the antennas it concerned, until after its patent issued. DX-35 is also dated before October 1963, when BT entered the antenna business, whereby this advertisement could not have been unfairly competitve with an antenna business that had not yet even begun. BT failed to lay a sufficient foundation for admission of DX-35 and it was inadmissible.

In view of the foregoing, it is respectfully submitted that BT was not deprived of due process at trial and has not made a sufficient showing to justify a reversal of the decision of the Court below.

***20** If BT Was Denied Due Process at Trial, the Denial Related Only to Some of the Claims and Judgment on Those Claims as to Which There Were no Reversible Errors Should be Severed and Judgment on Them Should Be Affirmed.

The last sentence of Rule 21 FRCP states: "Any claim against a party may be severed and proceeded with separately". Thus, the Counterclaim against JFD may be severed from the claim by the Foundation against BT and the Counts of the Counterclaim may be severed from each other. Transmirra Products Corp. v. Monsanto Chemical Co., 27 F.R.D. 482 (S.D.N.Y., 1961). See, Leesona Corp. v. Cotwool Mfg. Corp., 204 F. Supp. 139 (W.D.S.C., 1962) ; app. dism., 308 F.2d 895 (4 Cir., 1962). The Judgment on those now severed claims and Counts of the Counterclaim for which there is no reversible error should be affirmed.

Any possibly reversible errors committed during the trial, viz., denial of a continuance and refusal to admit evidence, all related to the claim by the Foundation against BT for patent infringement, and none concerned the BT Counterclaim against JFD and the Foundation. On the continuance, Dr. Chu was an expert only on the Foundation's infringement claim. Blonder was BT's expert on the Counterclaim, and particularly on BT's own patent infringement Count of the Counterclaim. Thus, if the Court holds that there was reversible error at the trial of this action, the Counterclaim by BT against JFD and the Foundation should be severed from the separate patent infringement claim by the Foundation against BT and the judgment on the Counterclaim should be affirmed. If there are reversible errors in only some Counts of the Counterclaim, these should be severed and the Judgment on the remaining Counts should be affirmed.

The Foundation's claim for infringement of its patents, BT's counterclaim Count III for infringement of its own patent and BT's Counterclaim Counts I and II, respectively, ***21** for unfair competition and antitrust law violation are all so distinct from each other that none of the testimony or evidence bearing on one of these also bears on any other, whereby severance will not cause unnecessary duplication of testimony.

After severance, the judgment in favor of JFD and the Foundation on those claims and Counts of the Counterclaim as to which there is no reversible error can be affirmed. Then, this Court can order a new trial of the remaining claims and Counts. There would be a great saving of a trial Court's time in not having to needlessly retry all the issues raised in the pleadings.

BT's Review of Isbell Patent (BT's Brief, pp. 23-37)

Validity of the Isbell patent is involved in the Complaint and Answer and not in

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the Counterclaim against JFD. JFD, the Foundation's licensee, relies upon the Foundation's arguments in support of the Isbell patent to controvert BT's discussion thereof.

QUESTION 4

JFD Did Not Have Access to the Foundation's Application for the Isbell Patent or to the Patent Office with Respect Thereto and Did Not Participate in the Alleged Fraud in the Patent Office.

(Responding to BT Br. pp. 38 and 53)

The University of Illinois, the assignor of the Foundation, obtained U. S. Patent No. Re. 25,740 without concert or cooperation with JFD. Because all patents are clothed with a presumption of validity when they issue, after its issuance, JFD had no reason to challenge the manner in which the patent was obtained, since it had no knowledge or notice of any wrongdoing and had no reason to inquire ***22** as to the manner in which the patent had been acquired. JFD had a non-exclusive license and no right to bring or defend any action which involved the validity of the patent. Channel Master Corp. v. JFD Electronics Corp., 260 F. Supp. 568 (E.D.N.Y., 1966); reargument denied, 262 F. Supp. 292 (E.D.N.Y., 1967).

Both the District Court (A. 82) and the Court of Appeals (A. 67-68) each made an express finding of fact that there had been no fraud practiced by the University in the Patent Office. These concurrent findings of the trial and appeal courts should be affirmed here. Faulkner v. Gibbs, 338 U.S. 267, 268 (1949); Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U.S. 271, 275 (1949). But, even if there had been fraud, neither the District Court (A. 81- 82), nor the Court of Appeals (A. 66-68) at all implicated, or even mentioned, JFD as a party to the fraud. BT has not even made any showing that JFD was involved in any alleged fraud. Being a mere innocent non-exclusive licensee, JFD cannot be found liable for any fraud of the University.

JFD advertised its antennas after the patents issued as being patented antennas. This was truthful and is not part of an intentional conspiracy to defraud either the Patent Office or the public. That some JFD advertisements coincided with the introduction of antennas by BT was merely fortuitous. There is no showing that the advertisements in any way contributed to a diminution of BT sales, or that the advertisements were wrongful.

Unfair Competition and Antitrust (BT's Brief, pp. 38-62)

BT's Question 4, upon which this Court granted Certiorari, does not raise any other matters than the alleged fraud, and particularly does not concern either alleged unfair competition or antitrust law violations by JFD. Therefore, this Court should not consider these issues. See, ***23** Supreme Court Rule 40(d)(2); General Talking Pictures Corp. v. Western Electric Co., 304 U.S. 175, 179 (1938); Dickinson Industrial Site v. Cowan, 309 U.S. 382, 389 (1940); Trailmobile Co. v. Whirls, 331 U.S. 40, 50 (1947). However, because BT briefed these issues, JFD has the following comments.

Blonder-Tongue's Unfair Competition Counterclaim I and its Anti-Trust Counterclaim II Do Not State a Cause of Action, Were Properly Dismissed in the District Court and the Dismissal in the District Court was Properly affirmed by the Court Below.

In its Counterclaim Counts I and II, BT accuses JFD of unfair competition and

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antitrust law violations. BT confuses several separate allegedly unfairly competitive acts by JFD to create, by innuendo, an aura of wrongdoing around JFD. BT speculates that the acts of JFD were wrongful, but more than mere speculation is required to justify such a conclusion. Yet, none of the separate and unrelated activities of JFD was wrongful. The BT General Manager, to whom its sales personnel reported (A. 366), testified that BT did not lose any customers or suffer any impairment of its good will due to the activities of JFD. (A. 366).

The District Court found, as a fact,
"--that JFD was not guilty of any wrongful practices with regard to the marketing and sales of their antennas." (A. 88).

In its Judgment Order, the District Court held:
"8. The Plaintiff and the Counterclaim defendant, JFD Electronics Corporation, did not commit acts of unfair competition or acts in violation of the antitrust laws as charged in the Counterclaim." (A. 91)

BT made virtually the identical arguments to the Court of Appeals that it is making to this Court with respect to unfair competition and anti-trust law violation, and that ***24** Court held that there was more than adequate justification for the findings of fact and conclusions of law tirade by the District Court.

Specifically, the Court of Appeals held, with respect to the landings of fact by the District Court (A. 68-69):
"Blonder-Tongue made a series of charges of unfair competition and the like. The allegations included exaggerated claims in advertising, threatened litigation against competitors, improper news releases concerning litigation, intentional patent mismarking, fraud on the patent office, already discnssed, raiding of Blonder Tongue by JFD to recruit key personnel, and attempting to force customers to buy unpatented articles, as a condition of obtaining patented ones.
Extended discussion is unnecessary. The best that can be said In any instance is that Blonder-Tongue presented evidence from which the district court might, but was not compelled to, draw inferences supporting the particular charge. Contrary inferences were equally, or more, reasonable. The findings made were not clearly erroneous, the standards applied as to fairness of trade practices were appropriate, and we agree with the conclusions reached."

These findings, now having been made by two levels of Courts, should not tie disturbed, as BT has not made any showing that any of the findings is clearly erroneous. Faulkner v. Gibbs, 338 U.S. 267, 268 (1949); Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U.S. 271, 275 (1949).

BT has presented no basis for considering together a number of separate, unrelated, all legally proper acts, or for torturing these acts into a finding of unfair competition or violation of the anti-trust laws.

We now turn to BT's arguments with respect to each of JFD's unrelated activities.

***25** BT's arguments are substantially identical to those which were rejected in the Court of Appeals:

1. JFD Did Not Coerce Tie-In Sales.

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(Responding to BT Br. p. 46)

The District Court, affirmed by the Court below, found as a fact:

"Blonder-Tongue has also argued that JFD attempted to force its customers to purchase its unpatented products as a "tie-in" with its patented products.... The only evidence, however, which tends to support this argument is the testimony of a JFD official who admitted that JFD salesmen would try to persuade their customers to handle not only JFD antennas but its other products as well. This is a normal business practice: all salesmen try to sell their entire line of merchandise rather than merely their most popular products. There was no probative evidence here of any coercion or threats made to customers to force their purchase of the entire JFD line". (A. 87-88) [Emphasis supplied.]

No evidence was presented at trial to counter the Court's finding. The JFD testimony quoted in BT's Brief supports this finding. It is natural for any producer to want its customers to handle only its line of products. JFD would be happy if its salesmen sold the entire line of JFD products but there is no evidence that they were required or expected to sell all customers the entire line. (See DX-42, p. 75). There is no evidence that JFD customers were not free to pick and choose as each saw fit.

BT unsuccessfully attempts to distort the testimony of Mr. Finkel, appearing at pages 73-76 of the transcript of his deposition, DX-42, to demonstrate tie-in selling. However, Mr. Finkel testified that he had not authorized JFD's salesmen to tell JFD customers that if they handled infringing antennas they might be sued. Finkel did not know of any JFD salesmen who had made declarations of this type. ***26** While it would have been proper to have warned JFD customers that they could be sued for infringement if they infringed the patents under which JFD was licensed, there is no evidence that even this type of warning was ever made. The mere statement of a wish by Mr. Finkel that his salesmen could sell the entire JFD line does not amount to an admission of tie-in sales, and this was found both by the District Court and by the Court of Appeals below.

In the absence of any actual evidence of any coercion by JFD of BT customers, BT distorts the testimony of its own witnesses in a vain attempt to show coercion.

Mr. Helhoski was BT's General Manager, Special Accounts, and formerly Director of Marketing, (JA 26). Contrary to BT's assertion, Helhoski testified that he had no written reports or direct proof of coercion, that JFD's coercion could only be inferred and that such inferences could be drawn only from BT's unsuccessful antenna operation (JA 26-28).

Similarly, Mr. Gilbert, the General Manager of BT, (A. 366) testified only that lie could not point to any report of or instance of coerced or tie-in sales and that all he heard was "talk" about it. (JA 22-23).

Finally, BT's Product Manager, Mr. Cohn (A. 363), testified that he knew of no tie-in sales (A. 365).

No BT salesmen produced evidence as to alleged customer coercion. If customers had been forced by JFD to buy certain products, they should have been sufficiently incensed to testify about it. The testimony of BT's employees amounts to merely repeating vague rumors. This is insufficient.

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Realizing the deficiencies of its own case, BT tries to pass the obligation for proving BT's case to JFD. BT has mistakenly confused its having come forward with a miniscule quantity of testimony concerning very remotely ***27** the allegation that JFD had engaged in tie-in sales, with BT's having to show by a preponderance of the evidence that JFD had actually attempted to make tie-in sales or had coerced BT's customers. Since BT failed to present even a prima facie case, JFD had no obligation to reply.

BT now presents two lame excuses for its admitted absence of proof of JFD's coercion and tie-in sales. First, it maintains that the loss of Mr. Balash, its employee, precluded its submitting proof of coercion. Mr. Balash's transfer to JFD is more extensively reviewed by BT in the next portion of its Brief, and we likewise treat this issue in greater detail in our corresponding next section. It is sufficient at this point to note, however, that Mr. Balash left BT long before the trial of this action and that BT had more than ample opportunity to gather other evidence of tie-in sales. Balash's departure was not the result of nor did it bring about any wrongdoing, which inured to the benefit of JFD.

Furthermore, BT had once taken the deposition of Mr. Balash in connection with this action (JA. 20) and could certainly have taken his deposition again if BT had any reason to think that there was any evidence in Mr. Balash's knowledge or possession, which could have been of use to BT. The lack of any deposition from Mr. Balash on this point shows that Mr. Balash's absence had no bearing on BT's ability to prove coercion.

As to the absence of Graham Sisson, the West Coast sales representative of BT, BT made no showing that Mr. Sisson had any knowledge concerning tie-in sales, cites no evidence that there were any tie-in sales efforts on the West Coast of the United States, presents no reasons why Mr. Sisson's deposition was not taken in connection with the action, and/or why he was not called as a witness at the trial of the action, presents no statement as to the evidence which Mr. Sisson would be expected to produce and, ***28** therefore, has not shown how Mr. Sisson's transfer away from BT is in any way relevant to the alleged tie-in sales.

BT cites a number of cases, but they do not complete the deficiency in the evidence. All of these cases deal with a patent owner's coercion of customers into buying unpatented items under the threat of the denial to the customer of patented items. The record in this case is void of a showing that JFD engaged in tie-in sales activities or coercion.

The findings of the District Court and the Court of Appeals as to the absence of tie-in sales and coercion should be affirmed by this Court since no basis has been shown for holding these findings to have been clearly erroneous.

2. JFD Did Not "Raid" BT for Employees.
(Responding to BT Br. p. 50)

Between March 1966 and December 1967 (almost two years), five BT employees transferred from BT to JFD. During the same period, a total of about 100 employees left BT (JA. 12). Based on this alone, the District Court was justified in finding as a fact (A. 87):

"Those employees later hired by JFD made up a small fraction of the total number

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of employees who left Blonder-Tongue during the same period of time, and a number of reasons, such as dissatisfaction with Blonder-Tongue, genuinely arrived at, appear from the evidence to have been instrumental in causing the employees to change their positions. The record contains no evidence that JFD "raided" Blonder-Tongue. Dempster Bros., Inc. v. Perfection Steel Body Co., 182 F. Supp. 307, 309 (N.D. Ohio 1959)."

This finding was affirmed by the Court below. See, Credit Bur. Mgmt. Co. v. Huie, 254 F. Supp. 547, 552 (E.D. Ark. 1966).

***29** No evidence of a campaign by JFD to raid BT personnel was presented. The employees came over individually, not in a mass. There are about twelve widely scattered producers in the commercial antenna field (A. 354) and JFD in Brooklyn, New York (A. 590) received a disproportionately small number of the personnel from BT, nearby in Newark, New Jersey (A. 38), even though geography favored a transfer to JFD. No trade secrets of BT were compromised by the transfers to JFD.

BT claims that the persons who transferred from BT to JFD were "key" personnel. The District Court found as a fact that this was "mere speculation" and stated that "more than mere speculation is required to justify such a conclusion. There must be proof, and such proof is lacking here." (A. 87).

BT seeks to puff up the importance of one of the employees who transferred, Jerome Balash. One BT employee testified that Balash was "the organizer of Blonder-Tongue's complete antenna business... from the marketing standpoint" (JA. 29) and Mr. Blonder, BT's President, testified that Mr. Balash was later home products manager in charge of antennas at BT. (JA. 8).

However, the bulk of the evidence presented by BT shows Balash was not important at BT. Gilbert, General Manager of BT (A. 366) testified that Helhoski, and not Balash, organized the antenna business of BT (JA. 24). Gilbert also testified that Balash was being moved out of BT's antenna business (JA. 23-24). Rather than being a key employee in July 1966, when Balash decided to leave BT, his importance to BT was continuously diminishing, and by May 1966, he had been relieved of all but "nominal" duties in connection with antennas (JA. 23-24).

The circumstances of Balash's leaving BT for JFD are important here too. Gilbert indicated that Balash had frequently expressed dissatisfaction with BT (JA. 24). ***30** From the very earliest part of Balash's career, he was looking around for another job (JA. 24). BT's Product Manager, Cohn (A. 363), confirmed that Balash had complained about and was dissatisfied with his job at BT (JA. 21).

Balash's first contact with JFD was at his instance after he heard JFD was looking for a salesman (JA. 20). Thus, active solicitation by JFD was not responsible for Balash leaving BT.

BT personnel testified that after Balash left BT certain documents could not be located (JA. 9, 23, 25-26, 28). However, BT admits that there is no evidence Balash misappropriated any BT documents (JA. 26, 28). In fact, the missing documents were kept on an open shelf from which anyone might have removed them (JA. 26).

There is no evidence that JFD received any documents from Balash, or received any

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information from BT records, or made use of any BT records. BT, therefore, came to no harm, vis-a-vis JFD, as a result of the alleged loss of BT documents.

BT claims that Balash was assigned to determine why customers were not buying antennas from BT, and kept related records, which BT could not locate after Balash left (JA. 8-9). If, as BT claims (JA. 23), Balash had knowledge of improper JFD practices, and of reasons for loss of customers, BT was negligent in the manner in which it ensured that the evidence alleged to be in Balash's possession was preserved. Balash notified BT in July 1966 of his plan to depart (JA. 20-21) and left nearly a month later. During this period, evidence and documents, if any, which Balash had gathered could have been obtained from him. The present action was commenced in March 1966, well before Balash gave BT notice he was leaving. Therefore, if the evidence allegedly being gathered by Balash was significant, BT should have taken steps to preserve it.

***31** However, it was not until after Balash left BT that BT first searched for the evidence alleged to have been in Balaslh's posession (JA. 9-10, 25, 28). It was negligent for BT not to have checked on the location of this evidence before Balash had departed.

The documents whose alleged disappearance was first discovered after Balash's departure did not contain information exclusively within the expertise or knowledge of Balash. Such information could have been gathered by others after Balash's departure and up to the time of the trial of this action in late 1967, a period of almost 1 1/2 years. BT shows no evidence of any effort to reproduce the alleged mising material. Thus, the alleged importance of any missing documents must be questioned.

BT took Balash's deposition (JA. 20) in connection with this action, but did not question Balash either about missing documents or about why BT was losing customers. Thus, there is no direct testimoney as to why any evidence may have been missing.

In summary, the transfer of Balash from BT to JFD was not part of any wrongdoing by JFD.

BT points to other employees who transferred from BT to JFD. There is no evidence that JFD recruited these transfers. The evidence is to the contrary (JA. 33-34). No records or trade secrets are alleged to have been lost or misappropriated as a result of these transfers.

BT complains about JFD's hiring away of Schenfeld on the "eve of trial". However, he actually left "in the middle of the year '67" (JA. 7), about six months before trial (A. 149). Schenfeld may have made performance tests on JFD antennas, and BT may have wished to have Schenfeld testify about these tests. No showing, hover, was made by BT as to why it could not have taken Schenfeld's deposition to preserve the test results, or as to why Schenfeld had not prepared a test report or as to why others did not make ***32** similar tests during the six months before trial. If Mr. Blonder could not testify as to Schenfeld's performance tests even though he had been qualified as an expert by BT (A. 333-35), and even though Shenfeld's tests had been performed at Blonder's direction and with his knowledge (JA. 8), then Blonder himself could have performed tests (see A. 345), or another expert should have been qualified in the time available.

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As for the three other BT employees who transferred to JFD, no irreparable harm was suffered by BT due to these transfers, and there is no evidence that BT was in any way hampered in its preparation for trial.

Hiring former employees of a competitor is a proper activity, Koehring Co. v. National Automatic Tool Co., 257 F. Supp. 282, 290 (S.D. Ind., 1966); affd., 385 F.2d 414 (7 Cir., 1967); Dempster Bros., Inc. v. Perfection Steel Body Co., 182 F. Supp. 307 (N.D. Ohio, 1959); affd., 286 F.2d 430 (6 Cir., 1960) It is wrong only if it involves the misappropriation of trade secrets. This is the only point made in and the only holding of the inapplicable Sugar Creek Creamery case cited by BT. There is no evidence that any trade secrets of BT were lost. See, E. TV. Bliss Co. v. Strthers-Dunn, Inc., 408 F.2d 1108, 1113 (8 Cir. 1969).

In view of the foregoing, it is absurd to maintain that the few personnel who transferred from BT to JFD did so as a result of personnel "raiding" by JFD.

3. BT's Charge of Fraud in the Patent Office.
(Responding to BT Br. p. 53)

This is a repetition of BT Br. p. 38, et seq. and has been treated in this Brief, ante p. 21.

***33** 4. JFD Did Not Mismark or Use False Patent Legends; But If Its Patent Legends Were Not Completely Accurate, Inaccuracies Occurred Through Inadvertent Error and Had No More Than Minimal Effect.

(Responding to BT Br. p. 54)

JFD has been the nonexclusive licensee of the Foundation under all its log periodic antenna patents and pending applications since 1962. At the time the 1962 License (DX-44) was entered into, only three licensed patents had issued, namely DX-65, 66 and 67. The initial JFD advertisements for log periodic antennas manufactured under license from the Foundation recited only those licensed patents that had already issued, and told the trade that the antennas came from the developments made at the University (DX-42, p. 42). Since, the JFD antennas were log Periodic and manufactured under the license agreement and the patents were licensed under the same agreement, there was a logical relationship between the antennas shown in the JFD advertisements and the patent numbers recited in the advertisements, and especially in those advertisements making reference to the license from the Foundation to JFD, whereby there was no mismarking.

The JFD statement about issued licensed patents provided information as to the then issued log periodic antenna patents.

JFD was first notified in or about April 1964 that its statements about the issued licensed patents might be misinterpreted. JFD thereafter took steps to change the patent legend it used. (See JFD's Finkel's letter of April 21, 1964 (DX-42-B-105). There is no showing that prior to the Finkel letter DX-42- B-105, cited by BT that JFD had notice or knowledge that its patent le-ends might be incorrect.

The changed notice subsequently used by JFD declared that the JFD manufactured log periodic antennas were: "Licensed under one or more of U. S. Patents 2,953,081; ***34** 2,985,879; 3,011,168; and patents pending in U. S. A. and Canada." (See the

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advertisements DX-42-B-106 and 113, which were cited by BT in its Brief.) Clearly, this revised form of patent legend is proper, U.S. v. General Electric Co., 82 F. Supp. 753, 817 (D.N.J., 1949). Cf., Rohr Aircraft Corp. v. Rubber Teck Inc., 266 F. 2d 613, 623-24 (9 Cir., 1959). The legend is truthful. It informs a person who desires to manufacture a log periodic antenna and to circumvent the Foundation's patent rights on log periodic antennas, that he should at least check the patents listed in the patent legend.

It may readily be concluded that due to inadvertence or lack of knowledge on the part of JFD or on the part of the person preparing the ad, the words "Licensed under one or more of" at the beginning of the legend and the words "and patents pending in U.S.A. and Canada" at the end of the legend were left off the initial JFD advertisements. There has been no showing by BT that the legend was shortened by JFD with intent to deceive. The District Court found as a fact (A. 85) that the "mismarking", if any, was not "deliberate".

Even if there was mismarking, it was found as a fact by the District Court that it did not have "damaging effect" A. 85). The Court continued:

"Its effect, if any, was minimal. There was no convincing evidence to support the conclusion that potential purchasers were influenced by such markings to buy or not to buy either JFD's or its competitors' antennas, or that such markings were deliberately intended to gain an unfair adventage over JFD's competition. S. W. Farber, Inc. v. Texas Instruments, Inc., 230 F. Supp. 883, 892 (D. Del., 1964); affd., 344 F. 2d 957 (3 Cir., 1965); cert. den. 382 U.S. 843 (1965)."

Cf., Falcon Lock Co. v. Best Universal Tack Co., 362 F.2d 221, 223 (9 Cir., 1966), and Hayes Spray Gun Co. v. E. C. Brown Co., 291 F.2d 319, 327 (9th Cir., 1961). JFD's patent ***35** markings, which served as notices to the trade, were adopted only in good faith by JFD and are not evidence of unfair competition.

BT has presented no evidence to overturn the finding that the alleged mismarking had only minimal, if any, effect. BT, to recover, must show special damages, which it has not done. Smith Victor Corp. v. Sylvania Electric Products, Inc., 242 F. Supp. 302, 308, 312 (N.D. Ill., 1965).

JFD's product line consists of approximately fifty different log periodic antennas. The Record shows very few uses of an allegedly improper patent legend. Therefore, JFD was not conducting a concerted campaign to mislead. The advertisements complained of were very limited in scope and in the effect they could have had on the market for antennas.

There is no evidence in the Record that JFD's patent legend dissuaded any BT customers from purchasing BT's "log periodic antennas". Surely, if BT had direct evidence of its customers being dissuaded, it would have introduced it. In neither of the two sections of the Record cited by BT is there mention of mismarking or of its effect on BT's customers.

The cases that are cited by BT all deal with intentional and repeated mismarking and misrepresentations. None of the cases, therefore, is relevant to the present action.

In summary, there was no mismarking by JFD. But, even if it should be found that there was mismarking, it was inadvertent. BT has made no showing of any damage to BT

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from the alleged mismarking, and the alleged mismarking was minimal in scope.

5. The Foundation Properly Brought the Present Action and It Was Proper for the Foundation and JFD to Have Circularized the Trade to Inform Them of the Pending Litigation.

(Responding to BT Br. p. 57)

The Foundation commenced the present action in the United States District Court for the Northern District of ***36** Illinois, a venue to which BT never objected during the entire course, of the trial, and which venue, as the District Court found, did not work to the competitive disadvantage of BT (A. 86).

After the present action was properly commenced by the Foundation, some of BT's customers received the three documents cited by BT, which noted the pendency of the BT litigation. Only one of these, the JFD Sales Bulletin of April 19, 1966, was issued by JFD. The Foundation news release was issued by the Foundation, not JFD, and the newspaper clipping was disseminated by an independent organization.

The single Foundation and JFD news releases were distributed for information purposes. Distributors for and customers of infringers of the Foundation patents could properly be sued for infringement by the Foundation. Therefore, informing the distributors and customers about the pending actions was a service to enable the recipients to take what steps they deemed necessary for their own protection.

The District Court, as affirmed by the Court of Appeals, found the entire distribution of news releases and the like documents, and particularly JFD's part in this distribution, to be wholly proper and not excessive (A. 86):

"... [But Blonder-Tongue's complaint is ... that news releases concerning this litigation were 'deliberately widely circulated in the trade,' and that such practices 'far transcend the proper use of patents and patent litigation.' A review of the evidence demonstrates clearly that such allegations are wholly without basis in fact. The patentee, in the belief that its patents were valid and infringed (as they have indeed been shown to be), had the right to protect its claim by notifying the trade of alleged infringements. Its activities here were not unreasonable. Al-Fab Aluminum Fabricators, Inc. v. Wagner, 220 F. Supp. 715 (N.D. Ill. 1963).]"

***37** Such concurrent findings are supported by the record and have not been shown to be clearly crroneous.

BT notes that the JFD Bulletin lists five pending actions, and lists the one against BT first. All five cases are listed in equal size type and are arranged alphabetically. Thus, BT's name naturally appears first. The news releases were not used by JFD to discriminate against weaker competitors. Note that Channel Master, which BT admits is the largest, antenna manufacturer (A. 367), appears on the list.

There was no expressed or implied threat to force customers to purchase all antennas of a particular type from JFD. BT maintains that its customers were threatened with suit if they took on the BT antenna line. The Blonder testimony cited by BT is merely hearsay. No direct evidence of such threats was introduced. Finkel of JFD speculated that such threats night have occurred, but there is no direct evidence that they did. If customers were threatened, at least some of them should have been sufficiently incensed against JFD, the threatener, to appear and testify on behalf of BT. Yet, BT produced no customers. There was no evidence of a

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prolonged, concerted advertising campaign with the purpose of intimidating the trade into dealing with no one but JFD.

JFD referred to the Foundation patents as "basic Log Periodic Patents". This has not been shown to be untrue. At worst, it is mere advertising "puffing". The statement is certainly no threat to the antenna distributors of BT who are regularly in the antenna business, and has not been shown to have caused BT any damage. Smith Victor Corp. v. Sylvania Electric Products, Inc., 242 F. Supp. 302, 308, 312 (N.D. Ill., 1965).

Following commencement of an action, the distribution of a letter and of a separate "news release" to customers is proper. Bryan v. Sid W. Bichardson, Inc., 254 F.2d 191, ***38** 198 (5 Cir. 1958). Al-Fab Aluminum Fabricators, Inc. v. Wagner, 220 F. Supp. 715 (N.D. Ill., 1963); Everybody's Tool & Die Works, Inc. v. Costa, 9 F. Supp. 440 (E.D.N.Y., 1934).

BT makes some wild, irrelevant charges about this action being improperly brought and without jurisdiction, solely for the purpose of circularizing the trade. These charges are so fanciful that they are not even dignified with citations either to the Record or to case law.

All of the cases cited by BT to support its point of view are so factually distinguishable from the situation in the present action that they do not support a finding against JFD. In both Panay and in Maytag, the patent owner intentionally made misrepresentations concerning infringement in unduly repetitious and extensive advertisements. The citation to Toulmin's text is aimed at the same activities. In Gerosa the patent holder misrepresented, and defamed the defendant in circulars to the trade. In Robbins, the patent owner unnecessarily interfered with the defendant's business, brought an excessive number of infringement actions against the defendant's customers, and made other excessive demands and threats against the customers.

In the present action, there was no misrepresentation by JFD, no excessive advertising by JFD and no illegal interference by JFD in BT's business. Thus, JFD's informing the trade of the pendency of this action was proper.

6. JFD Is Not Guilty of False Advertising.
(Responding to BT Br. p. 59)

JFD never claimed that the log periodic formula, per se, was patented. The District Court found, as a fact, that the use of the phrase "the Patented Log Periodic Cellular ***39** Formula" was not unfair (A. 85). The District Court reviewed this phrase further:

"JFD maintains that it referred to the antenna itself, log periodic antenna using the patented cellular concept. This is a reasonable construction of the phrase; the reader was not necessarily led to believe that JFD had patented the whole concept of log periodicity" (A. 85).

Log periodic antennas are designed in accordance with a mathematical formula or equation setting forth the relationshilp between the lengths of the dipoles, each of which is a pair of outwardly extending arms, of the antenna and the spacings between adjacent dipoles (A. 75-76).

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BT chooses to interpret the phrases it quotes from JFD ads, which phrases, we might add, are taken completely out of the context of the ads in which they appear, to mean that JFD is asserting that the log periodic equation in accordance with which its antennas are designed, is patented. Yet, the word "formula" has often been used to describe an article by reciting its constituent parts and the proportions and dimensions thereof. The "Log Periodic Cellular Formula" describes a log periodic antenna designed in accordance with a particular cellular concept, and such an antenna is claimed in U. S. Patent No. Re. 25,740 (PX-20). In the JFD advertisement DX-42-B-4A, JFD refers to "the original Log-Periodic design formula", showing that JFD means the word "formula" to denote an antenna design, not an equation.

Some of the patent claims at the end of the patent just mentioned recite the mathematical equation in accordance with which log periodic antennas are frequently designed. The only acceptable interpretation of the JFD advertisement is that JFD is referring to an antenna designed in accordance with the claims of the patent.

***40** For example, the text, without any deletions, of one of the statements in the JFD advertisement, DX-42-B-4A, cited by BT, reads:

"Do NOT BE MISLED BY LOG-PERIOIDIC IMITATIONS OR MISLEADING PATENT CLAIMS.

"THERE IS ONLY ONE GENUINE PATENTED LOG PERIODIC V-ANTENNA--THE JFD LPV!

Only JFD is licensed exclusively by the University of Illinois Foundation to make the patented Log Periodic LPV and all other Log-Periodic type TV and FM antennas."

The ad text extolls the virtues of the JFD antennas. No dealer-distributor customer in the antenna field who read this ad which appeared in a trade journal, Radio & Television Weekly, could have been coerced into buying only from JFD by this text. It is, at worst, mere harmless "puffing".

The same ad continues, ... "No other so-called Log-Periodic Antenna can work like the JFD Log-Periodic LPV ...". BT quotes the text this far and halts. But, the text goes on: "... because only JFD uses the original patented Log Periodic design formula of the Antenna Research Laboratories of the University of Illinois." With the complete text, the statement is seen to be true.

The advertisement DX-42-B-4A recites that JFD is licensed by the Foundation and says that the developments leading up to the patent were made at the Antenna Research Laboratories of the University by Prof. Mayes. JFD is proud that Prof. Mayes of the University made the development and is proud that it has a license under the Mayes patent. Furthermore, JFD's statements about the patented Log Periodic Cellular Formula and about the connection with the University harmlessly attempt to create an aura of technological supremacy for JFD's antennas.

***41** JFD was not attempting to coerce the trade to deal only with JFD. BT has not shown any special damage due to JFD's advertising claims. Thus, JFD's statements are not actionable. Smith Victor Corp. v. Sylvania Electric Products, Inc., 242 F. Supp. 302, 308, 312 (N.D. Ill., 1965).

BT points to a statement contained in a letter, DX-42-B-104, from the Foundation, the patent owner, to JFD that the log periodic formula is not patented. This letter was written by the Foundation to JFD in response to an inquiry made by JFD, as required by the license agreement between the parties to determine whether JFD's advertisements were acceptable to the Foundation. Out of an excess of caution and

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with a conservative outlook, the Foundation merely stated that it objected to the statement in the advertisement. The Foundation never "complained" as to the advertisement. Furthermore, JFD has no control over the Foundation and the assertions and conclusions of the Foundation are not binding upon JFD.

BT next turns to a statement by JFD as to the performance of one of its antennas and maintains that JFD misrepresented the facts. However, the Record is devoid of any evidence of false technical claims by JFD.

The only testimony which challenged the technical claims by JFD was presented by BT's president, Blonder (A. 345-46). However, it would be improper to consider this testimony to prove that JFD's technical claims were false, first, because Blonder's testimony was introduced for a special purpose, not the purpose for which it has now sought to be used, and second, because the testimony was later stricken from the Record. At A. 341, BT makes a first effort to gain admission of DX-32, a JFD advertisement. Blonder's testimony at A. 345-46 was solely for the purpose of gaining admission of DX-32 into evidence (JA. 11). The objection to the admission of DX-32 ***42** was finally sustained (A. 367-68). With its exclusion from evidence, the testimony used solely as a foundation for its admission should also be excluded from consideration. Blonder's testimony, taken only for the limited purpose of laying a foundation for introduction of DX-32, cannot now be used for the purpose of challenging JFD's technical claims.

The testimony BT sought to use concerns a performance test performed by Blonder on a JFD antenna. Blonder described the test range, or location used for testing the JFD antenna, as being the roof of BT's factory (A. 345). No testimony was presented to show that this test range was adequate. It may have been blocked by adjacent structures, it may have been in a poor reception zone or there may have been interference from other radiation emitters.

Blonder said the test was performed under his supervision. His obvious bias in trying to disprove the truth of any JFD technical claim cannot be ignored. Blonder tested only a single sample of a JFD antenna (A. 346) at only one allegedly critical channel (A. 346), and did not even bother to record the test results (A. 346). Consequently, his test results should be accorded no probative value. A test on an alleged single critical channel is not sufficient to substantiate a broad claim that JFD's antenna did not perform on all channels as claimed.

JFD did not present any evidence as to its technical claim because no showing, which was properly receivable in evidence, was made that JFD had misrepresented the performance of its antennas.

Even if the claim by JFD was exaggerated, the claim applies to only one of the many antennas in JFD's line. There are six antennas shown in the LPV line in JFD's advertisements, DX-42-B-102 and in DX-42-B-109. JFD's technical claim with respect to one antenna, therefore, could ***43** have had only a very limited effect. Also, the performance claim in DX-42-B-102 is buried near the end of three pages of text and is not emphasized. The claim in DX-42-B-109 is hidden in the second page of text of the advertisement and is not emphasized. It is unlikely, therefore, that many customers came across or were influenced by these passages. JFD's advertising has been quite extensive and there is small likelihood that a customer would see or remember these segments of these particular advertisements, in the broad context of

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JFD's advertising.

To further support its claim of allegerly being harmed, BT asserts that in the same period that JFD was making its performance claims, BT was advertising the true performance fignres for its own DART antenna. However, on p. 4 of X-JFD-23 (A. 727), BT shows a stylized representation of an antenna response curve showing an infinite front-to-back ratio, which is perfection. This is an impossibility in the real world, and is, therefore, an apparently inaccurate representation of true performance. BT's misrepresentation constitutes unclean hands, and BT cannot now be heard to raise a misrepresentation charge against JFD.

Furthermore, BT's obviously exaggerated performance claim shows that it is common practice in the trade to exaggerate performance characterists of an antenna. Bechik Products, Inc. v. Federal Silk Mills, Inc., 135 F. Supp. 570, 579 (D. Md., 1955). Consequently, if JFD exaggerated, this is an acceptable trade practice of "puffing" rather than an intentional misrepresentation.

BT cites a letter from the Foundation to JFD, DX-42-B-112 calling JFD's advertising claims "a gimmick" and threatening to cancel the license agreement. In fact, the threat was related to JFD's not having submitted its advertising to the Foundation for prior approval, as required by the license agreement. The threat had nothing to do with JFD's publicity as to performance. Besides, ***44** since JFD has no control over the Foundation, statements it makes are not binding upon JFD. Furthermore, use of a "gimmick" is acceptable. Gimmicks sell products and aggressive competition is desirable. Drop Dead Co. v. S. C. Johnson & Son, Inc., 326 F.2d 87, 95-96 (9 Cir., 1963); cert den., 377 U.S. 907 (1964).

BT's Antitrust Counterclaim was Frivolously Asserted, was not even Seriously Prosecuted and is without Merit.

In its pleadings, BT asserted that JFD violated the antitrust laws. (A. 26-27, 43).

BT did not even make a prima facie showing of a violation of the antitrust laws, and, in fact, did not even attempt to introduce sufficient evidence to make such a showing. After listening to the meager evidence which BT relied upon for its finding of a violation of the antitrust laws (JA. 16-19, A. 347- 53), the trial Judge rightly characterized the whole charge as a sham. At A. 353, the Court said:

"We know that these antitrust counter-claims are filed--shall I say routinely--in patent cases, certain patent cases, and I get a little weary of seeing prayers in countercomplaints for preliminary injunction as a result of alleged violations of the Sherman Act not pursued at all. To me this has always smacked of a lack of dignity.... I don't like those things if they are not substantiated."

Because of the absence of proof concerning an antitrust law violation and because the antitrust claim was asserted by BT to have some relationship to the alleged acts of unfair competition, the District Court treated the unfair competition and antitrust counterclaims together. Its entire Opinion on these counterclaims was devoted to the unfair competition issue (see A. 84-88). The Opinion of the Court of Appeals similarly emphasizes the alleged unfair competition because BT made no effort to prove its antitrust claim in that Court. The antitrust counterclaim should, therefore, not even be considered by this Court.

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***45** Only under intensive cross-examination by JFD's counsel was any basis at all for BT's antitrust counterclaim stated. At A. 350-51, BT's president indicated that the only basis for BT's charge under the antitrust laws was that JFD had published a number of advertisements for its antennas, which advertisements are discussed in connection with the unfair competition counterclaim, and which advertisements made some mention of the Foundation patents under which JFD was licensed. On such a meager showing of unlawful activity, it is no wonder that the Courts below did not treat the antitrust counterclaim seriously.

BT could have taken additional testimoney from its own witnesses or JFD's witnesses or it could have obtained testimony, at trial or through depositions, from persons and business concerns who were injured by the allegedly illegal activity. That BT did not even endeavor to introduce such testimony indicates that it had no belief in the strength of its own antitrust counterclaim.

Summary as to the Unfair Competition and Anti-Trust Counts.

BT has raised a number of insubstantial arguments concerning allegedly unfairly competitive acts by JFD, and, by innuendo, has attempted to label JFD as an unfair competitor, when as a matter of law, this is not the case. The above discussion clearly shows that none of these acts was wrongful. If any of these acts were improper, none of them was intentionally so. Throughout BT's many pages of innuendo, not one probative instance of actual or actionable damage caused by JFD to BT has been shown. JFD's advertising and publicity program has the necessary result of fostering competition, which is what the anti-trust laws are intended to encourage. Drop Dead Co. v. S. C. Johnson & Son, Inc., 326 F.2d 87, 95-96 (9 Cir., 1963); cert. den., 377 U.S. 907 (1964); Bailey's Bakery Ltd. v. Continental Baking Co., 235 F. Supp. 705, 718 (D. Hawaii, 1964).

***46** In view of the foregoing, the holding of the Court below on the unfair competition and anti-trust Counts of BT's Counterclaim should be affirmed.

QUESTION NO. 5

Petitioner's Patent is Invalid Scope of Question No. 5

Question No. 5 asks whther it is mandatory for lower courts, when dealing with the "obvious" provision of 35 U.S.C. 103, to make the three inquiries formulated by this court in Graham v. Deere, 383 U.S. 1 (1966). The sufficiency of the Court of Appeals opinion in this regard is not referred to in Question No. 5. However, in petitioner's Statement of the Case and Argument, the sufficiency of findings in the opinions of both courts below with respect to "obviousness" are assailed. The petitioner dilutes the question thus posed by also asserting that it has been deprived of a right to present expert testimony with respect to its own U. S. Patent No. 3,259,904 to Blonder et al DX-26 (A. 525).

Both courts below found that Claim 5 of the Blonder et al patent was invalid, and neither court considered whether Claim 5 had been infringed.

The sole issues fairly embraced by Question No. 5 are whether the suggestions by this Court in Graham v. Deere, supra, concerning inquiries for determining "obviousness" under § 103 are mandatory, and if the making of such inquiries is required by the circumstances of this case, did the District Court make such inquiries, and if it failed to do so, did the Court of Appeals make such inquiries.

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This Court declared that the § 103 condition for patentability:
"lends itself to several basic factual inquiries" (383 U.S. 1, 17),
***47** and went on to state:
"We believe that the strict observance of the requirement laid down here will result in that uniformity and definiteness which Congress called for in the 1952 Act." (383 U.S. 1, 18)

The above language "lends itself" and "We believe" constitutes an outline of a reasonable line of approach where the facts warrant the approach and where no other approach is available or is used.

In Anderson's-Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57 (1969), after restating the inquiries suggested in the Graham case with respect to 103 "obviousness", this Court, using more forceful language than in Graham, declared:
"We admonish that 'strict observance' of those requirements is necessary." (396 U.S. 57, 62)

This Court clearly intended that inquiry be made by the lower courts but just as clearly did not intend to prohibit lower courts from resorting to any logical procedures deemed appropriate to determine whether the "obviousness" requirement of § 103 has or has not been met. In accordance with the circumstances of a particular case, the controlling consideration is whether the opinion of a lower court sets forth a sufficient factual basis for a holding predicated on the "obviousness" provision of § 103. The Trial Court and the Court of Appeals made the necessary inquiry, each in its own way, the Court of Appeals going out of its way to show it was fully aware of the requirements of Graham v. Deere.

As will hereinafter be seen, even if it is suggested that the opinion of the District Court is insufficient in this regard, the opinion of the Court of Appeals cures any possible insufficiency. Thus, the holding that Claim 5 of the Blonder et al patent is invalid should be affirmed.

***48** The Opinions Below Contain the Required Findings to Support a Holding of Invalidity Under 35 U.S.C. 103

Even though the District Court could have made more findings of fact than it actually made, its opinion was clear enough for both the Court of Appeals and petitioner to recognize the factual basis for the conclusion that Claim 5 is invalid under § 103. The Court of Appeals was able from the record to make the findings suggested by Graham v. Deere. Any alleged error committed by the District Court in making its findings, if such error existed, was cured by the Court of Appeals and did not require remand by that Court on the issue of patent invalidity. Leighton v. One William Street Fund, Inc., 343 F.2d 565, 567 (2 Cir. 1965); Swain v. Boeing Airplane Co., 337 F.2d 940 (2 Cir., 1964), cert. den. 85 S. Ct. 1083; Urbain v. Knapp Bros. Mfg. Co., 217 F.2d 810 (7 Cir. 1954).

More important, in this particular case, since a full adequate Record was made at trial and since the issue of patent invalidity depends upon interpretation of written documents and examination of physical exhibits, the Court of Appeals was able to make, and did make, its own findings [FN12] addressed to each of the "obviousness" inquiries suggested in the Graham decision

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FN12. Seligson v. Roth. 402 F. 2d 883, 887 (9 Cir. 1968) and B. F. Goodrich v. Rubber Latex Products Inc., 400 F. 2d 401. 403 (6 Cir., 1968).

As for the scope and content of the prior art, the Court of Appeals found that Mr. Blonder, one of the coinventors, "testified that all the mechanical elements in claim 5 were old" (A. 70), and that a substantial separation of dipole located "planes is clearly shown * * * in the 1961 publication * * *, Technical Report No. 52, of the Antenna Laboratory". (A. 70)

***49** As for the difference between claim 5 and the prior art, the Court of Appeals noted that:

"Blonder-Tongue places chief reliance upon the fact that while Isbell teaches that the two planes in which the dipole elements lie are to be close enough together so that the dipoles are substantially coplanar, Blonder teaches that the planes may be separated by some distance, but less than the wavelength of the band". (A. 70)

As for the level of ordinary skill in the art, the Court of Appeals, after discussing the subject matter of the Blonder et al patent, found that:

"The very nature of the subject matter suggests that it was directed at the type of problems which might be solved when addressed by persons with ordinary skill in the art". (A. 69)

Thus, it is clear that the Court of Appeals meticulously followed the suggested line of inquiry set forth in the Graham opinion and made findings sufficient to support the holding that Claim 5 is "obvious" within the meaning of § 103.

Accordingly, the holding of the Court of Appeals that Claim 5 of the Blonder et al patent is invalid is not properly subject to a technical attack as failing to follow the Graham case, and such holding should be affirmed.

Further, under the circumstances of this particular case, even the opinion of the District Court contains sufficient findings to show that the Court had made those § 103 inquiries suggested in the Graham ease:

(a) The prior art is referred to in the opinion at A. 79.

(b) The scope and content of the prior art is covered by the testimony of one coinventor who admitted that all the mechanical elements of Claim 5 were old (JA. 14); it was therefore not necessary to discuss each element in detail.

***50** (c) The level of skill in the art is discussed in that portion of the opinion dealing with validity of the Foundation's patents.

(d) The extremely close correspondence between the prior art and Claim 5 is such that "obviousness" is clear even to one not skilled in the antenna art so that it was not necessary to determine the higher level of one skilled in such art.

(e) Blonder admitted that all structural elements of Claim 5 were known to the prior art (JA. 14), so that it was not necessary for the District Court to find that particular elements of Claim 5 were not present in the prior art.

Petitioner Has in Its Brief Raised Issues Beyond the Fair Scope of Question No.

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All issues fairly embraced by Question No. 5 can and should be resolved without reviewing evidentiary matters. JFD's argument up to this point on Question No. 5 covers all issues fairly embraced by Question No. 5.

But, under the guise of responding to Question No. 5, petitioner has gone far beyond the scope of Question No. 5 by raising issues of due process and patent validity, and makes the naked claim that Claim 5 is infringed. See, Supreme Court Rule 40(d) (2); General Talking Pictures Corp. v. Western Electric Co., 304 U.S. 175, 179 (1938); Dickinson Industrial Site v. Cowan, 309 U.S. 382, 389 (1940); Trailmobile Co. v. Whirls, 331 U.S. 40, 50 (1947).

As for BT allegedly being deprived of an opportunity to present expert testimony concerning the Blonder et al patent, Mr. Blonder was qualified as an expert in the art here involved (A. 333-6), and testified as BT's expert in that portion of this case charging infringement of the Blonder et al patent. Since on Page 66 of petitioner's Brief Blonder is referred to as "a masters-degree engineer", and at Trial BT's attorney referred to Blonder "as one skilled ***51** in the art" (A. 335), petitioner should not be permitted to deny that Blonder is a technical expert.

Thus, it is clear that petitioner had the benefit of expert testimony at trial of this action.

Even though this Court should not burden itself by reviewing the Record insofar as it relates to the evidentiary Matters for establishing patent invalidity, petitioner has gone beyond the scope of Question No. 5 and attacked the substantive basis for holding Claim 5 invalid.

Both courts below found Claim 5 to be Invalid.

If this court feels compelled to consider this issue, reference is made to the arguments presented by JFD to the Court of Appeals slowing invalidity of Claim 5 based on prior art, file wrapper estoppel, lack of invention, inoperativeness, indefiniteness, and insufficient disclosure. These arguments are set forth in detail in Addendum A of this brief entitled "Claim 5 of BT's U.S. Patent No. 3,259,904 (DX-26) Is Invalid".

BT's Assertions of Patent Validity Are Misleading and Irrelevant

The assertions in paragraphs numbered 1 through 8 on pp. 64-66 of Petitioner's Brief are misleading in their attack on the finding of obviousness. In Paragraphs 1 through 3 the most pertinent prior art citations, viz. Technical Report 52, X-JFD-10 (A. 705), the Mayes Antenna, X-JFD-13 and the Heslin Antenna, X-JFD-SD are not considered. Neither Mr. Blonder's testimony nor the Blonder et al patent (DX-26) (A. 525) refers to this prior art.

As to Paragraphs 4 and 5 on p. 65 of Petitioner Is Brief, the prior art is not limited to commercially available items. The alleged improvement of Claim 5 was taught by any one or a combination of X-JFD-10, 13 or 8D and prior art patents. By relying upon 35 U.S.C., Sec. 103 ("obvionsness") rather than upon 35 U.S.C., See. 102 (direct antlcipation), ***52** both Courts below recognized, that no single reference taught each and every element of Claim 5. However, a combination of

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references, such as in the chart X-JFD-14, shows the alleged invention of Claim 5 to be "obvious".

As to paragraph 6, testimony concerning surprise as to the success of his invention was not unexpected when coming from Blonder, one of the inventors of the BT patent in suit. Heslin's testmony (JA. 29-31) refers to surprise if he could feed his own 72 ohm antenna X-JFD-8D with a 300 ohm open wire line and obtain desired results without using a coupler. (See discussion concerning high SWR beginning at JA. 29.) Heslin was not concerned with BT's antenna in this testimony. The BT patent in suit DX-26 does not show or teach means for avoiding a high SWR when there is a large mismatch between the impedance characteristic of an antenna and the impedance of the transmission line feeding such antenna, and there is nothing of record to show that such a result is possible without using a coupler (transformer). In fact, instruction sheet X-JFD-26C (JA. 41) for BT's Color Ranger 3 antenna, at the middle of paragraph 4, states that "a matching transformer is required" when using coaxial cable (72 ohm) with the Color Ranger 3, since the latter is designed to operate with 300 ohni cable or twinlead.

As to paragraphs 7 and 8 on p. 66 of Petitioner's Brief, even though the Isbell and Mayes, et al patents were cited by the Patent Office, this does not indicate that the Patent Office knew of the more pertinent prior art cited by JFD in this action, including X-JFD-10, 13 and 8D. BT suggests that JFD copied its twin boom antennas from BT. However, the twin boom antenna, X-JFD-13, was built for the JFD consultant Dr. Mayes in 1961 (JA. 34), and he was designing twin boom antennas, including the LPV-VU-18 of DX-27A, for JFD in the Spring of 1963 .(JA. 35), while the BT TV antennas did not reach the market place until the Fall of 1963 (JA. 7).

***53** The allegedly "relatively widely spaced booms" of the Blonder-Schenfeld construction were part of the prior art to Blonder, et al, such as X-JFD-10 and 3A (JA. 705 and 673). In fact, X-JFD-3A suggests a spacing of as much as 7.75 inches, while the Blonder-Schenfeld spacing is only 1.0 inch (A. 526). (Col. 2, line 51 of DX-26.) This argument concerning alleged wide spacing of Blonder-Schenfeld's booms raises an irrelevant issue since Claim 5 of DX-26 does not require that the longitudinal conductors (booms) be widely spaced. The only requirement in Claim 5 is that the booms be spaced vertically in a vertical plane and that the boom spacing be less than the spacing between dipoles. Without referring to the Isbell and Mayes and Carrel patents PX-1 (A. 399) and 20 (A. 404), it is clear that the prior art antenna of Heslin (X-JFD-8D) includes boonis spaced vertically in a vertical plane as does the prior art Mayes antenna (X-JFD-13). Further, the prior art Technical Report No. 52 X-JFD-10 (A. 705) shows a log periodic antenna with parallel booms spaced vertically in a vertical plane (Fig. 6 of X-JFD-10) (A. 709).

Furthermore, twin boom antenna structures fed at the front end by parallel-wire transmission lines were known in the prior art. See Technical Report 52, X-JFD-10, at p. 18. There is no suggestion in the Blonder et al. patent DX-26 that the parallel-wire transmission line mounting and feed feature illustrated therein is critical, as BT now asserts in paragraph S. This feature is not essential because the performance of the antenna shown in Figure 1 of DX-26 would not deteriorate if the transmission line was brought directly from the connecting points 1" and 1'" to the standoff on mast M without passing through guide portions 2' and 4' (JA. 35). This last mentioned manner of mounting the transmission line (which does not use the allegedly critical feature) is the recommended way of using BT's log periodic twin

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boom antenna Ranger 3 (See instruction sheet X-JFD-26C) (JA. 41). The Ranger 3 is claimed by Blonder to be covered by Claim 5 (JA. 12). The limitation in the patent, therefore, is not critical since BT's own antenna ***54** allgedly covered by the patent, does not include this construction.

In addition, the BT Ranger 3 (X-JFD-26A) does not include even one standoff for supporting the transmission line. Not only is this transmission line support not critical, but the provision of standoffs or strain reliefs connected to antenna booms and positioned adjacent to the point of connection for twin lead was admitted by Blonder to be old in the art (JA. 12). X-JFD-4A, 4B, (A. 702), 5A, 5B (A. 704), 5C show examples of prior art constructions for boom mounted standoffs positioned adjacent to the twin lead connecting points separated by insulators labelled 100 in X-JFD-4A, 4B (A. 702), 5A.

The doctrine of Minneapolis-Honeywell Regulator Co. v. Midwestern Instruments, Inc., 298 F. 2d 36, 38 (7 Cir., 1962), cited on pages 64 and 68 of petitioner's brief as a basis for criticizing the quantity of prior art cited by JFD, is not in point in that in this case much of the prior art was cited merely to show the similarities between the prior art and JFD's accused antennas. One approach taken by JFD on invalidity requires the combination of only two prior art references (See Chart X-JFD-14 at JA. 39). The Court of Appeals found that the alleged improvement of claim 5 was shown in Technical Report 52, X-JFD-10 (A. 705) and the District Court found invalidity on four different grounds with each of three of these grounds referring to but a single prior art reference.

Infringement

Infringement of the Blonder, et al patent is far beyond the scope of Question No. 5 and would require detailed study of voluminous evidence. The finding of invalidity by both Courts below rendered moot the question of infringement. Hence, neither opinion below makes reference, either directly or indirectly, to whether the accused JFD antennas come within the scope of claim 5.

***55** Conclusion as to Question No. 5

The Court of Appeals meticulously made the inquiries suggested by Graham and by doing so cured any defect in this regard that may have been present in the opinion of the District Court. The findings and opinion of the trial court provided the material for the findings made in specific Graham v. Deere form by Court of Appeals.

Issues of due process, patent validity, and patent infringement are beyond the fair scope of Question No. 5 and should not be considered by this Court.

Accordingly, the Court of Appeals holding that Claim 5 of the Blonder et al patent is invalid should be affirmed.

Conclusion

There is no error in the decision of the Court of Appeals. There is no basis for holding that any finding was clearly erroneous. There is, therefore, no basis for reversing the decision of that Court with respect to validity of the Isbell patent, the invalidity of the Blonder-Schenfeld patent, the holding that there was no fraud in procurement or use of the Isbell patent or that there was no basis whatever for the charge of violation of the anti-trust laws or the charge of unfair competition.

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***56** The decision of the Court of Appeals should be affirmed.

Appendix not available.

U.S., 2004.
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• 1971 WL 133761 (Appellate Brief) Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of Kawneer Company, Inc. (Jan. 08, 1971)Original Image of this Document (PDF)

• 1971 WL 133763 (Appellate Brief) Brief for the United States as Amicus Curiae (Jan. 08, 1971)Original Image of this Document (PDF)

• 1971 WL 133760 (Appellate Brief) Brief of Respondent University of Illinois Foundation. (Jan. 04, 1971)Original Image of this Document (PDF)

• 1971 WL 133762 (Appellate Brief) Brief for the American Patent Law Association as Amicus Curiae (Jan. 04, 1971)Original Image of this Document (PDF)

• 1970 WL 122671 (Appellate Brief) Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of Automatic Electric Company (Dec. 31, 1970)Original Image of this Document (PDF)

• 1970 WL 122669 (Appellate Brief) Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of the Finney Company Supporting the Position of the Petitioner That the Isbell Patent in Suit is Invalid. (Dec. 07, 1970)Original Image of this Document (PDF)

• 1970 WL 122667 (Appellate Brief) Petitioner's Brief. (Dec. 02, 1970)Original Image of this Document with Appendix (PDF)

• 1970 WL 122668 (Appellate Brief) Reply of Respondent University of Illinois Foundation to Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit. (Jul. 27, 1970)Original Image of this Document (PDF)

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1971 WL 133760 (U.S.)

For opinion see 91 S.Ct. 917, 91 S.Ct. 563, 91 S.Ct. 449, 91 S.Ct. 363, 91 S.Ct. 101

Briefs and Other Related Documents

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Supreme Court of the United States.
BLONDER-TONGUE LABORATORIES, INC., Petitioner,
v.
UNIVERSITY OF ILLINOIS FOUNDATION, and JFD Electronics Corporation, Respondents.
No. 338.
October Term, 1970.
January 4, 1971.

On Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit.

Brief of Respondent University of Illinois Foundation.

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***1** STATUTES.

Conditions for patentability--Non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such ***2** that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 10, 1952, c. 950, § 1, 66 Stat. 798.

Presumption of validity-Defenses.

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting it. * * * July 19, 1952, c. 950, § 1, 66 Stat. 812; July 24, 1965, P. L. 89-83, § 10, 79 Stat. 261.

Attorney fees.

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The court in exceptional cases may award reasonable attorney fees to the prevailing party. July 19, 1952, c. 950, § 1, 66 Stat. 813.

STATEMENT OF THE CASE.

We call the Court's attention to the following errors and/or omissions in Blonder-Tongue's statement of the case. The sections are labeled to correspond with those in the brief of Blonder-Tongue (B-T).

In the Introduction to its Statement of the Case (B-T Brief, p. 5), and indeed in many other portions of its brief (note, in particular, pages 17-23), Blonder-Tongue ***3** alludes to its alleged deprivation of due process, arising from the fact that the trial court refused on December 26, 1967 to grant it an additional delay in the start of the trial, which had been postponed from October 23rd to December 18, 1967 at the request of Blonder-Tongue (A. 6, 132). The trial actually started on December 28, 1967 (A. 7).

Blonder-Tongue's argument in this regard was fully considered and rejected by the Court of Appeals for the Seventh Circuit (A. 55) and has not been presented to this Court as a question for review.

With respect to the Mayes et al. patent (B-T Brief, p. 6) there is no support for Blonder-Tongue's statement that the Court of Appeals for the Seventh Circuit reversed "by holding that the University of Illinois Foundation had indeed presented half-truths to the Patent office". The sole basis for the finding of invalidity of the Mayes patent was obviousness of the invention in view of the prior art (A. 65).

As to Question 4 (Fraud, Unfair Competition and Antitrust, B-T Brief, p. 7) the allegation that the Court of Appeals "found deception in the procurement of the Mayes patent" is without foundation. The court found no fraud had been committed (A. 67) and found that the failure to inform the Patent Office of what later proved to be a prior publication served only to rebut the presumption of validity of the Mayes et al. patent (A. 68).

Blonder-Tongue's allegation (Brief, p. 7) that the Isbell and Mayes et al. patents were "prosecuted together" in the Patent Office is misleading. Like every other patent application in the Patent Office, these were prosecuted individually. If Blonder-Tongne means to say that the periods of prosecution overlapped, which is the case, then we have no quarrel.

***4** There is no support in the record for the allegations made by Blonder-Tongue (Brief, p. 8) that the Isbell and Mayes et al. patents were "used in widespread threats and coercion in the marketplace"; that JFD was guilty of unfair competition in "hiring away, during preparation for trial, petitioner's key witness"; or that "other acts of unfair competition" had been committed. The only support for these charges is Blonder-Tongue's own allegations. Both courts that have considered them have found no merit whatever in these claims (A. 68, 69, 84-88).

SUMMARY OF ARGUMENT.

Question No. 1 (re Triplett v. Lowell).

The Triplett rule that a finding of patent invalidity is not res judicata is based on and consistent with sound legal principles which advance the public interest and

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should continue to be adhered to. The arguments usually offered in support of a change in the rule, namely, (1) that relitigation of patents already held invalid represents a substantial and unnecessary burden on the courts, and (2) that the rule prejudices the public interest in seeing that invalid patents are eliminated, are not well founded. The number of relitigated patents is so small as to be insignificant, as shown by a 1961 study prepared for the Subcommittee on Patents, Trademarks and Copyrights of the Senate Judiciary Committee. This report showed that during the 10 year period from 1949 through 1958, only about 1% of the patent cases filed in that period involved patents which were being relitigated after a prior determination of invalidity.

Similarly, the argument that relitigation of patents once held invalid is against the public interest ignores the equally important consideration that it is as much in the ***5** public interest to uphold a good patent as to strike a bad one. Because of the complex and intricate inherent nature of the issue of patent validity, the Triplett rule affords a desirable safeguard against erroneous findings of invalidity which is in the best interest of both patentees and the public.

Any change in the Triplett rule should be made only after careful consideration and for compelling reasons. In order to properly balance the sometimes conflicting interests of patentees, accused infringers and the public, while avoiding undue burden on the courts, any such change, if considered necessary, should be made by Congress, which is more flexible in its operation and in a better position to conduct the comprehensive investigation which the nature of the subject demands.

Question No. 2 (re Retroactive Application of Change in Triplett Rule).

Even if the Court decides that the rule in Triplett should be changed, it would be manifestly unfair to apply the change to respondent in this case. The finding of invalidity relative to the Isbell patent is even now not yet final, since there is still pending before this Court a petition for reconsideration of the denial of certiorari in the Winegard case. Further, at the time respondent initiated litigation against Winegard, Blonder-Tongne, and others, it had every justification for believing that a finding of invalidity in any one ease would not be applied in any other action. It would also be unfair for this Court to change the Triplett rule and to hold that respondent is barred by the Winegard litigation, and thereafter to hold that the Winegard case was improperly decided, if the Court agrees that the Court of Appeals for the Eighth Circuit applied an improper legal standard. The inequity ***6** which might result to respondent is a further reason for suggesting that any change in the rule be made by legislative action, which is more flexible in setting up means for avoiding such injustice.

Question 3 (re Isbell Patent).

The holdings of the courts below that Isbell's invention was nonobvious and hence valid under the standards set out by this Court in Graham v. John Deere Co., 383 U. S. 1, 17-18 (1966) is fully supported by the findings of fact which these courts made. Even though the individual elements of which Isbell's antenna is composed were known in combination with other elements, there was no basis on which one skilled in the art would find it obvious to first isolate the particular elements used by Isbell from the prior art and then combine these elements as Isbell did. Although there was a general theory which permitted a designer to design a "log-periodic"

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structure which potentially might be frequency independent in operation, the art itself recognized and the courts below found that it was impossible to predict which structures made in this manner would in fact have frequency independent properties. The number of log-periodic structures which could be designed using the known active elements was countless, and very few of the possible structures were frequency independent. Moreover, none of the possible structures could be singled out as having a greater likelihood of being frequency independent than the others. Accordingly, it was not obvious to test any one structure, such as that made by Isbell, to determine if it had frequency independent properties, on anything other than a blind trialand-error, hit-or-miss basis.

The holding of the Eighth Circuit Court of Appeals that the Isbell patent is invalid was based on an obvious-***7** to-try standard which is improper under the facts of this case. Applying such a standard effectively destroys the patent system, since any result, regardless of how unexpected, nonobvious, or unpredictable, can be achieved, at least theoretically, by a trial-and-error combination of known elements.

Blonder-Tongue has not presented any persuasive reason why the concurrent findings of the courts below should be reversed.

Question 4 (re Fraud, Unfair Competition, and Antitrust).

No fraud was committed during the prosecution of the Mayes et al. patent, as found by the Court of Appeals for the Seventh Circuit. If any trace of "unclean hands" resulted as a result of the prosecution of the Mayes patent, it is confined to that patent alone and does not affect the enforceability of the Isbell patent.

The courts below found that no conspiracy, acts of unfair competition, or antitrust violations were committed by either of the respondents, without which there is no basis for holding the Isbell patent to be unenforceable.

Question 5.

The trial court followed the procedure established by this Court in Graham v. John Deere Co. for considering the question of nonobviousness, even if its findings were not explicitly set forth. The Court of Appeals had no difficulty in affirming the propriety of the trial court's decision.

***8** ARGUMENT.

QUESTION 1.

(re Triplett v. Lowell.)

In the case of Triplett v. Lowell, 297 U. S. 638 (1936), this Court held that a determination of patent invalidity is not res judicata binding the patentee in subsequent litigation against a different defendant. The Court has requested the parties in this case to address themselves to the question of whether the above holding in the Triplett case should be adhered to, and if not, whether the prior determination of invalidity in the Winegard litigation binds the respondents in this case.

While we agree with Blonder-Tongue that the Triplett rule should not be reversed, we consider that the Court has asked the parties to discuss both sides of the

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question, and accordingly we will attempt to do so.

To summarize our position, we believe that the Triplett rule should not be changed by this Court, for the following reasons:

1. The rule of Triplett v. Lowell has been the law of the land for many years, and during that time it has, in our opinion, served well both the interests of the public as well as those of patentees. Any change in the rule should be made by Congress only after appropriate hearings and for compelling reasons. The pertinent factors to be considered in deciding whether the rule should be changed are many and complex, and involve balancing the rights of patent owners, accused infringers and the public interest and establishing new procedures designed to protect these various interests while avoiding undue burden ***9** on the courts. For this reason we suggest that any change in the rule should be made only by the legislature, after full and careful hearings of all the factors involved, and, if desirable, with appropriate changes in venue and other provisions which could not be made by this Court.

In this connection, it is of interest to note that Congress has considered the matter several times since the handing down of the Triplett rule, most recently in connection with the "Patent Reform Act of 1967", from which the so-called "in rem invalidity" clause was specifically deleted.

2. A change in the Triplett rule would make more difficult the establishment of uniform rules and standards for guidance of the lower courts in patent cases. Under its usual procedure, this Court does not grant certiorari in patent cases unless there are conflicting decisions of two courts of appeals. Thus, if the Triplett rule were reversed, no effective opportunity would be presented to this Court to review the standards applied in the case of patent actions brought originally in those circuits in which substantially all of the patents are held invalid.

3. Changing the Triplett rule would impose an unfair burden on those who, like respondent here, entered into multiple litigation relying on the Triplett v. Lowell doctrine. Proper means for avoiding individual injustice in such cases can be more readily provided by legislative action. If the Triplett rule is to be reversed, we submit that the venue provisions relating to patent infringement actions should also be changed to provide that all infringers may be sued together in one action, without limitations as to residence, place of business, or locale of acts of infringement. It is manifestly unfair to subject a patentee to a game of legal "Russian roulette", in which he may lose all his patent rights, yet stands to win only the right to take the same chance against another defendant.

***10** In the present case, the Foundation was forced to bring multiple actions, in the Eighth as well as the Seventh Circuits, not because it wished to multiply litigation, but because of a need to protect the patent. Under such circumstances, it would be highly unfair to bind a patentee if the patent is held invalid in the first action, yet to leave him vulnerable in the event his patent is upheld.

4. The arguments advanced for changing the Triplett rule, on careful examination, are not well founded and do not overcome the disadvantages which a change in the rule would entail.

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In general, the rationales propounded contra to the Triplett holding fall into the following two categories:

A. Relitigation of patents which have previously been declared invalid represents a substantial and unnecessary burden on the courts and public.

B. Since the public is a silent but important party in interest in all patent litigation, the Triplett rule significantly prejudices the public's interest in the elimination of specious patents.

Each of the above arguments for changing the Triplett rule will be separately evaluated in the following discussion.

A. The Triplett Rule Does Not Represent a Substantial and Unnecessary Burden on the Courts and Public.

The argument that the Triplett rule is burdensome was aptly presented by Judge Schnackenburg in his concurring opinion in the case of Aghnides v. Holden, 226 F. 2d 949, 951 (7th Cir. 1955), wherein he stated:

"[A] suit testing the validity of a patent is not a proceeding in rem and hence Aghnides may litigate and relitigate again and again the question of validity of his patent as long as he selects a different defendant in each of the infringement suits which he files, thus ***11** avoiding the wholesome doctrine of res adjudicata. This queer result is one which we are unable to avoid. It is a situation which is particularly abhorrent when considered against the backlog of untried cases which clogs our federal courts. The latter are cases where the litigant asks only for his day in court, not a plurality of (lays in court as Aghnides is entitled to under the existing law. The remedy lies not in our hands. The congress could by legislation grant relief."

This position, while on its face appealing to both reason and logic, fails Oil several grounds.

1. The Holding in Triplett Is Not an Exception to the Doctrine of Res Judicata.

It should be carefully noted that this Court held in Triplett that the doctrine of res judicata may not be pleaded as a defense in a subsequent suit against a different defendant. This is in effect merely an application of the so-called "mutnality" rule which requires that a person who seeks to claim the benefits of an adjudication upon any matter decided in a prior section be a party or privy in the prior adjudication sought to be relied upon. Restatement, Judgments § 93 (1942). [FN1]

> FN1. Comment d, example 10, to section 93 of the Restatement applies the mutuality rule directly to the factual situation raised in this case, that is: "10. A brings an action against B for infringement of a patent. B defends on the ground that the alleged patent was void and obtains judgment. A brings an action for infringement of the same patent against C who seeks to interpose the judgment in favor of B as res judicata, but, setting up no relation with B. On demurrer, judgment should be for A."

The mutuality requirement applied in Triplett is deeply rooted in the jurisprudence of the courts in this country.

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As early as 1887 this Court noted in Litchfield v. Crane, 123 U. S. 549, 552, that "estoppels to be good must be mutual." Likewise, in the later case of Bigelow v. Old Do***12** minion Copper Min. & S. Co., 225 U. S. 111, 127 (1912), the Court held, "it is a principle of general elementary law that the estoppel of a judgment must be mutual."

Although the doctrine of mutuality has been criticized by some writers, [FN2] and a few courts have avowedly rejected the doctrine, [FN3] it appears, in reviewing the authorities generally cited as indicating an erosion of the doctrine, that the courts in fact have been merely applying the doctrines of stare decisis and comity in spite of their broad language concerning the application of res judicata and rejection of mutnality.

FN2. See generally Currie, Mutuality of Collateral Estoppel: Limits of the Bernhard Doctrine, 9 STAN. L. REV. 281 (1957); Currie, Civil Procedure: The Tempest Brews, 53 CALIF. L. REV. 25 (1965); Comment, Mutuality of Collatercal Estoppel, 63 Nw. U. L. REV. 209 (1968). It should be noted also that there is ample authority urging the retention of the mutuality doctrine. See Von Mosehzisker. Res Judicata, 38 YALE L. J. 299 (1929); Moore & Currier. Mutuality and Conclusiveness of Judgments, 35 TULANE L. REV. 301 (1961.); Greenehaum, In Defense of the Doctrine of Mutuality of Estoppel, 45 IND. L. J. 1 (1969).

FN3. "[T]he doctrine of mutuality is a dead letter." B. R. DeWitt, Inc. v. Hall, 19 N. Y. 2d 141, 147, 225 N. E. 2d 195, 278 N. Y. S. 2d 596 (1967).

The distinction between the doctrine of res judicata and the doctrines of stare decisis and comity is an important one because application of stare decisis and comity, unlike the strict mechanical rule of res indicata, allows the court to examine the facts of the later-filed suit in order to determine whether they warrant relitigation of the issue decided in a prior suit. Likewise, the doctrines of stare decisis and comity allow the court to examine the rule of law applied in the prior suit in order to insure that the needs of justice have been fully met. As this Court stated in Mast, Foos & Co. v. Stover Mfg. Co., 177 U. S. 485, 488-89 (1900):

"Comity is not a rule of law, but one of practice, convenience, and expediency. It is something more than mere courtesy, which implies only deference to the ***13** opinion of others, since it has substantial value ?? securing uniformity of decision, and discouraging repeated litigation of the same question. But its obligation is not imperative. If it were, the indiscreet nction of one court might become a precedent, increasing in weight with each successive adjudication, until the whole country was tied down to an unsound principle. Comity persuades; but it does not command. It deela??s, not low a case shall be decided, but how it may with propriety be decided. It recognizes the fact that the primary duty of every court is to dispose of cases ??cording to the law and the facts; in a word, to deci??e them right.... Clearly it applies only to questions which have been actually decided, and which arose under the same facts."

Two recent patent cases are generally cited as ab??lishing the mutuality requirement in the application of the d??ctrine of res judieata. However, both of these cases, Nickerson v. Pep Boys--Manny, Moe & Jack, 247 F. Supp. 221, 224 (D. Del. 1965), and Technograph Printed Cir., Ltd. v. Packard Bell Elec. Corp., 290 F. Supp. 308, 318 (C. D. Cal. 1968), rested their decisions on the fact that no new

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eviden??e concerning validity was presented by the patentee in the subsequent suit. If the strict legal doctrine of res judi??ata or collateral estoppel had been mechanically applied i?? these cases, the "new evidence" considered and discussed??n both of these cases would have been totally irrelevant. [FN4] How ***14** ever, since these courts did consider the "new evidence" issue, they were in effect according the prior decisions comity, as explained by this Court in the above-mentioned Mast decision, and which is specifically provided for in Triplett. [FN5] This line of reasoning has been followed in the Third, Seventh, and Ninth Circuits, wherein the "new evidence" was evaluated in disposition of motions for summary judgment by one not privy to the previous litigation. [FN6]

FN4. See Southern Pac. R. R. v. United States, 168 U. S. 1, 62, 65 (1897). This mechanical application of estoppel to prevent the introduction of new evidence in the subsequent suit brought by the patentee has been used by a district court in only one instance to date. In the case. Nickerson v. Kutschera, 295 F. Supp. 1 (D. Del. 1969), rev'd, 419 F. 2d 983 (3d Cir. 1969), the district court stated:
"But with all deference to the Courts which have made 'new evidence' the eontrolling criteria in refusing to apply the doctrine of collateral estoppel to issues decided in a patent infringement action, it would appear conceptually that this test is irrelevant and contrary to controlling precedent in the field of collateral estoppel generally." 295 F. Supp. at 6.

FN5. "[T]he earlier decision may by comity be given great weight in a later litigation and thus persuade the court to render a like decree...." 297 U. S. at 642.

FN6. See Nickerson v. Kutschera, 390 F. 2d 812 (3rd Cir. 1968); Technograph Printed Cir., Ltd. v. Methode Elec., Inc., 356 F. 2d 442 (7th Cir. 1966); Technograph Printed Cir., Ltd. v. Packard Bell Elec. Corp., 290 F. Supp. 308 (C. D. Cal. 1968).

In the area of patent litigation, there is a special reason why relitigation should not be automatically banned as needless or redundant by strict application of the doctrines of res judicata and collateral estoppel. As recognized by Judge Learned Hand in Harries v. Air King Prods. Co., 183 F. 2d 158, 162 (2d Cir. 1950), the issue of patent validity is "as fugitive, impalpable, wayward, and vague a phantom as exists in the whole paraphernalia of legal concepts.... If there be an issue more troublesome, or more apt for litigation than this, we are not aware of it." [FN7]

FN7. As noted in Triplett (297 U. S. at 643-44), this Court has several times held valid claims of a patent held invalid by a Circuit Court of Appeals in an earlier suit brought by the patentee against another defendant. See Expanded Metal Co. v. Bradford, 214 U. S. 366 (1909); Diamond Rubber Co. v. Consolidated Rubber Tire Co., 220 U. S. 428 (1910); Abercrombie & Fitch Co. v. Baldwin, 245 U. S. 198 (1916).

It is submitted that due to the intrinsic nature and complexity of the subject, the first decision finding invalidity call be quite wrong or based on an insufficient record or presentation through no fault of the patentee. [FN8] The inflex ***15** ible and mechanical rule of res judicata is not appropriate for this type of litigation. The more flexible and equitable doctrines of stare decisis [FN9] and comity fully

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enable the courts to properly give great weight to the prior finding of invalidity while permitting review of any new evidence presented at the pre-trial and summary judgment stage, and grant the courts of the various circuits the independence contemplated by the Mast decision to insure that the ends of justice have been fulfilled. [FN9a]

FN8. See Technograph Printed Cir., Ltd. v. United States, 372 F. 2d 969, 977-78 (Ct. Cl. 1967).

FN9. For a patent case involving application of stare decisis (i.e., the binding effect of a prior judgment in the same circuit), see Rains v. Jil-Mic., Inc., 301 F. Supp. 545 (S. D. N. Y. 1969).

FN9a. It should also be noted at this point that under 35 U. S. C. § 285 (1954), a court has the power to award attorneys' fees to a defendant sued in bad faith for infringement of an obviously invalid patent. See Dole Valve Co. v. Perfection Bar Equip., Inc., 318 F. Supp. 122 (N. D. Ill. 1970). This section certainly mitigates against any abusive relitigation of patents properly held invalid in a prior suit against a different defendant.

2. Relitigation of Patents After an Initial Finding of Invalidity Does Not Represent a Significant Burden on the Federal Courts.

In 1961 the Subcommittee on Patents, Trademarks, and Copyrights of the Senate Judiciary Committee published the most comprehensive study to date concerning patent litigation in the federal district courts. [FN10] The study, covering the ten year period from 1949 through 1958, reported that during this period a total of 6,057 patent suits were commenced. [FN11] Of this number, only 62 cases (approximately ***16** 1%) involved patents which were being relitigated after a prior determination of invalidity. [FN12]

FN10. STAFF OF SUBCOMM. ON PATENTS, TRADEMARKS, AND COPYRIGHTS, SENATE COMM. ON THE JUDICIARY, 86TH CONG., 2D SESS., An Analysis of Patent Litigation Statistics (Comm. Print 1961) [hereinafter cited as 1961 Subeomm: Rep.].

FN11. Id. at 12 (Table 1). According to the most recent annual report of the administrative Office of the United States Courts, during the ten year period from 1959 through 1968 a total of 648,767 civil cases were filed in the U. S. courts; 7,875 of these (approximately 1.2%) being patent cases. 1969 ADMIN. OFFICE OF THE U. S. CTS. REP.

FN12. Id. at 19 (Table 16).

It is interesting to note that the majority of these subsequent suits were terminated without a second adjudication of the validity of the patent. [FN13] However, nine patents did receive a redetermination on the merits concerning validity, [FN14] of which seven were found to be valid. [FN15]

FN13. Id. at 19 (Note to Table 16).

FN14. Rollins, In Rem Invalidity: A solution in Search of a Problem?, 52 J. PAT. OFF. SOC'Y. 561, 569 (1970).

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FN15. 1961 Subcomm. Rep. 19 (Table 16).

This study makes clear two compelling facts. First, the number of patents which are relitigated after a finding of invalidity is so small that the problem seems to be de minimis. Of the total number of patent suits filed during the period studied, only about 1% involved patents which were being relitigated after an initial finding of invalidity. The results of the study permit the conclusion that suits involving relitigation of a previously determined invalid patent represent, on the average, only one out of every 10,000 civil cases filed in the federal courts.

The second compelling fact demonstrated by the study is that a substantial number of the patents which are relitigated after an initial holding of invalidity are held valid in the subsequent litigation. In fact, seven of the nine patents which had their validity redetermined during the period of the study were found to be valid. In view of the substantial weight given by the district courts to a prior holding of invalidity, this remarkable statistic tends to indicate that a patentee will risk the expense of relitigation only where his patent is of unusual merit and he is convinced, almost to the point of certainty, of the error of the prior decision.

It is apparent from these figures that the mechanical ***17** application of res judicata to foreclose subsequent suits on patents held to be invalid may well result in more valid patents being sacrificed than invalid patents being justly suppressed. In any event, surely "the doctrine of judicial finality is not a catch-penny contrivance to dispose of cases merely for the sake of disposition and ... [clearing] up dockets...." [FN16]

FN16. 1B MOORE, FEDERAL PRACTICE par. 0.412 [1], at 1811 (2d ed. 1965).

Further, reversal of the Triplett rule would probably lead to a flood of applications for reissue patents. The issues of infringement and validity are so intimately associated that one cannot be sure that a finding of invalidity is not really based on a finding that the patent is invalid if stretched to cover the defendant's acts. Accordingly, patentees would seek to protect their patents by having them reissued with slightly narrower claims.

Any relaxation in the requirement for mutuality in the doctrine of res judicata should, at the very least, insure that some significant benefit will ultimately be achieved toward lessening the case load in the federal courts, which probably cannot be accomplished without a change in venue rules to permit a patentee to join concurrent infringers in the same action, and insure that the ultimate ends of justice to the parties will not be thwarted. It is submitted that reversing the Triplett rule will achieve neither of these desired ends.

3. The Right To Be Heard Is Guaranteed by the Constitution.

It is a constitutional necessity that a person be afforded a right to be heard before he is estopped on the basis of a previous suit. [FN17] Therefore, by abandonment of mutuality as ***18** a requirement for the application of res judicata, there still remains the constitutional requirement that the patentee, in order to be bound by the prior judgment of invalidity, must have had his opportunity to be heard, his "day in court".

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FN17. Hansberry v. Lee, 311 U. S. 32 (1940); Postal-Tel. Cable Co. v. Newport, 247 U. S. 464 (1918). See generally 1B MOORE, FEDERAL PRACTICE par. 0.406 [2] (2d ed. 1965).

There is no question that the patentee has had his day in court against the defendant in the prior suit holding invalidity, and the judgment is conclusive between them. However, the patentee has had no opportunity to be heard in opposition to the defendant in the subsequent suit. As Judge Goodrich stated in Hornstein v. Kramer Bros. Freight Lines, 133 F. 2d 143, 145 (3d Cir. 1943), the conclusive effect of a prior adjudication should not:

"... go so far as to make the finding in one man's case in a personal action a conclusion of ultimate truth. A law suit is not a laboratory experiment for the discovery of physical laws of universal application but a means of settling a dispute between litigants. That which is settled as a fact between them through a given piece of litigation under the principles of res judicata, binds only the parties themselves and those who are in such relation to the parties as to be considered in privity with them."

To contend that the patentee has had his day in court, when the defendant in the subsequent suit uses the prior defendant's judgment finding invalidity against the patentee, clearly begs the question: His day in court against whom and on what issues? When the patentee was a party to the prior suit in which a judgment of patent invalidity was rendered, and the defendant in the subsequent suit was a stranger to that suit, the patentee has no more had his day in court against the sebsequent defendant than if the subsequent defendant had been a party to the suit and the patentee a stranger to it. [FN18]

FN18. See Moore & Currier, Mutuality and Conclusiveness of Judgments, 35 TUL. L. REV. 301, 310 (1961).

***19** 4. Overruling the Triplett Rule Would Adversely Affect the Current Process for Sustaining Good Patents and Rectifying Erroneous Holdings.

Under the present practice of this Court, certiorari is seldom granted in patent cases unless there is conflict in the appellate court decisions, [FN19] so that in most instances a patentee cannot expect to have an erroneous judgment of invalidity rectified by this Court, unless he can try again against a different defendant. It is therefore not uncommon for a patentee who has met rebuff (like respondent here), and who sincerely believes that an error has been committed, to seek to sustain his grant in another court. As noted above, this Court " has several times held valid the claims of a patent which had been held invalid by a Circuit Court of Appeals in an earlier suit brought by the same plaintiff against another defendant." Triplett v. Lowell, 297 U. S. at 643. If the res judicata effect of a judgment of invalidity were expanded, the first court to adjudge that a patent is invalid would, in effect, be the final arbiter for all rights and duties flowing from that patent. To escape this objectionable result of unilateral estoppel, in the interests of justice, this Court would be forced to alter its normal practice and consider granting certiorari more readily in the absence of conflicting decisions.

FN19. U. S. SUP. CT. REV. R. 19 ("Considerations Governing Review on Certiorari"); Universal Oil Prods. Co. v. Globe Oil & Ref. Co., 322 U. S. 471,

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473 (1944); Triplett v. Lowell, 297 U. S. 638, 644 (1936).

B. The Triplett Rule Does Not Significantly Prejudice the Public's Interest in the Elimination of Specious Patents.

In the recent case of Lear, Inc. v. Adkins, 395 U. S. 653, 674 (1969), this Court reaffirmed the well-founded public interest in the elimination of specious patents. The argument may be made that the Triplett rule, in allowing the ***20** relitigation of previously adjudicated patents, is contrary to this public interest. This argument, however, ignores the fact that it is equally in the public interest that a good patent be ultimately upheld as that a bad one be definitively stricken. [FN20]

FN20. Technograph Printed Cir., Ltd. v. United States, 372 F. 2d at 978.

As noted above, because of the intrinsic nature of the subject, the issue of patent validity is a troublesome matter involving greater than average uncertainty. For this reason, it would be in the public interest in promoting the progress of science "by securing for limited times to ... Inventors the exclusive Right to their ... Discoveries," [FN21] to allow patentees a degree of protection against an erroneous decision at least equal to that afforded to the ordinary litigant. Hence, making patent judgments an exception to the general mutuality rule of res judicata would run directly against the policy of the constitutional patent provision.

FN21. U. S. CONST. art 1. § 8.

In addition, a reversal of the Triplett rule would adversely affect the public interest in promoting and validating good patents. The framers of the Constitution, Congress, and practically every developed country in the world, even those with a Communistic background, consider a strong patent system essential to its continued progress. This country, in particular, must rely to an increasing extent on the native ingenuity of its people, now that its advantages in natural resources have largely disappeared. It is no answer to say that inventions will he made even without the existence of a strong patent system. They may be made, but in most cases cannot be promoted without protection. Who will spend the vast sums of money needed to develop and test a new product, even one having vast potential for promoting the common good, such as a new ***21** medicine, herbicide, or insecticide, if he does not have some assurance that lie can recover the expenses of such testing as well as those incurred with other products which fail? Even the government cannot fill this role, since the government will finance only those developments which are already advanced to the point where success seems reasonably certain.

Significantly, Congress has several times considered the Triplett rule and has refused to disturb it. In its most recent consideration of the subject, Congress has specifically deleted from the original version of the "Patent Reform Act of 1967" [FN22] this so-called "in rem invalidity" clause. [FN23] Therefore, this Court should refrain from altering the mutuality of res judicata rule enunciated in Triplett, a doctrine based upon sound legal and constitutional grounds, in view of the historical affirmative position taken by Congress concerning the subject.

FN22. S. 1042 90th Cong., 1st Sess. § 294 (1967).

FN23. The most recent version of that Bill in Congress, which has deleted the

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"in rem invalidity" clause, is S. 1246, 91st Cong., 1st Sess. (1969).

QUESTION 2.

(re Retroactive Application of Change in Triplett Rule.)

Even if this Court decides not to adhere to its prior holding in Triplett, the determination of invalidity in the Winegard litigation should not bind respondent in this case.

It is the general rule that the doctrine of res judicata will not apply where the prior judgment sought to be relied upon is not a final judgment. Restatement, Judgments § 41 (1942). Since finality is not accorded a judgment until affirmance in the event of an appeal, an appeal does not automatically stay the enforcement of an order, "but it does suspend the force of the order as a conclusive determination ***22** of the rights of the parties." 4A C. J. S. Appeal & Error § 626, at 422 (1957).

Thus, since the Winegard decision was on appeal to the Eighth Circuit Court of Appeals at the time the district court decided this case, it could not operate as res judicata as to any issues decided in the subsequent litigation against respondent. In fact, the Winegard decision is not yet final, since there is pending before this Court a petition by the Foundation for reconsideration of the denial of a writ of certiorari to the Eighth Circuit Court of Appeals (Oct. Term, 1968, No. 993). In any event, both the Winegard suit and this suit were filed almost simultaneously, and this Court should not allow the accident of the first decision to be filed to control not only the rights of the parties but the jurisdiction of the district courts.

Another reason this Court should not bind respondent in this case to the determination in the Winegard litigation, is that, in the current state of the law, respondent Foundation had every justification for believing that it would be able to pursue its claim against different defendants regardless of the judgment rendered in the first suit to be concluded. This had been the holding of this Court, [FN24] and the practice of multiple suits in patent litigation has long been recognized by the lower courts. [FN25] Consistent with this understanding, respondent Foundation filed six patent infringement suits in various courts against different defendants. It would be grossly inequitable to now tell respondent, at this stage, that defeat in the Winegard litigation ***23** now bars it from recovering in this action against petitioner. [FN26]

FN24. In addition to Triplett, see Maytag Co. v. Hurley Mach. Co., 307 U. S. 243, 245).

FN25. See discussion in Technograph Printed Cir., Ltd. v. United States, 372 F. 2d at 973-75.

FN26. Unlike the licensor in Lear, Inc. v. Adkins, 395 U. S. 653 (1969), it certainly cannot be. said that respondents in this case, "given the extent to which the ... principle had been eroded by our prior decisions, ... could not confidently rely upon the continning vitality of the doctrine." 395 U. S. at 674.

Still further, respondent believes that the decision in the Winegard case was based on a legal standard which is contrary to those established by this Court in Graham

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v. John Deere Co., 383 U. S. 1; and U. S. v. Adams, 383 U. S. 39. Since the Winegard case is still not final, it would be unfair for this Court to hold that respondent is barred by the Winegard case and thereafter to hold that Winegard was improperly decided. It would also be unfair to leave the Winegard decision standing, if this Court agrees that the decision was based on an improper standard of obviousness, after having considered the matter.

QUESTION 3.
(re Isbell Patent.)
A. Due Process.

As a prelude to its argument on the validity of the Isbell patent, Blonder-Tongue again complains of its alleged deprivation of due process at the trial. As we pointed out earlier, if Blonder-Tongue intended to make this alleged deprivation a basis for its petition to this Court, it should have presented it as a question for review. Because of its failure to do so, this Court should ignore entirely the extended argument made on pages 17 through 23 of its brief. We might add only that B-T has not challenged the finding of the court below (A. 55) that no offer of proof was made as to facts which would have been shown but for the alleged lack of due process.

***24** B. The Matter of "Obviousness".

Applying the "basic factual inquiries" which this Court set out in Graham v. John Deere Co., 383 U. S. 1, 17-18 (1966) the District Court for the Northern District of Illinois held that the invention made by Isbell was nonobvious, a conclusion which was affirmed by the Court of Appeals for the Seventh Circuit. The Court of Appeals for the Eighth Circuit came to a contrary conclusion in the Winegard case on essentially the same prior art, but without the benefit of the testimony of Dr. DuHamel, whose article and patent were the closest prior art, as to what was obvious to him as one skilled in the art. We submit that the Seventh Circuit properly applied the standard of obviousness defined by this Court, while the Eighth Circuit applied an improper standard.

The findings of fact made by the trial court relative to Isbell's invention, which were quoted with approval by the Court of Appeals for the Seventh Circuit (A. 58-60), are set out on pages 73-75 of the Appendix. The subject matter of the invention is so highly complex and technical that we consider it beyond the compass of this brief as well as that of oral presentation to delve into all of the details of the problems which faced the art and how these problems were solved in a nonobvious manner by Isbell's invention (A. 155-166). Without departing from the facts found by the courts below we will attempt here to highlight and amplify those findings so as to indicate to this Court that the findings were indeed based on substantial evidence.

As the trial court found (A. 74), the simplest antenna which has been used for television reception is a simple dipole, consisting of a pair of linear elements extending from each side of a transmission line (R. 157). It is characteristic of a dipole that it is narrowly receptive to radiation of a single frequency. Accordingly, a single dipole ***25** is not well adapted for use over a broad range of frequencies. A seemingly obvious way of extending the range of operation of a single dipole is to provide a second dipole receptive to a different frequency and somehow to interconnect the two dipoles so that they work together (rather than in opposition, which is also possible) to cover an extended range of frequencies (A.

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163).

Building up the frequency coverage of an antenna in this manner, piece by piece, is obvious to try, but one immediately finds that the obvious is unworkable (A. 163). The difficulty raises from the fact that when the individual active elements such as dipoles are brought into proximity, they no longer operate In the same manner they would if each element alone occupied the space. Each active element influences and is influenced by every other active element in close proximity. As a result, the performance of a given antenna of any complicated structure cannot be predieted, even if the individual performance characteristics of the elements are known, in the absence of a theory which makes such prediction possible. In the absence of such a design theory or method, one can only assemble an antenna array and test its performance after construetion rather than design the antenna beforehand with a reasonable expectation that its performance will be as expected (A. 165).

The art knew many individual active elements which could be combined in various configurations to produce antenna arrays of varying degrees of complexity. Some of those elements, e.g., simple dipoles, folded dipoles, triangular dipoles, spirals, cones, horns, etc., are illustrated in the exhibits introduced below (PX-30, A. 412, R. 308; PX-31, A. 413, 243; PX-32, A. 414, 246; PX-34, A. 415, 247; PX-36, A. 416, 248; PX-37, A. 417, 250; PX-38, A. 418, 251; PX-51, A. 427, 262) and are shown in the prior art (DX-1, A. 475, R. ***26** 235; DX-3, A. 477, R. 236; DX-4, A. 481, R. 236; DX-6, A. 483, R. 238; DX-14, A. 510, R. 283). The configuration of an element which might be used as an active element in an antenna array is limited only by the imagination of the designer. The permutations and combinations with which these active elements can be combined is countless, so that one could not even begin to try them all, even if he had the time and could afford the expense. Unless, therefore, there exists some theory which indicates that a particular combination of elements will yield a given result with some degree of assurance, the likelihood that a designer would stumble on a particular configuration by chance is comparable to the likelihood that one could compose Lincoln's Gettysburg Address by selecting words at random from a dictionary.

1. Log-Periodic Antennas.

The antennas covered by the Isbell patent belong to a class of antennas known as logarithmically periodic (logperiodic) arrays, composed of repeating design units (elements) called cells, which are generally of similar shape but varying size (A. 166).

It is characteristic of a log-periodic antenna that its response characteristics will be cyclic, repeating periodically as the frequency is increased or decreased. The nature of the response characteristics over one period is determined by the properties of the design cell. If a design cell can be found which, when combined into an array of cells, has uniform characteristics over one period, it follows that the antenna array will have uniform characteristics over its entire design range of frequencies, i.e., it will have frequency-independent performance (A. 166, 318, 320).

In this connection, the distinction between a log-periodic structure and a log-periodic frequency-independent antenna should be noted. Any structure composed of repeating cells ***27** whose dimensions are related by a constant scale factor can be

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said to be log-periodic in form, but would not necessarily or even probably have frequency-independent characteristics when used as an antenna (A. 166, 192, 238).

As the District Court found, the log-periodic design principle was developed in 1954 (A. 74). Much difficulty was encountered, however, in putting the principle to practical use because of the problem of finding design cells having constant performance characteristics over a period, which would lead to frequency-independent performance. As a result of this difficulty, only three or four frequency-independent log-periodic antennas had been developed prior to the time that Isbell made his invention, even though many attempts had been made by skilled antenna designers at the University of Illinois and elsewhere (A. 232, 241, 267).

In view of the unpredictability of performance of antennas of the log-periodic class, of which Isbell's is one, the courts below quite properly found that Isbell's design was nonobvious. Both courts were properly impressed by the testimony of Dr. DuHamel, whose article and patent were the closest prior art, that the Isbell approach was not one which was obvious to him and that in fact that Isbell's result surprised him when he first learned of it (A. 269). Dr. DuHamel's testimony was not available to the Court of Appeals for the Eighth Circuit and may well represent the key to the different conclusions arrived at by the two Courts of Appeals.

2. The Prior Art Does Not Teach the Invention of the Isbell Patent.

With the exception of DuHamel patent 3,079,602 (DX-14, A. 510, R. 283) and the DnHamel and Ore article (DX-6, A. 483, R. 238), none of the references cited by Blonder-Tongue deals specifically with log-periodic antennas. Rather, all of the references, with the exceptions mentioned, are pertinent ***28** to Isbell's invention only to the extent that these references show some isolated constructional feature of Isbell's antenna, but in otherwise different combinations with other elements. The K. O. antenna (DX-4, A. 481, R. 236) was found by the trial court to be "significantly different from a log periodic antenna" (A. 79).

The issue, of course, which is presented by prior art of this type is whether it would be obvious to one skilled in the art to isolate from each of the cited references a selected portion of an antenna (not taught by the reference itself) and to combine these isolated portions in the manner taught by Isbell.

We submit that without the teachings of the Isbell patent as a guide, it would have been impossible for one ordinarily skilled in the art to select from the myriad of individual antenna elements and the multitude of ways in which these elements can be and have been combined, the precise configurations covered by Isbell. The mere fact that the elements individually were old does not support a finding that the combination is therefore unpatentable, since as this Court said in United States v. Adams, 383 U. S. 39, 50:

"It begs the question, and overlooks the holding of the Commissioner and the Court of Claims, to state merely that magnesium and cuprous chloride were individually known battery components. If such a combination is novel, the issue is whether bringing them together as taught by Adams was obvious in the light of the prior art."

3. The Isbell Invention Was Nonobvious.

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The conclusion that the Isbell patent is valid is fully supported by the findings of the courts below:

1. At the time of the invention, it coulld not be predicted which, if any, log-periodic structures would operate in a frequency independent manner (A. 62, 75).

***29** 2. Dr. DuHamel, an expert in the field and the coinventor in one of the main references relied on by Blonder-Tongue (DX-14, A. 510, R. 283) who was working in the field of log-periodic antenna design at about the same time, failed to achieve Isbell's construction because it was not obvious to him, and moreover was surprised to learn that such a structure worked (A. 63, 64, 78, 268, 269).

3. None of the prior art references cited by defendant teaches or suggests, alone or in combination, a logperiodic array employing simple dipoles (A. 79, 256).

4. "Secondary considerations" of commercial success, long felt but unsolved needs, failure of others, etc., bolster the conclusion of nonobviousness (A. 78, 257).

Of these concurrent findings, Blonder-Tongue has attacked primarily the one stating that the performance of logperiodic antennas was unpredictable. Blonder-Tongue attempts to argue the case de novo by reference to Quarterly Report No. 1 (DX-7, A. 496, 213), from which it has lifted a small portion out of contest without showing what the quoted statement refers to specifically. The excerpt quoted on pages 25-26 of its brief relates to a class of antennas which are self-complementary (PX-55, page 18-14, A. 429, 443, R. 347) and made of sheet metal, and these statements are limited to such structures. The fact is that Isbell's dipole array does not fall into this self-comple-mentary category (A. 63, 64), and its operation cannot be predicted, as the art itself recognized and the courts found. Further, Blonder-Tongue's comments concerning Isbell's planned investigation of thin linear elements ignores the fact that there are many varieties of log-periodic structures having thin linear elements, most of which do not work (e.g., ***30** PX-36, A. 416, 248, 249; PX-37, A. 417, 250, 251; PX-38, A. 418, 251, 252).

Blonder-Tongue's attempt to characterize the operation of Isbell's antenna as "predictable" is contradicted by the prior art itself as well as by the findings of three courts which have considered the matter (A. 62, 78, 94-95). Moreover, the basis for B-T's argument is taken out of context and does not support the conclusion which B-T would like this Court to accept.

4. Unpredictability of Result Cannot Be Ignored in Determining Nonobviousness.

Another attack by Blonder-Tongue on the validity of the Isbell patent is based on the legal distinction between "predictability" and "obviousness". We grant that the two concepts are not fully interchangeable and that the standard for patentability expressed by this Court is based on non-obviousness rather than unpredictability. We submit, nevertheless, that predictability is a major factor to be considered in resolving the issue. As the C. C. P. A. said in Application of Pantzer, 341 F. 2d 121, 126 (1965):

"In other words, an invention can be said to be obvious if one ordinarily skilled in the art would consider that it was logical to anticipate with a high degree of probability that a trial of it would be successful." (Emphasis added.)

In Mandel Bros., Inc. v. Wallace, 335 U. S. 293, this Court held that the results of a mere routine investigation would not be unobvious even though the specific result was unpredictable, when it was apparent to one skilled in the art that "he should make the simple experiment that was made here ...". The investigation

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involved in Mandel Bros. required only the routine substitution of one compound for another, when the general nature of the substituents was known and only one variable ***31** had to be considered. In the present case the investigation is not routine, since the number of variables and the possible combination of these variables is practically unlimited.

At the time Isbell's invention was made, there were no guidelines which could be used to estimate success in the design of a log-periodic antenna with any degree of probability, let alone with a "high degree". This is strikingly illustrated by the fact that only three or four frequency independent antennas were found prior to Isbell out of many designs made by skilled designers (A. 232, 241); that slight differences in construction had profound effects on performance (A. 248, 249); and that no explanation for the failure of some of the unsuccessful designs could be given (A. 243).

Blonder-Tongue argues (Brief, p. 25) that "the only real issue was the obviousness of trying or using Isbell's type of straight wire antenna; and as to this, Dr. Mayes had to concede that most of them operated 'satisfactorily' ". Blonder-Tongue's reliance on the testimony of Dr. Mayes in this respect is both misplaced and misleading, since his statement referred solely and specifically to antennas having Isbell's structure (A. 317):

"Q. Were there a hundred attempts to achieve operation with a structure of the Isbell patent, Plaintiff's Exhibit 1?
A. With that specific structure, you mean?
Q. Yes.
A. Well, I would say that there were quite a number of models built. Most of them operated satisfactorily."

The fact that the operability of Isbell's antenna, after it was conceived by Isbell, was proved by the construction and testing of a number of models thereof does show that it was obvious to try Isbell's structure, as Blonder-Tongue implies.

***32** C. The Purported Publication of QER-2.

On pages 26-29 of its brief, Blonder-Tongue presents the argument that the Isbell patent is invalid because of the "publication of Quarterly Engineering Report No. 2 (QER-2) at the University of Illinois more than I year prior to the filing date of the patent". It should be noted that this issue is not fairly encompassed within the questions presented for review by this Court nor does it play any part in the conflict in the decisions of the Courts of Appeals. Although this issue was covered in the Eighth Circuit, neither the District Court nor the Court of Appeals of the Eighth Circuit inside any reference to this report in their decisions. On the other hand, both the District Court and the Court of Appeals in the Seventh Circuit considered the question and found that no publication occurred prior to May 5, 1959, on which date the report was mailed to those persons on the distribution list (A. 57, 80, 81.).

While we believe that Blonder-Tongue's argument should be ignored as not coming within the questions, presented for review, we will nevertheless briefly summarize our position on this point. We have no quarrel with the law which has been cited by Blonder-Tongue relating to the facts. When the facts concerning the purported publication of a reference are ambitious, however, as in the present case, it is the intent with which the purported act of publication is carried out which is

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controlling. As the Court of Appeals for the Sixth Circuit said in Hamilton Laboratories, Inc. v. Massengill, 11 F. 2d 584, 585 (1940):

"We think intent that the fruits of research be available to the public is determinative of publication under the statute, whether the paper be printed or typewritten, ..."

***33** Thus, the actual unrestricted deposit of a single copy of a reference in a library evidences the intent on the part of the publisher to relinquish his control over the publication and to make it thereafter available to the public. Similarly, other acts evidencing the intention to publish, which therefore constitute publication, are sale or exposure to the public for sale or otherwise, and the announcement of availability to the public.

The receipt of the printed copies of the Report in Miss Johnson's office on April 30, 1959 is an ambiguous fact which does not establish publication. It should be remembered that Miss Johnson served a dual capacity at the time. In addition to her main duties as Technical Editor of the Publications Office, obarged with seeing that the reports emanating from the Department were properly edited, printed, and distributed (A. 326, 327), Miss Johnson also functioned as the custodian ("librarian") of a collection of publications which were kept primarily for the convenience of members of the University staff (A. 328). When the printed copies of QER-2 were returned by the printer to Miss Johnson's office on April 30. 1959, she received them in her role as Technical Editor and not as custodian of the "local library". From the time the report was so received on April 30, 1959, until it was admittedly published by mailing on May 5, 1959, there is no evidence to establish an intent to publish during the intervening period. The printed copies of the Report remained in wrapped packages as received from the printer (DX-22, pp. 241-243, R. 289). There was no release of any copy to the public, no announcement of availability, nor any actual filing within the collection of the local library. There was in short nothing that would establish any intent to publish the report prior to May 5, 1959.

Blonder-Tongue's argument that QER No. 2 was published ***34** prior to March 5, 1959 is therefore seen to be based solely on Miss Johnson's testimony concerning the purported "availability" of this Report prior to its publication date of May 5. That the Report was physically available is conceded, but no evidence of an intent to publish is present. Even Miss Johnson's answer to the question whether the Report would have been available to any member of the public evidences equivocation. Her answers "Very likely" and "To my knowledge, yes" (DX-22, pp. 216, 217, R. 289) indicate only that Miss Johnson was expressing her own opinion as to the availability of the references, since any action she might have decided to take in response to a request for a copy of the Report could well have been countermanded by her superiors.

Mr. Lawlor, Miss Johnson's immediate superior, testified that the policy of the Department was that the copies of work reporting sponsored research, as in the present case, be distributed first to those on the official distribution list, and then to any others who were interested (A. 329). Accordingly, it has not been shown that Miss Johnson would have been free to distribute copies of the Report to members of the public prior to the distribution to those on the distribution list, in spite of her opinion that the Report was available.

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The burden of establishing that the Isbell patent is invalid by reason of the publication of QER-2, like any attack on the validity of a patent, is on the proponent, Blonder-Tongue (35 U. S. C. 282). We believe that Blonder-Tongue has not met its burden and the findings of the courts below that no publication occurred are fully supported by the evidence.

***35** D. Purported Anticipation by the Prior Art.

On page 29 of its brief, Blonder-Tongue attempts in a fanciful manner to show that DuHamel patent 3,079,602 (DX-14) represents a complete anticipation of Isbell's invention. Specifically, Blonder-Tongue refers to Figure 5 of this patent as showing the same structure as that of the Isbell patent, "with the one exception that the dipoles are triangular loops instead of straight wire" in view of the fact that triangular loop dipoles, as well as the straight wire dipoles used by Isbell, were both known. Granting that triangular loop dipoles and simple straight dipoles were both known to the art prior to Isbell's invention in simple structures such as shown in DX-2 (A. 475, 476), as Blonder-Tongue contends, the issue then is whether the substitution of one for the other in DuHamel's structure was obvious at the time that Isbell made his invention. The evidence shows clearly that such a substitution was not obvious.

Perhaps the most convincing evidence against Blonder-Tongue's position is the testimony of Dr. DuHamel, the co-inventor of the patent on which Blonder-Tongue relies. Dr. DuHamel testified during the trial that not only was Isbell's structure not obvious to him when his patent application was filed, but also that he was surprised that Isbell's invention worked when he later heard of it, and was disappointed with himself in not having also thought of it (A. 269). Clearer proof that the Isbell structure was not obvious to those skilled in the art can hardly be imagined.

Dr. DuHamel's failure to arrive at Isbell's structure is understandable in view of the disclosure of his patent. Although the DuHamel patent discloses that the angle between the booms of the antenna may approach 0°, there is no teaching in this patent of the use of spaced dipoles. Each of the triangular elements 51(e), 51(d), 51(c), etc., ***36** in this patent is connected directly to its adjacent similar elements. Accordingly, there is no spacing between elements and therefore the arrangement cannot suggest Isbell's construction, in which the spacing between adjacent dipoles varies from one end of the array to the other. Since, in fact, each of the triangular elements is directly connected to each of its neighbors, there is no transmission line as such, corresponding to that used in Isbell, and therefore it cannot be said that the transmission line is transposed in connection between adjacent elements, as in Isbell.

There is, moreover, no disclosure or teaching in the DuHamel patent that his disclosed structures are made up of dipoles, simple or otherwise (A. 288). Certainly, when the structure is in the preferred form wherein the two booms are angularly widely separated, the elements of the structures are too far apart to operate as dipoles. In this respect, see also the discussion of DuHamel and Ore's logperiodic structures in Jasik's handbook (PX-55, p. 18-12, A. 429, 441, R. 347), wherein they are described as nonplanar, which is the obviously preferred embodiment,

There is, therefore, no suggestion to one skilled in the art that the triangular

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elements (not dipoles) having zero spacing between adjacent elements should be replaced by simple dipole elements of a variable spacing, in accordance with the Isbell patent. In making this argument, B-T is obviously using only hindsight, in the light of the teachings of the Isbell patent, rather than what would have been obvious to one skilled in the art at the time.

E. Infringement of the Isbell Patent.

On pages 30-33 of its brief, Blonder-Tongue argues that, regardless of its validity, the Isbell patent is not infringed by Blonder-Tongue's antenna structures. This argument represents still another attempt by Blonder-Tongue to review ***37** questions not properly before this Court. Only the validity and enforceability of the Isbell patent are encompassed within the scope of the questions presented by Blonder-Tongue for review. Both the District Court and the Court of Appeals for the Seventh Circuit found that Blonder-Tongue's antennas were within the scope of the Isbell claims and were therefore infringements. The courts in the Eighth Circuit expressed no opinion on this subject since that action involved the non-analogous products of another manufacturer.

As to Blonder-Tongue's contention that its antennas do not have coplanar elements, the District Court in the Seventh Circuit fond as a fact that "the Blonder-Tongue antennas' dipole elements are separated by not more than 1/18 wave-length, making them substantially coplanar" (A. 84), a finding which was affirmed by the Court of Appeals, which held, "The District Court concluded these elements are substantially coplanar, and we agree." (A. 68.)

These concurrent findings of a fact of the most technical nature should not be reviewed by this Court. The finding is amply supported by the evidence, and it was not a basis for the grant of the writ of certiorari by this Court.

F. The Alleged Unenforceability of the Isbell Patent.

Ignoring completely the findings of the courts below that no fraud was involved in the prosecution of the Mayes et al. patent, and that no acts of unfair competition or antitrust violations in the marketplace had been committed either by the Foundation or its licensee JFD, Blonder-Tongue nevertheless alleges that the Foundation is guilty of unclean hands and that therefore the Isbell patent should not he enforced regardless of its validity.

Of the alleged unfair competition and antitrust violations catalogued by Blonder-Tongue, only two represent activities ***38** in which the Foundation played any role and for which, therefore, it might be held accountable. These are (1) the purported fraud in the prosecution of the Mayes et al. patent and (2) the purported impropriety of issuing news releases concerning the litigation by the Foundation against Blonder-Tongue.

As to the news releases, the District Court found (A. 86):

"A review of the evidence demonstrates clearly that such allegations are wholly without basis in fact."

Blonder-Tongue has not shown that the trial court's finding was not supported by the evidence presented in the case. Every single one of the alleged violations set out on pages 42 and 43 of Blonder-Tongue's brief was considered specifically by the trial court, who found no evidence what-soever to establish the charges. Blonder-Tongue's argument relative to these violations is based only on its own allegations

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rather than on competent evidence in the record.

In this connection, some of Blonder-Tongue's allegations are so widely divergent from the facts as to appear to be deliberate misrepresentations. For example, at the bottom of page 43 of its brief, B-T alleges that "the District Court found that suit had knowingly been brought with improper 'venue' against Blonder-Tongue, with the intended purpose of issuing throughout the trade ... news releases describing the litigation' " (Emphasis added). No-where in the decision of the District Court is there any finding remotely resembling this allegation. The fact is that the action was instituted in the Northern District of Illinois with proper venue against a distributor of Blonder-Tongue's products. Blonder-Tongue was named as a defendant and served with process in the expectation, eventually justified, that Blonder-Tongue would appear voluntarily ***39** in order to defend its distributor. Blonder-Tongue's allegation that the suit was brought in this manner with an ulterior motive and in furtherance of a conspiracy is wholly unjustified and unsupported by the facts.

In a similar manner, all of the other allegations of Blonder-Tongue in this regard are also unsupported. Since, however, we believe that the issues will be treated in detail in the brief of JFD we will comment on only the issue directly involving the Foundation, namely, the purported misrepresentation to the Patent Office and its effect on the enforceability of the Isbell patent.

At the outset it should be made abundantly clear that the purported fraud which Blonder-Tongue claims was committed by the Foundation (contrary to the express finding of the Court of Appeals in this regard) occurred during the prosecution of the Mayes et al. patent, which is not directly involved in the review before this Court. The Court of Appeals for the Seventh Circuit found the Mayes et al. patent to be obvious over the art and concluded that, although the failure to inform the Patent Office of the prior publication detracted from the presumption of validity of the Mayes et al. patent, it did not constitute fraud. Blonder-Tongue now seeks to have this Court overturn the finding of the Court of Appeals for the Seventh Circuit, to find that fraud was in fact committed on the Patent Office in connection with the Mayes et al. patent and to hold as a consequence thereof that the Isbell patent is unenforceable. It should be noted that the action against Blonder-Tongue in the trial court was the first instance in which the Foundation attempted to enforce the Mayes et al. patent. The Foundation has accepted the finding of the Seventh Circuit Court of Appeals that the Mayes patent is invalid and has not sought further to enforce it.

***40** On the facts in this case, it has not been established that the Foundation has been guilty of any acts which should lead to a finding of unenforceability of the Isbell patent. Whether the Foundation had been guilty of any wrong-doing whatsoever with respect to the prosecution of the Mayes et al. patent was at least arguable when the action against Blonder-Tongue was commenced, in view of the finding by the District Court that no duty to the Patent Office was breached by the Foundation's actions in the Patent Office. The facts in this case do not evidence the type of deliberate material misrepresentation to the Patent Office as existed in the Hazel Atlas mid Precision Instruments Manufacturing Company decisions cited by Blonder-Tongne.

There is no evidence whatsoever that counsel for the Foundation knew, at the time

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the affidavit was filed in the Patent Office, that a prior publication equivalent to that cited by the Patent Office existed. Although Dr. Mayes knew of the fact that such a report had been issued by the University, it is easy to see why, under the circumstances, lie (lid not call attention to the existence of the prior report.

The routine and periodic reports issuing from the antenna laboratory (lid not fall within the category of "publications" as the term is commonly used in academic circles. The reports (lid not have the characteristics of typical printed publications, such as books and journal articles which are widely distributed and freely available. Rather, the University of Illinois reports in question were circulated only among a small group of individuals and organizations named on the circulation list at the end of each report (A. 211). In fact, under similar circumstances, reports of this type have been held not to be "publications", even though there were no restrictions on the circulation and the reports could well have been available to the general ***41** public. See Ex part Suozzi, 125 U. S. P. Q. 445, 447 (P. O. Bd. of App. 1959):

"At best, even assuming that there was no prohibition against the author of the report, or the named or other recipients of copies thereof, from giving copies or imparting information contained in said report to others who would be classed as the public in general, this would be merely permissive and would not show unequivocally that there was in fact any publication of the report on the July 15, 1953 date here of concern." (Emphasis added.)

Although Dr. Mayes knew that these reports had been prepared, it cannot be said, and it certainly has not been demonstrated, that he knew or should have known that they had achieved legal status as "publications" at the time the affidavit was made.

The finding of the Court of Appeals that no fraud had been committed is clearly justified under the circumstances. In any event, any consequences of the prosecution of the Mayes et al. patent should be confined to that patent alone. There is no basis for holding that the Isbell patent should be held unenforceable by reason of the acts occurring during the prosecution of the Mayes et al. patent. Regardless of whether the Mayes et al. patent would now be enforceable, assuming it had been held otherwise valid, Blonder-Tongue has given no reason why the Isbell patent should now be held unenforceable, other than the incidental fact that the applications were prosecuted "together" in the Patent Office and the unsupported allegation that both patents were involved in a "conspiracy" to commit acts of unfair competition and to violate the antitrust laws, contrary to the findings of the courts below.

In order to hold a patent unenforceable as a result of "unclean hands", there should be some connection between the alleged inequitable conduct and the patent. As the ***42** Court of Appeals for the Sixth Circuit said in Republic Molding Corporation v. B. W. Photo Utilities, 319 F. 2d 347, 349 (1963):

"What is material is not that plaintiff's hands are dirty, but that he dirtied them in acquiring the right he now asserts, or that the manner of dirtying renders inequitable the assertion of such rights against the defendant."

The only relationship which has been established, and in fact the only relationship which existed between the Foundation and JFD, was that of licensor and exclusive licensee. The only area in which any type of joint activity concerning the. Foundation and JFD occurred was in the review of JFD's advertisements to insure that misleading statements involving the name of the University of Illinois or the

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Foundation were not made (A. 368-371, R. 740, 741, 742). There is no evidence whatsoever to connect the Foundation with any of the other activities set out at length at pages 41-62 of Blonder-Tongne's brief, such as tie-in sales, raiding of employees and patent mismarking. We believe that the evidence in the case fully supports the findings of both courts below that there is no persuasive evidence that any act of unfair competition or antitrust violation was committed by JFD, but even if this Court disagrees, there is no basis for ascribing to the Foundation any responsibility for JFD's acts, or holding that a conspiracy existed between the Foundation and JFD. In the absence of such a conspiracy, which might taint the Isbell patent, there is no basis for holding the patent to be unenforceable.

***43** G. The Winegard Decision.

Relying on substantially the same prior art as was considered by the Court of Appeals for the Seventh Circuit, the Court of Appeals for the Eighth Circuit held the Isbell patent invalid, saying that Isbell's invention lacked "nonobviousness as a matter of law for essentially the same reasons set forth by the Court below" (A. 94). It is submitted that the Court of Appeals for the Seventh Circuit correctly applied the standards which this Court has established for deciding the issue of obviousness, while the Eighth Circuit incorrectly applied those standards.

In holding the Isbell patent invalid, the trial court in the Eighth Circuit said (A. 112):

"It is thus apparent that the Isbell antenna is a combination of elements, all known in the prior art and also that these known elements were combined in the Isbell antenna in a manner dictated by a theory also known in the prior art."

The theory referred to by the Court as known was stated to be "the log-periodic method of designing frequency independent antennas" (A. 112).

If the trial court's premise concerning the elements of the Isbell antenna and the manner in which these elements were combined had been correct, we would have no quarrel with the court's determination that the result must have been obvious to one skilled in the art. The fact of the matter is, however, that there was and is no "log-periodic method of designing frequency independent antennas" but only a method of designing log-periodic structures which potentially have frequency independent properties, but which in the vast majority of cases do not. It should be noted that the "log-periodic method" (A. 94, 95, n. 3) does not itself specify which elements should be used in constructing the ***44** log-periodic structure or give any basis whatsoever for predicting that any given element would be more likely than any other element to achieve a structure having frequency independent properties. The shape and form of the elements to be combined in a structure following the logperiodic method is limited only by the imagination of the antenna designer. The "esoteric shapes of antennas, spirals, cones, horns, ground planes" referred to by Blonder-Tongue on page 24 of its brief, are illustrative of the many elements used by skilled antenna designers in fruitless attempts to produce frequency independent antennas, all of which were log-periodic in form, and all of which failed to perform in a frequency independent manner. The prior art itself, at the time of Isbell's invention and thereafter, recognized the impossibility of predicting which of the infinite permutations of structures that could be made with all of the elements available to a designer would have frequency independent properties.

On appeal to the Court of Appeals for the Eighth Circuit, the Foundation argued

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that the trial court's decision was incorrect, because it was based on an improper premise, namely that the art knew how to design frequency independent log-periodic antennas. The Court of Appeals agreed with the Foundation's argument, holding (A. 94, 95):

"On the face of the record, we must agree that this finding is erroneous. The record discloses that the logperiodic formula for antenna design was a recognized theory within the calling. This formula is discussed in the authoritative article by Drs. DuHamel and Ore entitled Logarithmetically Periodic Antenna Designs, published in March of 1958. However, as pointed out by plaintiff, this same article discloses:

'Unfortunately, no theory has been established which even predicts the types of structures which will give frequency independent operation.'

***45** Jasik's Antenna Engineering Handbook, a recognized authority in the field, verifies on page 18:

'It is not possible to determine a priori the frequency independent type of log-periodic antennas'.

The record is clear that both plaintiff and defendant experts agreed with this fact."

Having thus held that there was in fact no method which could be used at the time of Isbell's invention to design a frequency independent log-periodic antenna, the Court of Appeals nevertheless held the invention to be obvious, saying (A. 98):

"The problem here was one of trial and error with a combination of commonly used elements operating within known principles of electronics and mechanics to each achieve a desired result."

and (A. 99):

"Here again the evidence reflects that plaintiff did nothing more than logical and mechanical experimentation within suggested principles and design from the existing art."

The court in essence held that in view of the availability of the elements of which Isbell's antenna is formed it was obvious to combine them to produce Isbell's invention, on a hit-or-miss, trial-and-error basis.

The "obvious-to-try" test which was applied in effect by the Court of Appeals in the Winegard case is both unrealistic and contrary to statute (35 U. S. C. 103), which provides that "Patentability shall not be negative by the manner in which the invention is made." This approach has further been criticized by the courts. As Judge Learned Hand said in B. G. Corp. v. Walter Kidde & Co., 79 F. 2d 20, 22 (2d Cir. 1935):

"All machines are made up of the same elements * * * But the elements are capable of an infinity of ***46** permutations, and the selection of that group which proves serviceable to a given need may require a high degree of originality. It is that act of selection which is the invention...."

Similarly, in Application of Tomlinson, 363 F. 2d 928, 931 (1966), the C. C. P. A. rejected the argument that the invention involved only "routine experimentation", saying:

"Our reply to this view is simply that it begs the question, which is obviousness under section 103 of compositions and methods, not of the direction to be taken in making efforts or attempts. Slight reflection suggests, we think, that there is usually an element of 'obviousness to try' in any research endeavor, that it is not undertaken with complete blindness but rather with some semblance of a chance of

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success, and that patentability determinations based on that as the test would not only be contrary to statute but result in a marked deterioration of the entire patent system as an incentive to invest in those efforts and attempts which go by the name of 'research'." (Emphasis in original.)

The decision of the Court of Appeals for the Eighth Circuit effectively denies the patentability of all combinations of known elements, since a desired result can readily be imagined without any knowledge of how to achieve the result and since a trial-and-error procedure can always be employed using the known elements. The court's rationale could just as readily be applied to deny patentability of a novel chemical compound having the unpredictable property of curing cancer or of growing hair on bald heads, on the ground that since the chemical elements are known, the result can be achieved in an obvious way merely by trial-and-error experimentation with all possible combinations of these chemical elements.

As another example of the obviously improper result which the rationale of the Court of Appeals for the Eighth ***47** Circuit would reach, consider the difficulty which is still encountered today, in spite of our technological progress, in separating the segments of a grapefruit from the skin and membranes. Even the tedious use of a knife to cut out individual segments rarely produces satisfactory separation, while the use of a spoon causes the juice to spatter about in a very disconcerting way. Imagine that an astute inventor solved this homely but real problem by subjecting the grapefruit to the action of ultrasonic sound energy which ruptured the bonds between the grapefruit segments and the membranes but did not fluidize the contents, thereby permitting each segment to be separated cleanly and easily. Such a solution to the problem would nevertheless be considered obvious by the Court of Appeals for the Eighth Circuit, on the ground that both grapefruit and ultrasonic sound are known and that such treatment could have been made by trial and error "within known principles".

As Cyril A. Soans points out in his recent book, Return to Robinson (1890), Whitehall Co., Northbrook, Ill. (1970), page 51:

"Dr. Anthony Deller, formerly chief patent counsel for International Nickel Co. and the author of both editions of Deller's edition of Walker, says in the Canadian Pat. Inst. Bulletin, Series 7, Vol. 15, December 1965, Page 27, that every day 'more and more capital is required' to commercialize inventions, and on Page 29 quotes Elihu Thompson as saying,

'Publish an invention freely and it will almost surely die from lack of interest, ... Patent it, and if valuable, it will be taken up and developed into a business.' "

If the "obvious-to-try" criterion is accepted as the proper standard of obviousness, the result would be the marked deterioration or indeed the destruction of our entire patent system, as the C. C. P. A. noted in the Tomlinson case ***48** quoted above. If the mere fact that known elements are intentionally combined renders a combination unpatentable even though the result is unpredictable and the combination is made without a reasonable prospect for success, then no discoveries will be patentable. Since the method of arriving at an invention is of no importance (under 35 U. S. C. 103), even accidental discoveries of the greatest merit would be considered obvious. Charles Goodyear's discovery of vulcanization of rubber, for example, would have been considered obvious under the standard applied by the Court of Appeals for the Eighth Circuit, since both sulfur and rubber were known, as was

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the application of heat. Surely the proper standard of obviousness is not as broad as that envisioned by the Eighth Circuit Court of Appeals.

QUESTION 4.

(re Fraud, Unfair Competition and Antitrust.)

In support of its position that the Isbell patent should be held unenforceable, Blonder-Tongue has accused the Foundation and its licensee JFD of several illegal activities, including fraud on the Patent Office, tie-in-sales, patent mismarking, improper news releases and false advertising, all of which were considered and properly rejected by both courts below. Of the accusations made by Blonder-Tongue only two, the prosecution of the Mayes et al. patent and the issuing of news releases concerning the litigation involving the patents in suit, relate to acts which were carried out by the Foundation. Both of these accusations have been considered above in this brief (pp. 37-42).

With respect to the charges directed primarily against JFD, the courts below found none of them to be supported by the evidence (A. 86, 69). Regardless, however, of whether this Court agrees with the courts below on all aspects of ***49** Blonder-Tongue's charges, there is absolutely no evidence tying in the Foundation with any of the activities of which JFD is accused and therefore no basis for ascribing to the Foundation any liability therefor which might render the Isbell patent unenforceable.

QUESTION 5.

Blonder-Tongue complains that the trial court failed to follow the procedure set out by this Court in Graham v. John Deere Co., as appropriate in treating the issue of obviousness. It is not clear whether this Court intended its described procedure as a mandatory part of a trial court's opinion rather than only a description of the type of inquiry which the trial court should carry out in arriving at its conclusion.

It is apparent that in discussing the validity of the Isbell and Mayes et al. patents, the trial court did in fact follow precisely the procedure which this Court has prescribed. It is reasonable, further, to assume that the same procedure was applied with respect to the Blonder patent and that the abbreviated discussion of the court's inquiry results more from the quite obvious nature of the purported invention rather than from any slighting of its duty to analyze the prior art in the prescribed manner. The Court of Appeals for the Seventh Circuit, although indicating that its task would have been facilitated by a formal statement of the trial court's findings regarding the prior art, nevertheless found no difficulty in affirming the correctness of the lower court's decision. Except perhaps with respect to its form, the decision reached by the trial court and affirmed by the Court of Appeals is eminently correct and should be permitted to stand.

***50** CONCLUSION.

For the reasons given above, this Court should continue to adhere to the rule it set out in Triplett v. Lowell. The advantages of this rule far outweigh any possible disadvantages, to both patentees and the public alike. If, nevertheless, the Court feels that changes should be made, such changes can be more flexibly handled by Congress.

With respect to the Isbell patent, the findings of the courts below that Isbell's

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invention was nonobvious over the art and therefore valid should be affirmed by this Court. None of the reasons advanced by Blonder-Tongue for finding the patent invalid or unenforceable are persuasive. All of the arguments which were made to this Court by Blonder-Tongue were also made to the courts below, which rejected them after careful consideration.

The decision of the Court of Appeals for the Seventh Circuit should be affirmed in its entirety.

U.S., 2004.
Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation

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Supreme Court of the United States.
BLONDER-TONGUE LABORATORIES, INC., Petitioner,
v.
UNIVERSITY OF ILLINOIS FOUNDATION, et al., Respondents.
No. 338.
October Term, 1970.
January 4, 1971.
On Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

Brief for the American Patent Law Association as Amicus Curiae

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***1** 1. AUTHORITY TO FILE

This brief is filed by the American Patent Law Association (APLA) as amicus curiae and is presented to the Court under Rule 42(2). The letters of consent from petitioner and respondents are on file with the clerk of the Court.

II. PURPOSES OF BRIEF

The purposes of this brief are to:

1. Urge that this Court's interpretation in Graham, Calmar and Adams (the Trilogy [FN1]) of the nonobviousness test of 35 ***2** U.S.C. 103 be the sole and exclusive basis for determining the patentability of new contributions to the useful arts. [FN1a]

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FN1. Graham v. John Deere Co., 383 U.S. 1 (1966); Calmar, Inc. and Colgate-Palmolive Co. v. Cook Chem. Co., 383 U.S. 1 (1966); and United States v. Adams, 383 U.S. 39 (1966).

FN1a. The Patent Act of 1952 enacted as Title 35 of the United States Code requires that an invention to be patentable must satisfy the three conditions of patentability set forth in Sections 101, 102 and 103, i.e., the invention must be new, useful and unobvious. See Commr. Patents v. Deutsche Gold-und-Silber-Scheideanstalt Vormals Roessler, 397 F.2d 656 (D.C. Cir. 1968).

2. Point out that since the Trilogy was decided in 1966, the United States Courts of Appeals have split over the meaning of the Trilogy's criteria for nonobviousness in two different and inconsistent ways to establish two incompatible patent systems in the United States.

3. Urge that this Court reaffirm its criteria for nonobviousness by clarifying the language it used in Anderson's - Black Rock [FN2] to the extent that implications therein suggest that a different standard, a test of "invention", survives the passage of the Patent Act of 1952.

FN2. Anderson's-Black Rock v. Pavement Salvage Co., 396 U.S. 57 (1969).

4. Put in perspective the relitigation question and point out some important policy reasons for this Court to back up the lower Federal courts in sustaining the rules of Triplett v. Lowell. [FN2a]

FN2a. 297 U.S. 638 (1936).

Petitioner Blonder-Tongue presents five questions for consideration by the Court, some of which are further subdivided. This amicus brief deals only with the nonobviousness condition of patentability which is involved in petitioner's questions 3 and 5, and the relitigation issue posed in petitioner's question 1. This limitation on the scope of the present amicus brief is imposed because APLA believes that the other questions do not present the broad policy issues raised by the two questions to which this brief is directed.

***3** III. INTEREST OF THE AMERICAN PATENT LAW ASSOCIATION

The American Patent Law Association is an association of approximately 3,900 members of the bars of many states interested in the patent system and the administration and interpretation of the laws relating to patents. Over one-half of the patent lawyers in the United States are members of APLA and the nature of their practice and the types of clients they represent cover the entire spectrum. Some members are in private practice while others are employed by corporations and the government. Some represent individuals while others represent small research and development companies and large corporations. Nearly all of them sometimes represent parties seeking to uphold patents and at other times parties seeking to invalidate patents.

Since the members of the Association are sometimes on one and sometimes on the other side of the various issues now before the Court, the Association's sole interest in this amicus brief is to explain to the Court why it is concerned about

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the issues it proposes to discuss, how they are related to the proper functioning of the patent system and what adverse effects are to be expected if the issues are not dealt with properly.

IV. 35 U.S.C. 103 AS INTERPRETED BY THE TRILOGY - THE SOLE TEST OF PATENTABILITY

A. The Split Among the Circuits After The Trilogy

Since the Court of Appeals for the Seventh Circuit in its adjudication of validity below properly looked to the Trilogy and its explication of the patentability test established by 35 U.S.C. 103 and ignored the "invention" test with or without the synergism to which Black Rock makes reference, the Court may well ask why the APLA bothers to appear herein as amicus curiae at all. The reason is that the same Isbell patent had been held invalid by the Court of Appeals ***4** for the Eighth Circuit in University of Illinois Foundation v. Winegard Co. [FN3] and that court also looked to the Trilogy as the basis for its holding.

FN3. 402 F.2d 125 (1968), cert. denied, 394 U.S. 917 (1969).

This split is only one instance of the dichotomy that has developed in this country on how the nonobviousness criteria enunciated in the Trilogy are to be applied and what their practical purpose really is. Comprehensive statistical and substantive compilations and analyses lead to the necessary conclusion that the various U.S. Courts of Appeals are using more than one set of legal standards. Thus, the Seventh and Fifth Circuits' holding 45.6% and 51.8% of its adjudicated patents to be valid after the Trilogy is strikingly different from the Eighth and Ninth Circuits' holding of 0.0% and 16.3%, respectively. [FN4] Statistical analysis suggests what substantive analysis by students of the subject has demonstrated, namely that the Trilogy has resulted in a statistically significant split among the federal appellate courts on what nonobviousness means under the law.

FN4. See Kayton, The Crisis of Law in Patents. Pt. 1, 5 & Appendix 2, 13- 14 (Patent Resources Group, Wash., D.C. (1970)).

Amicus believes the Seventh Circuit correctly construed and the Eighth Circuit misconstrued the nonobviousness criteria of the Trilogy. Unfortunately, Anderson's - Black Rock used language which has seemingly approved both of these conflicting views at the same time.

It is of transcendent importance to the continued vitality of the Patent System that the proper test for the third condition of patentability be chosen and correctly applied to the resolution of the factual issues presented herein by petitioner and respondents.

If the proper test to be applied is clarified now, patent owners, businessmen and potential infringers can order their business activities to accord with whatever threshold level ***5** of patentability this Court and Congress agree upon. [FN5] Whatever the level, the parties will be able to predict with some degree of accuracy what test a lower court will select to determine the validity of patents which come before them.

FN5. One aspect of the problem which is not going to be discussed in this

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amicus brief is whether the standard of patentability is being applied too strictly or too loosely. Whether the courts were (or are) too strict or too lax in deciding questions of validity, whether the Patent Office applied (or applies) too low a standard in issuing patents, whether the Patent Act of 1952 dictated a relaxation of the level of patentability and whether this Court was correct in holding that, as to the level of patentability, the 1952 Act was a codification of prior law have been hotly debated. As much as these controversies interest and affect amicus and its members, they are not germane to the position APLA takes in this brief.
If the courts are currently applying Section 103 too restrictively as some have suggested, then Congress will no doubt clarify its intent through further legislation. Indeed, legislation looking toward this end is presently before the Congress (S.2756, 91st Cong., 1st Session (1969). Amicus Curiae limits its discussion herein to the nature of the test prescribed by 35 U.S.C. 103 and the deficiencies of the "invention" test it was designed to replace.

This Court has rightly condemned the "nose of wax." [FN6] approach to claim interpretation. Its application to the test for patentability should be no less repugnant to the development of a uniform and reasonably predictable body of law on the nature and application of the proper standard for patentability. [FN7]

FN6. White v. Dunbar, 119 U.S. 47, 51-52 (1886).

FN7. Since a great deal of the discussion herein relates to conditions for patentability under the 1952 Act, the conflicting requirements for "invention" and the Black Rock decision, for the convenience of the court three pertinent articles on the subject are included in the separate Appendix.

B. Section 103 and the Patent Act of 1952

Even though an invention is new and useful, Section 103 provides that "A patent may not be obtained ... if the differences between the subject matter sought to be patented ***6** and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." [FN8]

FN8. 35 U.S.C. 103 (1964).

Two points emerge from a review of the Patent Act of 1952 in general and Section 103 in particular. First, the plain language of Section 103 makes it quite clear that Congress intended to define with considerable particularity the considerations which were to be part and parcel of a determination of the third requirement for patentability. [FN9] Second, the nonobvious test of Section 103 was to be used to determine patentability instead of the subjective "invention" test of earlier years. This second point is demonstrated by the fact that the term invention is used in the 1952 Patent Act only to identify the thing discovered, devised or created, and not to measure the patentability of a new product, apparatus or process. Although the exact meaning of invention does vary, [FN10] nowhere in the Act is there any reference to a requirement of "invention." Indeed, as Judge Rich, one of the draftsmen of the 1952 Act, made clear even before the Trilogy was decided, "the drafters did this deliberately in an effort to free the law and lawyers from bondage to that old and meaningless term...." [FN11]

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FN9. Even before the Trilogy, some courts recognized this fact. See the discussion in Note: After Black Rock: New Tests of Patentability- The Old Tests of Invention, 39 Geo. Wash. L. Rev. 123, 139 el seq. (1970); writers were aware of it, e.g., see Note, The Siandard of Patentability-Judicial Interpretation of Section I 03 of the Patent Act, 63 Colum. L. Rev. 306 (1963); and the House Committee Report on the bill, which ultimately became the Patent Act of 1952, reflected the fact that Section 103 was a major innovation of the bill "to revise and codify the laws relating to patents," see S. Rep. No. 1979, 82d Cong., 2d Sess. 1,88 (1952).

FN10. See Janicke, The Varied Meanings of "Invention" in Patent Practice: Different Meanings in Different Situations, 2 Pat. L. Persp. (1971).

FN11. Rich, "Congressional Intent-Or, who Wrote the Patent Act of 1952", in Patent Procurement and Exploitation 61, 70 (B.N.A. 1963).

***7** C. The Trilogy

This Court's decisions in the Trilogy are entirely consistent with the foregoing comments on the legislative intent with respect to the 1952 Act and Section 103. In all three of the cases which make up the Trilogy, this Court focused on the requirements of Section 103. In Graham and Calmar, the ground rules were established:

"[T]he § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unresolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. See Note, Subtests of 'Nonobviousness,' 112 U. Pa. L. Rev. 1169 (1964). [FN12]"

FN12. 383 U.S. at 17-18.

While it has been suggested following the Trilogy that it was the differences between the subject matter sought to be patented and the prior art that had to be unobvious, rather than the subject matter as a whole, [FN13] and that the so-called secondary considerations were not to be used unless obviousness was in doubt, [FN14] the application of the Trilogy ***8** test to the factual setting of the Adams case leaves no doubt but that such distinguishing forays are in error. Moreover, they are illogical and inconsistent with the purpose behind the nonobviousness test of Section 103.

FN13. The author of the Trilogy. Justice Clark, scotched this effort to restrict the holding when he sat on the Court of Customs and Patent Appeals by designation. In In re Wiggins. 397 F.2d 356 (C.C.P.A. 1968), he pointed out that the Court had meant that the "subject matter as a whole" had to be nonobvious, just as section 103 specified. See also Palmer v. United States, 390 F.2d 1006 (Ct. Cl. 1968).

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FN14. See, e.g. Proler Steel Corp. v. Luria Bros., 417 F.2d 272 (9th Cir. 1969). But see Sylvania Electric Products Co. v. Columbia Broadcasting System, 415 F.2d 719 (1st Cir. 1969).

It will be recalled that the Adams' invention was a constant current, nonrechargeable battery which used water as an electrolyte. The structure claimed in the Adams patent was quite similar physically and chemically to the prior art although it was not directly anticipated under 35 U.S.C. 102. The Adams battery used electrodes of cuprous chloride and magnesium and, while electrodes of these materials had not been used in the same battery, zinc and silver chloride electrodes had been and the prior art taught the equivalency of cuprous chloride and silver chloride electrodes and magnesium and zinc electrodes. Had this Court restricted its consideration to the small structural changes which distinguished the Adams battery from prior art batteries, the inventor would have undoubtedly been out of luck. Instead, the differences were examined in the context of the subject matter as a whole, the level of ordinary skill in the pertinent art, the unexpected properties of the combination and the dramatic secondary factors of commercial success, long-felt need and other forms of objective evidence.

The finding of validity in Adams properly underscores the fact that courts must marshal all the evidence before deciding whether a particular invention is obvious or nonobvious. In a given technology, a small structural change may portend a monumental new discovery, whereas large structural differences may only evidence a Rube Goldberg approach to a simple problem. Whether the differences make the "subject matter as a whole" obvious or nonobvious depends, for example, on the results obtained, the level of skill and sophistication in the art, the problems the art has solved and has tried to solve. To decide into which category a new invention fits, the Patent Office and the courts must look at all the evidence available on these questions just as the triers of fact ***9** in any case must look to all the evidence in deciding disputed issues and their legal consequences. [FN15] The determination that an invention is obvious or nonobvious is a legal conclusion but it must necessarily be based on the factual inquiries this Court so cogently enumerated in the Trilogy.

FN15. The recent Note on Black Rock, which is reprinted in the Appendix for the convenience of the Court, aptly describes the nature of the secondary considerations as follows:
"These evidentiary considerations are "secondary" in the sense that they occupy a different level in the hierarchy of legal and factual conclusions. Obviousness is the ultimate issue; the claimed invention, prior art and level of skill in the pertinent art, and difference between the prior art and claimed invention as compared to the level of skill in the art are all sub-issues preliminary to the determination of obviousness. To resolve the crucial sub-issues a court entertains factual evidence such as the claims, specification and file history of the patent, prior patents, publications and testimony of those skilled in the art and any other facts such as commercial success and long-felt need."
Note, After Black Rock: New Tests of Patentability- The Old Tests Of Invention. 39 The Geo. Wash. L. Rev. at 142 n. 127 (1970).

The secondary considerations are secondary in time only. As evidence they are necessarily not only primary but the only evidence that can be derived on the issue

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of what is obvious to a person of ordinary skill in the art. Judge Learned Hand emphasized this fact on a number of occasions even before the 1952 Patent Act was passed. For example, in Safety Car Heating and Lighting Co. v. General Electric Co. [FN16] Judge Hand made the following observations in discussing how courts should approach the appraisal of an inventor's contribution:

FN16. 155 F.2d 937 (2d Cir. 1946).

"In appraising an inventor's contribution to the art, as we have often said, the most reliable test is to look at the situation before and after it appears. Substantially all inventions are for the combination of old elements; what counts is the selection, out of ***10** all their possible permutations, of that new combination which will be serviceable. No objective standard is practicable; ... as, for example, whether each of the elements operates in a different way from what it did in other combinations. That is almost never true of a machine; each member ordinarily performs the same mechanical function which it does in any other machine; it is their cooperation that produces the result, and the value of that cooperation depends upon the sagacity which divined the end and fabricated the means. Courts, made up of laymen as they must be, are likely either to underrate, or to overrate, the difficulties in making new and profitable discoveries in fields with which they cannot be familiar; and, so far as it is available, they had best appraise the originality involved by the circumstances which preceded, attended and succeeded the appearance of the invention. Among these will figure the length of time the art, though needing the invention, went without it: the number of those who sought to meet the need, and the period over which their efforts were spread: how many, if any, came upon it at about the same time, whether before or after: and-perhaps most important of all-the extent to which it superseded what had gone before. We have repeatedly declared that in our judgment this approach is more reliable than a priori conclusions drawn from vaporous, and almost inevitably self-dependent, general propositions." [FN17]

FN17. Id. at 939.

In many ways the problem is similar to situations when so-called "structurally obvious" compounds, i.e., different but very similar structurally, are sought to be protected. It was asserted before the Court of Appeals for the District of Columbia in Commr. Patents v. Deutsche Gold-und-Silver-Scheideanstalt Vormals Roessler [FN18] that the Trilogy demanded that once an invention was determined to be "structurally obvious" that was the end of the matter. The court in a clearly reasoned opinion rejected this argument. The unexpected ***11** properties of the new compound rendered the invention patentable. The results counted and warranted patent protection for even a compound so structurally similar as to be prima facie obvious. Closeness structurally to the prior art can never tell the whole story on obviousness. For example, in the Eibel Process case, [FN19] the improvement in the Fourdrinier machine was really made when the reason for the limitation on the speed of the existing machine was understood. Raising one end of the machine some fifteen inches with respect to the other end was a small change but it permitted a major increase in speed to be attained. But a bare bones approach to this change in the machine's orientation would have never revealed the inventor's genius.

FN18. 397 F.2d 656 (D.C. Cir. 1968).

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FN19. Eibel Process Co. v. Minnesota & Ontario Paper Co., 216 U.S. 45 (1923).

D. Black Rock, the "Invention" Test and Combinations

In Black Rock, the court held the combination patent apparatus for laying continuous black-top paving invalid because it failed to meet the test of "invention":

"Each of the elements combined in the patent was known in the prior art....

"The combination of putting the burner together with the other elements in one machine, though perhaps a matter of great convenience, did not produce a 'new or different function,' Lincoln Co. v. Stewart-Warner Corp., 303 U.S. 545, 549, within the test of validity of combination patents....

"We conclude that while the combination of old elements performed a useful function, it added nothing to the nature and quality of the radiant-heat burner already patented. We conclude further that to those skilled in the art the use of the old elements in combination was not an invention by the obvious-nonobvious standard. Use of the radiant burner in this important field marked a successful venture. But as noted, more than that is needed for invention." [FN20]

FN20. 396 U.S. at 59, 60, 62-63.

***12** The Court elaborated on its finding of invalidity by stating:

"A combination of elements may result in an effect greater than the sum of the several effects taken separately. No such synergistic result is argued here. It is, however, fervently argued that the combination filled a long felt want and has enjoyed commercial success. But these matters 'without invention will not make patentability.' A & P Tea Co. v. Supermarket Corp., 340 U.S. 147, 153." [FN21]

FN21. Id. at 61.

The juxtaposition of these statements in Black Rock raises two basic problems:

(1) what happens to the obvious-nonobvious standard when a combination invention is present?

(2) what effect does the "invention" test of patentability have on the "secondary considerations" which figured so heavily in the Trilogy.

The ensuing discussion will treat each of these problems in order.

1. Combination Inventions and the Obvious-Nonobvious Standard

Given only the foregoing excerpts from Black Rock which contain only the briefest reference to the obvious-nonobvious standard, it would seem that the nonobvious test was no more. But the Court's opinion goes on to repeat the Trilogy criteria for determining nonobviousness and proclaims that "We admonish that 'strict observance' of those requirements is necessary." [FN22]

FN22. Id. at 62.

While the Trilogy test and the "invention" test of Black Rock might be reconciled in theory, in practical effect the reconciliation is not that at all but a determination that the "invention" test is the super test which is always applied. [FN23] How does this come to pass?

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FN23. See The Crisis of Law in Patents, supra note 4 in Pt. 1, 8.

***13** If the tests are to be mutually compatible, then the Trilogy criteria for nonobviousness is always applicable and operative while the A & P test [FN23a] only comes into play and is superposed on those criteria when the invention happens to be a combination of old elements. Under these circumstances, the following questions will have to be answered before patentability may be decided with respect to any particular invention even though it is admittedly new and useful:

FN23a. Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U.S. 147 (1950).

(a) Is a combination of old elements really present?
(b) If so, does the combination of old elements produce a "new or different function" (not merely a new, different or unexpected result)?
(c) How new, how unexpected, how different, how much synergism must exist in a combination of old elements case as contrasted with patentable inventions which are not combinations of old elements?

Considering these in turn, when do we have a combinaof old elements calling into play the super-standard overshadowing the Trilogy? The question can be more realistically dealt with by rephrasing it. When is an invention, any invention, not a combination of old elements, or in the case of a process, a combination of old steps?

The answer is never. Scientists and engineers (and artists as well), no matter how brilliant, do not create without using elements, components, materials, symbols or techniques that are known. Even Dr. Seaborg's invention of the trans-uranium elements, [FN24] curium and americum, involved combinations of old or known elements-protons, electrons and the like.

FN24. See In re Seaborg, 328 F.2d 993, 996 (C.C.P.A. 1964).

No one has put it better than Judge Learned Hand, who was a most articulate and thoughtful commentator on the ***14** law of patents, and Professor C. E. Ayres, who has devoted a lifetime to the study of inventions and discoveries and their economic consequences. Judge Hand made the point in a number of cases, including the Safety Car Heating decision which was Previously quoted and Reiner v. I. Leon Co. [FN25] In Reiner, which is cited with approval in Graham, he stated:

FN25. 285 F.2d 501, 503 (2d Cir. 1960), cert. denied, 366 U.S. 929 (1961).

"It is idle to say that combinations of old elements cannot be inventions; substantially every invention is for such a 'combination'; that is to say, it consists of former elements in a new assemblage."

Dr. Ayres made the same point in somewhat greater detail and from another point of view:
"...there is no difference between 'mechanical' invention and 'scientific' discovery. Scientific discoveries also result from the combination of previously existing devices and materials, laboratory instruments and techniques. It was by

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combining a magnet with a Crookes tube. for example, that J. J. Thomason discovered that the stream of incandescence in the tube was in fact a stream of physical particles and was even able to calculate the mass of the electrons. It was by combining a prism with a telescope that astronomers were able to identify elements (such as helium) in the sun. Even in the fine Arts 'creation' comes about in the same way. Leonardo's great achievement illustrated by the famous Mona Lisa ... was that he applied techniques which the monks had devised for the portrayal of angels to the portraiture of living subjects. Cezanne characterized his achievement as resulting from the application of Pissarro's studio technique to painting from nature. In every innovation analysis reveals the combination of previously existing devices. That is what the ***15** achievement is which in different fields we call invention or discovery or creation." [FN26]

> FN26. C.E. Ayres, The Theory of Economic Progress 115 (University of North Carolina Press, Chapel Hill (1944)). Ayres also made the same point in The Problem of Economic Order 13 (Farrar & Rinehart, Inc. New York (1938)), as follows:
> "Whatever the ingenuity of the individual inventor, an invention always results from the combination of pre-existing mechanical contrivances. No chemist, however brilliant, could bring about a given chemical reaction if the substances of which it is the reaction did not exist, and no mechanical genius could apply the vacuum tube to wireless telephony if neither telephony nor wireless telegraphy nor vacuum tubes had been developed."

The fact of the matter is that all inventions are combinations, the elements necessarily having been the building blocks at hand.

Where a new combination includes an element that is itself nonobvious, that element is subject to independent and separate patent protection. Given such patent protection for the element, that element's novelty cannot be the sole basis for patentability of the combination in which it resides. [FN27] For example, in Black Rock, the novelty of the radiant burner element was properly held to lend nothing to the patentability of the overall combination in which it was claimed. To hold otherwise would result in a grant of patent protection in two different patents for the very same contribution, a condition expressly rejected by the doctrines of double-patenting and that of an old or exhausted combination when the combination itself fails to be novel.

> FN27. This was, in part, the situation in Lincoln Engineering Co. v. Stewart Warner Corp., 303 U.S. 545 (1938). The apparatus in question was used to lubricate automobile bearings. The patentee made two inventions although the Court believed there was only one invention present. The Court assumed arguendo that that one invention-the coupling member for the apparatus-was patentable and used that fact to hold the patent claiming the combination of the pump, hose, fitting and coupling member invalid for some sort of misclaiming.
> In current parlance, the combination was clearly an invention in the sense the term is used in the 1952 Act and so was the coupling member. Whether the combination was a patentable invention as measured by Section 103 and the Trilogy criteria was a different matter.

***16** If the A & P test and the Trilogy test are to coexist and be considered in pari

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materia, the superimposed criteria of A & P will always be operative until someone can persuade through sophistry that a particular invention is not a combination of old elements or steps. The A & P test dominates the Trilogy in every case, and indeed, courts have said as much. [FN28] If they are not reading A & P. the Trilogy and Black Rock as this Court intended, they should be so advised or the instructions clarified.

FN28. In this sense, the Sixth Circuit got the message and so expressed it in Minnesota Mining & Mfg. Co. v. Norton Co., 426 F.2d 1117, 165 U.S.P.Q. 755 (6th Cir. 1970):
"In 1952 Congress added § 103 to the patent law so as to give statutory recognition of that 'impalpable something' which the courts had long required for 'invention.' ...
"The Supreme Court command in Great A & P Tea Co. v. Supermarket Equipment Co....still may be the clearest indication of the proper nature of our appellate review: ... '[] t is the standard of invention that controls.' ...
"In Section 103, Congress has merely outlined a somewhat functional inquiry into 'obviousness' as opposed to 'invention.' "

The second issue raised by Black Rock, namely, does the combination produce a new or different function, appears from the Black Rock language to be distinguished from the production of a new or different result. The latter, of course, is a significant factor in determining nonobviousness as the Court effectively demonstrated in Adams. It was the totally new and different result produced by the Adams battery that led the Court to hold it patentably nonobvious despite the fact that each element of the battery (every one of which was old) functioned in exactly the same way as it did in the prior art. Indeed, the government's attack on nonobviousness attempted to exclude the new and different nature of the result and focused exclusively on the ***17** fact that each element was known and each functioned as taught by the prior art. The combination, the invention as a whole, was responsible for the startling result. Black Rock, however, reinstitutes the possibility that unanticipated results, disbelieved and taught away from by experts in the art, do not make for patentability unless the elements function in a new way, a result antithetical to the holding in Adams.

The last consideration is, how much synergism is necessary? In Adams, a sufficiently new and different result was found but no so in Graham and Calmar where the results were new and different but apparently not sufficiently so. Perhaps they did not push back the frontiers of science as the concurring opinion in A & P suggested was necessary, although many had thought this proposition had been tacitly rejected in the Manson [FN29] case requirement of "practical" utility.

FN29. Manson v. Brenner, 383 U.S. 519 (1966).

2. Effect of "Invention" Test on Secondary Considerations

The effect of the Black Rock formulation of the Lincoln Engineering-A & P "invention" test on the so-called secondary considerations is quite clear from the language used: "But those matters 'without invention will not make patentability.' " [FN30]

FN30. 396 U.S. at 61.

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As the discussion in the previous section makes abundantly clear, it is not possible to determine nonobviousness without looking at these secondary considerations. They are the primary evidence on what the level of ordinary skill in the art is. Without them, a court is operating in an absolute vacuum in trying to divine whether an invention is obvious or nonobvious. Surely, this approach to the complexity of patent validity questions can have only dire ***18** consequences for the patent system and perhaps even more importantly for the public confidence in our courts.

Increasingly, the objective or secondary considerations of nonobviousness raised by the Trilogy are not considered at all if the prior art and the claimed invention are determined to be structurally quite similar and thus, in a sense, prima facie obvious. [FN31] Unless all the evidence, including the objective evidence dealing with factors such as long felt need in the art, unsuccessful attempts by those skilled and expert in the art to solve the problem, commercial success, extensive licensing, prompt and immediate copying, is considered in the determination of validity, we are thrust back to the precise situation which called Section 103 of the 1952 statute into being, without regard to the full and painful legal history of how the subjective standard of "invention" and its shifting burden was replaced by a reasonably objective standard of patentability.

FN31. See survey of the post-Black Rock decisions in Pat. L. Persp. § A.l[[1] (1969-70 Annual Review).

E. THE BLONDER-TONGUE-FOUNDATION CONTROVERSY

It is significant that the courts in the Seventh Circuit below and in the Eighth Circuit in Winegard all sought to use Section 103 and the Trilogy criteria to ascertain the patentability of both the Isbell and Blonder-Tongue patents. It is noteworthy that none of the four courts involved even cited Lincoln Engineering or A & P even though the patented antennas are clearly combinations of old elements. It does demonstrate, however, that so called combination inventions can be treated under the criteria laid down in the Trilogy without reference to Lincoln Engineering or A & P.

None of the courts nor the parties seriously questioned the fact that all the elements of the Isbell antenna were disclosed in various parts of the prior art. Even the district ***19** court in the Eighth Circuit, which held the Isbell patent invalid as obvious, characterized Isbell's frequency independent unidirectional antenna as a combination of "the dipole array of Katzin with the transposed feeder line of the Channel Master 'K.O.' or the Koosman or Winegard Patents.... adjusted by the log periodic theory of antenna design....." (Appendix 111) The district court in the Seventh Circuit agreed and further observed:

"In order to defeat a meritorious patent it is not enough 'to pick out isolated features' in the prior art, 'combine them in one particular way with hindsight acquired only from the patent under attack, and then say that no invention would have been involved in selecting those particular features and combining them in the particular way in which the patentee did.' Eversharp. Inc. r. Fisher Pen Co., Inc., 204 F.Supp. 649, 662-63 (N.D. 111. 1961)." [[Appendix 78]

The district court below thus looked to all three factual inquiries of the Trilogy as well as the "secondary considerations." (Appendix 78) The Eighth Circuit in Winegard listed the inquiries under the Trilogy to be the "(I) scope and content of

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the prior art, (2) differences between the subject patent and the prior art, (3) the level of the skill in the art at the time involved and (4) secondary considerations relating to commercial success, long-felt need, et al." It pointed out immediately thereafter that "of course, the latter factors cannot alone determine patentability." (Appendix 96)

The problem with this exclusionary judgment is that a court cannot fully understand "the level of the skill in the art at the time involved" and, to a lesser extent, "the scope and content of the prior art," unless it examines these secondary considerations which provide the primary evidence. Just as courts receive parole evidence to understand the intent of the parties to a contract or the meaning of its terms, so must courts look to the secondary considerations outlined in the Trilogy.

***20** While it appears that neither court of appeals automatically closed its collective eye to secondary considerations, these considerations need to be brought out from under the table and considered as the principal factual inquiry dictated by Section 103. Unless this is done, lower courts will be prone to ignore the secondary considerations altogether-or at least ignore them until the first three inquiries are determined with the hindsight borne of having the patentee's teaching and organization in front of them. At that point, it may be too late to derive the full impact and importance from the so-called "secondary considerations," without which an objective evaluation of the level of ordinary skill cannot be made.

Amicus curiae is not proposing that any one of the factual inquiries should be controlling, let alone the secondary considerations. It is the sum total of the Trilogy criteria that should be the basis for a court's legal conclusion as to nonobviousness. Anything short of this puts a premium on reaching a decision-often involving highly complex technology-on an incomplete and therefore inadequate record.

Indeed, the different records before the trial courts in the Seventh and Eighth Circuits below, consisting largely of the testimony of Dr. DuHamel and Mr. Blonder and the DuHamel patent, illustrate the point. Had the courts of the Eighth Circuit had before them all the prior art along with these flesh and blood judgments of persons involved in antenna technology, they might have agreed with the Seventh Circuit that the patent was valid. For, after all, it is the level of ordinary skill in the art, not that of judges having the hindsight of Monday morning quarterbacks, that is the standard.

If all such evidence is received and considered together before reaching a legal judgment on nonobviousness, it promises to shed the most light on how the predictability issue, which loomed large in the Eighth Circuit's opinion in Winegard, fits into the present picture. There the Court observed that "where logical exploration within known principles of science achieves an unpredictable result ... ***21** the burden of nonobviousness is not necessarily overcome." (Appendix 96)

Routine experimentation may make the outcome "obvious" depending upon what the prior art teaches or suggests. The level of experimentation which can properly be described as routine depends vary largely on the level of skill in the art and even on what adepts in the art consider routine. While DuHamel's or Blonder's testimony may not be conclusive, it is indeed material to an understanding of what "routine"

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means to a person skilled in the pertinent antenna art.

The argument that it is "obvious to try" and therefore obvious is a dangerous one. As the court in In re Tomlinson. [FN32] aptly pointed out:

FN32. 363 F.2d 928. 931 (C.C.P.A. 1966).

"[T] he question ... is obviousness under section 103 of compositions and methods, not of the direction to be taken in making efforts or attempts. Slight reflection suggests, we think, that there is usually an element of 'obviousness to try' in any research endeavor, that it is not undertaken with complete blindness but rather with some semblance of a chance of success, and that patentability determinations based on that as the test would not only be contrary to statute but result in a marked deterioration of the entire patent system as an incentive to invest in those efforts and attempts which go by the name of 'research.' "

The critical question is really whether the result obtained or the reason for the routine experimentation is so completely taught or suggested by the prior art that a person having ordinary skill in the art would get the message. If so, the patent is invalid. If not, the nonobviousness condition of patentability is met. The best judgment on this issue can be reached only by considering all the evidence which bears on the subject.

***22** V. THE TRIPLETT V. LOWELL QUESTION

A. Introduction

The American Patent Law Association does not view the Triplett v. Lowell [FN33] question as one which has a side of the angels and a side of the demons. Nor is it a question on which the interests of inventors lie wholly with the side urging "no retreat" from the stark rigor of Mr. Justice Stone's words in his 1936 Triplett v. Lowell opinion:

FN33. 297 U.S. 638 (1936).

"Neither reason nor authority supports the contention that an adjudication adverse to any or all the claims of a patent precludes another suit upon the same claims against a different defendant".

On the other hand, the solution of "in rem invalidity" advanced by the President's Commission [FN34] is unrealistically Draconian in the other direction. Including the instant case, there have been no less than six patents first held invalid by one court and then found valid by another since 1954. Clearly, reasonable men (Federal judges) can differ about the sufficiency of a given state of facts to invalidate a patent; to give "sudden death" standing to a single holding of invalidity may very well, therefore, be a denial of justice to a worthy inventor.

FN34. Report of the President's Commission on the Patent System (Washington, D.C., 1966) 44.

The American Patent Law Association is deeply concerned with the efficacy of the patent laws to accomplish their constitutional purpose, [FN35] namely, "to promote the progress of***useful arts." If litigation to enforce patent rights is protracted, expensive, burdensome, and unwieldy, something is amiss with those laws,

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at least procedurally. If to such faults is added that of uncontrolled relitigation, the reputation of the patent system itself suffers. However, to substitute ***23** for the latitude of Triplett v. Lowell the full rigor of collateral estoppel as urged by the proponents of in rem invalidity is to work a grave injustice in many cases both on patentees and on the system by the Procrustean expedient of fitting the sleeper to the bed.

FN35. Graham v. John Deere Co., 383 U.S. 1 (1966).

The conclusion which the American Patent Law Association draws from its examination of the problem is this:

The Supreme Court should not overrule Triplett v. Lowell in the instant, or any other case, but it should urge upon the Congress the prompt consideration of legislation dealing with patent litigation to the end that a patentee can be assured of a full and fair opportunity in a single plenary proceeding to achieve, if he prevails, a victory commensurate in economic value with the loss he would suffer, if defeated. While awaiting legislative resolution of all the complexities of the problem of restructuring a just and complete system for efficient patent enforcement, the Supreme Court should give its explicit support to the use by the lower Federal courts of existing devices available to them for the summary disposition of, and the imposition of full-compensatory recovery of litigation expenses in, cases where a patent once finally held invalid is unjustifiably relitigated.

B. The Forum Shopping Problem

The heart of the objection to the application of rigorous collateral estoppel to the relitigation of an issue of patent validity is unfairness to a patentee stemming not from the old mechanistic notion of "mutuality," but from the nonuniformity with which the trial courts and lower appellate courts treat that issue. As this Court well knows, there is no litigant so alert to the advantages flowing from the choice of venue as a patent litigant with the possible exception of a personal injury plaintiff on the trail of a big city verdict. The reason for this is well known, too. There simply is not a nationally applied standard of patentability in terms of a uniform concrete application by the lower Federal courts of the verbal formulae taken from recent opinions of this Court to the fact situations of actual patents.

***24** The response. of patentees and putative infringers to this situation is, of course, forum shopping, both active and passive. Thus, a patent owner may create a patent holding corporation in a validity jurisdiction in order to limit venue of declaratory judgment actions attacking the validity of the patent to that jurisdiction. Or a patent owner suing a widespread infringer will select the most validity-minded of the available jurisdictions, regardless of convenience considerations, and seek by judicious joinder of codefendants to thwart a transfer to a more convenient, but invalidity-minded forum. A patent owner who has not taken precautionary measures and who undertakes a licensing campaign thereby courts a declaratory judgment action brought by the most minor league of the putative infringers in the most antipatent jurisdiction in which the patentee can be brought to bar.

The decisions of this Court have weighted the odds in the forum "derby" rather severely against the patentee in that the restrictively-interpreted 28 U.S.C. §

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1400(b) severly limits the patentee-plaintiffs choice of forum in an infringement action, [FN36] while the liberally-interpreted 28 U.S.C. § 1391 gives the declaratory-judgment plaintiff [FN37] seeking to establish invalidity the widest range.

FN36. Fourco Glass Co. v. Transmirra Products Corp., 353 U.S. 222 (1957).

FN37. General Tire & Rubber Co. v. Watkins, 326 F.2d 960 (4th Cir. 1964), cert. denied 377 U.S. 909 (1964).

It seems clear that mere reversal of Triplett v. Lowell can only intensify this forum shopping by further increasing the stakes a patent owner has at hazard. Moreover, it would further heighten the odds against him.

C. The So-Called Burden of Multiple Patent Litigation is Exaggerated

In these days of crowded dockets, it is impossible not to sympathize with a desire to give each litigant his day in court, but only one such "day" on a given issue. Obviously, ***25** the justice of such a result depends on the courts involved being completely free of outcome-predictability "bias", else one "day" is in no sense the equivalent of some other "day".

We have already noted that, although patent law has been a purely national matter since 1789, there is not in 1970 even a freedom from outcome-predictability "bias" in the Federal courts sufficient to give an approximation of national uniformity in patent law enforcement. For this reason, Triplett v. Lowell has been felt by inventors to be their best assurance of a chance of getting a national standard applied to the testing of the validity of their patents through review by this Court of conflicting decisions should they have the bad luck to encounter an antipatent tribunal on the first try.

There has been a Senate study [FN38] of patent litigation satistics. It reports for the period 1 949-1958 that 80% of patents litigated were litigated only once and an annual average of only 2.7 patents were relitigated following an adverse holding on validity. The American Patent Law Association has not verified the up-dating information that over the period 1954-1970 there were only 23 relitigations of a patent once held invalid, but it has no reason to doubt the substantial accuracy of the figure. This shows a more recent yearly average of less than 2 relitigated cases that would be eliminated by reversal of Triplett v. Lowell and the adoption of rigorous in rein invalidity.

FN38. An Analysis of Patent Litigation Statistics, Staff Report of the Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary, United States Senate (Washington, D.C., GPO 1961).

D. Some Legislative Options

Triplett v. Lowell was decided in 1936. In 1952, the patent laws were recodified, and to some extent revised, and enacted into positive law as Title 35, United States Code. No change was made by the Congress in the Triplett v. Lowell doctrine.

***26** By 1966, a need felt in some quarters for further modernization of the patent laws resulted in the Report of the President's Commission, supra. In that report, a complete reversal of Triplett v. Lowell by legislation was proposed and a bill

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[FN39] was introduced in the First Session of the 90th Congress by the Administration proposing as § 294 of a new Title 35, in pertinent part:

FN39. S.1042 (McClellan) 90th Cong., 1st Sess. (1967).

"In any action in a Federal court***a final adjudication***limiting the scope of the claim or holding it to be invalid, shall constitute an estoppel against the patentee***in any subsequent Federal action***." [FN40]

FN40. It may be observed in passing that the recent prominence given (in Lear, Inc. v. Adkins, 395 U.S. 653 (1969)) to State adjudication of the issue of patent validity in the context of some cause of action other than patent infringement even raises some doubt about the completeness of the solution proposed.

After the appearance of S. 1042, there was a flurry of activity and a number of other "patent reform" bills were introduced and rather extensive hearings were held in both Houses. No legislation has been adopted yet, but it is noteworthy that the latest "McClellan" bill, S.2756, introduced into the 91st Congress, First Session, contains no provisions on estoppel, thus manifesting a conscious decision on the part of Senator McClellan, Chairman of the Subcommittee, to leave Triplett v. Lowell untouched.

Certain proposals that have been made over the years which Congress could and should weigh carefully are set out below. The American Patent Law Association, in calling these possible alternatives to the all-or-nothing dichotomy of Triplett v. Lowell versus in rem invalidity, espouses none of them. Our purpose is merely to demonstrate the soundness of our suggestion that restructuring of patent litigation, including any restraint found appropriate on relitigation not already provided by rule or statute, is best handled by the ***27** comprehensive legislation process. In the meanwhile, proper consideration for stare decisis suggests that this Court join the lower Federal courts [FN41] in leaving Triplett v. Lowell alone.

FN41. Nickerson v. Kutschera, 419 F.2d 983 (3rd Cir. 1969); Blumcraft of Pittsburgh v. Kawneer Co., 318 F.Supp. 1399, 166 U.S.P.Q. 265 (N.D. Ga. 1970) [petition to appeal denied August 20, 1970 by the Court of Appeals for the Fifth Circuit and denial reaffirmed by that court en banc September 18, 1970].

Since the older doctrine of "mutuality" probably had its origins in the sporting theory of justice [FN42] there is no reason to insist on its retention uniquely in patent litigation, but real considerations of down-to-earth fairness require that the rule of Triplett v. Lowell be replaced by some other approach than in rem invalidity. Some of these considerations and proposals to accommodate them are:

FN42. See Bruzewski v. United States, 181 F.2d 419 (3rd Cir. 1950), cert. denied, 340 U.S. 865 (1950).

1. Particularly in patent cases, for reasons already noted, choice of forum is a serious consideration. Further, as dramatically shown by the decision of this Court in Adams, a determination of validity may be decisively influenced by the actual impact of the invention on the practices of the of the Art. Thus a different rule of estoppel could appropriately be applied in cases where a patent is held invalid in

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an action begun by a patentee at a time chosen by him in a forum chosen by him, from that applied in declaratory judgment actions brought against him and reaching the same result.

2. The artificially restricted venue rule [28 U.S.C. § 1400 (b)] applicable to patent infringement actions makes it difficult for a patentee to join all suspected infringers in a single action. [FN43] Since there are public policy reasons for permitting ***28** successive putative infringers to contest patent validity, thus preventing any estoppel creating in rem validity, a great deal of the possible unfairness to patentees would be eliminated if liberal venue provisions such as those applicable in antitrust actions were adopted. Such relaxation would enable a patentee to have one big action in which he could obtain judgment against substantially all infringers, thus eliminating his present necessity of suing seriatim, with consequent savings in judicial time, and leaving him no just ground for complaint at being estopped to bring a second suit if his patent were held invalid.

FN43. The restrictive venue policy of 28 U.S.C. § 1400(b), as construed by this Court, was held to place a crippling limitation on the availability of the class action device (Rule 23, Fed.R.Civ.P.) to patentees in Technitrol, Inc. v. Control Data Corp., _____ F.Supp. _____, 164 U.S.P.Q. 552 (D.Md. 1970).

3. An assistance toward national uniformity of patent validity doctrine in actual application might be found in legislation assigning to the Patent Office some amicus role in litigation in which the validity of a patent was an issue.

4. Alternatively, the creation of a single court of patent appeals has been proposed to serve the unifying role this Court filled before the creation of the Circuit Courts of Appeals.

No sufficient justification has been shown for reversal of Triplett v. Lowell. The complexities of the problem involved demand a legislative solution to prevent the creation of new evils. Only an integrated restructuring of patent litigation can provide at one and the same time for protection against waste of judicial effort, fairness to patentees, and protection against oppressive reassertion of void patents.

VI. CONCLUSION

From the foregoing discussion, amicus' prayer to this Court can be stated briefly:

(1) Reaffirm that Section 103 as interpreted in the Trilogy is the only standard for determining the patentability of new contributions to the useful arts;

(2) Declare that since all inventions are combinations of old elements, all inventions are to be subjected to the same standard of patentability;

***29** (3) Prescribe that under the Trilogy criteria, the socalled "secondary considerations" must be included as an integral part of the evidence to be reviewed prior to determination of the obviousness issue; and

(4) Adhere to Triplett v. Lowell so that the Congress can restructure patent litigation with due regard to all the interests involved.

U.S., 2004.
Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation

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Supreme Court of the United States.
BLONDER-TONGUE LABORATORIES, INC., Defendant and Counter Claimant-Appellant, Petitioner,
v.
UNTVERSITY OF ILLINOIS FOUNDATION, Plaintiff and Counterclaim Defendant-Appellee,
and
JFD Electronics Corporation, Counterclaim-Defendant-Appellee, Respondents.
No. 338.
October Term, 1970.
December 31, 1970.

Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of Automatic Electric Company

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***1** To the Honorable Chief Justice and Associate Justices of The Supreme Court of The United States:

Automatic Electric Company, a defendant in Technograph Printed Circuits, Ltd., and Technograph, Inc. v. Automatic Electric Company now pending in the District Court for the Northern District of Illinois (Civil Action 63 C 36), respectfully moves for leave to file the annexed BRIEF AMICUS CURIAE in this case now before the ***2** Court on writ of certiorari to the United States Court of Appeals for the Seventh Circuit.

Automatic Electric Company has requested the consent of each of the parties to the present action and consent has been refused.

It is the understanding and the belief of Automatic Electric Company that none of the parties to this case will advance the negative position as to the first question which this Court asked the parties to brief in its letter of October 29, 1970; more particularly, neither party will contend that the holding of Triplett v. Lowell, 297 U.S. 638 (1936), should be overturned. Furthermore, it is the understanding and the belief of Automatic Electric Company that none of the parties to this case will advance the affirmative position on the second question raised by this Court, that is, none of the parties will contend that the determination of invalidity in the Winegard litigation binds the respondents in this case. The attached amicus brief is directed only to the two questions relating to the Triplett rule.

Automatic Electric Company is vitally interested in the Court's decision on the question of Triplett v. Lowell, 297 U.S. 638 (1936), because of its conviction that patent litigation, like all litigation, should come to an end and because the Court's overturning of the Triplett rule will be controlling in the Technograph cases pending in the District Court for the Northern District of Illinois.

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The Technograph cases were converted to a class action in 1968 (See Technograph Printed Circuits, Ltd. v. Methode Electronics, 285 F.Supp. 714 (N.D. Ill. 1968)) after the Seventh Circuit Court of Appeals had held that a prior adjudication of invalidity in an earlier action against another defendant could be given weight by comity only after a second trial on the merits. Technograph v. Method ***3** Elect. Inc., 356 F.2d 442 (7 Cir. 1966). Together with three other defendants [FN*], Automatic Electric has been designated a class representative for most of the electronics industry including approximately fifty defendants in actions pending in other districts.

> FN* The other representative defendants have been more or less inactive in the case; only Automatic Electric Company and RCA Corp., a class member, actively participated in the trial of the case. (RCA disputes its membership in the class but was given leave to participate without waiver of any rights relative to the dispute.)

The plaintiff in the class action is Technograph, Inc., the owner of Eisler patent No. 2,706,697, which allegedly covers a widely used process for manufacturing printed circuits. The patent was declared invalid in Technograph Printed Cirouits, Ltd. v. Bendix Aviation Corp., 218 F.Supp. 1 (D. Md. 1963); aff'd per curiam, 327 F.2d 497 (4 Cir. 1964); cert. denied, 379 U.S. 826 (1964), and in Technograph Printed Circuits, Ltd. et al. v. United States, 164 U.S.P.Q. 584 (Comm. Ct. Clm. 1970).

The Technograph action in Chicago was tried and briefed earlier this year; oral arguments were originally scheduled for November 13, 1970. On November 9, 1970, the trial judge, Hubert L. Will, vacated the oral argument because this Court indicated its interest in re-examining the decision in Triplett v. Lowell, 297 U.S. 638 (1936), on the present writ. In vacating the oral argument, Judge Will stated:

"Let us suppose the Supreme Court Were to hold, which it seems to me is quite possible ... that as against the patentee a determination of invalidity is the ball game. I always thought that ought to be the rule, incidentally. I don't see why ... a patent that is declared invalid should be relitigated against other ***4** alleged infringers in the hope that some court will end up holding it is valid, when you have got an opportunity to appeal the first declaration of invalidity and get it resolved.

* * *

"Suppose they hold that, that prior rulings in this case to the contrary notwithstanding, that is the end of this case, isn't it?"

The Triplett decision is the only obstacle to concluding the Technograph class action on the basis of the earlier decisions of invalidity (See Technograph Printed Circuits v. Methode Elect., Inc., 356 F.2d 442 (7 Cir. 1966)). If this Court overturns Triplett it will obviously have a substantial and probably controlling effect on the District Court's decision in the Tecthograph cases.

The appended brief was prepared as soon as possible after Automatic Electric Company learned that the petitioner did not support the view that Triplett should be overruled. Because Automatic Electric Company is not supporting the position of the petitioner on this issue, and because no other party will brief this question, the

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present brief is considered timely and important in the proper consideration of the issues raised by the Court.

Accordingly, Automatic Electric Company requests that leave be granted to file the brief submitted with this motion.

***5** QUESTIONS PRESENTED

Automatic Electric Company (hereinafter Automatic Electric) will discuss the following two questions on which the Court, in its letter of October 29, 1970, requested briefing:

"1. Should the holding of Triplett v. Lowell, 297 U.S. 638, that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, be adhered to?

"2. If not, does the determination of invalidity in the Winegard litigation bind the respondents in this case?"

INTEREST OF AUTOMATIC ELECTRIC

Automatic Electric is a defendant in Technograph Printed Circuits, Ltd., and Technograph, Inc. v. Automatic Electric Company (Civil Action 63 C 36, N.D. Ill.), one of four cases now pending in the District Court for the Northern District of Illinois as part of a class action (See Technograph Printed Circuits, Ltd. v. Methode Electronics, 285 F.Supp. 714 (N.D. Ill. 1968)).

The plaintiff, Technograph, Inc., alleges that the class members infringe Eisler patent No. 2,706,697, which purportedly covers a widely used process for manufacturing printed circuits. Defendants challenge the validity of the patent.

The Eisler patent has been declared invalid in Technograph Printed Circuits, Ltd. v. Bendix Aviation Corp., 218 F.Supp. 1 (D. Md. 1963), aff'd per curiam, 327 F.2d 497 (4 ***6** Cir. 1964), cert. denied, 379 U.S. 826 (1964), and an opinion and recommendation of invalidity have been rendered by Commissioner Davis in Technograph Printed Circutits, Ltd. et al. v. United States, 164 U.S.P.Q. 584 (Comm. Ct. Clm. 1970).

The trial court in the Automatic Electric case granted a motion for summary judgment holding the patent invalid on the same grounds as in Bendix, but the Court of Appeals for the Seventh Circuit reversed on the grounds of the Triplett decision (Technograph Printed Circuits v. Methode Elect., Inc., 356 F.2d 442 (7 Cir. 1966)). The decision of the Court of Appeals lead to a new trial on the validity issues in the class action. There are still about seventy other civil actions pending in about twenty federal districts on the same patent, only some of which are subject to the outcome of the class action. Thus, any argument that there are only two or three cases a year relitigating invalid patents and that this type of litigation is not a burden on the courts and on the public must be faulty.

The Technograph class action in Chicago was tried and briefed earlier this year and oral arguments were originally scheduled for November 13, 1970. On November 9, 1970, the trial judge, Hubert L. Will, vacated the scheduled oral argument because this Court granted the present writ of certiorari and indicated its interest in re-examining the decision in Triplett v. Lowell, 297 U.S. 638 (1936). The Triplett

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decision is the only obstacle to concluding the Technograph litigation on the basis of the earlier decisions of invalidity (See Technograph Printed Circuits v. Methode Elect., Inc., 356 F.2d 442 (7 Cir. 1966)). If the holding in Triplett is overturned or reinterpreted in this case, the Court's decision will probably be controlling in the Technograph cases.

***7** STATEMENT

The facts relating to the two questions are set out in the opinions of the Seventh Circuit Court of Appeals (reported at 422 F.2d 769 (A.54-71 [FN1]) and the Eighth Circuit Court of Appeals (reported at 402 F.2d 125 (A.93- 100)).

FN1. All record references in this brief are to the Petitioner's Appendix which is before the Court.

The Eighth Circuit suit was brought by the University of Illinois Foundation against the Winegard Company in the District Court for the Southern District of Iowa and charged infringement of the Isbell patent 3,210,767. Winegard successfully raised the defense of invalidity on the ground of obviousness (35 U.S.C. § 103), and the patent was declared invalid on June 23, 1967. University of Illinois Foundation v. Winegard Company, 271 F.Supp. 412 (S.D. Iowa 1967), (A.101-114). The decision was affirmed in University of Illinois Foundation v. Winegard Company, 402 F.2d 125 (8 Cir. 1968), (A.93-100), and this Court denied certiorari, 394 U.S. 917 (1969).

After the Iowa District Court's decision of invalidity, the District Court for the Northern District of Illinois considered and rejected the same obviousness defense and found the patent valid (A.71-90) in the present suit against Blonder-Tongue. In the appeal which followed the Blonder-Tongue decision, the Court of Appeals for the Seventh Circuit thought that, as a matter of "sound judicial policy," it should follow the invalidity decisions in the Eighth Circuit. Nevertheless, the court considered itself constrained by this Court's decision in Triplett v. Lowell, 297 U.S. 638 (1936), and was compelled to arrive at an independent decision on the obviousness issue. The Court ***8** of Appeals affirmed the trial court and upheld the patent. University of Illinois Found, v. Blonder-Tongue Lab., Inc., 422 F.2d 769 (7 Cir. 1970). This Court granted certiorari. Thereis other litigation pending on the same patent.

***9** ARGUMENT

QUESTION 1

Introduction.

The Triplett rule is based on the archaic and rapidly disappearing doctrine of mutuality of estoppel--a defendant cannot have the benefits of an earlier decision, the doctrine says, unless lie was a party to the earlier litigation and would have been bound by the decision had it gone the other way. The doctrine has been dying slowly over the past twenty years and is now virtually eliminated from most areas of the law where it was a problem; the significant exception is the patent law and its interpretation of this Court's statements in the Triplett case.

The mutuality doctrine and its effects are entirely inconsistent with the constitutionally established purposes and restrictions of the patent grant and the substantial public interest involved in the issue of patent validity on which this

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Court has founded its recent landmark decisions in the patent field (see Lear, Inc. v. Adkins, 395 U.S. 653 (1969); Graham v. John Deere Co., 383 U.S. 1 (1966); Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964); and Compco Corp. v. Day-Brite Lighting, 376 U.S. 234 (1964)). It is clearly incongruous to a federal patent system, which "requires that all ideas in general circulation be dedicated to the common good unless they are protected by a valid patent" (Lear, supra, at p. 668), to allow free distribution by the successful defendant, and others in the Eighth Circuit, and at the same time restrict the unsuccessful defendant, and others in the Seventh Circuit, leaving everyone operating in any of the eight other circuits in total doubt and confusion as ***10** to the legal consequences of their activities. It is equally incongruous to say that every patent which is subject to two possible district court holdings which are not clearly erroneous is entitled to review by this Court. (See this Court's order denying certiorari in National Sponge Cushion Co. v. Allen Industries, Inc., No. 1012 (October 1968).) While the Triplett decision itself does not require such results [FN2], this is precisely how the courts have interpreted it. [FN3]

FN2. In Triplett, the court stated that an "earlier decision may by comity be given great weight," and further provided a test for the comity question: "... the court must decide whether the issues of law and fact in the two cases are the same, and if they are not it is not bound by the earlier decision." (297 U.S. at p. 648).
See the discussion in Nickerson v. Pep Boys--Manny, Moe & Jack, 247 F.Supp. 221 (D. Del. 1965). The test obviously does not require a full trial the second time around. Moreover, the precedents cited by the court, Mast, Foos & Co. v. StoverMfg. Co., 177 U.S. 485 (1900), and Sanitary Refrigerator Co. v. Winters, 280 U.S. 30, 35 (1929), do not compel the result of a second trial because the question was not presented; in both cases the patent had been held valid in the earlier decisions.

FN3. Examples are: Gold Seal Importers, Inc. v. Westerman-Rosenberg, Inc., 133 F.2d 192 (2 Cir. 1943);
Aghnides v. Holden, 226 F.2d 949 (7 Cir. 1955);
Technograph Printed Circuits v. Methode Elect., Inc., 356 F.2d 442 (7 Cir. 1966);
Technograph Printed Circuits, Ltd. et al. v. United States, 164 U.S.P.Q. 584 (1970); Nickerson v. Kutschera, 419 F.2d 983 (3 Cir. 1969), compare dissent of Hastie, C.J., 419 F.2d at p. 984;
Blumcraft of Pittsburgh v. Kawner Co., 166 U.S.P.Q. 265 (N.D.Ga. 1970)
Rains v. Jil-Mic, Inc., 301 F.Supp. 545 (S.D.N.Y. 1969), (dicta);
For an analysis of the decisions on the question, see Kananen, Comments and Observations on Res Judicata and Patent Laws, 18 W. Res. L.R. 103 (1966).

***11** The various Courts of Appeal have recognized the anomaly of the Triplett doctrine in the patent law, and have expressed their disagreement with its results as a matter of judicial policy. Nevertheless, the courts consider themselves bound by the decision, and its subsequent interpretation, just as the Seventh Circuit Court of Appeals did in the case now before the Court, where it said:

"... It would seem sound judicial policy that the adjudication of that [[validity] issue against the Foundation in one action where it was a party would provide a defense in any other action by the Foundation for infringement of the same patent.

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"That, however, is not the law in this field..." 422 F.2d at p. 772 (citing Triplett).

In an earlier case in the Seventh Circuit, Aghnides v. Holden, 226 F.2d 949 (1955), involving a similar situation, Judge Schnackenberg, in a concnrring opinion, stated at page 951:

"... Aghnides may litigate and relitigate again and again ... as long as lie selects a different detendant. in each of the infringement stilts which lie files... This queer result is one which we are unable to avoid."

The same view has been expressed by the Third Cirenit Court of Appeals in Nickerson v. Kutschera, 419 F.2d 983, 984 (3 Cir. 1969), where the court said:

"We continue to believe that such change as may be desirable in this exception in patent cases to the general rule of collateral estoppel should be made, on a record such as this, by the Supreme Court itself or by Congress, which so far has refused to change the rule in Triplett. In this retard, it is noted that, while the oriental version of the 'Patent Reform Act of 1967' introduced in the Senate contorted a section providing, for collateral estoppel in patent cases, the present version of that Bill has deleted this so-called 'in rem invalidity' clause."

***12** As the Third Circuit Court of Appeals recognizes, Congress has failed to deal with the problem and it remains for this Court to provide the directive which these Courts have requested. (Lear, Inc. v. Adkins, 395 U.S. 653 (1969).)

The Doctrine of Mutuality of Estoppel Per Se Has No Place in the Law of Res Judicata.

The mutuality rule has absolutely nothing to recommend it but symmetry for the sake of symmetry. The proliferation of litigation which the rule can create, together with the lack of any redeeming merit [FN4], have been enough to condemn it in most areas of the law. The irrationality of the rule was exposed more than twenty years ago by Chief Justice Traynor. Speaking for the Supreme Court of California, Judge Traynor stated, in Bernhard v. Bankof America, 19 Cal.2d 807, 122 P.2d 892 (1942):

> FN4. The proponents of the rule offer little of a positive nature in arguing for its retention. See 1B Moore's Federal Practice (2d Ed.) ¶ 0.412 [[1].

"The criteria for determining who may assert a plea of res judicata differ fundamentally from the criteria for determining against whom a plea of res judicata may be asserted. The requirements of due process of law forbid the assertion of a plea of res jndicata against a party unless he was bound by the earlier litigation in which the matter was decided. * * * He is bound by that litigation only if he has been a party thereto or in privity with a party thereto. * * * There is no compelling reason, however, for requiring that the party asserting the plea of res judicata must have been a party, or in privity with a party, to the earlier litigation.

"No satisfactory rationalization has been advanced for the requirement of mutuality. Just why a party ***13** who was not bound by a previous action should be precluded from asserting it as res judicata against a party who was bound by it is difficult to comprehend. * * *"

The strength of Judge Traynor's logic has virtually eliminated the doctrine of mutuality from areas of the law where it has been even less a problem than in the

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patent field. In United States v. United Air Lines, Inc., 216 F. Snpp.709, 725-729 (E.D. Wash. 1962), aff'd sub nom, United Air Lines, Inc. v. Wiener, 335 F.2d 379, 404 (9 Cir. 1964), the District Court totally rejected the mutuality doctrine as to the finding of fault in an airline disaster case, stating, at pages 725 and 726:

"While it is true that the general rule requires that there be identity of parties to invoke the doctrine of res judicata, nevertheless, the Courts, increasingly so in the last 20 years, have not adhered to that doctrine, and have held that no constitutional right is violated where the thing to be litigated was actually litigated in a previous suit, final judgment entered, and the party against whom the doctrine is to be invoked had full opportunity to litigate the matter and did actually litigate it. (Emphasis original).

Similarly, the Fourth Circuit Court of Appeals rejected the doctrine in Graves v. Associated Transport, Inc., 344 F.2d 894, 897 (4 Cir. 1965), (personal injury litigation), where the court stated:

"The mutuality rule was probably never a solid wall; exceptions were created under the pressure of the public interest in an end to litigation. The thought was that under certain circumstances once the party against whom the former judgment was asserted had been afforded a full and fair day in court and a reasonable opportunity to be heard on all the relevant issues, even though against a different adversary, a plea of estoppel by judgment ought to be recognized."

***14** And in Zdanok v. Glidden Company, Durkee Famous Foods Division, 327 F.2d 944 (2 Cir. 1964), (contract case), the court commented in rejecting the doctrine:

"This doctrine of the need for mutuality of estoppels, criticized by Bentham over a century ago as destitnte of any semblance of reason, and as 'a maxim which one would suppose to have found its way from the gaming-table to the bench' ... has been much eroded in recent years." (327 F.2d at p. 954).

United Air Lines and Graves, are diversity cases. [FN5] But, as in Zdanok, the mutuality doctrine has been thoroughly ***15** rejected in federal question cases. See Gibson v. United States, 211 F.2d 425 (3 Cir. 1954), (admiralty); Bruszewski v. United States, 181 F.2d 419 (3 Cir. 1950), (Longshoreman action); United Banana Company v. United Fruit Company, 172 F.Supp. 580 (D. Conn. 1959), (antitrust); State of Michigan v. Morton Salt Company, 259 F.Supp. 35 (D. Minn. 1966), (antitrust), aff'd sud nom, Hardy Salt Company v. State of Illinis, 377 F.2d 768 (8 Cir. 1967); and Connelly v. Balkwill, 174 F.Supp. 49, 62-63 (D. Ohlo 1959), (securities case), aff'd per curiam, 279 F.2d 685 (6 Cir. 1960).

FN5. Additional examples are:
Fleischer v. Paramount Pictures Corporation, 329 F.2d 424 (2 Cir. 1964), (dicta-contractual obligation);
Davis v. McKinznon & Mooney, 266 F.2d 870 (6 Cir. 1959), (personal injury);
People v. Ohio Casualty Insurance Company, 232 F.2d 474 (10 Cir. 1956), (estate administration);
Seguros Tepeyac, S.A., Compania Mexicana v. Jernigan, 410 F.2d 718, 727 (5 Cir. 1969), (personal injury);
James Talcott, Inc. v. Allahabad Bank, Ltd., 310 F.Supp. 6 (S.D. Georgia 1969), (interpleader); Factor v. Pennington Press, Inc., 230 F.Supp. 906 (N.D. Ill. 1963), (libel);
Louisville Trust Company v. Smith, 192 F.Supp. 396 (W.D. Ky. 1961), (estate administration);

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State of Maryland v. Capital Airlines, Inc., 267 F.Supp. 298 (D. Md. 1967), (air disaster);
Goldstein v. Doft, 236 F.Supp. 730 (S.D.N.Y. 1964), (contract), aff'd, 353 F.2d 484 (2 Cir. 1965); and
Gorski v. Commercial Insurance Company, 206 F.Supp. 11 (E.D. Wis. 1962), (personal injury).
And see:
B. R. Dewitt Inc. v. Hall, 19 N.Y.2d 141, 225 N.E.2d 195 (1967);
Good Health Dairy Products Corp. v. Emery, 275 N.Y. 14, 9 N.E.2d 758 (1937);

Viewed against these decisions in a wide spectrum of litigation, the patent cases adhering to the mutuality requirement are a. singular exception which have withstood attack in the Courts of Appeal solely by virtue of a questionable interpretation of a decision of this Court. The compelling reasons Of fundamental fairness and judicial administration which led Judge Traynor, and the other courts following his lead, to unconditionally reject the "gaming table" doctrine of mutuality of ostoppel leave no room for Triplett in the patent field.

TheReasons for Rejecting the Mutuality Doctrine Are Even More Convincing in Patent Cases.

Above and beyond the reasons discussed above, the publie, interest in the patent grant and its relation to the competitive system, as well as the complexities involved in patent litigation with their potential for harassing abuse, are additional reasons for Triplett's interment. Judge Learned Hand aptly summarized the special nature of ***16** patent decisions in Royal Typewriter Co. v. Remington Rand, 168 F.2d 691 (2 Cir. 1948):

"[T]he reason why we should pass on ... [the validity] question ... is so that invalid claims shall not remain in terrorem of the art."

Until Triplett is overruled or reinterpreted, however, that purpose cannot be realized.

1. Inconsistent Validity Determinations Are Irreconcilable With a Federal Patent System.

The prospect of a patent being invalid in some areas of the country and valid in others is obviously inconsistent with "the strong federal policy favoring free competition in ideas which do not merit patent protection" (Lear, Inc. v. Adkins, 395 U.S. 653, 656 (1969)).

It is precisely the need for a uniform law which places patents in the realm of federal jurisdiction. As this Court noted in Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964), at p. 228:

"Before the Constitution was adopted, some States had granted patents either by special act or by general statute, but when the Constitution was adopted provision for a federal patent law was made one of the enumerated powers of Congress because, as Madison put it in The Federalist No. 43, the States 'cannot separately make effectual provision' for either patents or copyrights."

It is just as irrational to permit nonuniform patent protection in the various circuits as it is to allow each state its own patent system. Either result is inconsistent with ***17** a federal concept. One who wishes to sell a patented device

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can and should be compelled to obtain a license from the patentee and pay royalties, but not when his competitors have been freed from the monopoly either by a favorable decision of invalidity, or by simply being resident in the circuit where the decision of invalidity has been handed down. There is no conceivable reason consistent with the patent system for granting residents of the Eighth Circuit immunity while severely restricting their neighbors in the Seventh Circuit and leaving the rest of the country in doubt and free to act only in the peril of expensive and harassing patent litigation. It is equally unjustifiable that such inconsistencies should be permitted and even encouraged, with the burden of a final uniform decision always resting on this Court.

In the situation presented by the case at bar, but for this Court's intervention, Winegard, the successful Eighth Circuit defendant, would enjoy an unwarranted competitive advantage over Blonder-Tongue, the loser in the Seventh Circuit, and all others in the Seventh Circuit who may be reluctant to practice the invention out of fear of a Seventh Circuit suit. In the rest of the country, only continued and protracted litigation can be expected. [FN6] In such cases, public policy would be far better served by invocation of the doctrine of res judicata or collateral estoppel which would not only preclude relitigation after a full and fair trial and a decision of invalidity but would effectively devitalize the spurious monopoly for the ***18** benefit of the whole public, including unsuccessful defendants in prior suits. (The last judgment rendered would presumably be controlling. See Dimock v. Revere Copper Company, 117 U.S. 559 (1886); Dowell v. Applegate, 152 U.S. 327 (1894); Treinies v. Sunshine Min. Co., 308 U.S. 66 (1939); Garden Suburbs Golf & Country Club v. Murrell, 180 F.2d 435 (5 Cir. 1950); and Eyber v. Dominion National Bank of Bristol Office, 249 F.Supp. 531 (W.D. Va. 1966).)

FN6. The Isbell patent is presently being asserted in The Finney Company v. JFD Electronics Corp. and University of Illinois Foundation, Civil Action No. 65 C 671, United States District Court for the Northern District of Illinois, Eastern Division.

The prospect of inconsistent validity determinations and the thwarting effect that prospect has on new entries into a market [FN7] were major factors leading to the "in rein invalidity" clause embodied in the proposed 1967 version of the Patent Reform Act pursuant to the recommendation of the 1966 Report of the Presidential Commission. [FN8] The clause read:

FN7. The thwarting effect is discussed in 59 Georgetown L. J. 73, 81 (1970).

FN8. Report of the President's Commission on the Patent System entitled " 'To Promote The Progress of ... Useful Arts' In An Age of Exploding Technology," Nov. 17, 1966, pp. 38-39.

"A final federal judicial determination declaring a patent claim invalid shall be in rem, and the cancellation of such claim shall be indicated on all patent copies subsequently distributed by the Patent Office."

In making the proposal, the Commission stated:

"Under present law, even though one or more claims of a patent have been held invalid in one Federal circuit, the patentee may pursue a different defendant in another circuit for infringement of the same claims.

"As a result, a party may be held liable as an infringer or required to pay

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royalties in one circuit, while his direct competitor is practicing the same in-***19** vention without restriction in another circuit. Moreover, the mere possession of a patent, even though held invalid in one or more circuits, serves as a potential threat to persons unwilling or unable to defend a suit on the patent.

"A patentee, having been afforded the opportunity to exhaust his remedy of appeal from a holding of invalidity, has had his 'day in court' and should not be allowed to harass others on the basis of an invalid claim. There are few, if any, logical grounds for permitting him to clutter crowded court dockets and to subject others to costly litigation."

Congress' failure to enact that legislation and thereby correct the problem merely heightens this Court's responsibility to reinterpret its own precedent (Lear, Inc. v. Adkins, 395 U.S. 653 (1969)).

2. Judicial Economy and Preventing Harassment.

In Commissioner v. Sunnen, 333 U.S. 591, 597 (1948), this Court referred to the basis of the res judicata doctrine as "economy of judicial time." There are few areas of the law where economy would be more welcome then in the patent field. Patent litigation is notoriously complex. (See "Classes of Potentially Complex Cases" identified in the Manual for Complex and Multidistrict Litigation (¶ 0.22).) The history of the Technograph litigation, as related in Judge Becker's ruling establishing the ***20** class action (Technograph Printed Circuits, Ltd. v. Methode Electronics, 285 F.Supp. 714 (N.D. Ill. 1968), and in Judge Hall's decision imposing sanctions on the plaintiff (Technograph Printed Cir. v. Packard Bell Electronics Corp., 290 F.Supp. 308 (C.D. Calif. 1968), illustrates the extremes to which such complexities may be aggravated by a patent owner. The first decision of invalidity was handed down in 1963 (Technograph Printed Circuits, Ltd. v. Bendix Aviation, 218 F.Supp. 1 (D. Md. 1963)), and affirmed in 1964 (327 F.2d 497 (4 Cir. 1964)); cert. denied, 379 U.S. 826 (1964). Yet the patent owner continues the litigation in the Fourth Circuit (where the patent has already been held invalid), the Seventh Circuit (a class action), and the Ninth Circuit.

If Triplett had not been the law when Technograph Printed Circuits v. Methode Elect., Inc., 356 F.2d 442 (7 Cir. 1966), was decided, all of the subsequent proceedings could have been avoided. If the court now overrules the Triplett doctrine, it can eliminate additional time and expense from the history of an exceedingly long and complex series of cases. The Nickerson cases [FN9] and the Aghnides cases [FN10] are other examples where the Triplett rule has required large expenditures of judicial time.

FN9. Nickerson v. Kutschera, 419 F.2d 983 (3 Cir. 1969); and Nickerson v. Pep Boys--Manny, Moe & Jack, 247 F. Supp. 221 (D. Del. 1965).

FN10. Aghnides v. Holden, 226 F.2d 949, 107 U.S.P.Q. 195 (7 Cir. 1955); Aghnides v. Goodrie, 210 F.2d 859, 100 U.S.P.Q. 335 (7 Cir. 1954); Aghnides v. S. H. Kress & Co., 140 F.Supp. 582, 110 U.S.P.Q. 234 (M.D.N.C. 1956), aff'd, 246 F.2d 718, 114 U.S.P.Q. 187 (4 Cir. 1957), cert. denied, 355 U.S. 889, 115 U.S.P.Q. 426 (1957); and Aghnides v. Meyer's Co., 117 F.Supp. 839, 99 U.S.P.Q. 488 (M.D.N.C. 1954).

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***21** The complexities of patent litigation provide substantial potential for harassment as illustrated by the Technograph cases just discussed. Moreover, a study of patent litigation during fiscal years 1949-1958 [FN11], found that patents were reasserted in 62 instances "after a prior determination of invalidity," but that a "vast majority of suits commenced after a prior determination of the invalidity of the patent" were settled without a second decision on the merits, a disturbing statistic which suggests the widespread acceptance of licenses under invalidated patents. [FN12] Moreover, it is undoubtedly true that a large number of licenses are taken without filing a second complaint.

FN11. "An Analysis of Patent Litigation Statistics," Staff Report of the Subcomm. on Patents, Trademarks, and Copyrights of the Senate Comm. on the Judiciary, 86th Cong., 2d Sess., S. Res. 240, p. 19.

FN12. In the Technograph class action, one member of the class agreed to pay a six figure sum for settlement on the eve of the third trial on the Eisler patent, previously declared invalid in Technograph Printed Circuits, Ltd. v. Bendix Aviation Corp., 218 F. Supp. 1 (D. Md. 1963), aff'd per ouriam, 327 F.2d 497 (4 Cir. 1964), cert. denied, 379 U.S. 826 (1964). Under the settlement agreement, Technograph gambled nearly half of that sum that it could obtain a holding of validity in its second effort to sustain the patent, that is in the litigation against the United States in the Court of Claims.

Yet just such a result is to be expected in view of expense incident to patent litigation and the lack of certainty in legal relations consequent from the rule in Triplett:

"... The businessman can be subjected to considerable harassment as an alleged infringer. Even in cases where he feels strongly that the patent would ultimately be held invalid, when lie considers the hundreds of thousands of dollars in complex cases that could be involved in defending a suit, he may ***22** conclude that the best course of action is to settle for less to get rid of the problem. These nuisance settlements, although distasteful, are often, under the present system, justified on pure economics." Hearings Before the Subcomm. on Patents, Tradcmarks, and Copyrights of the Comm. on the Judiciary, United States Senate, 90th Cong., 1st Sess., pursuant to S. Res. 37 on S. 2, S. 1042, S. 1377, S. 1691, pt. 1, at 103 (May 17, 18, 1967).

All these reasons lead to the conclusion that Triplett should finally be interred; Automatic Electric urges the Court to answer the first question in the negative.

QUESTION 2

With the first question answered in the negative, in a more usual case, the second would seem to follow logically, since the decisions of the Seventh and Eighth Circuits involve the same issue and the same plaintiff (See Bernhard v. Bank of America, 19 Cal.2d 807, 122 P.2d 892 (1942)). Here, however, Blonder-Tongue has specifically requested that the court not overrule Triplett (Petitioner's Brief, p. 9), and apparently it has neither pleaded the defense of res judicata nor has it any desire to do so.

Nevertheless, Blonder-Tongue has placed the issue of validity before the court and the public interest in the court's decision is sufficient reason for considering the collateral estoppel question in the specific context of this litigation (Haughey v. Lee, 151 U.S. 282, 285 (1894); Paramount Publix Corp. v. American Tri Ergon Corp.,

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294 U.S. 464, 477 (1935); Kellogg Switchboard and Supply Co. v. Michigan Bell Telephone Co., 99 F.2d 203, 205 (6 Cir. 1938)).

Withthe mutuality question resolved against the University of Illinois Foundation, the only remaining con-***23** sideration is whether the same "right, question or fact" at issue in the present ease was "distinctly put in issue and directly determined" by the District Court and Court of Appeals in the Eighth Circuit (Southern Pacific Railroad v. United States, 168 U.S. 1, 48 (1897)).

The opinions of the Seventh and Eighth Circuit Courts of Appeal leave no room for doubt on the question. Both courts were dealing with the same Isbell patent. In both cases, the issue of invalidity on the basis of obviousness was specifically raised and considered. Thus, precisely the same validity issues were raised in the two cases.

The Foundation has argued in its reply to the petition that the record on the obviousness issue is different in the two cases (Reply p. 5). Specifically, it argues that the Seventh Circuit Court of Appeals had the benefit of Dr. DuHamel's testimony. [FN13] But the fact that the records are different in the two cases is immaterial in view of the identity of the issues. While the question of "new evidence" was sometimes an issue under the Triplett rule [FN14] , ***24** it has no applicable place in a determination of collateral estoppel or res judicata. When a similar contention was made in Southern Pacific Railroad v. United States, 168 U.S. 1 (1897), the court stated at page 65:

> FN13. DuHamel is a University of Illinois professor who worked in the same laboratory as Isbell on projects sponsored by the United States Air Force (A. 231-32) when the alleged Isbell invention was made. DuHamel has a financial interest in the outcome of the litigation (A. 359). His testimony was obviously available to patentee in the Winegard case but was not presented-- possibly in anticipation of an adverse decision from the Eighth Circuit in view of that Court's strict adherence to the principles of Graham. Instead, the DuHamel evidence was saved for presentation in the statistically far more favorable climate of the Seventh Circuit. In these circumstances, it is in the public interest that the DuHamel testimony, if received at all, should be given little or no weight.
>
> FN14. Sec Aghnides v. Holden, 226 F.2d 949 (7 Cir. 1955).

"We cannot concur in the view that the evidence upon this branch of this case is of such nature as to compel the court, in the interest of truth and justice, not only to consider it but to pass again upon the issue made in the former suits as to the character of the maps of 1872. Whatever is new in the evidence now before us, touching that matter, is simply cumulative on the one side or the other. The application to consider that evidence is practically an application for a rehearing as to things directly determined in the former suits ... Such a course of procedure is wholly inadmissible under the settled rule of res judicata."

We need only add that the public policy considerations involved obviously require that the Court's ruling be given full retroactive effect (Lear, Inc. v. Adkins, 395 U.S. 653, 674 (1969)).

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The second question, therefore, should be answered in the affirmative.

***25** CONCLUSION

The Triplett rule of mutuality of estoppel should be excised from the patent law and based on this record the owner of the Isbell patent should be barred from asserting that patent following the final holding of invalidity by the Eighth Circuit Court of Appeals.

U.S., 2004.
Blonder-Tongue Laboratories, Inc. v. Untversity of Illinois Foundation

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For opinion see 91 S.Ct. 1434, 91 S.Ct. 917, 91 S.Ct. 563, 91 S.Ct. 449, 91 S.Ct. 363, 91 S.Ct. 101

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Supreme Court of the United States.
BLONDER-TONGUE LABORATORIES, INC., Defendant and Counter Claimant-Appellant-Petitioner,
v.
UNIVERSITY OF ILLINOIS FOUNDATION, Plaintiff and Counterclaim Defendant-Appellee, and JFD Electronics Corporation, Counterclaim-Defendant-Appellee, Respondents.
No. 338.
October Term, 1970.
December 7, 1970.

Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of the Finney Company Supporting the Position of the Petitioner That the Isbell Patent in Suit is Invalid.

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***1** To the Honorable Chief Justice and Associate Justices of The Supreme Court of The United States:

The Finney Company, a manufacturer of radio and television antennas in Bedford, Ohio, respectfully moves for leave to file the annexed brief amicus curiae in support of a reversal of the decision of the United States Court of Appeals for the Seventh Circuit and of the decision below by the United States District Court for the Northern District of Illinois, Eastern Division, to the extent that those decisions found the Isbell patent in suit to be valid.

This case is now before the Supreme Court as a result of its granting of the petition of Blonder-Tongue Laboratories, Inc. (Defendant and Counter-Claimant-Appellant, below) for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit. When granting ***2** that petition, the Supreme Court also granted a motion of The Finney Company for leave to file a brief amicus curiae annexed thereto in support of granting of the petition.

The Finney Company is the plaintiff in a pending declaratory judgment action seeking, inter alia, a judgment that the Isbell patent of the University of Illinois Foundation (the same Isbell patent involved in the above action) is invalid. [FN1] That declaratory judgment action is but one of several other pending suits involving the questions of validity and infringement of the Isbell patent. [FN2]

FN1. The Finney Company v. JFD Electronics Corp. and University of Illinois Foundation, Civil Action No. 65 C 671, United States District Court for the Northern District of Illinois, Eastern Division.

FN2. Petition of Blonder-Tongue Laboratories, Inc., p. 9, note 2.

The further brief amicus curiae of The Finney Company, annexed hereto, is addressed in part to the merits of the particular issue of the litigation which its prior brief asked the Supreme Court to consider. In addition, however, the present brief is directed to the merits of another issue that is critical to the validity or invalidity of the Isbell patent in suit. It is believed that a ruling on both of those issues by the Supreme Court would create a better understanding of the law on those issues and a more consistent application of that law by the Federal trial and appellate courts, as well as insure a correct disposition in several other pending suits of the ultimate issue of validity of a patent that has been held valid below after a final decision of the Court of Appeals of the Eighth Circuit holding the same patent invalid.

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Printing, filing, and service of the annexed brief have been completed as quickly as possible after the appendix and other record citations therein could be ascertained ***3** from the record as filed by the parties. Advance consent to the filing of such a brief having been refused by the University of Illinois Foundation (one of the Respondents), granting of this motion and consideration of the annexed brief are earnestly requested.

Note: Page 4 missing in original document

***5** The Finney Company, as amicus curiae, respectfully supports the position of the Petitioner in this case insofar as it seeks a reversal of the decisions below on the issue of validity of the Isbell patent in suit No. 3,210,767 (PX 1, A. 399, R. 122).

The history of this case and the issues involved are sufficiently set forth in the Petitioner's brief.

QUESTIONS PRESENTED.

The Finney Company, as amicus curiae, respectfully requests the Supreme Court to direct its attention to two important questions of law involved in the decisions below and on which both of the courts below are believed to have erred in finding the Isbell patent in suit to be valid. Those two questions are:

Question I: Where logical exploration within known principles of the art achieves an unpredictable result, does the necessity of logical experimentation, in and of itself, negate obviousness under 35 U.S.C. 103?

Question II: Where, more than one year before the filing date of a patent, the patented invention was described in a printed publication available to persons in the art, upon request, in a university repository maintained and used for that purpose, does such publication fail to qualify under 35 U.S.C. 102(b) as a bar to the grant of a valid patent because--

***6** a. the university repository may not have met some unspecified definition of a "genuine library," or

b. the person responsible for the operation of such repository failed to qualify as "truly a librarian," by some unspecified standard, or

c. despite the availability of the publication to persons in the art for a few days before the critical date, there was only a "rather remote possibility that a person knowing of the report might have asked for it and obtained a copy of it" during such a short period?

Question I, above, is the fundamental point of divergence of the respective, conflicting decisions of the Seventh and Eighth Circuit trial and appellate courts on the issue of validity of the Isbell patent. As will be developed in the correspondingly numbered section of the ensuing ARGUMENT, that question has been dealt with by the Supreme Court and other courts in numerous decisions during the last few decades, generally in a manner consistent with the decisions of the Eighth Circuit trial and appellate courts on the Isbell patent but contrary to the decisions of the Seventh Circuit trial and appellate courts with which we are here

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directly concerned. However, the Supreme Court has not ruled on this question since enactment of the present patent statute in 1952.

The decisions below not only depart from the law on this question as applied by prior federal court decisions, but are believed to depart from the obviousness test of patentability prescribed by 35 U.S.C. 103. Therefore, clarification of this aspect of the question of obviousness under 35 U.S.C. 103 should provide much needed guidelines for deciding similar questions in the future and, ***7** particularly, in the several still pending suits on the same Isbell patent.

Question II, above, involving the requirements of a "publication" within the meaning of 35 U.S.C. 102(b), was an issue in the trial on the Isbell patent before the District Court of the Eighth Circuit, but was neither ruled upon by that court nor considered on appeal by the Eighth Circuit Court of Appeals in view of their disposition of the case by a holding that the Isbell patent is invalid for obviousness under 35 U.S.C. 103. However, this "publication" question was considered and ruled upon below by both the trial and appellate courts of the Seventh Circuit, but in a manner contrary to all known precedent involving similar facts. This will also be apparent from the correspondingly numbered section of the ensuing ARGUMENT. Accordingly, a ruling by the Supreme Court on this basic question of statutory construction is also important for insuring a proper application of the "publication" bar of 35 U.S.C. 102(b) in the future.

STATEMENT OF THE FACTS.

Facts Relevant to Question I.

As found by the trial courts in this and the related Eighth Circuit cases (A. 73-75, 103-105), the invention of the Isbell patent relates to so-called "broadband" radio and television antennas. The patented antenna consists of an array of interconnected elements, called "dipoles," that progressively decrease in length and spacing from one end to the other of the array. They are so connected, each to the next, that the array is unidirectional in operation. The progression of dipole lengths and spacings follows a so-called "log-periodic formula" (recently developed by the prior art as discussed below) which requires ***8** that the length of each successive antenna element and of each successive space between elements be the same fraction of the preceding element length or element spacing, i.e., they all vary by the same fractional multiplier or "scale factor." Such proportioning of the array of dipoles is alleged in the patent to produce uniform performance "over any desired bandwidth" of broadcast frequencies, i.e., "frequency independent operation."

A dipole is a conventional, rod-like, antenna element of the prior art having a central gap that provides terminals or "feed points" for connecting the dipole, or a series of dipoles, to a receiver or transmitter. The tip-to-tip length of a dipole determines a narrow range of frequencies for which its response is optimum. It had sometimes been used in the generally equivalent form of an elongated loop, called a "folded dipole."

Long prior to Isbell's work, broadband antennas composed of similar arrangements of a number of dipole elements were old for covering moderate bandwidths, for example, the television low band (channels 2 to 6) or high band (channels 7 to 13). The dipoles were spaced apart, as required by their known interaction effect on one another, and they varied in lengths so that each would operate with optimum response

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at the frequency determined by its length to render the array as a whole responsive to all frequencies in the particular bandwidth to be covered.

The most pertinent of such prior art, broadband antennas, having dipoles of varying lengths and spacings, were the antennas of the Katzin patent No. 2,192,532 (DX 3, A. 477, R. 236) and the K.O. antenna (DX 4, A. 481, R. 236), the latter employing the same scheme for interconnecting (i.e. "feeding") the dipoles that is disclosed ***9** and claimed by Isbell for obtaining unidirectional operation of the antenna (A. 61, 107-108). The K.O. antenna was not considered by the Patent Office. [FN1] Other prior art arrays of two or more dipoles similarly interconnected for unidirectional operation are shown in patents No. 1,-964,189 to Koomans, No. 2,105,569 to White et al., and No. 2,700,105 to Winegard, none of which was considered by the Patent Office.

FN1. As indicated by its omission from the list of references at the end of the Isbell patent (A. 403).

The antenna of the Isbell patent in suit differed significantly from the multiple dipole antennas of such prior art only by the proportioning of the dipole lengths and spacings of the Isbell antenna according to the aforementioned log-periodic formula of the prior art (A. 61, 95). Thus, rather than being a pioneer, as Respondents have argued, Isbell merely applied a recently developed prior art formula to a particular class of prior art antennas for the same purpose that the formula had been previously employed.

In 1957, only shortly prior to Isbell's work on the invention of his patent in suit (completed before May 1959 as explained below), DuHamel and the same Isbell, working at the University of Illinois, published the first disclosure of so-called log-periodic antennas having frequency independent operation (i.e. uniform operation) over theoretically unlimited bandwidths. Those antennas were circularly curved tooth structures cut out of sheet metal. The lengths and spacings of the teeth varied progressively by a common multiplier or "scale factor" according to the so-called log-periodic formula.

Next, early in 1958, DuHamel and Ore published the results of their further work with log-periodic antenna ***10** structures at Collins Radio Company (DX 6, R. 238). [FN2] The "Introduction" of this publication first described the prior work of DuHamel and Isbell, noting that the new results to be reported in this publication demonstrated that "the equi-complementary condition" originally believed necessary was "not always necessary," since several antennas to be disclosed deviated severely from that condition (A.484) They then made the following statement, of particular significance in this case, regarding the objectives of their work (A.484):

FN2. Published March 31, 1958, more than one year before Isbell's filing date of May 3, 1960, so as to be prior art under 35 U.S.C. 103.

"A great number of logarithmically periodic antenna configurations are possible. The investigation reported in this paper was conducted to study impedance, pattern, and polarization characteristics of a variety of structures. Another objective of the investigation was to devise practical forms of this type of antenna. Since large, circular tooth structures would be difficult to construct, the possibility of simplifying this basic structure by straightening the teeth and by making wire

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approximations of the teeth was investigated and is reported in the following sections." (Emphasis added)

This publication (DX 6), only briefly preceding Isbell's invention of the patent in suit, was the first disclosure of how the log-periodic principle could be applied to the proportioning of practical, wire or rod-type antennas to obtain varying degrees of frequency independence over any desired frequency range. It illustrated and described various forms of log-periodic antennas progressing in design toward the wire or rod-type antennas of the prior art.

Finally, a DuHamel and Ore patent No. 3,079,602 ***11** (DX 14, A. 510, R. 283), also standing as prior art herein against the Isbell patent in suit, disclosed the antennas of the above described publication and additional variants that still more closely approached (as explained below) the structure of the prior art, broadband, multiple dipole antennas mentioned above and the similar structure of the antennas of the Isbell patent. Nether the DuHamel and Ore publication nor this DuHamel and Ore patent was considered in the actual Patent Office prosecution of the Isbell patent in suit, [FN3] nor was the DuHamel and Ore patent considered by the Eighth Circuit courts.

> FN3. Note 14 of the decision by the trial court in the Eighth Circuit (A. 112-113) and the list of references at the end of the Isbell patent.

The DuHamel and Ore publication (DX 6) showed a progression of designs of antennas in which upper and lower, planar structures were respectively inclined upwardly and downwardly from a feed point and diverged by an angle psi (??). The feed point was the forward end of the antenna, and the forward end of the antenna pointed toward the transmitter of a wave or signal to be received. The angle psi was varied from a disclosed minimum of 7° (table on p. 146, A. 490) to a maximum of 180° (table on p. 142, A.486). The illustrated designs of the angularly disposed, upper and lower structures progressed from the original, curved-tooth, sheet metal structures of DuHamel and Isbell (Figure 1) through a number of similar, straighttooth structures (Figures 2, 3, 6, and 8), to various noncomplementary, wire or rod approximations of the sheet metal structures (Figures 9, 10, 12, and 15). (A.483-491)

The DuHamel and Ore patent disclosed essentially the same progression of structures. However, it differed from their prior publication by disclosing (col. 2, lines 52-54) that the angle psi may be reduced to 0° (A. 519) When the ***12** angle psi is 0°, the upper and lower structures in Figures 1-7, 13, and 15 of the patent are parallel and closely spaced. All of the forms of Figures 1-7, 13, and 15 of the patent (A.510-518) when the angle psi is 0°, differ from the Figure 2 form of the Isbell patent only in the form of the teeth, as DuHamel confirmed with reference to the antenna of Figure 5 of the patent (A. 287-288). DuHamel also confirmed that each triangular tooth of the antenna of Figure 5 of the patent would function similarly to the corresponding straight rod tooth of the Isbell patent "in the E plane or principle plane" of operation of the antennas (A. 288-293).

Thus, the only difference between the antennas of Figure 5 of the DuHamel and Ore patent (with the angle psi at 0° as disclosed) and Figure 2 of the Isbell patent is that Isbell used a single, straight rod (half of a conventional dipole) in place of each triangular element 51b, 51c, 51d, etc. of DuHamel and Ore. And as DuHamel acknowledged, the operation of the two types of elements is similar, and thus

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equivalent.

In identifying the prior art, the Seventh Circuit Court of Appeals first referred only to the art before the Eighth Circuit courts (A. 60) and later mentioned the DuHamel and Ore patent only in passing (A. 63), as the trial court below had done (A. 79), apparently not recognizing how closely the antenna of Figure 5 of that patent approached the antenna of the Isbell patent in both structure and operation of the active elements. [FN4]

> FN4. This important and evident oversight by both of the trial and appellate courts below reflects seriously on the cogency of their treatment of the question of obviousness, as explained in the ensuing ARGUMENT herein.

The Courts of Appeals of the Seventh and Eighth Circuits both recognized in their decisions that the only significant difference between the antennas of the Isbell ***13** patent and the broadband, multiple dipole, prior art antennas (such as the K.O. antenna, DX 4, or antennas of the Katzin patent, DX 3) is that, according to the Isbell patent, the lengths and spacings of his conventional dipoles vary according to the prior art log-periodic formula (A. 61, 95). Both of those appellate courts referred to Jasik's Antenna Engineering handbook (Px 55, A.429), which explained that the Isbell antenna was merely an adaptation of the log-periodic scaling principle to prior art broadband antennas for the purpose of achieving more uniform (i.e., more frequency independent) performance over a frequency band (A. 63, 95 and A. 442).

As both of those appellate courts and the Seventh Circuit trial court found, the frequency independent operation of the antenna of the Isbell patent, or any logperiodic antenna, was unpredictable (App. 62, 78, 96). However, as both appellate courts indicated by quotations from the Jasik handbook, whether or not a particular antenna, proportioned according to the log-periodic formula, would be frequency independent in its operations was readily determinable "by logical experimental methods" (App. 62, 99 and A. 442).

It is significant to note that the Isbell patent, itself, and the records of the Seventh and Eighth Circuit cases contain no assertion or evidence that the antennas of that patent are any more frequency independent than the similar prior art antennas of DuHamel and Ore. Thus. the difference between the claims of the Isbell patent and the closest prior art (such difference being what Isbell actually patented) produced no new or surprising results.

The trial and appellate courts below both relied upon testimony of Dr. DuHamel about his initial surprise on learning of the Isbell invention (A. 64, 78-79). As quoted by that Court of Appeals, DuHamel stated that he was ***14** initially "surprised at the simplicity of the structure" of the Isbell antennas, adding--

"At first I was somewhat surprised that they worked but after thinking more about it and thinking back, then I was not surprised. At first I was surprised that it did work."

The trial court stated, "There can scarcely be more convincing proof that Isbell's invention met a 'long felt but unsolved need' in the antenna industry." That conclusion, on its face, is a non-sequitur. Referring to this testimony at a later point in its decision, the trial court characterized DuHamel's reaction as one of astonishment (App. 79), which that testimony obviously does not warrant.

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Whatever DuHamel's reaction may have been, there is no evidence or finding that, despite his academic degree and distinguished work in sophisticated antenna research, he (or his co-worker, Ore) had any familiarity with the common, unsophisticated, skills found in the commercial television antenna business, or any knowledge of the prior art K.O. antenna for home television reception, or of the particular prior art antenna patents of record in this case. Accordingly, the record does not support even an inference that what was initially surprising to DuHamel or what he may have failed to accomplish while working in his particular environment, would not have been obvious "to a person having ordinary skill" in the commercial television antenna art and having all of the prior art before him. Toledo Pressed Steel Co. v. Standard Parts, 307 U.S. 350, 356 (1939).

Respondent, the University of Illinois Foundation, has made reference to alleged prior efforts and failures by others to achieve Isbell's results. However, the record reveals no failures and only the efforts of Isbell, who ***15** quickly found that applying the known log-periodic formula to prior art dipole antennas produced the same results previously obtained by DuHamel and Ore.

Respondent has also argued that the art prior to Isbell led away from Isbell's patented antenna, citing United States v. Adams et al., 383 U.S. 39 (1966). However, there is no evidence or finding to that effect. The only relevant evidence involves the work of DuHamel and Ore, which was shown to have proceeded successfully in the direction of Isbell's structure, rather than away from it, and to encourage further work in that direction.

Facts Relevant to Question II.

As found by the District Court below, the Isbell patent was applied for on May 3, 1960, but the invention of the patent was described in a publication (DX 8, A. 500, A. 213) printed at the instance of the University of Illinois and received at the Publications Office of the Electrical Engineering Research Laboratory on April 30, 1959, more than one year before the application for the Isbell patent (A. 79-80). The circumstances are summarized briefly in the decision of the District Court below as follows (A. 80):

"The evidence which tends to support the defendant's position on the question of publication is the testimony of Miss Marjorie Johnson in the Winegard trial, of record in this case by stipulation. Miss Johnson, whose formal position with the University of Illinois in 1959 was Technical Editor of the Electrical Engineering Research Department, was responsible for distributing Electrical Engineering Laboratory publications, such as the quarterly reports. As part of her duties, Miss Johnson also kept copies of such publications in a 'library' of sorts, where, because there were no supervisory personnel, materials ***16** were kept in locked cabinets and were generally obtained by request from a member of the publications staff having a key. Miss Johnson testified that the quarterly report involved here was in the publications office on April 30, 1959, and was therefore 'available for distribution upon request on that date,' although they were not actually distributed to persons on the distribution list until May 5, 1959."

The District Court below summarized the effect of Miss Johnson's testimony as follows (A. 80):

"If Miss Johnson were truly a librarian and the document had been available in a genuine library, even a very small or a highly specialized library, this court would

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be compelled by the weight of authority to hold that such availability constituted 'publication' within the meaning of § 102. See, e.g., Hamilton Laboratories, Inc. v. Massengill, 111 F.2d 584 (6th Cir. 1940)."

In holding that the facts did not constitute "publication" within the meaning of 35 U.S.C. 102, the District Court stated (A. 80-81):

"However, the court finds the nature of the availability of the document in this case was not sufficiently 'public' in nature to constitute the kind of publication intended by the act, at least until the report was distributed on May 5, 1959. In my view, the document had merely arrived from the printer and had come into the possession of the publications office on April 30, 1959, and although there existed the rather remote possibility that a person knowing of the report might have asked for it and obtained a copy of it on that date, this kind of availability did not represent 'publication.' " (Emphasis added.)

The Court of Appeals apparently also reviewed Miss Johnson's testimony and the testimony of her immediate ***17** superior, Harold D. Lawler, and first resummarized the essential facts as follows (A. 56-57):

"Isbell was associated with the Antenna Laboratory of the University of Illinois in performance of an Air Force contract. Reports were prepared and distributed from time to time pursuant to the contract. Quarterly Engineering Report No. 2 contained a description of Isbell's investigation of a type of log-periodic antenna, and it is conceded that if this report was published more than one year before May 3, 1960, the patent was invalid under 35 U.S.C. § 102(b). The printer delivered copies of the report to the office of Miss Johnson, technical editor of the Electrical Engineering Research Laboratory, April 30, 1959. Copies were mailed out of Miss Johnson's office, pursuant to the Air Force contract, to persons on the distribution list May 5."

* * *

"It appears that the Engineering Research Laboratory had a 'library' or reading room near Miss Johnson's office. It was unattended, and she had the keys to the cabinets in which materials were kept." The Court of Appeals then continued (A. 57):

"It is unlikely that a copy of the report in question reached the 'library' before May 3. Miss Johnson testified that a report would normally not be processed and made available as a library copy for a week or two after delivery by the printer."

However, that supplemental finding by the Court of Appeals (in the nature of mere speculation) had reference only to cataloging and physically placing the publication in question in the library. It neither contradicted nor modified the trial court's finding that the publication was available for reference in the Publications Office or "library of sorts," on request.

***18** That availability of the publication for reference had been made clear by Miss Johnson's further testimony, which the trial court had apparently accepted, as follows (DX 22, pp. 216-217, R. 289):

"Q. And you previously indicated that when materials were delivered from the printer to your office, they were available for distribution on the date they were delivered to your office?

A. Yes.

Q. With the extra copies of this material that you had printed, and I specifically refer to Quarterly Report No. 2, would it have been available in your office for distribution upon request on the date it was delivered in your office?

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A. Yes.
Q. If I had come to your office on April 30th, the date indicated on that requisition document, and requested a copy of Report No. 2, would I have been likely to have been delivered a copy?
A. Very likely.
Q. Would you say then, Miss Johnson, that Quarterly Engineering Report No. 2 was available in your office on April 30th, 1959 to the same extent as any other publication or report was available in your office either as a library reference or as an extra copy?
A. To my knowledge, yes.
Q. So that, to this extent, you would not distinguish the availability of this Report No. 2 from any other similar report then in your office?
A. No."

The Court of Appeals also noted (A. 57) testimony by Lawler (A. 329) that--
"A. * * * Quarterly reports normally were restricted in their distribution. Distribution had to be made, first of all, in accordance with the distribution list which the contractor would supply." (Emphasis added.)
***19** Here that Court was led into error in suggesting that copies might not have been made available "to others" prior to such formal "distribution" under the contract. As Miss Johnson had testified, extra copies had been ordered at University expense "for our own purposes" (DX 22, p. 198) and were available for distribution "to others" as soon as received from the printer (DX 22, p. 198), i.e., April 30, 1959. This was clearly what the trial court found as a fact.

In this connection, Lawler testified further on crossexamination (A. 332)--
"Q. Who, Mr. Lawler, had more detailed information with regard to the availability of and dates of publication of the Quarterly Reports, Defendant's Exhibits 7 and 8, you or Miss Marjorie Johnson? (Emphasis added.)
A. She would probably have more detailed information on them, yes."

In concluding that the document in question was not a "publication" prior to May 3, 1959, the trial court explicitly relied on uncertainty of the proof that Miss Johnson was "truly a librarian," or that the "library" or "reading room" in question was "a genuine library," or that there had been more than a "remote" chance of anyone actually asking for and obtaining a copy of the document prior to May 3, 1959. As the trial court stated, but for those particular uncertainties, it would have been "compelled by the weight of authority to hold that such availability" of the document "constituted 'publication' within the meaning of § 102." Because of those uncertainties, it held that "the nature of the availability of the document in this case was not sufficiently 'public' in nature to constitute the kind of publication intended by the act, at least ***20** until the report was distributed on May 5, 1959." (A. 80-81). The Court of Appeals affirmed (A.57).

That both of those courts erred as a matter of law is explained and supported in the second section of the ensuing argument.

ARGUMENT.

Question I.

By the foregoing statement of facts relevant to Question I, we have sought to crystallize how the conflicting Seventh and Eighth Circuit decisions on validity of

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the Isbell patent diverge primarily on the issue of whether or not "unpredictability," in and of itself, can negate "obviousness" as the test of patentability under 35 U.S.C. 103. [FN5]

> FN5. To the extent that the courts of the Seventh Circuit attached significance to DuHamel's failure to achieve Isbell's particular structure and to his surprise that Isbell's antenna worked, that, in itself, was error as the Supreme Court has held. Toledo Pressed Steel Co. v. Standard Parts, supra.

The issue thus presented was decided by the Supreme Court prior to the present patent statute in Mandel Bros., Inc. v. Wallace, 335 U.S. 293, 295-296 (1948). In that case, involving a new use for an old chemical composition, it was argued that the prior art would not have led a skilled chemist to apply the old compound to the new use, so that the success of the patentee in doing so was "unpredictable by a skilled chemist" and, therefore, patentable. In ruling otherwise, the Supreme Court stated:

"But we think that the state of the art was plainly sufficient to demonstrate to any skilled chemist searching for an anti-corrosive agent that he should make the simple experiment that was made here. * * * It is not surprising therefore that after experimenting ***21** with various standard alkalies in an effort to find a corrosion inhibitor that would not greatly reduce acidic astringency, the patentees promptly turned to urea. Their success was immediate.

"As the United States Court of Appeals for the Second Circuit pointed out when this patent was before it: '* * * skillful experiments in a laboratory, in cases where the principles of the investigations are well known, and the achievement of the desired end requires routine work rather than imagination, do not involve invention.' "

The present patent statute has, since that decision, prescribed the "obviousness" test of patentability in such situations, and no decision by the Supreme Court appears to have been rendered on a similar set of facts since that time. However, other courts have rendered such decisions, arriving at the same conclusion that patentability is not imparted to the results of routine investigations merely because success is unpredictable where the direction such investigation should take was sufficiently pointed out by the prior art to make it obvious to try the particular thing sought to be patented.

In 1961, the Court of Customs and Patent Appeals considered the question with which we are concerned and rendered a decision that has since become a landmark case. Application of Moreton, 288 F.2d 940, 943-944 (CCPA, 1961). Without citing any prior authority, that court reached the result of the Supreme Court's decision in Mandel Bros. v. Wallace, supra. In commenting on the argument that unpredictability negates obviousness, the Court of Customs and Patent Appeals stated--

"What this amounts to is an argument that if one slavishly following the prior art, albeit with a little educated imagination, will sometimes succeed and sometimes fail, then he is always entitled to a patent ***22** in case of success. This is not the intention behind 35 U.S.C. Sec. 103. Obviousness does not require absolute predictability. Where, as here, the knowledge of the art clearly suggests a certain class of compounds, materials actually known by the term 'viscosity improving agents,' as useful to improve the viscosity index of a certain group of hydraulic fluid lubricants, the mere possibility of failure does not render their successful use 'unobvious.'

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"Appellant has not shown the production of anything unexpected here."

Since its decision in Application of Moreton, supra, the Court of Customs and Patent Appeals has repeatedly considered the same question and has consistently followed and cited that prior decision wherever the prior art taught a line of routine investigation to be followed and sufficiently suggested trying the particular thing sought to be patented to render it obvious to investigate its operability. See, for example, Application of Pantzer, 341 F.2d 121, 126 (CCPA, 1965); Application of Wilson, 368 F.2d 269, 271 (CCPA, 1966); Application of Chi K. Dien, 371 F.2d 886, 887 (CCPA, 1967). See, also, In re Wietzel et al., 39 F.2d 669, 672 (CCPA, 1930) rendered long prior to the Moreton decision and prior to the present patent act, reaching the same result on the same line of reasoning and quoting with approval from the Patent Office Board of Appeals as follows:

"And, where there is no real reason to suppose that the result would not be produced there is no invention in trying it and finding out that the process is successful."

In its brief before the Seventh Circuit Court of Appeals, Respondent, the University of Illinois Foundation, cited Application of Tomlinson, 363 F.2d 928, 931 (CCPA, 1966) in which the Court of Customs and Patent Appeals***23** refused to apply and drew a distinction from its earlier decision in the Moreton case. However, the distinction involved the extent to which the prior art suggested the line of investigation to be pursued and the particular kinds of things to be tested. Nothing in the Tomlinson decision indicates that the court questioned the soundness of the doctrine announced by it in the Moreton decision.

Similarly, the decision by the Court of Customs and Patent Appeals in Application of Miegel and Verbanc, 404 F.2d 378 (CCPA, 1968) turned on the sufficiency of the prior art to bring the applicants under the Moreton doctrine, the majority holding that Moreton applied and was controlling. A dissent by Judge Rich disagreed only because he felt that the results obtained by the applicant were unexpectedly superior to results obtained by the prior art (not true in the case of Isbell's results). From this and related considerations, he felt that the prior art teachings would not have led one to try the particular solution to a new problem for which the applicants were seeking a patent.

Other courts have applied the reasoning and results of the Court of Customs and Patent Appeals decisions in the Moreton and subsequent cases reviewed above. The District Court for the District of Columbia first did so in Hedman, et al. v. Commissioner of Patents, 253 F. Supp. 515, 520 (DC, DC, 1966), and shortly thereafter in Clinical Products, Limited v. Commissioner of Patents, 255 F. Supp. 151, 152 (DC, DC, 1966), drawing the important distinction between any requirement of absolute predictability and the "paramount rule of 'reasonably based predictions.' "

The District Court for the Northern District of Illinois, in which the present case originated, faced the same problem in LaMaur, Inc. v. DeMert & Dougherty, Inc., ***24** et al., 265 F. Supp. 961, 977 (DC, N.D. Ill., 1965), aff'd. 152 USPQ 163 (7th Cir., 1966). Citing both the Supreme Court decision in Mandel Bros., Inc. v. Wallace, supra, and the Court of Customs and Patent Appeals decision in Application of Moreton, supra, it reached the same result, holding that obviousness was not negated by the necessity for conducting a single and obvious experiment to establish that a

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known film-forming compound was compatible with other ingredients of a patented hair spray and, therefore, that it could be used to advantage in the patented composition.

As is evident from the summary of the prior art in the foregoing review of the Facts Relevant to Question I, the DuHamel and Ore article (DX 6) and their patent (DX 14) not only taught the direction of the routine investigations required to arrive at Isbell's structure, but produced a number of successful log-periodic antennas that carried the investigation almost to that structure, itself. Their success (not failure) clearly indicated that the investigation should be continued further in the same direction, as by applying the log-periodic formula to the proportioning of the broadband dipole antennas of the Katzin patent (DX 3) and of the K.O. antenna (DX 4). Rather than discouraging such further work in that direction, the reasonable probability of continued success in doing so was demonstrated.

As the trial and appellate courts of the Eighth Circuit held, one skilled in the art having the prior art, broadband, dipole antennas before him, along with the prior art DuHamel and Ore publication, should reasonably have expected the former to be rendered more frequency independent by proportioning the dipole lengths and spacings according to the log-periodic formula. At the very least, it should have been obvious to such a person to take that ***25** simple step and test the resulting antenna despite the fact that success was not predictable with any certainty. By the reasoning of Mandel Bros. v. Wallace and of the other later decisions on the same question under the present patent statute, the result of such an obvious further step should also be obvious under 35 U.S.C. 103.

With the additional prior art patent to DuHamel and Ore, teaching that the angle psi in Figure 2, for all of the similar antennas disclosed, could be reduced to 0°, the Seventh Circuit courts were shown that DuHamel and Ore had even more closely approached the precise structure claimed by Isbell. What little had been left to the imagination of one skilled in the antenna art was thus further reduced by the record before the latter courts. Under the authority of the cases reviewed above, it is respectfully submitted that they erred as a matter of law in differing from the conclusion of the Eighth Circuit Courts, whether solely or only partly because Isbell's success was unpredictable.

Question II.

As is clear from the foregoing summary of the Facts Relevant to Question II, Quarterly Engineering Report No. 2 (DX 8) described the invention of the Isbell patent so as to invalidate it under 35 U.S.C. 102(b) if it was published before May 3, 1959. Printed copies of the report were delivered to and available at the Publications Office of the Electrical Engineering Research Laboratory at the University of Illinois by April 30, 1959, and were available on that date, and thereafter in an adjacent "library" or "reading room," upon request of either Miss Johnson, Technical Editor of the Publications Office, who was in charge, or a member of her staff.

***26** As the District Court expressly held (A. 80), it "would have been compelled by the weight of authority to hold that such availability constituted 'publication' within the meaning of § 102" if--

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a. The Publications Office and adjacent library or reading room were "a genuine library," and
b. Miss Johnson had been "truly a librarian," and
c. There had been more than a "remote possibility" that a person knowing of the report might have asked for it and obtained a copy of it between April 30 and May 3, despite its clear availability for that purpose.

The question presented is whether or not, under those circumstances, the courts of the Seventh Circuit erred as a matter of law in holding that the report was not a "publication" within the meaning of § 102 before May 3, 1959.

It is respectfully submitted that the availability of Quarterly Engineering Report No. 2 more than one year before the application for the Isbell patent in suit on May 3, 1960, constituted "publication" under the law.

An early decision, Cottier, et al. v. Stimson, et al., 20 Fed. 906 (Cir. Ct., D. Ore., 1884), set forth the Court's views as to the general requirements for a "publication" under the patent law. In that decision (p. 910), the Court said:

"In Walk. Pat. 56, it is said that a 'printed publication is anything which is printed, and, without any injunction of secrecy, is distributed to any part of the public in any country. Indeed, it seems reasonable that no actual distribution need occur, but that exposure of printed matter for sale is enough to constitute a printed publication.'

***27** "But something besides printing is required. The statute goes upon the theory that the work has been made accessible to the public, and that the invention has thereby been given to the public, and is no longer patentable by any one. Publication means put into general circulation or on sale, where the work is accessible to the public. See Reeves v. Keystone Bridge Co. 5 Fisher, 467." (Emphasis added)

In brief, that decision held that a printed work is a "printed publication" under the law when it is accessible without an injunction of secrecy to any part of the public. This accessibility to the public can occur in a number of different ways that have been specifically considered by the courts.

One of the common ways in which a printed work is made accessible to the public is by placing a copy in a library. Another early decision, John Crossley & Sons v. Hogg, 83 Fed. 488 (Cir. Ct., D. Mass., 1897), held that publication had been established by proof that a single copy of a book was received in a library and that such publication was sufficient to bar the grant of a valid patent.

There has been no requirement that members of the public actually used the printed copy contained within a library, apparently on the logical theory that its availability begins when it is received by the library, and it is the act and intent of making it available that should be binding on an inventor and those in privity with him. Thus, the Patent Office Board of Appeals, in Gulliksen v. Halberg v. Edgerton v. Scott, 75 USPQ 252, 257 (1937), held the following in a case involving the deposit of a thesis in a college library:

"Since both affidavits referred to above clearly show that the thesis was received September 25, 1929, ***28** it is held that the dates when the same was bound or indexed is of no importance for the thesis became available to the public as soon as received in the library." (Emphasis added)

Consistently with such a theory, the Sixth Circuit Court of Appeals held in Hamilton Laboratories, Inc. v. Massengill, 111 F.2d 584, 585 (1940):

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"* * * the Weed thesis is in the prior art and marks a step in its development since it was put on file in the library of the college, available to students there and to other libraries having exchange arrangements with Iowa State. John Crossley and Sons v. Hogg, C.C., 83 Fed. 488, 490; Britton v. White Mfg. Co., C.C., 61 Fed. 93, 95. We think intent that the fruits of research be available to the public is determinative of publication under the statute * * *." (Emphasis added.)

Robinson, an early, eminent patent text author, [FN6] related intent to the act of publication as follows:

FN6. W. Robinson, "Patents," § 326, 327 (1890).

"A work of public character is such a book or other printed document as is intended and employed for the communication of ideas to persons in general, as distinguished from particular individuals. Private communications, although printed, do not come under this description, whether designed for the use of single persons or of a few restricted groups of persons." (§ 326)

* * *

"The publication must not only be intended for the public * * *. [I]t must have been actually published in such a manner that anyone who chooses may avail himself of the information it contains. [T]he deposit of a single copy in a library to which the public have or can obtain admission places the work within the reach of all." (§ 327)

***29** Recent decisions have followed and further clarified the foregoing statements of the law. For example, the sufficiency of the deposit in a library of a single copy of printed matter and the immateriality of the obscurity of the library were commented on by the Court of Customs and Patent Appeals (while deciding that material on microfilm is not "printed" within the meaning of the patent law) in the case of In re Tenney, Frank and Knox, 254 F.2d 619, 624- 627 (1958). In that case, the Court observed--

"The essence of all we have quoted is that, in consideration for the patent grant, something must be given to the public which it did not have before (albeit that the enjoyment of this 'something' may be postponed for 17 years). If the public is already possessed of that 'something,' or if it is accessible to the public, there is a failure of consideration and no patent may be granted." (Emphasis added.)

Explaining what "accessible to the public" means, the Court stated further (at 254 F.2d 626-627)--

"But though the law has in mind the probability of public knowledge of the contents of the publication, the law does not go further and require that the probability must have become an actuality. In other words, once it has been established that the item has been both printed and published, it is not necessary to further show that any given number of people actually saw it or that any specific number of copies have been circulated. The law sets up a conclusive presumption to the effect that the public has knowledge of the publication when a single printed copy is proved to have been so published. See Evans v. Eaton, 1818, 3 Wheat. 454, 514, 4 L.Ed. 433; Curtis, Law of Patents, pp. 500-03 (4th ed. 1873)." (Emphasis added.)

* * *

***30** "It is no doubt true that our present law is anomolous, as evidenced by our

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conclusion that a microfilm is not 'printed.' A foreign patent file, laid open for public inspection, is not a printed publication because typewritten, while a printed publication available to the public only in a Southern Rhodesian library would be."

Still more recently, the District Court for the Southern District of California held that the filing of a copy of a thesis in a college library on October 9, 1950, barred a patent applied for October 30, 1951 (21 days over the permissible one year). Indiana General Corp. v. Lockheed Aircraft Corp., 249 F. Supp. 809, 815, 816 (1966). In that decision, the Court cited the Hamilton Laboratories v. Massengill case, supra, as an authority "squarely in point."

About the same time, the District Court for the Southern District of New York (while denying a motion for summary judgment because of unresolved questions of fact in the particular case) reviewed the same and related questions of law in some detail in I. C. E. Corporation, et al. v. Armco Steel Corporation, 250 F. Supp. 738, 743 (1966). In doing so, it stated its conclusion that a " 'printed publication' as contemplated by Congress in 35 U.S.C. 102"--

"can include a document printed, reproduced or duplicated by modern day methods, including microfilming, upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation." (Emphasis added.)

***31** The foregoing decisions involving deposit in a library make several points clear on which there appears to be no conflict. Only a single copy need be deposited. It is the date of receipt by the library that determines the date of publication, not the date when the work was cataloged or put on a reference shelf, since the author has thus put the work out of his control with the intent that it be available to the public. It is immaterial how small or obscure the library may be, so long as it is available to members of the public who may happen to look for it; and the chances that anyone may have looked for it there on that date are immaterial.

As the first of the cited decisions also notes (along with others unnecessary to cite here) putting the work on sale is a publication of the work, without regard to the date of first actual sale.

From all of the cited authorities, a principle is clear: Publication occurs by the act of exposing the work anywhere that a member of the public, without an injunction of secrecy indicating a contrary intention, could either read or secure a copy if he wished to do so. Persons having a particular interest in the subject matter of the work being the class of persons with whom 35 U.S.C. 102(b) is concerned in this regard, such availability to any of that class of persons, without limitation to specific persons for purposes of secrecy, should suffice as constituting exposure to the public within the clear meaning of the decisions interpreting that law. Thus, it should be immaterial that only students, faculty, and staff of a university, for example, may have such unrestricted access, or only the members of a professional society, or the like.

Obviously, the controlling principle is not limited by the dictionary or official name given to the repository of one or more copies of the work, such as "library,"

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or "publications ***32** office," or "book store," or the name given to the person in charge or to members of his staff, such as "librarian."

Looking at principle, rather than mere words or form, it seems evident beyond logical argument, that Quarterly Engineering Report No. 2 (DX 8) in this case became a publication on April 30, 1959, within the meaning of 35 U.S.C. 102(b). Such being the case, it is respectfully submitted that the courts below erred in failing to hold the Isbell patent invalid on that ground.

CONCLUSION.

It is respectfully urged that both Question I and Question II, above, be considered and that the decisions below be reversed by a holding that the Isbell patent in suit is invalid for each of the two main reasons presented, i.e.,--

1. Because the invention of the patent was obvious under 35 U.S.C. 103, and
2. because the invention of the patent was described in a printed publication more than one year before the application for the patent, in violation of 35 U.S.C. 102(b).

U.S., 2004.
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For opinion see 91 S.Ct. 1434, 91 S.Ct. 917, 91 S.Ct. 563, 91 S.Ct. 449, 91 S.Ct. 363, 91 S.Ct. 101

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Supreme Court of the United States.
BLONDER-TONGUE LABORATORIES, INC., Petitioner,
v.
UNIVERSITY OF ILLINOIS FOUNDATION, et al., Respondents.
No. 338.
October Term, 1970.
December 2, 1970.

On Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit.

Petitioner's Brief.

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***1** OPINIONS BELOW.

The opinion of the Court of Appeals for the Seventh Circuit is reported at 422 F. 2d 769 (1970) and appears at A. 54. In this opinion, Isbell patent 3,210,767 was found valid. The decision of the District Court, Northern District of Illinois, Eastern Division, is not reported but is reproduced at A. 71.

The judgment of the Court of Appeals for the Seventh Circuit was entered on February 13, 1970, and the modified judgment, on a timely petition for rehearing, was entered on April 2, 1970.

***2** The Isbell patent was held invalid in an earlier opinion of the Court of Appeals for the Eighth Circuit, University of Illinois Foundation v. Winegard Co., 402 F. 2d 125 (1968). The opinion appears at A. 93. The decision of the District Court for the Southern District of Iowa, 271 F. Supp. 412 (1967), which was affirmed by the Eighth Circuit, appears at A. 101. Certiorari was denied, 394 U. S. 917 (1969).

JURISDICTION.

The jurisdiction of this Court is invoked under 28 U. S. C. Sec. 1254(1). The federal jurisdiction of the District Court was based on 28 U. S. C. 1338.

The Supreme Court has consistently exercised jurisdiction in cases such as this where a Court of Appeals has sustained an important and dominant patent (which in this case is controlled by the world's largest manufacturer of the patented item), following an earlier holding of invalidity of the same patent by another Court of Appeals. Supreme Court Rule 19(1)(b).

The petition for certiorari herein was seasonably filed following the April 2, 1970 modified judgment of the Court of Appeals for the Seventh Circuit, and was granted on October 19, 1970.

STATUTES AND REGULATIONS INVOLVED.

Monopolizing trade a misdemeanor; penalty.

Every person who shall monopolize, or attempt to monopolize, or combine or conspire with any other person or persons, to monopolize any part of the trade or commerce among the several States, or with foreign nations, shall be deemed guilty of a misdemeanor, and, on conviction thereof, shall be punished by fine not exceeding fifty thousand dollars, or by imprisonment not exceeding one year, ***3** or by both said punishments, in the discretion of the court. July 2, 1890, c. 647, § 2, 26 Stat. 209; July 7, 1955, c. 281, 69 Stat. 282. 15 U. S. C. 2.

Sale, etc. on agreement not to use goods of competitor.

It shall be unlawful for any person engaged in commerce, in the course of such commerce, to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies, or other commodities, whether patented or unpatented, for use,

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consumption, or resale within the United States or any Territory thereof or the District of Columbia or any insular possession or other place under the jurisdiction of the United States, or fix a price charged therefor, or discount from, or rebate upon, such price, on the condition, agreement or understanding that the lessee or purchaser thereof shall not use or deal in the goods, wares, merchandise, machinery, supplies, or other commodities of a competitor or competitors of the lessor or seller, where the effect of such lease, sale, or contract for sale or such condition, agreement, or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce. Oct. 15, 1914, c. 323, § 3, 38 Stat. 731. 15 U. S. C. 14.

Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless--

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, July 19, 1952, c. 950, § 1, 66 Stat. 797, 35 U. S. C. 102(b).

Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section ***4** 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1952, c. 950, § 1, 66 Stat. 798. 35 U. S. C. 103.

QUESTIONS PRESENTED.

QUESTION 1. Should the holding of Triplett v. Lowell, 297 U. S. 638, that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, be adhered to?

QUESTION 2. If not, does the determination of invalidity in the Winegard litigation bind the respondents in this case

QUESTION 3. Is the Isbell patent, purporting to dominate the present-day home television receiving antenna field, valid, as held by the Court of Appeals for the Seventh Circuit in this cause; or is that patent invalid, as held a short time earlier by the Court of Appeals for the Eighth Circuit in the Winegard case, following the latest pronouncements of the Supreme Court regarding patentability?

QUESTION 4. Has a patentee (University of Illinois Foundation) any standing in a court of equity where, in the words of the Court of Appeals in this cause, the patentee

"affirmatively presents a half-truth to the patent office in order to overcome a rejection,"

knowing

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"that the whole truth would support rather than overcome the rejection;"

or does such misconduct in the Patent Office, in line with previous pronouncements of this Supreme Court, but ***5** ignored by t?? Court of Appeals, bar relief of patent enforcement ?? unclean hands, and even constitute an antitrust viol??on, when such improperly obtained patent was used vig??usly by the patentee and its exclusive licensee (JFD ??lectronics Corporation) to restrain competition ?

QUESTION 5. Are the requirements upon the District Court for due ??rocess in patent litigation and, more particularly, for s??cific findings underlying the determination of "obviousne??" in patent causes, as laid down by the Supreme Cou??in Graham v. Deere, 383 U. S. 1 (1966), mandatory or??st optional and ignorable, as held by the Court of Appe??s in this cause, in conceding that the

"district ??urt did not describe the scope and content of the pri??art, identify the differences between the prior art??d claim ... nor state the level of ordinary skill in th??ertinent art"

--in short, ma?? none of the findings required by Graham v. Deer in co?? ection with petitioner's patent asserted against respon??nts in a counterclaim?

STATEMENT OF THE CASE.

A. Introduction.

The Univere?? of Illinois Foundation brought suit for infringement o??two of its patents in the home television receiving ante?? a field (3,210,767, issued October 5, 1965, in the name ?? D. E. Isbell; and Re. 25,740, reissued March 9, 1965, ?? the name of P. E. Mayes et al.) against a Chicago cus??mer of a small New Jersey electronics firm, Blonder-??mgue Laboratories, Inc., which had just entered the an?? a business. Blonder-Tongue voluntarily subjected itsel??o the jurisdiction of the Court to defend its customer, and counterclaimed against the University of Illinois Foundation and its exclusive licensee of these ***6** patents, JFD Electronics Corporation. In the counterclaim, Blonder-Tongue Laboratories asserted the invalidity and non-infringement of the Isbell and Mayes et al. patents and complained of unfair competition, antitrust violation and infringement of its own patent by JFD Electronics Corporation and the University of Illinois Foundation.

The petitioner was forced to defend against the Isbell and Mayes et al. patents, through no fault of its own, without the benefit of a single witness of its own on these issues, and in a trial that was earmarked by various deprivals of due process by the District Court.

The District Court found both the Isbell and Mayes et al. patents valid and infringed and dismissed all of petitioner's counterclaims.

On appeal, the Court of Appeals for the Seventh Circuit reversed with regard to the validity of the Mayes et al. patent; reversed by holding that the University of Illinois Foundation had indeed presented half-truths to the Patent Office; sustained the finding of validity of the Isbell patent; and sustained also the dismissal of petitioner's counterclaims.

B. As to Question 3 (Isbell Patent).

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In sustaining the Isbell patent, which purports to be the dominant patent in the home television receiving antenna field today, the Court of Appeals for the Seventh Circuit frankly states that it has made its decision in direct conflict with the earlier decision of the Court of Appeals for the Eighth Circuit (Winegard, supra), finding the Isbell patent invalid.

The main issue of disagreement between the two Courts of Appeals in applying the same prior art to this patent rests on the issue of the standard for "obviousness" of ***7** invention, reiterated by this Supreme Court recently in Graham v. John Deere Co., supra.

When it is reflected that petitioner was only able to produce documentary material from the Winegard suit in opposition to the University of Illinois Foundation's main patent case--as a result of being forced to trial after repeated postponements and at a time just after Christmas when it could not reassemble any of its witnesses--it will be observed that the Court of Appeals for the Seventh Circuit has reached what it calls a "different result" from that reached by the Court of Appeals for the Eighth Circuit, on the same prior art evidence. However, this "different result", a finding of non-obviousness, was reached in the face of the denial of petitioner's right to testimony regarding the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art.

Petitioner asserts invalidity of the Isbell patent on prior art and on the ground that the claimed subject matter was disclosed in a. printed publication more than a year prior to the filing date of the application for patent, 35 U. S. C. 102(h). This defense was not relied on by the District Court or the Court of Appeals in the Wingard case. Lack of infringement and unenforceability are also urged.

C. As to Question 4 (Fraud, Unfair Competition and Antitrust).

The Court of Appeals, in overruling the District Court, found deception in the procurement of the Mayes patent which was prosecuted together with the Isbell patent, with both the Isbell and Mayes so-called inventions involved in the fraudulent affidavit filed with the Patent Office.

The Court of Appeals declined even to comment, however, upon petitioner's demonstration that such conduct ***8** should have denied any relief to the plaintiff for unclean hands; and since these patents, promptly upon their issuance, were then used in widespread threats and coercion in the market place, antitrust violation appeared evident.

The Court of Appeals similarly gave only casual treatment to other acts of unfair competition, failing even to mention the deliberate interference with the conduct of the trial by the action of JFD in hiring away, during preparation for trial, petitioner's key witness in connection with the unfair competition and antitrust aspects, all of whose records mysteriously disappeared when he left. The lower courts also failed even to comment upon the propriety of JFD's hiring away the co-inventor of your petitioner's counterclaim patent just before the trial, under circumstances where that co-inventor was in possession of the information concerning the infringement by JFD of petitioner's patent.

D. As to Question 5 (Petitioner's Blonder-Schenfeld Patent).

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Neither the District Court nor the Court of Appeals made a single finding out of the list of specific findings that this Supreme Court set forth in Graham v. John Deere Co., supra, as necessary to apply the standard of "obviousness" under Section 103 of the Patent Statute.

This is altogether apart from the deprival of petitioner, through no fault of its own, of its right to expert testimony in connection with presenting its own patent counterclaim.

***9** SUMMARY OF ARGUMENT.

Question No. 1 (re Triplett v. Lowell).

Petitioner not only considers that Triplett v. Lowell should not be overruled, but considers the doctrine of this case to be one of the primary safeguards for justice for patentees in the present difficult and inadequate system of judicial review under the patent laws.

Question No. 2.

In view of our answer to Question 1, no answer is here required.

Question No. 3 (re Isbell Patent).

Despite the denial of due process to petitioner in forcing it to defend plaintiff's suit on the Isbell patent without the benefit of any of its intended witnesses, petitioner was able to introduce into the record the same prior art patents and publications considered in the Eighth Circuit in the Winegard case, supra, clearly showing invalidity for obviousness.

In addition, petitioner has produced a contemporaneous report showing that, as of the time that Isbell proposed his so-called invention, those in his own university laboratory found "predictable" the design of "multi-element log periodic antennas".

Further, petitioner introduced the DuHamel patent, 3,079,602, and a model of the same which, together with admissions on cross-examination of DuHamel, show complete anticipation of the Isbell claims.

Similarly, admissions on cross-examination of plaintiff's expert, Harris, show complete anticipation of the Isbell claims by a prior "KO" antenna.

***10** In addition, a Quarterly Report No. 2 completely describing the Isbell invention, was available as a published document in a library more than a year before the filing date of the Isbell patent, in contravention of 35 U. S. C. 102b.

And even were the Isbell patent valid, the deliberate two-plane structure of petitioner's antennas comes outside the scope of the substantial coplanar constructions of the Isbell claims, with petitioner's antennas being inoperable if adjusted to be "substantially coplanar" as taught and claimed by Isbell.

Lastly, the Isbell patent would in any event be unenforceable against petitioner because of plaintiff's inequitable conduct.

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Question No. 4 (re Fraud, Unfair Competition and Antitrust).

The Court of Appeals has overruled the District Court, finding deception before the Patent Office in the obtaining of the Mayes et al. patent.

Since both the Isbell and Mayes et al. patent applications were prosecuted together and both inventions were involved in the misleading affidavit before the Patent Office which the Court of Appeals found "affirmatively presents a halftruth", all relief should have been denied plaintiff for unclean hands; and since these patents, promptly upon issuance, were used for threats and coercion by the exclusive licensee, JFD, in cooperation with the plaintiff, antitrust violations appear an inescapable conclusion.

A series or pattern of acts ignored as a pattern by both the District Court and the Court of Appeals, have been proven, involving tie-in sales, hiring away of witnesses with special information for this litigation, fraud in the Patent Office and in subsequent misrepresentations of patent scope and coverage in advertising, patent mismarking, improper ***11** news releases, and deliberately false advertising making claims under the aura of the University of Illinois sponsorship to discredit the technical capability of competitive products.

Though the proofs are not copious, this has been shown to be in part because of the hiring away of petitioner's witnesses and employees during this litigation by JFD, and with them the sudden disappearance of such documentary evidence--all the more significant when no specific defense to petitioner's proofs was offered in the court room.

Question No. 5 (re Petitioner's Blonder-Schenfeld Patent).

Neither the District Court nor the Court of Appeals made a single one of the findings required by this Supreme Court in Graham v. John Deere Co., supra, in summarily dismissing this patent as "obvious".

Apart from this, the legal conclusion as to "obviousness", predicated on the necessary combination of fifteen pieces of prior art is patently in error--the requirement for such a massive number of references, in combination, proving, rather, lack of obviousness and hardly overcoming the statutory presumption of validity.

***12** ARGUMENT.

QUESTION 1.

(Re Triplett v. Lowell)

This Court sua sponte has requested argument as to this question presumably since, if the doctrine of Triplett v. Lowell, 297 U. S. 638, were to be overruled, then in view of the earlier finding of invalidity of the Isbell patent in the Winegard litigation, this issue might be foreclosed to the patentee in this cause.

Though petitioners stand to gain by any such result, we cannot urge the destruction of a long-accepted safeguard for patentees merely for the expediency of victory.

In the first place, as pointed out by the Supreme Court in Triplett v. Lowell, the right of a patentee to retest his patent against another defendant, in good faith

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and in the conviction of miscarriage of justice, did not originate with that decision. The recognition of that right at least dates back to the late 1800's with the Barbed Wire Patents case (143 U. S. 275), and it has been specifically reaffirmed by the Supreme Court in case after case, as indicated in Triplett v. Lowell, and subsequently thereto.

More than this, consistently in this century, Congress has rejected suggestions to overrule this principle, the latest of which rejections occurred within the past few years following a recommendation of a Presidential Commission. We do not belabor this history further because it is our understanding that others will present these details.

Suffice it to state that we decline to be a party to the concept that the Supreme Court has any justifiable authority ***13** to legislate by overturning its consistent prior decisions that have been deliberately allowed to stand with approval by the Congress over many decades.

Secondly, we are unprepared to urge the modification of established doctrines, such as res judicata, merely for the convenience of placing another tool in the hands of patent busters.

Thirdly, our rather extensive experience in trying cases in the present generation of district courts throughout the land brings us to the sincere conviction that nothing but injustice can be wrought by abolishing the safeguards of Triplett v. Lowell.

A very excellent example of this is evident in the present case where, as will be seen from a discussion of Question 5, the District Court violated every requirement laid down by this Supreme Court for specific findings to be made in connection with the test of obviousness in patent causes, and summarily threw out petitioner's counterclaim patent with a mere fiat that it was obvious in the light of some unexplained combination of the teachings of fifteen different pieces of unexplained prior art.

This shameful treatment was met with equally callous review in the Court of Appeals; and except for the unique circumstances that this case involved a conflict of decisions on another patent, the Supreme Court would never have reviewed this action in connection with your petitioner's patent, judging from the record of certiorari denials over the past generation.

Without the safeguard of Triplett v. Lowell, and absent certiorari in this cause, petitioner would have been improperly deprived of its patent without any redress.

A second example resides in the experiences of petitioner's counsel in connection with the Pierce cases, where one of the greatest inventions in the field of radio was held ***14** valid in one District Court (Pierce v. American Communications Company, Inc., 1953 D. C. Mass., 111 F. Supp. 181) and then was held to be unenforceable, though valid, on a brand new principle of law evolved by the Court of Appeals for the First Circuit, American Communications Company v. Pierce, 1953, 1 Cir., 208 F. 2d 763, cert. denied, 347 U. S. 944, reh. denied, 347 U. S. 970, 348 U. S. 851.

Triplett v. Lowell, however, was still the law, and so Professor Pierce became

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enabled to try again, this time in the Third Circuit. But the Court of Appeals for the Third Circuit also ruled against him, Pierce v. Allen B. DuMont Laboratories, Inc., 1961, 3 Cir., 297 F. 2d 323. This ruling however, did not adopt the position of the Court of Appeals for the First Circuit that the patent was valid, but unenforceable, but it evolved a brand new principle of patent law that the patent was valid only up to a certain date and then became invalid.

The inventor thus became deprived of the fruits of his invention in both the First and Third Circuits, but for two entirely different reasons, both unique in the law of patents and both laid down for the first time in two opinions that have never been reviewed by this Supreme Court.

But Triplett v. Lowell was still in force, so that Professor Pierce could try a third time, this time in the Fifth Circuit.

And the Court of Appeals for the Fifth Circuit, in full knowledge of and in complete disagreement with the adverse rulings of the Courts of Appeals for the First and Third Circuits, refused to follow either of these rulings and held the patent valid and enforceable, Pierce v. Aeronautical Communications Equipment, Inc., 1962, 5 Cir., 307 F. 2d 790, cert. denied 371 U. S. 954.

This event illustrates that not only is the doctrine of Triplett v. Lowell necessary to protect patentees from lack of due process, as in petitioner's case, but it provides that ***15** opportunity to get different interpretations of difficult and unsettled points of patent law on which trained lawyers may disagree, and which justice requires, particularly in view of the impossibility of this Supreme Court reviewing any appreciable number of patent cases.

There is still a further type of experience that the active patent trial practitioner endures in today's courts, however, that points out a further necessity for the safeguards of Triplett v. Lowell. This resides in the perhaps unpleasant, but none-the-less true, fact that many lay judges do not have the ability to comprehend some of the more technical intricacies of sophisticated technology patents. A classic example in the experience of your petitioner's counsel is Nyyssonen v. Bendix Corporation, 137 U. S. P. Q. 853, 860; C. A., 1 Cir., 342 F. 2d 531; cert. denied, 328 U. S. 847, reh. denied, 382 U. S. 934.

In that case, the District Court frankly conceded that it just could not understand the technology and just adopted the findings of one side, in desperation. The Court of Appeals stated it could not understand the technology sufficiently to determine whether the District Court's finding of invalidity was or was not erroneous.

Without Triplett v. Lowell, the creative benefactors of our society, both individual and corporate, would thus be deprived of that measure of fair play and justice that the Constitution guarantees in speaking of securing to inventors the rights to their discoveries.

This is altogether apart from the frankly expressed passions of certain courts to destroy patents, as so ably stated by the late Justice Jackson in Jungersen v. Ostby and Barton Company, 335 U. S. 560, 572, pointing out that

"the only patent that is valid is one which this Court has not been able to get its hands on."

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***16** Lest this Supreme Court labor under a popular misconception that all patentees are the big corporations and that the patent system really only serves the purposes of concentrated industrial power, we invite attention to the chart annexed to this brief (Addendum I) which shows that the individual inventor and the small company inventor today, even in the face of massive government and industrial research and development, produce a large 40% of all current patentable inventions.

It is more particularly in the interest of justice for this sector of the patent community, which produces an inordinately large percentage of the more important current break-through inventions, [FN*] that we urge the Supreme Court to adhere to the safeguards of Triplett v. Lowell, so essential in the imperfect but struggling system of justice that we attempt to administer in today's America.

> FN* John Jewkes et al., The Sources of Invention, MacMillan, 1959; R. H. Rines, Create or Perish, The Case for Inventions and Patents, Academy of Applied Science (permission M. I. T. Press), Acropolis Press, 1964, 1969, p. 45, 102-108; Victor McElheney, Giant Firms Bested by Lone Inventors, Boston Globe, p. 60, Feb. 21, 1967.

QUESTION 2.

In view of our answer to Question 1, no answer is required here.

QUESTION 3.
(Re Isbell Patent)

In this case, in sustaining the Isbell patent, which purports to be the dominant patent in the home television receiving antenna field today, the Court of Appeals for the Seventh Circuit frankly states that it has made its decision in direct conflict with the earlier decision of the Court of Appeals for the Eighth Circuit (Winegard, supra), finding the Isbell patent invalid.

***17** The main issue of disagreement between the two Courts of Appeals in applying the same prior art to this patent rests on the issue of the standard for "obviousness" of invention, reiterated by this Supreme Court recently in Graham v. John Deere Co., supra.

When it is reflected that petitioner was only able to produce documentary material from the Winegard suit in opposition to the University of Illinois Foundation's main patent case--as a result of being forced to trial after repeated postponements and at a time just after Christmas when it could not reassemble any of its witnesses--it will be observed that the Court of Appeals for the Seventh Circuit has reached what it calls a "different result" from that reached by the Court of Appeals for the Eighth Circuit, on the same prior art evidence. However, this "different result", a finding of non-obviousness, was reached in the face of the denial of petitioner's right to testimony regarding the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art.

Before delving into this question of "obviousness", your petitioner must explain how it happens that so little different documentary evidence appeared in this case from what had previously been considered in the Winegard case-- this reflecting on the question of due process underlying the defense against the Isbell patent and in

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the proofs in support of your petitioner's counterclaims, more particularly raised in Question 5.

A. Petitioner Was Deprived of Due Process at the Trial.

It is an unpleasant task for counsel to have to complain of a deliberate deprival of due process by an able trial judge, not to speak of continued hostility and lack of judicial demeanor.

***18** The record shows, however, that Blonder-Tongue was forced to go to trial the second day after Christmas after seven postponements by the Court of successive trial dates, including a postponement of a trial date set for as late as December 18th, for which petitioner was prepared in terms of the availability of its Boston trial counsel, its Cambridge, Massachusetts technical professorial patent expert, who had been working on this case for over a year in preparation for trial, principal witnesses from Blonder-Tougue in New Jersey, as well as witnesses from all over the country who had been prepared to testify more particularly in connection with the unfair competition and antitrust aspects of the counterclaim in this cause (A. 125-132).

Showings were made under oath (A. 135-139) that the postponement of the December 18, 1967 trial date by the Court, and the inability of the Court then to state when or if there would be a trial, even as late as December 20, made it impossible for Blonder-Tongue's business executives in New Jersey, its patent expert in Cambridge, Massachusetts, and numerous other witnesses around the country, to postpone their Christmas and New Year's plans any longer, not just in connection with personal and family matters, but in connection with repeatedly postponed business and professional activities in this country and abroad. The record shows that the Boston counsel succeeded in holding the patent expert, Professor Lan Jen Chu of the Massachusetts Institute of Technology, for the December 18th trial date; but that when no firm substitute trial date could be set, Dr. Chu had to leave for Taiwan for a few weeks' mission that simply could not be postponed longer. The record further shows that other witnesses similarly had to go to different parts of the country and Canada on long-postponed professional and business activities when no firm date could be given immediately following the postponement of the December 18th trial date.

***19** The record further shows that when the Court set the second day after Christmas for the trial date, Boston counsel tried desperately to get the return of Professor Chu for the patent trial, and the presence of the other witnesses; but was unable to do so (A. 138-9).

Counsel's respectful explanation to the Court with a request for just a thirty-day delay to try to get the witnesses together again from abroad and all over the country was rudely dismissed with abuse heaped upon both Boston and local counsel for even intimating that the Court would be "depriving anybody of due process" if Blonder-Tongue were forced to go to trial without its patent expert, let alone any of its other witnesses (A. 144-147).

The record further shows that throughout the presentation of the Foundation's patent infringement case, Blonder-Tongue was deprived of expert testimony and, in fact, testimony of any of its own witnesses at all, as a result of being forced to

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trial under these circumstances.

When it is reflected that the whole decision with regard to patent validity herein turns on the matter of the significance of the prior art and the obviousness of any differences therefrom in the patented structures, the grievous and prejudicial damage to Blonder-Tongue by depriving it, through no fault of its own, of its patent expert and other testimony, both to defend against the patent suit of the Foundation and to conduct its own patent counterclaim--in short, its day in court--is patently evident.

The Court of Appeals dismissed this position on what was apparently a very superficial study of the record, stating that

"Mr. Blonder did testify. Professor Chu (who had gone to Taiwan in late December) did not, but counsel has not shown the substance of testimony expected from him and not otherwise available."

***20** In the first place, Mr. Blonder was not present and did not testify during the complete case-in-chief of the University of Illinois Foundation; and petitioner did not have any witness of any type available to show the scope and content of the prior art, the level of skill or knowledge of the ordinary worker in the art, the lack of existence of any problem to be solved, and the other elements showing obviousness of invention and anticipation.

The record decidedly shows that the substance of testimony expected from Professor Chu was explained; namely, the above-mentioned matters, elementary to defending a patent suit. In the first motion to reschedule the trial, an affidavit of counsel was filed (A. 135) explaining that as to the issues raised in the answer of "invalidity and non-infringement", that

"Evidence on behalf of defendant with regard to the technical aspects of the litigation will be presented by Dr. Lan Jen Chu, one of the foremost antenna authorities in the world."

It was explained that Mr. Blonder was to testify regarding Blonder-Tongue's antennas and that he and "Other witnesses from scattered points throughout the country will testify regarding the unfair competition and antitrust."

In a supplemental affidavit in support of the motion (A. 137-9), it was further explained that Professor Chu was the "technical expert" of the defendant, that he had "pre-eminent knowledge in the antenna art involved in this litigation" and had engaged in "copious preparation for this trial" and that

"counsel for Defendant ... (is) ... at a serious disadvantage in being forced to trial without having technical counsel during the presentation of Plaintiff's case in order to object to relevance, materiality and other matters, including testimony inconsistent with the depositions, and more particularly as to cross-examination."

***21** More than this, it was explained that in connection with trying to prove the defendant's case without Mr. Blonder, counsel

"presently cannot prove Defendant's case, particularly since counterclaim defendant, JFD, in the midst of this litigation, deliberately hired away co-inventor Schoenfeld from Defendant, such that the latter is now in the opposition camp."

At the oral argument on the motion (A. 145), petitioner's counsel pointed out the

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"two principal witnesses that are required first for the defense of the suit against our client and, second, for our counterclaim, our Professor Chu, who is the technical expert and who has been working with us for a year in the preparation of this case, and, secondly, Mr. Blonder himself, who is a co-inventor of the Blonder patent involved in the counterclaim and the principal witness in the antitrust and unfair competition counterclaim."

Again, in the opening statement, the Court was once more informed (A. 149) of the technical evidence to be offered as defense to the plaintiff's patents, pointing out that petitioner would "endeavor to show your Honor that the subject matter of the claims of the two university patents was fully anticipated by the prior art."

The Court criticized counsel for saying "endeavor", instead of "will" and was again informed that "We pleaded that when we knew we were going to have witnesses, your Honor. I am just hoping I can get my witnesses."

This was met with the kind of hostility that continued throughout this trial:
"The Court: Well, I am not concerned with that. I don't start these cases. I just listen to them."

***22** Other evidences of outbursts and hostility throughout the trial are contained at A. 167-8, 173, 215-16, 221, R. 725-6. [FN*]

FN* "R" designates references to the Appendix to Brief for Defendant, in the Court of Appeals for the Seventh Circuit.

In addition to the above, however, the District Court made numerous arbitrary exclusions of evidence and other rulings that were clearly erroneous, without foundation in law, and highly prejudicial to Blonder-Tongue both in matters of defense with regard to the complaint, and offense in the matter of the counterclaim.

In connection with the Foundation's patent counts, moreover, not having any witnesses of its own, Blonder-Tongue called to the stand Dr. Mayes, the purported inventor of the Foundation's own Mayes et al. patent in suit, who was in court; but the District Court even refused to permit perfectly proper questions as to the technical content of Dr. Mayes' own reports, bearing on prior art and on the antenna project of Isbell that Dr. Mayes supervised and that led to the Isbell patent in suit (A. 214-218); refused to permit even questioning as to the technical content of Dr. Mayes' own patent here in suit (A. 222-224); refused to permit the establishment of the adverse nature of the witness, in that he receives income from the licensing by the Foundation of the patents in suit (later elicited, A. 317-19), or any other interest on the part of Dr. Mayes in the subject matter of the suit from which it would be inferred that Mayes was in fact an adverse witness (A. 225-6); and refused Blonder-Tongue even the right to show Dr. Mayes' relationship to JFD (A. 226) that would entitle counsel to lead the witness (A. 228-30).

As another glaring example hearing upon the unfair competition and antitrust counts (and, of course, the general doctrine of unclean hands, as well), one of the pleaded allegations was that JFD, under color of the name of the University of Illinois and its patent license from the Foundation, ***23** had engaged in a nation-wide advertising campaign involving false technical claims and deprecations of the apparatus of competitors, including Blonder-Tongue, and false patent representations and

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markings.

Though thus pleaded, and though JFD's counsel admitted in open court that numerous advertisements were JFD's publications, and though offer was made of the testimony of the single witness available, Mr. Isaac S. Blonder, chairman of Blonder-Tongue, to show by first-hand knowledge the falseness of the representations and claims in these advertisements, the District Court arbitrarily refused to permit the introduction in evidence of these admitted publications of JFD (A. 335-341, R. 539-40).

Blonder-Tongne was deprived of a fair trial.

Ordinarily, the remedy in a cause such as this would be the reversal of the District Court and a remand for a new trial.

Despite the fact that petitioner has been deprived of its flay in court, however, the District Court has made sufficient fact findings on certain issues, the Court of Appeals has made sufficient findings, and there are sufficient admissions of the Foundation and JFD in the record (much elicited by cross-examination), to support reversing the conclusions of law of the District Court and the Court of Appeals and finding for petitioner, as a matter of law, on each and every count of the complaint and counterclaim.

B. The Matter of "Obviousness".

The District Court did make some findings that agreed with the District Court of the Southern District of Iowa in the Winegard case, which had found the Isbell patent invalid as failing to meet the test of unobviousness of 35 U. S. C. 103, Supra, p. 3. Specifically, Judge Hoffman found that, prior to Isbell,

***24** "Shortly after 1954, the log-periodic principle of antenna design was developed" (A. 74);

and that all that Isbell contributed was thinning down the prior art thicker dipoles antenna elements to the "straight or simple dipoles used by Isbell" (A. 77) (which straight configuration, however, Judge Hoffman conceded had long preceded Isbell in the "television reception" field, A. 74).

The question is, therefore, whether the Patent Office may grant as many patents as there are different wellknown shapes of dipole antenna elements arranged in accordance with the same old log-periodic dimensioning.

The District Court and the Court of Appeals were impressed with the fact that, at least at one time, it could not be "predicted" whether all structures so arranged would "operate successfully as a log-periodic antenna" (A. 75); and that Mr. DuHamel (who derives direct royalty income from the Isbell patent licensing program of the Foundation, A. 273) stated he was "surprised" that Isbell's antenna worked (A. 78).

Because of this supposed "unpredictability", the District Court and Court of Appeals concluded that the Isbell invention must be "unobvious".

But the DuHamel testimony with regard to log-periodic antennas that, in the early days, did not work, had nothing to do with the simple linear dipole antennas of Isbell, a. form long known in the art and long used in even the same kind of array, as shown, for example, in the Katzin patent reproduced in Judge Stephenson's

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decision in the Winegard suit (A. 120). DuHamel's testimony dealt rather with esoteric shapes of antennas, spirals, cones, horns, ground planes (PX 30, A. 412, R. 308; PX 31, A. 413, 243; PX 32, A. 414, 246; PX 34, A. 415, 247; PX 36, A. 416, 248; PX 37, A. 417, 250; PX 38, A. 418, 251; and PX 51, A. 427, 262).

***25** The only real issue in this case was the obviousness of trying or of using Isbell's type of straight wire antenna structure; and as to this, Dr. Mayes had to concede that most of them operated "satisfactorily" (A. 317).

Thus the whole basis of supposed unpredictability really had nothing to do with the Isbell type of linear antenna elements.

But even at that, "predictability" and "obviousness" are not the same thing in the law, as pointed out by the 8th Circuit Court of Appeals in affirming invalidity of the Isbell patent in the Winegard case, supra

"The statutory standard of patentability under Sec. 103 is not 'predictability'. This terminology helps to obscure the true issue of 'nonobviousness.' The valid test relates the subject patent to whether its developments would be obvious to one skilled in the art" (citing Graham v. John Deere Co., 383 U. S. 1, 17).... "In other words, the necessity of logical experimentation does not in and of itself negate obviousness." (citations) (A. 96.)

And altogether apart from whether "predictability" and "obviousness" are or are not the same thing, the record in the present suit contains the additional unequivocal admission that, as of the time of the Isbell proposal to thin down the old log-periodic dipoles (as distinguished from the earlier period of "unpredictability" referred to by the District Court, A. 75), all log-periodic antennas were actually then fully and entirely predictable.

If we look, indeed, into the contemporary documentation, the Antenna Laboratory's Quarterly Report No. 1, D. Ex. 7 (A. 496, 213), we find that, prior to Isbell's so-called invention and before he started to investigate his antenna, Dr. Mayes and the scientists at the Laboratory considered that

"The experimental results which have been obtained ***26** for the multielement log periodic antennas are found to be predictable ..." (p. 2, emphasis added).

And the only distinction from known log periodic designs that Isbell was going to undertake was

"An investigation of log-periodic structures of thin linear elements (zero tooth width) is planned" (p. 2, emphasis added).

Thus, the record in this case shows entire predictability and obviousness at the time Isbell made his proposal, demonstrating the invalidity of the Isbell patent.

C. The "Invention" Was Published More Than a Year Before the Isbell Patent Application Filing Date, in Contravention of 35 USC 102b.

The District Court has correctly found (A. 79, 80) that there was a printed report (Quarterly Engineering Report No. 2, D. Ex. S, A. 500, 213) that:

1. "... 'would have anticipated Isbell's invention if it had been published at a sufficiently early date' ..."
2. "... the report was printed and physically available prior to May 3, 1959, ..."

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which was more than one year before the "... application for the Isbell patent ... was filed on May 3, 1960."

3. There was a " 'library' of sorts" in the University of Illinois Electrical Engineering Research Department where "publications, such as the quarterly reports" were kept "for distributing". Such reports were "generally obtained by request from a member of the publications staff."

4. The person "responsible for distributing" these publications was Miss Marjorie Johnson who "testified that the quarterly report involved here was in the publications office [" 'library' of sorts"] on April 30, 1959, and was therefore 'available for distribution upon request on that date' ".

***27** 5. "the document ... had come into the possession of the publications office on April 30, 1959" and there "existed the rather remote possibility that a person knowing of the report might have asked for it and obtained a copy of it on that date." (Emphasis added.)

The District Court, while admitting that

"If Miss Johnson were truly a librarian and the document had been available in a genuine library, even a very small or a highly specialized library, this court would be compelled by the weight of authority to hold that such availability constituted 'publication' within the meaning of Sec. 102. See e.g. Hamilton Laboratories, Inc. v. Massengill, 111 F. 2d 584 (6th Cir. 1940),

proceeds to say that this availability in the engineering laboratory " 'library' of sorts" was still, as a matter of law

"not sufficiently 'public' in nature to constitute the kind of publication intended by the act."

This, however, is clearly an incorrect interpretation of the well-established law.

Apparently the Court of Appeals appreciated that this was a wrong conclusion of law because it undertook not to apply the law to the facts as found by the District Court, but to speculate on its own that "it is unlikely that a copy of the report in question reached the 'library' before May 3" (A. 57).

Note that the Court of Appeals conceded the matter of the existence of a "library"; and it could hardly have done otherwise, particularly since the University itself called it the "Local Library E. E. R. L." (D. Ex. 22, DX H-4, A. 392, R. 289).

Instead of accepting the District Court's findings of fact that the report had reached Miss Johnson on April 30, 1959 and "was physically available prior to May 3, ***28** 1959", the Court of Appeals thus engaged in its own speculation that the report might not have reached the "library", and on this ground refused to apply the law. While there is not a great deal of law in the Supreme Court on this matter, there appears to be unanimity in the lower courts as to the consequence of these facts.

The Sixth Circuit Court of Appeals, for example, held in The Hamilton Laboratories, Inc. v. Massengill, 111 F. 2d 584, 585 (6 Cir., 1940):

"... the Weed thesis is in the prior art and marks a step in its development since it was put on file in the library of the college, available to students there and to other libraries having exchange arrangements with Iowa State. John Crossley & Sons v. Hogg, C. C., 83 F. 488, 490; Britton v. White Mfg. Co., C. C., 61 F. 93, 95. We think intent that the fruits of research be available to the public is determinative

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of publication under the statute...." (Emphasis added.)

The sufficiency of the deposit in a library of a single copy of printed matter and the immateriality of the obscurity of the library were commented on by the Court of Customs and Patent Appeals in the case of In re Tenney, Frank and Knox, 254 F. 2d 619, 627 (1958). In that case, the Court observed that there was publication even with

"a printed publication, available to the public only in a Southern Rhodesian library,"

See, also, Interchemical Corporation v. Sinclair & Carroll Co., Inc., "A printed publication ... is anything that is printed and made accessible to any part of the public." 50 F. Supp. 881 at 890 (D. C., N. Y.), reversed 144 F. 2d 842 (2 Cir., 1944); reversed 325 U. S. 327 (1945). Also, Gulliksen v. Halberg v. Edgerton v. Scott, 75 USPQ 252 (P. O. Bd. App., 1937), and Ex parte Hershberger, 96 USPQ 54 (P. O. Bd. App., 1952).

***29** Still more recently, the District Court for the Southern District of California held that the filing of a copy of a thesis in a college library on October 9, 1950, barred a patent applied for October 30, 1951 (21 days over the permissible one year). Indiana General Corp. v. Lockheed Aircraft Corp., 249 F. Supp. 809, 815, 816 (1966), reversed on other grounds 408 F. 2d 294.

Thus the Isbell invention was published more than a year before the Isbell patent application was filed (May 3, 1960), and there is a statutory bar to the Isbell patent, 35 U. S. C. 102b.

On this one ground alone, as a matter of law, the Isbell patent should be declared invalid.

D. The Isbell Patent Is Completely Anticipated by Prior Art.

The Isbell invention, moreover, is clearly anticipated by the disclosure of DuHamel patent 3,079,602, D. Ex. 14, (A. 510, R. 283) not before the courts in the Winegard case. DuHamel appeared as a witness for the plaintiff in this cause during the presentation of its case-in-chief--a period when, it will be recalled, petitioner had absolutely no witnesses of its own available to it.

In cross examination, however, petitioner was able to elicit from DuHamel that an antenna model, D. Ex. 24 (R. 472), was a correct representation of Fig. 5 of his patent (A. 287, 511).

During the argument before the Supreme Court, it will be visually shown that this DuHamel antenna configuration, D. Ex. 24 (R. 472), anticipates completely the Isbell structure with the one exception that the dipoles are triangular loops instead of straight wires. All of the rest of the log periodic length and spacing dimensions and electrical feed ***30** and performance specified in the Isbell claims are fully met by this structure.

Mr. Harris, another witness for plaintiff, on cross-examination (A. 171), conceded that these triangular loop dipoles and the thinner wire or cylindrical dipoles of Isbell were both old and well-known dipole antennas prior to Isbell's invention; and that their performance, operation, and current distributions were similar (D. Ex. 2,

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item 6, A. 476, R. 236; and D. Ex. 1, item 1, A. 475, R. 235; A. 181–83, 191–92).

Certainly, DuHamel's antenna of his Fig. 5 thus constituted an anticipation of Isbell's structure, particularly since the Isbell claims broadly refer to "dipoles", and do not exclude DuHamel's well-known dipoles.

Even more, however, DuHamel taught making his dipoles of any variable "width" (col. 3, line 15, A. 520), thus teaching every single element of Isbell's alleged invention. Dr. DuHamel, indeed, conceded that at least the outer regions of his dipole elements of Fig. 5 were of substantially zero width (A. 286).

Obviously a valid patent cannot be granted for each old and well-known type of dipole that is substituted in the same old antenna array configuration.

E. The Isbell Patent, Even Were It Valid, Is Not Infringed by the Blonder-Tongue Structures.

Both the District Court and the Court of Appeals agreed that the Blonder-Tongue antennas are not constructed with the antenna elements in the same plane, but have the elements, rather, in two vertically spaced planes.

While finding that the Isbell and Mayes et al. patents teach only a "substantially planar, parallel arrangement" (A. 75) and that, contrary to those coplanar teachings, the ***31** Blonder-Tongue antennas have a deliberate "separation in the planar arrangement", the District Court gratuitously extended the monopoly of the Isbell patent and construed this as "substantially coplanar" and within the claims of the patents (A. 84).

The Court of Appeals, however, could only sustain this position on a ground that it imagined for itself; namely, that it was not physically possible for petitioner to build the structure with antennas actually substantially in one plane, so that the Blonder-Tongue antennas, though in two planes, infringe upon the Isbell "coplanar" claims. In the precise words (A. 68) of the Court of Appeals

"Apparently it is difficult or impossible to construct the Isbell antenna (or similar arrays with two transmission lines) so that all dipole elements lie exactly within one plane. The Isbell patent states that the dipoles are 'substantially coplanar'."

In its original decision, the Court of Appeals was under the impression that all the Blonder-Tongue antennas were spaced only an inch apart and, therefore, put that fact in the decision (A. 68), thus reaching the conclusion that Blonder-Tongue's antenna was, therefore, "substantially coplanar".

When it was called to the attention of the Court of Appeals that the Blonder-Tongue Ranger antennas, for example, had the planes four inches apart, clearly having nothing whatever to do with the problem of any difficulty or impossibility in close construction, instead of correcting itself, the Court of Appeals merely took the reference to the inch dimension out of its decision.

At the hearing of this case before the Supreme Court, petitioner's counsel will visually show these antennas, so that it will be immediately evident that there is no relationship between the actual spacing between the planes thereof ***32** and any problem in not being able physically to construct the antenna with a closer

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positioning of the various antenna elements.

This will show the spuriousness of the holding that these antennas can possibly be construed to fall within the "substantially coplanar" limitations of the Isbell claims.

Clearly, if Isbell had been entitled to a claim covering any substantial separation of planes of antennas, none of its skilled attorneys, the patent applicant or the Patent Office would have permitted or required a limitation in the claims to "substantially coplanar".

Indeed, the Patent Office itself allowed the Blonder-Schenfeld patent of your petitioner over the precise teachings of the Isbell patent (D. Ex. 26, A. 525, R. 477, col. 4, line 54), and with this deliberate spacing of planes as one of the vitally different constructional and operational features.

More than this, Dr. Mayes, on cross-examination, admitted during the trial of your petitioner's patent (A. 316), that if the Blonder-Tongue antenna booms were made substantially coplanar, the antenna would no longer operate properly.

"Q. Dr. Mayes, if the two booms of the Blonder-Tongue Dart antenna, Plaintiff's Exhibit 10, are moved together so that they are substantially in the same plane, very close, very small separation as compared with the three-quarters of an inch, will there not be a serious mismatch between this antenna and the 300 ohm transmission line feeding it over the UHF band?

* * *

"The Witness: Yes.

"By Mr. Rines:

"Q. Will this not result in a serious deterioration of the gain or figure of merit of the antenna?

"A. Yes."

***33** A basic principle of patent law is that for infringement there must be identity of means, operation and result.

The District Court was unwarranted, as a matter of law, in reading out of the Isbell patent claims the specific, requirement for a coplanar construction, without which limitation these patent claims would not have been granted--a construction deliberately not employed in the Blonder-Tongue antennas and, indeed, entirely unemployable for satisfactory operation of the same; a fact which the Patent Office itself recognized in holding the Blonder-Tongue antenna an unobvious departure from the work of Isbell in granting the Blonder and Schenfeld patent, D. Ex. 26 (A. 525, R. 477).

It is elementary that a device that cannot work in accordance with a patent claim cannot possibly be an infringement thereof.

Finally, it will be shown that the structure of the DuHamel antenna, D. Ex. 24 (R. 472) is of much less separation between the planes of antennas than the Blonder-Tongue Dart antenna, and is of much smaller separation than the four inches involved in the Blonder-Tongue Ranger antennas. Plaintiff's own witness, Mr. Harris, conceded that the DuHamel structure was not coplanar (A. 186-7). This was also positively

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stated by DuHamel himself (A. 292).

If the DuHamel structure is not "coplanar" then, of course, clearly neither of the Blonder-Tongue antenna structures is coplanar and the Isbell patent is clearly not infringed.

Even though deprived of expert testimony to which it was entitled, petitioner believes that it has proven, as a matter of law, that the Isbell patent is not infringed by the Blonder-Tongue antennas, even were the patent valid, which it is not.

***34** F. Even Were It Valid, the Isbell Patent Is Unenforceable Against Petitioner.

The unclean hands of the plaintiff, not only in connection with deceit in the Patent Office, but unfair competition and anti-trust violations in the market place together with the counterclaim defendant JFD, should, under well-established authority set forth later in connection with Question 4, bar enforcement of the Isbell patent against petitioner, even assuming such patent were valid and infringed, which it is not.

G. Conclusion as to the Isbell Patent.

Though deprived of its day in court, and its right to present witnesses, and through them evidence of prior art and the various elements of obviousness of invention and non-infringement, including the deprival of the right to examine on direct examination, let alone cross-examination, the plaintiff's patentee, Mayes, concerning the Isbell and Mayes patents in suit, petitioner did succeed in getting into the record the following:

1. The same prior art patents and publications considered by the District Court and the Court of Appeals for the Eighth Circuit in connection with the Winegard litigation, from which the conclusion was reached that the Isbell patent was invalid for obviousness--a conclusion that is also here urged on the same reasoning;
2. A contemporaneous report from the University of Illinois laboratory of Isbell and Mayes at the time that Isbell was first proposing to modify prior art log periodic antennas by reducing the width of the antenna elements to nearly zero so that they were straight tube or wire dipoles, which admits that, as of that late date, as distinguished from earlier times, the "multi-element log-periodic antennas are found to be predictable" ***35** (Quarterly Report No. 1, D. Ex. 7, A. 496, 213, page 2, emphasis added);
3. The prior art DuHamel patent 3,079,602 (D. Ex. 14, A. 510, R. 283) together with cross-examination of DuHamel not before the Eighth Circuit, in which it is admitted that the antenna model D. Ex. 24 (R. 472) is a correct representative of Fig. 5 of that patent (A. 511), shows the identical type of antenna array taught by Isbell, but with the DuHamel triangular loop dipoles instead of standard straight dipoles--this being coupled with cross-examination of plaintiff's expert, Mr. Harris, also not before the Eighth Circuit, admitting that these triangular dipoles and the thinner straight dipoles of Isbell were both old and well known prior to Isbell's so-called invention (A. 171) and that their performance, operation and current distribution were similar (D. Ex. 2, Item 6, A. 476, R. 236; and D. Ex. 1, Item 1, A. 475, R. 235; A. 181-83, 191-2);
4. The Isbell patent claims refer broadly to "dipoles"; they do not exclude DuHamel's "dipoles"; and thus they read directly on the evidence of item 3;
5. The "KO" antenna of Channel Master (D. Ex. 4, A. 481, R. 237), which was

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admitted to be in public use more than a year before the filing of the Isbell patent application (A. 181) and which is an identical structure except that the dipoles are of the so-called rectangular loop or folded type instead of the straight single rods of Isbell--and which folded dipoles plaintiff's witness, Mr. Harris, conceded had similar performance, operation and current distribution to those of Isbell (D. Ex. 2, Item 7, A. 476, R. 236; A. 191-92)-- it being further significant that there is not a single word in the Isbell patent specification or in a single claim thereof that excludes folded dipoles;

***36** 6. Antenna Laboratory Quarterly Report No. 2, D. Ex. 8, A. 500, 213 that admittedly completely described the so-called Isbell invention, and that the District Court conceded was available at a local library of the University of Illinois on April 30, 1959, more than a year before the filing date of the Isbell patent, in contravention of 35 U. S. C. 102b;

7. Evidence that even were the Isbell patent valid, the Blonder-Tongue antennas are constructed deliberately not to be "substantially coplanar" and, indeed, will not operate satisfactorily if so adjusted, by the admission of plaintiff's own patentee, Mayes (A. 316); and

8. That for reasons more particularly set forth in the subsequent discussion of Question 5, the Isbell patent would in any event be unenforceable because of inequitable conduct.

It appears, moreover, that the plaintiff's case in connection with the Isbell patent should properly have been dismissed on petitioner's motion to dismiss following the presentation of the plaintiff's case-in-chief.

In support of that motion, it was pointed out (A. 196-207) that neither the Court nor defendant had been apprised in the so-called prima facie proofs of a single claim of the Isbell patent that was alleged to have been infringed; that the District Court was not supplied with any technical explanation of the meaning of much of the scientific terminology used in the patent and in the claims; and that, apart from a generalization or conclusion of plaintiff's expert, Harris, that structural elements of the patents (not the actual elements of the claims) existed in the petitioner's antennas, there was no testimony or explanation of any underlying facts necessary to establish the meeting of the terms of the claims by the petitioner's antennas.

***37** It had heretofore been the law in the Seventh Circuit, as elsewhere in the United States (Briggs v. M. & J. Diesel Locomotive Filter Corp., 228 F. Supp. 26, 48-9 (D. C. N. D. Ill. 1964), aff'd 342 F. 2d 573 (1965), cert. denied 383 U. S. 801) that, in technical cases, the courts cannot engage in guess work or attempt to decipher technical language for themselves; and certainly cannot guess as to what claims might or might not be asserted as infringed or how they might read on the allegedly infringing structures.

Plaintiff's prima facie case contained no establishment that the language of a single claim found response in the accused devices.

It was not until the plaintiff's brief after trial that plaintiff even identified what claims were allegedly infringed and purported for the first time to show, in the language of the Briggs case, supra, that the "words of the claims find a response in the accused device".

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But failure to prove a prima facie case cannot be cured by a brief after trial, and such brief cannot be used to establish underlying facts or evidence. Nor can a brief be used to rectify the failure of plaintiff to produce a record that explains the meaning of technical words of the claims, particularly in technical fields where, as previously conceded by the Court of Appeals for the Seventh Circuit itself in Technograph Printed Circuits v. Methode Electronics Inc., 356 F. 2d 442, 448 (1966):

"... the patents in suit ... are of such technical nature as to escape our understanding. They may 'speak for themselves' but we feel the need of expert translation and interpretation, screened for us by appearance and demonstration before a trial court."

The motion to dismiss should thus have been granted.

***38** QUESTION 4.

(Re Fraud, Unfair Competition and Antitrust.)

The University of Illinois Foundation simultaneously prosecuted the patent applications for the Isbell patent and the Mayes et al. patent here in suit. In fact, Mayes was in the same university laboratory as Isbell, and the same attorneys handled the prosecution of the two patent applications.

The patent examiner had rejected the Mayes et al. application as not constituting invention over the earlier antenna of Isbell, described in a printed publication.

In order to overcome this rejection, the attorneys prepared, and Mayes executed, an affidavit under Rule 131 of the Patent Office, [FN*] swearing that Mayes et al. had made the invention before the publication of this article describing the Isbell antenna.

> FN* "Rule 131. Affidavit of prior invention to overcome cited patent or publication. (a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year prior to the dale on which the application was filed in this country." (Emphasis added.)

While the District Court refused to find anything wrong in this prosecution, the Court of Appeals for the Seventh Circuit, in view of the deliberate misrepresentation before the Patent Office, was forced to overrule the District Court in this particular.

"Neither Mayes nor counsel pointed out the fact, known to Mayes, that the Isbell article, with very ***39** slight revision, had first been published ... more than one year prior to the filing date", (emphasis added)

and thus that this earlier publication could not be sworn back of under Rule 131.

The Court of Appeals characterized this as a case where

"an applicant affirmatively presents a half-truth to the patent office in order to overcome a rejection when he must know that the whole truth would support rather

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than overcome the rejection."

From this, the Court of Appeals clearly stated the law that
"The applicant's knowledge of a fact as to which he knows the patent office is ignorant or mistaken and which would be material under the theory he knows the patent office is applying would impose an obligation of candor."

The Court of Appeals went further and stated that, with regard to the prior publication suppressed by Mayes et al. in this affidavit,
"It is clear that the publication date ... would, on the theory followed by the examiner, have prevented issuance of the patent."

Not only did Mayes et al. and his counsel suppress that earlier publication, but they also suppressed still another earlier publication of which they had knowledge, which also would have supported the examiner's rejection. In the words of the Court of Appeals
"Presumably the same would be true of the publication of Quarterly Report No. 2, May 5, 1959".

Though finding this misconduct before the Patent Office, the Court of Appeals, for some reason that it failed even to mention, ignored the clear requirements of this Supreme Court that patentees who have misrepresented will not be entitled to enforcement. (See, for example, Hazel-Atlas ***40** Glass Company v. Hartford-Empire Co., 322 U. S. 238, 246-7 (1944); and Precision Instrument Manufacturing Co. v. Automotive Maintenance Machinery Co., 324 U. S. 805, 818, 819 (1945).)

The Hartford-Empire case, moreover, makes plain that equitable principles require denial of relief where the Patent Office has been subjected not only to "fraud", which the Court of Appeals said it was "reluctant" to find, [FN*] but for "deception" (page 246), which the Court of Appeals did find was practiced

> FN* The reluctance to use the word "fraud" was apparently based upon the feeling of the Court of Appeals that the Isbell article referenced an earlier publication; but that footnote reference did not state the actual date of publication of the report from which the Examiner could have determined a statutory bar. That was known only by Mayes and his counsel, who did not communicate this to the Patent Office.

Since both the Isbell and Mayes et al. patent applications were prosecuted together, and both inventions were involved in this affidavit before the Patent Office, which the Court of Appeals found "affirmatively presents a halftruth", the Court of Appeals should have denied any relief to the plaintiff for unclean hands under established equitable doctrines and the clear mandate of the Supreme Court.

More than this, since these patents, promptly upon their issuance, were then used in tremendous advertising campaigns, A. 84-5, and in threats and coercion by the exclusive licensee, JFD Electronics Corporation, the matter of antitrust violation appears an inescapable legal conclusion, Walker Process Equipment, Inc. v. Food Machinery & Chemical Corporation, 382 U. S. 172 (1965).

Turning to these further violations performed under color of the improperly obtained patents, it should be explained that the District Court made a number of

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findings from which that Court drew what we consider to be ***41** incorrect legal conclusions; and the Court declined to examine the effect of the totality or scheme or pattern of these acts, as distinguished from the individual separate acts themselves, in drawing legal conclusions as to unfair competition and antitrust violation.

While conceding (A. 68, 69) that the District Court could have found oppositely, the Court of Appeals gave this whole issue a mere passing comment without examining a single situation or the total effect of the pattern of conduct.

It is thus in order to review these matters because, frankly, it is doubted that there has often been a case wherein so many unfair acts and restraints on competition were practiced in complete disregard, not just of ethics and common decency, but of the legal metes and bounds of proper conduct in the administrative agency (the Patent Office), the market place, and in the very processes of the courts themselves.

A. A Summary of the Unfair Competition and Antitrust Aspects.

Though, as above explained, by being forced to trial without any of its intended customer and other witnesses, Blonder-Tongue was deprived of its right to complete proofs of these counterclaims, [FN*] the District Court did make certain findings of fact in connection with that evidence which Blonder-Tongue was able to muster, as through depositions. Based on these findings it is clear that the District Court drew entirely the wrong conclusions of law. It appears, indeed, that those findings entitle Blonder-Tongue to a reversal and to judgment, as a matter of law, as to both the counterclaim for unfair competition and the counterclaim for antitrust violation.

FN* As before stated. competent, relevant evidence was arbitrarily excluded, p. 20-23, supra; R. 666, 7.

***42** First, a brief review of the series of acts that the counterclaim alleges constituted a pattern of unfair competition and antitrust violations (A. 13-18, 41-43):

1. A nationwide advertising program in technical, consumer, trade and news publications knowingly falsely representing the scope of patent coverage of the JFD antennas marketed under license from the Foundation, and deliberately or negligently grossly exaggerating the performance thereof. The ads used the names of both the Foundation and the University of Illinois to give color, credence and prestige to the misleading statements as to the patent monopoly of the Foundation and JFD in log periodic television antennas, with the innuendo of threat against any customers who use log periodic antennas of other manufacturers, including Blonder-Tongue.

2. Coupled with this advertising program, there was a campaign of litigation and threatened litigation against numerous manufacturers of log periodic antennas, including Blonder-Tongue. This was accompanied by wide circulation to the trade and to antenna customers, including those of Blonder-Tongue, of news releases of such suits and threats of suits and of newspaper clippings and reprints relating to the same. Suit was brought against Blonder-Tongue in the Northern District of Illinois with the knowledge that there was no jurisdiction, clearly for the purpose of immediately releasing and mailing to Blonder-Tongue's customers and the trade news releases both of JFD and the Foundation which prominently mention the suit against Blonder-Tongue.

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3. A campaign of patent mismarking of the JFD antennas licensed by the Foundation, knowing the antennas not to be covered by the patents so marked, and even widely representing falsely that the Foundation patents actually covered the log periodic formula itself, with the intent of deceiving the public into thinking that the antennas offered for sale were already protected by patents of the Foundation and that no other manufacturer could lawfully even use the log ***43** periodic formula, thereby to dissuade customers from purchasing log periodic antennas from anyone else, including Blonder-Tongue.

4. Procuring the Mayes et a1. patent 3,108,280 (forming the basis of the reissue patent 25,740) by filing in the Patent Office a misleading affidavit, either willfully or through gross negligence, defrauding the Patent Office.

5. Raiding key personnel associated with the Blonder-Tongue antenna business and program at times clearly calculated to handicap Blonder-Tongue in collecting and presenting evidence in this trial as well as to prevent Blonder-Tongue from effectively competing as an antenna marketing company.

6. A campaign under the threat of the Foundation patents to force customers to buy unpatented items from JFD and not from Blonder-Tougue and other competitors.

Now to some of the actual findings of the District Court as to these pleaded allegations:

First, the District Court concedes that at least "some of the language employed in JFD advertisements" requires interpretation to give it veracity, including the false statement that the Foundation had patented the "log periodic cellular formula" itself. From this statement, the Court held that a reader could be led, though he "was not necessarily led to believe that JFD had patented the whole concept of log-periodicity" (emphasis added). (The Court concluded, however, that this was "not so offensive as to be characterized as 'unfair' "; A. 84.)

Second, the District Court found that suit had knowingly been brought with improper "venue" against Blonder-Tongue, with the intended purpose of issuing throughout "the trade ... news releases describing the litigation". (The Court found this to be "the right" of the Foundation.)

Third, the District Court found there was actually patent "***44** mismarking" in addition to the representations above-quoted as to the supposed patenting of the formula itself. (As to this, the Court concluded that "Its effect, if any, was minimal.", A. 85.)

Fourth, the District Court did not dispute that Mayes et al., in filing the affidavit in the Patent Office that induced the Examiner to allow their patent, did not tell the whole truth, as before discussed. The Court found, only, that Mayes et al. "were under no obligation to disclose their knowledge of references". (As to this, the Court concluded there was no misrepresentation, A. 82, and that such action did not constitute "unfair competition", A. 86.) The Court of Appeals reversed this holding and found deception (A. 67).

Fifth, the District Court found, A. 87, that:

"The record shows that several persons formerly in Blonder-Tongue's employ were subsequently hired by JFD and that, after the departure of one of these, some records dealing with customers were found to be missing."

The Court seemed to have trouble dismissing this as lightly as the other issues,

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stating, A. 87, that the Court

"might be tempted to conclude, with Blonder-Tongue, that that company had been (in popular parlance) 'raided' by JFD."

(As to this, however, the Court concluded that since the number of employees so hired away was only a "small fraction" of the turn-over of personnel, that this was not raiding, as a matter of law, A. 87.)

Sixth, the District Court found that Blonder-Tongue had actually produced some evidence "which tends to support this argument" that JFD would "force its customers to purchase its unpatented products as a 'tie-in' with its patented products". (The Court concluded, however, that ***45** since this was "a normal business practice" it was legal, A. 87, 88.)

B. The Legal Significance of Such a Series or Pattern of Activities that the District Court Found Had Existed.

Altogether apart from whether the District Court was or was not correct that, of themselves, each of these six types of activities was permissible and not unfair, or in restraint of competition, the aw--ignored by the District Court-- is quite clear that the pattern of such a series of acts can be unfair competition (and also antitrust violation), even if the acts individually by themselves were nonactionable.

The language used in American Tobacco Co. v. United States, 328 U. S. 781, 809, is appropriate:

"It is not the form of the combination or the particular means used but the result to be achieved that the statute condemns.... Acts done to give effect to the conspiracy may be in themselves wholly innocent acts. Yet, if they are part of the sum of the acts which are relied upon to effectuate the conspiracy which the statute forbids, they come within its prohibition."

Unfair competition and antitrust often result from the same actions. One commentator expresses it as follows:

"When, of course, unfair competition has an anticompetitive effect as in restraint of trade or monopoly, the antitrust laws as well as the law against unfair competition are concurrently applicable." Callmann Unfair Competition Trademarks and Monopolies,. Third Edition, Sec. 15.1c (Volume 1, p. 287).

C. The Illegality of the Individual Acts Themselves.

But even as to the unfair competition (and antitrust) aspects of the separate or individual acts found by the District Court to have been performed by JFD and the Foundation, the Court erred in the conclusions as to the legal effect of these acts, taken individually.

***46** 1. Tie-In Sales.

Turning to the sixth point (i.e., "tie-in" sales), it is not the law, as stated by the District Court, that because this may or may not be "a normal business practice", it is legal. To the contrary, the law is well-established that where salesmen have a patented line, and, as the Court has here found, try to force the sale of their other nonpatented products with this as a wedge, this is not only a misuse of patents, barring relief for patent infringement, but decidedly unfair

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competition and in restraint of competition in violation of Section 3 of the Clayton Act (15 USC 14).

This was recently reiterated, for example, in Preformed Line Products Company v. Fanner Manufacturing Co., 225 F. Supp. 762 (D. C. N. D. Ohio 1960), Aff'd 328 F. 2d 265 (6 Cir. 1964), cert. den. 379 U. S. 846,

"restraining competition in unpatented or licensed armor rods by tying the purchase of such devices to the purchase of the patented dead ends."

The quoted testimony in the Preformed Line Products Company case, indeed, closely parallels that elicited on deposition prior to trial from JFD Vice President Finkel in this case. A transcript of the deposition is in evidence as D. Ex. 42, R. 515. On page 73, Mr. Finkel conceded that petitioner and JFD have competitive lines of converters and amplifiers that are used with antennas in receiving systems:

"Q. Was it the fact, to your knowledge, that Blonder-Tongue Laboratories had a competitive line of converters and amplifiers?

"A. Yes, of course."

Mr. Finkel also conceded that JFD's converters and amplifiers are not covered by patents, pp. 75-6: [FN*]

FN* Page references are to the deposition transcript.

"On the existing line, no."

***47** Mr. Finkel further admitted, pp. 73-4, that JFD's salesmen and distributors stress that the JFD antennas

"are covered by patents of the University of Illinois Foundation",

and that JFD is

"the exclusive licensee under those patents."

As part of what Mr. Finkel characterized as the "normal selling" by JFD salesmen and distributors, he conceded that they also might make statements to a potential customer that if such customer

"handled anyone else's line of log periodic antennas, they would be sued."

And further as to this "normal selling" of stressing the antenna patents and the possibility of suit, he frankly conceded that JFD salesmen try to tie in the non-patented converters and amplifiers of JFD, as well (pp. 74-5):

"Q. And would you acknowledge that in connection with this normal selling they at the same time tried to persuade the customer to handle your antennas and your line of converters and boosters?

"A. Our salesmen are always trying to sell all of our accessory merchandise along with our antennas ...

* * *

"Q. Do you know in connection with these customers that handle your entire line, whether the distributors tried to persuade the customers to handle only the JFD line of products and not those of the competitor?

"A. You are talking of distributors persuading dealers when you say customers?

"Q. Yes.

"A. This, again, is par for the course, because all distributors are trying to get the dealer convinced that the product they are selling is better than anybody

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else's.
"Q. So it is conventional for them to say, to try to ***48** get the dealers to handle only JFD antennas, converters, boosters?
"A. They try, but too few succeed."

Under mention of the antenna patents and threat of suit if the dealer handles anyone else's log periodic antenna, thus, JFD admittedly tries to get customers to purchase its unpatented converters and amplifiers to the exclusion of competition.

This practice was also verified by the deposition of Mr. Helhoski, who testified that he received reports that customers received the implication from JFD that JFD would not sell its patented antennas to those who did not purchase JFD's converters and amplifiers or to those who purchased BT equipment (R. 686- 88).

Mr. Gilbert similarly testified (on deposition) to oral customer reports of JFD salesmen refusing to sell JFD antennas to BT customers when they bought BT products (R. 675-76).

Mr. Cohn similarly testified, with names of specific customers, as to JFD's tie-in sales policy (A. 364, 365).

Because of the truth of these activities, JFD has chosen to remain absolutely silent and has offered not one word of explanation.

The tie-in sales admitted by JFD's executive vice-president, Mr. Finkel, constitute an antitrust violation. See also, Carbice Corp. of America v. American Patents Corp. and Dry Ice Corp. of America, 283 U. S. 27, 75 L. Ed. 819 (1931); Leitch Manufacturing Co., Inc. v. Barber Co., Inc., 302 U. S. 458, 82 L. Ed. 371 (1938); Morton Salt Co. v. G. S. Suppiger Co., 314 U. S. 488, 86 L. Ed. 363 (1942).

It is not necessary to show an antitrust violation to establish misuse of patents by tie-in sales practices.

***49** As stated in Waco-Porter Corp. v. Tubular Structures Corp. of America, 222 F. Supp. 332 (D. C. S. D. Cal. C. D. 1963)
"It is clear that even a mere restriction on competition with the patented device itself is sufficient to constitute a patent misuse."
See, also, Baldwin-Lima-Hamilton Corp. v. Tatnall Measuring Systems Company, 169 F. Supp. 1 (D. C. E. D. Pa., 1958), aff'd 268 F. 2d 395:
"its marketing policy ... constituted a misuse of the Simmons patent. That misuse bars the enforcement of the patent ... regardless of whether the 'tying' practices resulted in a violation of the antitrust laws."

To all this must be added the fact that JFD has described itself as "one of the world's largest producers of TV antennas" (D. Ex. 42-B-101 A. 549, R. 515); and as "the world's largest manufacturer of TV and FM antennas" (D. Ex. 42--J6 A. 573, R. 515), a statement which Mr. Finkel testified was "accurate" and "true" (D. Ex. 42, p. 22 R. 515). The activities complained of were, therefore, of the leading manufacturer and supplier in the field and were directed against Blonder-Tongue, a brand newcomer to the commercial antenna market.

As before pointed out, not only was Blonder-Tongue deprived by the District Court

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of a postponement to reassemble its customer witnesses, but it was JFD's own deliberate actions that inhibited other modes of proof and interfered with the very processes of the court:

1. The District Court found that "some records dealing with customers were found to be missing" (A. 87) when one employee (Balash), who had been "assigned ... to personally investigate" the threats of JFD to customers, to reply to this suit (R. 511-2; 694-5), was "subsequently hired by JFD" (A. 87).

***50** 2. Just before the trial, JFD hired away Blonder-Tongue's West Coast sales representative, Graham Sisson--the West Coast being one of the places where there had been specific distributor customer coercion and where petitioner counted on testimony (see literature sent by JFD to Sacramento Electronics, D. Ex. 43, A. 576, R. 528).

Even without its full day in court, Blonder-Tongue succeeded at least in convincing the District Court that there was some evidence "which tends to support this argument" (A. 87).

We question the conclusion of law, therefore, that because this is what the District Court called "a normal business practice", it is proper to use a line of allegedly patented antennas as a club to force the purchase of unpatented related converter and booster equipment.

Admittedly the proofs aren't the strongest or most complete (thanks, in part, to the actions of JFD); but, as the District Court itself had to conclude, there was some evidence and nothing specific to rebut the same on the other side.

2. The Raiding.

The District Court's conclusion, that the JFD hiring away of antenna employees was not illegal since it represented a small fraction of the personnel turn-over, appears to represent a brand new principle of law, unsupported by any authorities.

The details of the nature of the personnel and the timing of their hiring by JFD were omitted from the Court's finding that "several persons formerly in Blonder-Tongue's employ were subsequently hired by JFD and that, after the departure of one of these, some records dealing with customers were found to be missing" (A. 87).

***51** These details are uncontradicted in the record.

They show that several of these employees were key men in the Blonder-Tongue antenna business, and included the "organizer" of that business and even the co-inventor of the Blonder-Tongue patent in suit in this cause!

First, one Jerome Balash was the "organizer of Blonder-Tongue's complete antenna business ... from the marketing standpoint" (R. 689) and later product manager in charge of antennas at Blonder-Tongue (R. 510); and, following the filing of this suit, was "assigned ... to personally investigate" why the customers were not purchasing antennas, including the threats of JFD (R. 511-2; 694-5).

Though then on notice that Blonder-Tongue was trying to join JFD in this litigation, in the midst of Mr. Balash's investigation of customers and JFD threats to the same, Mr. Balash was hired by JFD.

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The day after Mr. Balash left, a search was made for Blonder-Tongue's files of Mr. Balash's correspondence with the customers, but they couldn't be found (R. 512-514, 676-7, 689). These files included the reports relating to the activities of JFD in the market place that Mr. Balash had been assigned to investigate for the purposes of this counterclaim; and the Blonder-Tongue-IBM reports ending April 30, 1966, giving breakdown of customers, addresses and products sold, disappeared at the time of Mr. Balash's departure for JFD as well (R. 680-2, 688-9).

Mr. Balash's being hired away by JFD during his investigation for Blonder-Tongue of the activities of JFD in the market place that were hampering Blonder-Tongue's antenna program and the attempt to get evidence and testimony from witnesses, not only injured the sales activity of the Blonder-Tongue antenna program, but frustrated the obtaining of evidence for this suit.

***52** But JFD was not content with hiring just Mr. Balash.

In the heat of this litigation, with the case set for trial, JFD hired away three other important Blonder-Tongue engineering employees: two engineers, Mr. Eduardo Elesandro, the "project engineer in charge of ... master television antenna equipment division" at Blonder-Tongue and another (R. 518-9); and Mr. Abraham Schenfeld, coinventor of the Blonder-Schenfeld patent in suit in this counterclaim.

The record shows how hampered Blonder-Tongue was in its proofs (and what interference this caused with the processes of the Court) as a result of the hiring away of co-inventor Schenfeld on the eve of the trial. Mr. Blonder testified (R. 504-5) that Mr. Schenfeld made the performance tests on the JFD antennas charged with infringement; and Mr. Blonder had no knowledge that qualified him to testify as to those particular tests! And Mr. Schenfeld was now in the "enemy" camp.

But even this was not enough in the campaign to prevent Blonder-Tongue's emergence in the antenna field and to hinder the proofs in this litigation. As before stated, JFD even lured away the West Coast sales representative of Blonder-Tongue, Mr. Graham Sisson (R. 519), just before the trial.

What other purpose could the hiring away of these key Blonder-Tongue employees have had, and at the critical times above discussed, except to compete unfairly with Blonder-Tongue and to hinder its proofs in this cause and interfere with the processes of the Court?

JFD has not offered one word of specific explanation of any of this.

If this is not illegal "raiding", it is hard to conceive what is.

***53** The hiring away of key employees for such motives has certainly been held in the lower courts to be an actionable wrong. See, for example, Sugar Creek Creamery Company v. Momence Milk Cooperative Assn., 75 USPQ 193 (D. C. N. D. Ill., 1947).

These wrongful acts of JFD have greatly impeded Blonder-Tongue's ability to compete in the antenna market and have seriously hindered its preparation for the trial. In addition to the damage done Blonder-Tongue, these acts have had the effect of frustrating justice by preventing the presentation to the Court of much of the evidence of JFD's wrongdoing.

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3. The Fraud in the Patent Office and in Advertising.

It has been demonstrated before that the Mayes et al. patent, the basis of Re. 25,740 in suit, was secured by a fraud on the Patent Office in the filing of a misleading affidavit. The subsequent action of the Foundation, asserting the patent in an attempt to foreclose others from manufacturing log periodic home television receiving antennas, is a violation of Section 2 of the Sherman Act, 15 U. S. C. 2, Walker Process Equipment, Inc. v. Food Machinery & Chemical Corporation, 382 U. S. 172,. 15 L. Ed. 2d 247, 86 S. Ct. 347 (1965).

It should also be observed that promptly upon the issuance to the Foundation of the improperly procured Mayes et al. patent, many ads appeared (D. Ex. 42, B-4, B??4A, A. 546, 7, R. 515) falsely claiming the log periodic formula to be patented, and all with the name of the Foundation and/or University prominently bannered in such ads, rendering the conclusion inescapable that this was part and parcel of a crude, unethical and improper conspiracy to defraud both the Patent Office and the public. This is more fully treated hereinafter.

***54** The timing of these ads coincided with the Blonder-Tongue introduction of its antennas; and, as the record shows, resulted within "a few months" in customers refusal "to take on our line" (R. 520-1). [FN*]

FN* The proofs as to the extent and amount of damages were deferred until after the decision on the trial.

4. Patent Mismarking.

In addition to falsely claiming the log periodic formula to be patented as just mentioned (D. Ex. 42-B-4, 4A, A. 546, 7, R. 515) to dissuade the trade from purchasing log periodic antennas from Blonder-Tongue or from any manufacturer other than JFD, the exclusive licensee of the Foundation, JFD listed patent numbers in its ads and on its antennas that simply did not relate to or cover those antennas--the so-called "mismarking" referred to by the District Court.

The record shows, without contradiction, that none of the antennas advertised by JFD in advertisements such as D. Ex. 42-B-108, A. 565, R. 515 was covered by any of the three patents exclusively enumerated right under the Mayes and Carrel LPV antennas advertised therein (Dyson 2,958,081, D. Ex. 66, R. 1023; DuHamel 2,985,879, D. Ex. 67, R. 1023; and Isbell 3,011,168, D. Ex. 65, R. 1023). [FN†]

FN† Mr. Finkel, vice-president of JFD, admitted in his deposition, D. Ex. 42, pp. 43-45, R. 515, that none of the "three patents mentioned" in these ads were the patents of the "Mayes and Carrel" antenna. Patent numbers were placed on antenna boxes, also, D. Ex. 42, p. 28.

More than this, in its answering brief before the District Court (p. 5), the Foundation conceded that JFD's advertising head and executive vice-president, Mr. Finkel

"may have known as of April, 1964 (D. Ex. 42) that its commercial products were not covered by issued patents."

***55** Indeed, Mr. Finkel's own letter of April 21, 1964 (D. Ex. 42-B-105, p. 2, A. 561, R. 515) so stated:

"At the present time we are not selling any products that come under the Dyson,

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DuHamel and Isbell patents."

And yet, the uncontradicted evidence unequivocally shows that JFD advertisements in this same April of 1964 and thereafter (for example, D. Ex. 42-B113 and B106, A. 571 and 563, R. 515) used these very same three patent numbers in connection with the same advertised Mayes and Carrell LPV-11 and similar antennas which the Foundation itself has admitted, supra, "were not covered by issued patents." Even in 1966, these patents were still included in JFD advertising (D. Ex. 37, A. 542, R. 659).

Thus the "mismarking" was not innocent.

Contrary to the District Court's view of the law that such "mismarking" can be dismissed as merely of "minimal" effect (A. 85), false or overstated patent marking has long been recognized as an act of unfair competition. This was one aspect of the decision in Kobe, Inc. v. Dempsey Pump Co., 198 F. 2d 416, 10 th Cir., 1952, where Kobe gave wide publicity to the number of patents which it owned and "they were used to the limit in its attempt to stop Dempsey," page 424.

In the Seventh Circuit, Judge Evans criticized misrepresentations concerning non-existent patent protection, and refused to enforce trademark rights because of unfair business practices. Perfection Mfg. Co. v. B. Coleman Silver's Co., 270 F. 576 (7 Cir., 1921).

In Angel Research, Inc. v. Photo-Engravers Research, Inc., 223 F. Supp. 673 (D. C. Ill., 1962), Judge Perry held that the actions of Photo-Engravers Research, Inc. in attributing to a patent a scope which it did not have and in threatening members of the trade with the patent were ***56** factors in the creation of a monopoly. Photo-Engravers Research, Inc. had also misused the patent by refusing to sell allegedly patented material to certain customers who wouldn't join the research group.

In another case involving the counterclaim defendant JFD, the United States District Court for the Eastern District of New York held allegations of false representations by JFD with respect to their antennas and those of another stated a cause of action both under the Patent Law, 35 U. S. C. 292, and Section 43a of the Lanham Act, 15 U. S. C. 1125a. Channel Master Corp. v. JFD Electronics Corp., 260 F. Supp. 568 (D. C., N. Y., 1966).

The evidence with regard to false advertising and marking is clear. There can be no question regarding the applicability of the law.

Further, such false and overstated patent markings and claims serve to extend patents to cover an unpatented product, which appears to be a "per se" violation of the antitrust laws as to which no special damage need be shown, White Motor Co. v. United States, 372 U. S. 253, 259-60 (1963). Specific damage to Blonder-Tongue tied in to the period of these falsely marked advertisements has, however, been shown (R. 520-1, 675-6, for example).

False and overstated patent marking, done for the purpose of excluding others from the market, is an antitrust violation, as well (Kobe v. Dempsey, supra; Angel Research v. Photo-Engravers Research, supra).

Altogether apart from antitrust considerations, moreover, such false-marking use

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"of a patent to restrain competition with the sale of an unpatented product constitutes a misuse of the patent, and warrants denial of recovery to a plaintiff in an infringement action", Surgitube Products Corp. v. Scholl Mfg. Co., 158 F. Supp. 540 (D. C. S. D. N. Y., 1958), p. 543; aff'd. 262 F. 2d 824 (2 Cir., 1959).

***57** 5. Improper News Releases.

The District Court found nothing wrong, as a matter of law, in the Foundation deliberately and knowingly bringing suit with improper venue and then issuing news releases of the same.

Some further details of the basic facts found by the Court, however, lead to an entirely different conclusion of law.

The uncontradicted record shows that at least two of Blonder-Tongue's distributor-customers received from JFD, after suit was filed herein, a set of three documents:

JFD Sales Bulletin of April 19, 1966 (D. Ex. 43, A. 576, R., 528--XB6a; D. Ex. 46, A. 613, R. 530-- XB5a);

University of Illinois Foundation news release of April 7, 1966 (D. Ex. 43-- XB6c; D. Ex. 46--XB 5b);

Print of a newspaper clipping (D. Ex. 43--XB6b; D. Ex. 46--XB 5c).

JFD's Mr. Finkel specifically testified, D. Ex. 42, R. 515, p. 78, that the Foundation gave "authorization ... to send" the above-mentioned Foundation news release (D. Ex. 43--XB 6c and D. Ex. 46--XB 5b) to the antenna distributors and representatives in the trade.

The JFD Sales Bulletin refers to five suits, using the name "Blonder-Tongue Laboratories, Inc." prominently at the top. It not only announces these suits, but threatens others:

"The Foundation is taking vigorous action in the courts to sue all violators of the basic Log Periodic Patents."

Note the characterization of "basic Log Periodic Patents"--clearly intended to imply, as in the previously discussed misleading advertising campaign, that no one but JFD could make a log periodic antenna (when, of course, no such basic patent existed).

***58** The context in which this JFD campaign was carried out, moreover, is important to these issues. Mr. Blonder testified, without contradiction, that distributor-customers also reported being threatened with suit "By JFD and the University of Illinois Patent Foundation" if the distributors "were to take on our line" (R. 520-1).

That lie was aware that such threats were in fact made to such distributor-customers was conceded by Mr. Finkel of JFD at D. Ex. 42, R. 515, p. 74:

"Q. Are you aware that salesmen and distributors of yours have made these comments?

[i.e., "if they handled anyone else's line of log periodic antennas, they would be sued"]

"A. It might be they have made them. This is the normal kind of selling that goes on in the field, not just this one."

In this case: suits were used to coerce the trade into dealing with JFD

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exclusively; newspaper clippings of litigation and news releases announcing litigation and threats thereof were deliberately widely circulated in the trade and to customers of competitors, including Blonder-Tongue; and this suit was brought, knowingly without jurisdiction, merely to enable the issuance of a news release mentioning Blonder-Tongue under the letterhead of the Foundation, which was mailed to Blonder-Tongue's customers. This far transcends the proper use of patents and patent litigation.

Such publicity with regard to suits for patent infringement and threats of suits have long been held in the lower courts to constitute an act of unfair competition. A case in the Seventh Circuit, Panay Horizontal Show Jar Co. v. Airdor Co., 292 F. 858 (1923). criticized the publicity given to a patent and a suit which had been filed but not yet heard. Judge Evans said (p. 859):

***59** "The practice of trying suits in newspapers or circulars, in order to scare or daunt competitors, is pernicious and apparently growing. While courts are always open to protect patentees or manufacturers who have established a business which is being unfairly assailed, they cannot permit or sanction the use of the court's name, in advance of adjudication (or falsely after adjudication), to harass or obstruct a rival. A patentee who resorts to such practices comes into court with unclean hands, and on that ground alone will be denied the relief to which he otherwise might be entitled."

To a similar effect is Maytag Co. v. Meadows Mfg. Co., 35 F. 2d 403 (7 Cir., 1929).

H. S. Toulmin, Jr., in Patents and the Anti-Trust Laws of the United States, 1960, says:

"Mass patent litigation and the sending of notices of patent infringement may be regarded as evidence of unfair competition. This unfair competitive method is aggravated where it is coupled with a general attack on a trade, both by patent notices and litigation." Vol. 4, page 696, Chap. 23, Sec. 23.1.

See also Gerosa v. Apco Mfg. Co., 299 F. 19 (1 Cir., 1924); Robbins v. Petersime, 51 F. 2d 174 (10 Cir., 1931).

6. False Advertising.

The question here is whether the District Court is correct, as a matter of law, that widely disseminated advertising statements, e.g., that the log periodic formula had been patented, when such was not the case, were fair and proper.

Once more, the District Court's findings of fact omit many subsidiary findings necessary to determine the correctness of this legal conclusion.

With regard to the "formula" matter, the JFD ads contained further statements, not mentioned by the Court, clearly showing a deliberate intention to give the reader ***60** the impression that the District Court admitted the reader might get: namely, "that JFD had patented the whole concept of log-periodicity." (A. 85). For example, the February 10, 1964, Radio & Television Weekly ad (D. Ex. 42--B4 and 4A, A. 546 and 547, R. 515) refers to

"The Patented Log-Periodic Cellular Formula".

Note, also, the statements that "Only the JFD Log Periodic LPV operates according To The Patented Log-Periodic Cellular Formula", and "Do Not Be Misled By Log-Periodic Imitations", and "No other so-called Log-Periodic Antenna can work like the JFD Log Periodic LPV". This same "no other antenna" libel is also repeated as late

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as 1965, D. Ex. 42--J6, A. 573, R. 515.

And all this under color of the name of the University itself, and even (in D. Ex. 42--B4A, A. 547, R. 515), the picture of Prof. Mayes and the legend "Antenna Research Laboratories of the University of Illinois".

Such false representations of the coverage of the Foundation patents, under the name of the University, clearly told the trade that they could not buy a log periodic antenna from anyone other than JFD--since every log periodic antenna follows the log periodic formula!

After the damage had been done to Blonder-Tongue in the market place (R. 520- 1, 675-6), and after willingly collecting royalties from JFD for sales attained by these patently illegal advertising tactics over many months, the Foundation itself finally complained to JFD:

"Paragraph 4 is untrue. The Log-Periodic LPV formula is not patented." (Emphasis added.) (D. Ex. 42--B-104, p. 2, A. 560, R. 515.)

While a certain amount of "puffing" is recognized in the selling arena, where numerical figures of performance are presented to the customers in technical fields, it is not "puffing" to put in false figures; it is fraud.

***61** But that is just what JFD has done in this case. In its Radio Electronics article of June, 1963 (reprinted for advertising use), D. Ex. 42-- B-102, A. 553, R. 515, JFD baldly stated that

"the LPV-11 ... maintained a front-to-back ratio of 35 db...."

This was repeated in advertisement D. Ex. 42-B-109 (upper right-hand corner of second sheet), A. 567, R. 515.

The significance of this figure resides in the fact that it numerically rates the performance of the antenna in receiving the desired television signal, much as horsepower rates an automobile's performance.

The record shows, however, that tests--as to which JFD introduced no contrary evidence obviously because they were true--demonstrated that the JFD LPV-11 fell far short of producing the claimed "35 db" and, indeed, produced only

"about 10 to 12 db" (A. 346).

The significance of this is that, in the same 1963-1964 period, Blonder-Tongue was advertising the true figures of performance of its log-periodic DART antenna (JFD Ex. 23, p. 7, for example, R. 731).

Now appear these false JFD performance figures, under color of the name and prestige of the University of Illinois, impressing customers and potential customers that the JFD LPV antenna was 3.5 times better than it actually was-- and, of course, thus far above the Blonder-Tongue antenna in performance.

What customer would not be persuaded that an antenna designed by the University of Illinois Antenna Laboratory and with such tremendous performance figures--and all covered by patents and even a patented formula--was the one to buy, rather than that of a "Johnny-come-lately" in the antenna field, Blonder-Tongue?

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***62** Finally the Foundation realized that JFD was using its name and that of the University "as a gimmick" to support its "publicity" and "new peak of performance" claims, and threatened to "cancel" the license (D. Ex. 42-B-112, A. 570, R. 515); but irreparable damage had been done in the marketplace by this extensive, unchecked advertising campaign for almost two years.

7. Summary as to the Unfair Competition and Antitrust Counterclaims.

It has been shown that the total pattern or scheme of acts performed by the Foundation and JFD constitutes unfair competition (and antitrust violation) under the law, irrespective of whether the individual acts are separately illegal.

It has further been demonstrated that the District Court's legal conclusions as to the propriety of the individual acts standing alone are decidedly in error.

And, finally, it has been shown that several of these acts are misuses, barring enforcement of the Foundation's patent here in suit, even had it been valid and infringed.

Though petitioner has not had its full day in court as to those issues, it appears that sufficient facts have been found by the District Court, and others are uncontradicted in the record, to entitle Blonder-Tongue to judgment on Counterclaims I and II, as a matter of law.

QUESTION 6.

(Re Petitioner's Blonder-Schenfeld Patent.)

The Court of Appeals for the Seventh Circuit conceded that, in treating the counterclaim patent of petitioner,

"the district court did not describe the scope and content of the prior art, identify the differences between the prior art and claim ... nor state the level of ordinary skill in the pertinent art".

***63** This, indeed, is precisely what the Supreme Court has recently held in Graham v. John Deere Co., supra, must be found by the trial court in order to apply the standard of "obviousness" under Section 103 of the patent statute.

The Court of Appeals went on to treat this, however, as merely a discretionary requirement and not an absolute one and sustained the District Court on its finding of "obviousness" without making a single one of these determinations itself and in complete contravention of the express instructions from the Supreme Court.

The mere conclusion by the District Court (A. 89) that

"claim 5 of the Blonder-Tongue patent was obvious at the time it was made and is therefore invalid,"

is entirely unsupported by any special or subsidiary facts or findings whatsoever, in direct contravention of Rule 52(a) F. R. C. P. See, for example, B. F. Goodrich Company v. Rubber Latex Products, Inc., 400 F. 2d 401, 402 (6 Cir. 1968).

While showing knowledge (A. 76) of the requirement for specific fact finding as to the matter of "obviousness" under 35 U. S. C. 103, recently reiterated by the Supreme Court in Graham v. John Deere Co., supra, the District Court failed, in connection with the Blonder-Schenfeld patent (as distinguished from the way it treated the University of Illinois patents) to make a single finding as to "the

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scope and content of the prior art", "differences between the prior art and the claims at issue", "the level of ordinary skill in the pertinent art", or any other findings to support its conclusion.

It is perhaps in order to point out that, absent the fact that this Supreme Court has taken jurisdiction principally because of other issues, unless there were the safeguard of Triplett v. Lowell, petitioner would have no redress from the grossly inadequate treatment afforded his patent in the lower courts.

***64** On this record, moreover, the District Court, even without the necessary findings that constitute due process, asserted the legal conclusion that statutory presumption of validity of petitioner's patent was overcome by some possible but unexplained combination of the teachings of fifteen pieces of prior art, allegedly indicating "obviousness" as a matter of law.

But the legal conclusion to be drawn from a situation where so many references have to be combined allegedly to anticipate an invention is quite to the contrary.

As earlier stated by the Court of Appeals for the Seventh Circuit itself in a similar factual situation in Minneapolis-Honeywell Regulator Company v. Midwestern Instruments, Inc., 298 F. 2d 36, 38 (7 Cir., 1962):

"defendant designated thirteen prior art patents in addition to the twenty references considered by the Patent Office. Such an approach (sometimes designated as 'Shotgun') has been held to be indicative of invention or of the futility of prior art to solve the problem. Ric-Wil Co. v. E. B. Kaiser Co., 7 Cir., 179 F. 2d 401, 404, Cert. den. 339 U. S. 958, 70 S. Ct. 981, 942 L. Ed. 1369."

Thus, as a matter of law, it appears that the lower courts reached the wrong legal conclusion as to "obviousness", apart from their failure to make the supporting findings required by the law.

This, indeed, is further borne out by uncontradicted testimony of Mr. Blonder and documents in evidence showing that:

1. There was a long-standing problem of "ghosts" with prior art television antennas (including the "log periodic linear and V-type antennas" of the Isbell and Mayes et al. patents here in suit). (Blonder-Schenfeld patent, D. Ex. 26, col. 1, line 20 on A. 526, R. 477; testimony of Mr. Blonder, R. 481-2.)

***65** 2. Numerous proposals were tried through the years, including "crossed harnesses", "multiple connections requiring rivets" and the structures of the prior art cited by the District Court at A. 88-9, to try to minimize these effects; but, notwithstanding, the "problems ... have always existed" (R. 481, 509).

3. The Blonder-Schenfeld solution involved a radical departure from what the District Court characterized as the Isbell patent concept of a "substantially planar, parallel arrangement to form an antenna array" (emphasis added), in that

"Unlike prior-art arrays, including Yagi arrays, conventional log-periodic structures and the like, first and second pluralities of horizontal dipole elements 5, 7, 9, ... 11 and 5', 7', 9' ... and 11' are provided, lying in corresponding first and second vertically spaced horizontal planes 1 and 1' containing the respective longitudinal conductors 1 and 1'" (emphasis added) (D. Ex. 26, col. 2 at top A. 526, R. 477)

instead of the Isbell coplanar arrangement; and a

"parallel-wire transmission line TL is connected at looped terminal portions 1"

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and 1'"" (D. Ex. 26, col. 2, line 17 on A. 526, R. 477),

in a certain uncommon and critical geometric and rigidly held arrangement that amazingly obviates electrical field pattern aberration because of "wind motion" or otherwise (R. 483-488; P. Ex. 10, R. 123, D. Ex. 26 A. 525, R. 477).

4. No one in the "television industry" prior to this invention introduced such a structure (R. 487, 509); no prior publications or writings disclosed such a structure (R. 488-9).

5. By relying on 35 U. S. C. 103 ("obviousness") and not 35 U. S. C. 102 (disclosure or direct anticipation), the District Court tacitly conceded that none of ***66** the cited prior art (A. 88-9) actually discloses the claimed structure.

6. The fact that the Blonder-Schenfeld structure, unlike the Isbell and Mayes et al. coplanar structures, solved these problems and still worked so well electrically, was a matter that "happily surprised" Mr. Blonder (a masters-degree engineer) and his engineering associates (R. 488); and, indeed, was a matter that Mr. Robert Heslin (a senior electronics engineer and JFD's own witness) conceded was "a surprise" both to him "at that time" and to Mr. Campbell, the technical editor of Q. S. T., an electronics publication (R. 723).

7. The Patent Office fully considered the prior art of Isbell and Mayes et al. A. 527 so that the issuance of the Blonder-Schenfeld patent constitutes a considered and deliberate finding that this was an unobvious invention over the work of these investigators; and though all three of these engineers have been inventing for the University of Illinois, and Mayes has been designing antennas for JFD as well, the fact is that the Blonder-Schenfeld construction never occurred to them (i.e., was not obvious) until after Blonder-Tongue showed the way.

8. After Blonder-Tongue introduced into the market its antennas with the Blonder-Schenfeld patent construction, JFD promptly redesigned its antennas, abandoned the "cross harness" and other schemes (D. Ex. 42-B-106 and 108 A. 563 and 565, R. 515) and adopted the Blonder-Schenfeld construction with relatively widely spaced booms and the critical parallel-wire transmission line mounting and feed (D. Ex. 27, R. 491; D. Ex. 27A, R. 499; D. Ex. 37, A. 542, R. 659; D. Ex. 42, p. 53, R. 515; JFD Ex. 25; R. 734, R. 446, 500-2, 761).

***67** There. thus appears to be sufficient uncontradicted evidence of unobviousness meeting the Supreme Court's test in the Graham case, supra. This, coupled with the District Court's erroneous conclusion of law in contradiction to the doctrine of the Minneapolis-Honeywell case, supra, would appear to permit this Supreme Court even on this record, to find the Blonder-Schenfeld patent valid and infringed.

CONCLUSION.

Apart from the significant issues of whether the Isbell patent is or is not valid and enforceable, and whether petitioner's counterclaims are or are not sustainable, this case involves circumstances demonstrating the degeneration of the standards of legalized fair play

(a) before the administrative agency (the Patent Office),
(b) in the market place,
(c) in the action of parties litigant before the court, and
(d) in the conduct of the courts themselves,

--in short, issues embracing all facets of our society concerned with the operation of industrial property rights.

We wonder whether an opportunity such as this has previously been presented to this Supreme Court to redefine legal conduct that has too long been allowed to continue

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unchecked to the point where, as illustrated in this case, lawyers and engineers find nothing wrong in misrepresenting to the Patent Office, in blatant harrassment of competitors, in hiring away key witnesses during litigation, and in performing almost every conceivable act of unfair competition ranging from deliberately misleading and false advertising, false representation of the scope of patents in such advertising, false representation of the ***68** rights of others to make similar products, false patent marking, threats under color of patents to force not only sale of the patented line but unpatented items, as well, and using the medium of a large number of suits and publicity announcing and threatening the same, deliberately to stifle competition.

Not only do we witness this conduct as "normal" in today's society, but we further witness in this case the misuse of power by the courts, with a shocking deprivation of rights inherent in due process of law, which is supposed to be the guaranteed birthright of us all.

As this Supreme Court well knows, America is facing revolutionary times, and it is hungrily searching for worth-while substance to believe in. We cannot find that substance if we excuse misrepresentation in the Patent Office; if we excuse misuse of patents to restrain competition; if we excuse misconduct by the parties in hindering the process of the courts themselves by acts that have resulted in the suppression of evidence; and if we excuse clear misconduct and misapplication of due process in the courts.

We are looking to this Supreme Court to reset our standards of conduct in the administrative agencies, the market place and in the courts, such that America may again have some substantial measure of purpose, direction and integrity.

Specifically, we request in this cause the over-ruling of the finding of the Court of Appeals that the Isbell patent represented invention, that it is infringed by petitioner's antennas, and/or that it is enforceable under the circumstances herein of misrepresentation, unfair practices and unclean hands.

Petitioner further seeks redress by way of a finding of unfair competition and antitrust violation in the barrage of unfair and illegal practices engaged in by JFD, in consort ***69** with the plaintiff, to try to maintain a monopolistic position in the antenna field--which, indeed, very nearly resulted in putting the petitioner out of business altogether.

Lastly, we seek in this Supreme Court the same safeguards of a fair and complete trial and the right to the same type of findings of fact and due consideration in connection with petitioner's patent, that the District Court showed it knew it was supposed to give in connection with the patents of the plaintiff.

Appendix not available.

U.S., 2004.
Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation

Briefs and Other Related Documents (Back to top)

• 1971 WL 133764 (Appellate Brief) Motions of Blumcraft of Pittsburgh Opposing Motion of Kawneer Company, Inc. for Leave to File Brief Amicus Curiae and Brief

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Amicus Curiae of Blumcraft of Pittsburgh. (Feb. 18, 1971)Original Image of this Document (PDF)

• 1971 WL 133761 (Appellate Brief) Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of Kawneer Company, Inc. (Jan. 08, 1971)Original Image of this Document (PDF)

• 1971 WL 133763 (Appellate Brief) Brief for the United States as Amicus Curiae (Jan. 08, 1971)Original Image of this Document (PDF)

• 1971 WL 133759 (Appellate Brief) Brief of Respondent JFD Electronics Corporation (Jan. 04, 1971)Original Image of this Document with Appendix (PDF)

• 1971 WL 133760 (Appellate Brief) Brief of Respondent University of Illinois Foundation. (Jan. 04, 1971)Original Image of this Document (PDF)

• 1971 WL 133762 (Appellate Brief) Brief for the American Patent Law Association as Amicus Curiae (Jan. 04, 1971)Original Image of this Document (PDF)

• 1970 WL 122671 (Appellate Brief) Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of Automatic Electric Company (Dec. 31, 1970)Original Image of this Document (PDF)

• 1970 WL 122669 (Appellate Brief) Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of the Finney Company Supporting the Position of the Petitioner That the Isbell Patent in Suit is Invalid. (Dec. 07, 1970)Original Image of this Document (PDF)

• 1970 WL 122668 (Appellate Brief) Reply of Respondent University of Illinois Foundation to Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit. (Jul. 27, 1970)Original Image of this Document (PDF)

• 1970 WL 122670 (Appellate Brief) Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of the Finney Company Supporting Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit. (Jul. 09, 1970)Original Image of this Document (PDF)

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Westlaw.
1970 WL 122668 (U.S.)

For opinion see 91 S.Ct. 1434, 91 S.Ct. 917, 91 S.Ct. 563, 91 S.Ct. 449, 91 S.Ct. 363, 91 S.Ct. 101

Briefs and Other Related Documents

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Supreme Court of the United States.
BLONDER-TONGUE LABORATORIES, INC., Petitioner,
v.
UNIVERSITY OF ILLINOIS FOUNDATION, and JFD Electronics Corporation, Respondents.
No. 338.
October Term, 1970.
July 27, 1970.

Reply of Respondent University of Illinois Foundation to Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit.

CHARLES J. MERRIAM, WILLIAM A. MARSHALL, BASIL P. MANN, Counsel for Respondent, University of Illinois Foundation.

Of Counsel: MERRIAM, MARSHALL, SHAPIRO & KLOSE, 30 West Monroe, Street, Chicago, Illinois 60603.

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Graham v. John Deere Co., 383 U. S. 1 ... 4, 5

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***1** Respondent University of Illinois Foundation submits that the petitioner's statement of the issues in this case omits significant matters and is in certain respects slanted and argumentative. We therefore respectfully present the following comments for the Court's consideration.

***2** JURISDICTION.

We do not contest the jurisdiction of this Court. We further recognize that there exists in this case a factor (diversity of opinion among two Courts of Appeals respecting the validity of a patent) which has sometimes, but not always [FN1], served as sufficient basis for this Court to exercise its jurisdiction and to grant a writ of certiorari. In this particular case, we submit that, in view of the different records on which each Court of Appeals based its decision, there is no actual conflict and that the case does not present any question of law of sufficient importance to justify review by this Court.

> FN1. A recent example of this Court's refusal to grant certiorari in a patent case involving a conflict in the decisions of two Courts of Appeals respecting the validity of a patent occurred in National Sponge Cutshion Co. v. Allen Industries, Inc., No. 1012, October Term 1968.

QUESTIONS PRESENTED.

The only question of sufficient importance to warrant possible consideration by this Court is Question I, relating to the conflict in the decisions of the Courts of Appeals. Petitioner has improperly designated Question I by including the allegation that the Isbell patent purports "to dominate the present day home television receiving antenna field". There is no support in the record for such an allegation.

Question II has no relationship to the conflict of decision between the Courts of Appeals on which petitioner has principally relied as a basis for asking this Court to exercise its jurisdiction. The patent alleged by petitioner to have been obtained by "misconduct in the Patent Office" is not the Isbell patent with respect to which the opinions ***3** of the Courts of Appeals differ. The patent to which petitioner refers, Mayes et al. Re. 25,740, was found invalid solely on the ground of obviousness by the Court of Appeals. The Foundation has accepted the decision of the Court of Appeals and has made no further effort to enforce this patent.

Question III seeks to create an issue where none properly exists within the context of this case. The alleged deficiency in the findings alluded to by petitioner refers to the findings of the District Court and not those of the Court of Appeals to which certiorari is directed. Petitioner does not allege that the findings of the Court of Appeals for the Seventh Circuit contained the same deficiency.

STATEMENT OF THE CASE.

Petitioner's statement of the case is replete with allegations having no relationship whatsoever even to petitioner's version of the question legitimately presented by this case. In our view, the only question of sufficient importance for this Court to consider is the validity of the Isbell patent. We will therefore direct our remarks primarily to those portions of petitioner's statement having relevance to this issue.

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Question I.

It should be noted that the issue of the validity of the Isbell patent was once previously presented to this Court in a petition for a writ of certiorari filed by respondent Foundation in early 1969 (University of Illinois Foundation v. Winegard Company, October Term, 1968, No. 993). In that petition, respondent Foundation sought review of the decision of the Court of Appeals for the Eighth Circuit which held the Isbell patent invalid, in view of the conflicting decision of the District Court for the Northern District ***4** of Illinois which had held the patent valid after consideration of the decision of the trial court in the Eighth Circuit. The decision of the Illinois District Court was then on appeal to the Seventh Circuit Court of Appeals. The Foundation's petition for a writ of certiorari was denied by this Court on March 24, 1969. [FN1]

> FN1. A petition for out-of-time rehearing was recently filed by the Foundation.

Petitioner's allegation that there exists a conflict in the standard for obviousness which was applied by the Courts of Appeals for the Seventh and Eighth Circuits is erroneous. The standard applied was the same in both cases. The Court of Appeals for the Eighth Circuit should have found nonobviousness on the basis of the record, but at any rate the Court of Appeals for the Seventh Circuit had a different record to consider on this point and came to a different conclusion. Accordingly, although review by this Court would settle the immediate issue of whether the Isbell patent is valid over the cited prior art, no broadly applicable principle of law is involved in this petition.

The Court of Appeals for the Eighth Circuit, while admitting that Isbell's result was unpredictable, nevertheless held that it might be achieved by trial-and-crror and was therefore obvious, even though, on the record, a random trial of all possibilities might have taken almost infinite amounts of time and money, since it was admitted that there were no guide posts which could be followed to arrive at the relatively few operative antennas among the countless number which would not work as desired. The Court quoted this Court's decision in Graham v. John Deere Co., 383 U. S. 1, 17, as saying the test of nonobviousness is "one of inquiry, not quality."

Respondent's position in its petition for certiorari to the Court of Appeals for the Eighth Circuit was that if ***5** something is unpredictable it cannot be said to be obvious. We acknowledge that obviousness does not require absolute predictability, as in a situation where only a few alternatives exist, in which it might be obvious to try them all just to see what would happen. In this particular case, however, there were countless possibilities and no guide posts to direct a researcher to one rather than another. The record showed that the great majority of the possibilities would fail. To use an analogy from another field, there are millions of stars and probably millions of solar systems in the universe. Many authorities believe that advanced life must exist on some of them. There are, however, no guide posts which can be used to point out those systems which support an advanced level of life as we know it. Since a trial-and-error approach could be used on this problem, identification of those systems having life by a modern day Columbus would appear obvious, following the rule applied by the Eighth Circuit Court of Appeals.

In its petition for a writ of certiorari, respondent took the position that there

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was a divergence between the principles applied by the Court of Appeals for the Eighth Circuit and those set out by this Court in Graham v. John. Deere Co. for determining obviousness. However, this Court refused to grant the writ.

Realizing that denial of a petition for a writ of certiorari does not necessarily constitute approval of the decision of the lower court, respondent was careful to improve the record in the Seventh Circuit case by including the testinony of Dr. DuHamel, an expert in the specific phase of the antenna art encompassing Isbell's invention (i.e., the log periodic field) and an author of the publication which was primarily relied upon by the Court of Appeals for the Eighth Circuit to support its finding of obviousness. Dr. DuHamel testified that the Isbell development was not obvious to him and that when he first heard of Isbell's invention he was surprised that it worked.

***6** The record is therefore different in the two cases on the very point which was basic to the decision of the Court of Appeals for the Eighth Circuit. While respondent still regards the difference between "unpredictable" and "nonobvious" as being purely semantic, whatever difference may exist was emphasized in the Blonder-Tongue case.

Petitioner's argument that unless this petition is granted, the Isbell patent will be valid in one part of the United States and not in another is wholly specious. It erroneously assumes, in the first place, that if the petition is granted the patent will be held invalid. If the petition is granted and the patent is upheld, as it should be on the record, then the patent will be valid in the Seventh Circuit, but there will continue to be a decision against it in the Eighth Circuit. And, secondly, it assumes that it would be impossible to obtain a new decision in the Eighth Circuit upholding the patent on the same record as is here presented.

Question II.

Only two comments regarding Question II are necessary. First, the Court of Appeals for the Eighth Circuit did not find that the Mayes et al. patent was procured by fraud or wrong-doing. It held the patent invalid solely on the ground of obviousness.

Secondly, the Isbell patent and the Mayes et al. patent provided respondent Foundation with separate and independent causes of action against Blonder-Tongue. Even if some wrong-doing respecting the Mayes patent had been found, this would not serve as a basis for holding the Isbell patent invalid. Keystone Driller Co. v. General Excavator Co., 290 U. S. 240, 245.

***7** Question III.

Regardless of the degree of particularity with which the District Court set out its findings regarding Blonder-Tongue's patent, the Court of Appeals found sufficient basis in the record to affirm the lower court's decision. Any error which existed in the trial court's decision was harmless.

CONCLUSION.

For the above reasons, we do not believe this petition to present questions of sufficient importance to warrant further review. If the writ is granted, however, we submit that it should be limited to the issue of the validity of the Isbell patent, and request that the Court grant respondent a rehearing of its petition for a writ

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of certiorari in the Eighth Circuit case.

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Westlaw.
1970 WL 122670 (U.S.)

For opinion see 91 S.Ct. 1434, 91 S.Ct. 917, 91 S.Ct. 563, 91 S.Ct. 449, 91 S.Ct. 363, 91 S.Ct. 101

Briefs and Other Related Documents

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Supreme Court of the United States.
BLONDER-TONGUE LABORATORIES, INC., Defendant and Counter Claimant-Appellant-Petitioner,
v.
UNIVERSITY OF ILLINOIS FOUNDATION, Plaintiff and Counterclaim Defendant-Appellee, and JFD Electronics Corporation, Counterclaim-Defendant-Appellee, Respondents.
No. 338.
October Term, 1970.
July 9, 1970.
Motion for Leave to File Brief Amicus Curiae and Brief Amicus Curiae of the Finney Company Supporting Petition for a Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit.

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Of Counsel: MCNENNY, FARRINGTON, PEARNE & GORDON, 920 Midland Building, Cleveland, Ohio 44115, WALTHER E. WYSS, MASON, KOLEHMAINEN, RATHBURN & WYSS, 20 North Wacker Drive, Chicago, Illinois 60606.

***1** To The Honorable Chief Justice and Associate Justices of The Supreme Court of the United States:

The Finney Company, a manufacturer of radio and television antennas in Bedford, Ohio, respectfully moves for leave to file the annexed brief amicus curiae in connection with the Petition in the above case for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit.

Consent to the filing of that brief has been refused by University of Illinois Foundation, Respondent to said Petition, speaking through its attorneys of record, thus necessitating the filing of this motion under Supreme Court Rule 42.

The movant, The Finney Company, is the plaintiff in a declaratory judgment action seeking, inter alia, a judgment that the Isbell patent of the University of Illinois ***2** Foundation (the same Isbell patent involved in the above action) is invalid. [FN1] That declaratory judgment action is but one of several other suits involving the questions of validity and infringement of the Isbell patent. [FN2]

FN1. The Finney Company v. JFD Electronics Corp. and University of Illinois Foundation, Civil Action No. 65 C 671, United States, District Court for the Northern District of Illinois, Eastern Division.

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FN2. See Petition of Blonder-Tongue Laboratories, Inc., p. 9, note 2.

The annexed brief presents a persuasive reason, not presented by the Petitioner, for the Supreme Court to grant the requested writ. It has been filed as soon as possible after the Petition became available since it appears unlikely that either of the Respondents would present that reason why the Supreme Court should review the decision of the Court of Appeals for the Seventh Circuit.

As explained in the annexed brief, the conflicting decisions of the Courts of Appeals for the Seventh and Eighth Circuits diverge on an important question of law to which the Supreme Court has not specifically addressed itself heretofore. That question arises under the "obviousness" provision of 35 U.S.C. 103 and is the following:

Where logical exploration within known principles of the art achieves an unpredictable result, does the necessity of logical experimentation, in and of itself, negate obviousness?

The Eighth Circuit Court of Appeals first answered that question "No" and held the Isbell patent in suit invalid. The Seventh Circuit Court of Appeals subsequently relied upon unpredictability of Isbell's success to reach the opposite result.

Clarification of the answer to that question should not only affect the suit in which The Finney Company is involved ***3** and the other pending suits on the same Isbell patent, but it should produce a better understanding and more consistent application of the law of patentability by the federal trial and appellate courts handling patent cases.

Accordingly, granting of this motion and consideration of the annexed brief are earnestly requested.

Note: Page 4 missing in original document

***5** The Finney Company [FN1], as amicus curiae, respectfully supports the Petition in this case for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit, for the additional reason that, despite a common understanding of the facts, the United States Courts of Appeals for the Seventh and Eighth Circuits, reached different and conflicting legal conclusions in applying the "obviousness" provision of 35 U.S.C. 103 [FN2] to determinations of validity of the Isbell patent in suit. Such a conflict demonstrates an urgent need for further clarification of the meaning of that provision of the patent laws.

FN1. Declaratory judgment plaintiff in The Finney Co. v. JFD Electronics Corp. and University of Illinois Foundation, involving the Isbell patent here in suit and pending in the United States District Court for the Northern District of Illinois, Eastern Division. See Petition, p. 9, note 2.

FN2. Reproduced in the Petition, pp. 3-4.

The history of this case and the other reasons for granting certiorari have been sufficiently set forth in the Petition of Blonder-Tongue Laboratories, Inc., Defendant and Counterclaim-Appellant below (pp. 1-6).

QUESTION PRESENTED.

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Where logical exploration within known principles of the art achieves an unpredictable result, does the necessity of logical experimentation, in and of itself, negate obviousness?

The answer to that question of law, on which the Courts of Appeals of the Seventh and Eighth Circuits reached directly contrary conclusions, is the fundamental ***6** point of divergence of their respective, conflicting opinions on validity of the Isbell patent in suit. The public importance of clarifying the answer to that frequently encountered question of law is indicated by the circumstance that both of the similarly conflicting District Court decisions below, which the two Courts of Appeals respectively affirmed, purported to apply 35 U.S.C. 103 to the same facts in the manner prescribed by the Supreme Court in Graham v. John Deere Co., 383 U.S. 1, 12 (1966). [FN3]

FN3. See District Court decisions reproduced in the Appendix to the Petition, both citing Graham v. John Deere in this regard (App. A24 and A50).

DISCUSSION.

The invention of the Isbell patent relates to so-called "broadband" radio and television antennas and is alleged in the patent to produce uniform performance over a broad range of frequencies. Broadband antennas composed of similar arrangements of similar elements, called "dipoles," were old. It was also known to the prior art that certain types of broadband antenna structures could be given such uniform performance characteristics by proportioning them according to a so-called "logperiodic formula" (App. A7-A8, A42, and A51-A59).

Both Courts of Appeal had before them the same prior art (App. A8). Both Courts recognized that the significant difference between the antennas of the Isbell patent and the prior art antennas of similar character is that, according to the Isbell patent, the lengths and spacings of the successive dipoles vary progressively according to the log-periodic formula (App. A8 and A47). Both Courts referred to Jasik's Antenna Engineering ***7** handbook, which explained that the Isbell antenna was merely an adaptation of the log-periodic scaling principle to prior art broadband antennas to achieve uniform (i.e., frequency independent) performance over the frequency band (App. A10 and A43). As both Courts indicated by quotations from the Jasik handbook, whether or not a particular antenna, proportioned according to the logperiodic formula, would be frequency independent in its operation was simply determinable "by logical experimental methods" (App. 9A-10A and 47A).

However, both Courts also recognized from the evidence, as also stated in the Jasik handbook, that the frequency independent operation of the Isbell antenna (or any log-periodic antenna) was unpredictable, though verifiable by such simple, logical experimentation (App. A9, A44, and A47).

Based on such a common understanding of the facts, both the Seventh and Eighth Circuit Courts considered the crucial question to be whether it would have been obvious to a person having ordinary skill in the art to dimension the dipoles and dipole spacings of the prior art antennas according to the log-periodic formula.

The Eighth Circuit Court, noting that "the statutory standard of patentability under § 103 is not 'predictability' " (App. A44), stated--

"Where logical exploration within known principles of the science achieves an

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unpredictable result, even though a commercially desirable one, the burden of nonobviousness is not necessarily overcome. In other words, the necessity of logical experimentation does not in and of itself negate obviousness." (App. A45-A46.)
Citing the Jasik handbook for support, the Eighth Circuit Court further stated (App. A47)--
***8** "The problem here was one of trial and error with a combination of commonly used elements operating within known principles of electronics and mechanics to achieve a desired result."
Accordingly, that Court affirmed the District Court below and held that (App. A48)--
"The standard of patentability under § 103 requires more."

Based on the same understanding of the facts, the Seventh Circuit Court (App. A9-A10), like the District Court below (App. A25-A26), relied on the unpredictability of Isbell's success to arrive at the opposite conclusion that the Isbell invention was not obvious within the meaning of § 103 (App. A12).

The Supreme Court has heretofore ruled that the results of routine investigation, where the prior art pointed the way, do not involve invention. Mandel Bros. v. Wallace, 335 U.S. 293, 295-296 (1948). Cf. Atlantic Works v. Brady, 107 U.S. 192, 199-200 (1882). But that was prior to the present patent statute and prior to the Supreme Court's decision in Graham v. John Deere Co., supra, making "obviousness" the sole test of patentability where an element of novelty over the prior art exists.

Thus, it would seem to remain for the Supreme Court to settle the question of law first posed above. Apart from the need to resolve conflicting appellate decisions that have left an important patent valid in one circuit and invalid in another, settling that important question of law in this case should go far toward producing a better understanding and more uniform application of 35 U.S.C. 103 on which patentability depends in the majority of patent cases.

***9** For the foregoing reasons, it is urged that the Petition of Blonder-Tongue Laboratories, Inc. in this case be granted.

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