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Ball: Dynamics of the Patent System

Robert A. Choate

University of Michigan Law School

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RECENT BOOKS

DYNAMICS OF THE PATENT SYSTEM. Edited by *William B. Ball*. New York: Central Book Co. 1960. Pp. xix, 449. \$12.50.

Despite the fact that the quality of the material in this multi-authored symposium fluctuates considerably from section to section, this book can be recommended to students and lawyers (and judges) alike as a treatise well worth the reading and a worthwhile addition to a patent law library. It is directed to persons with some background in patent law, rather than to laymen, and might be considered as a post-graduate course for students and a refresher course for practicing attorneys.

Coming as it does some years after the Patent Act of 1952, this book can serve in some measure, as do the welcome annual trademark reviews of Dr. Walter Derenberg, to summarize and highlight the developments in the case law under the new act.

But *Dynamics of the Patent System* goes more deeply than a case review into the very heart of the patent system as it reflects in the mind and the feeling of each contributor.

Even recognizing, as does Professor William B. Ball of Villanova University in his Introduction, that the printed word is subject to progressive obsolescence with each fast-coming advance sheet, the panoramic view afforded by this book is sufficiently extensive that it can serve for some time as a reference in the particular areas discussed.

Ten subjects of patent law are treated in a series of recorded meetings sponsored by Villanova University, each topic being handled first in a formal way and then by an assigned commentator who leads in a floor discussion of the topic. In general, it can be said that the formal treatments by the selected and outstanding authorities on the various subjects constitute the best meat for busy readers.

The first section on "The Standard of Invention in the Patent Office" is a most practical and down to earth discussion of this baffling question. It is handled by Edwin L. Reynolds, Chief Technical Advisor of the United States Court of Customs and Patent Appeals and Associate Professor at Georgetown University. Mr. Reynolds is well versed in the problems, pressures, and mechanics of Patent Office procedures. He discusses the wide gap between court decisions and the Patent Office standards and analyzes the practical reasons for this gap.

Mr. Reynolds suggests that this discrepancy might be reduced by a close personal supervision of examiners found to be unduly lenient. It may be fair to comment that this plan would face the difficulties of the time lapse between the examiner's decision and any final court review, and the age-old problem of accurate advance evaluation of an idea at the application stage.

Mr. Thomas Cooch, a practicing attorney from Wilmington, Delaware, in the chapter on "The Standard of Invention in the Courts," plunges into the controversy of whether determination of invention is a question of law or fact. The Seventh Circuit has recently devoted a large portion of a deci-

sion to this matter after requesting special briefs [*Armour & Co. v. Wilson & Co.*, 124 U.S.P.Q. 115, 274 F.2d 143 (1960)] and Floyd Crews, aptly points out on page 128 of *Dynamics* that the attorneys can blow hot and cold on this point depending on whether they go to appeal representing a losing party or a winning party. Mr. Cooch gives further advice on the use of evidence to the point of invention in a masterpiece of brevity on pages 36, 37 and has good advice on the use of practical experts as distinguished from "professional" experts.

The floor discussion, led by C. Marshall Dann, following the presentation by Mr. Cooch, is supplemented by some interesting charts and statistics on court decisions and contains an enlightening portion on jury trials in patent cases. An outstanding brief treatment of affirmative tests of invention appears at page 67 from W. Wyclif Walton, of Philadelphia.

A scholarly and practical dissertation on "Patent Claims Before the Patent Office" by Joseph Gray Jackson, of Philadelphia, provides a valuable insight for every attorney who is prosecuting applications. The discussion following the section is not too fruitful with the exception of a few tricks of the trade which appear. Mr. Jackson covers the purpose of a claim, the statutory classes, process claims, statutory new use claims, completeness of claims and definiteness.

The experience of a practicing attorney, Floyd H. Crews, of New York, shows clearly in the section on "Patent Claims and Infringement." Here is a very realistic approach to the problems of file estoppel, self-imposed limitations, and court-imposed limitations. The difficulties of giving positive advice to a client on either infringement or validity are advanced. Mr. Crews advocates selling the invention to the court in the most current fashion available and suggests the court will find the law to fit with the assumption, it is presumed, that the advocate would render it readily available.

Another capable lawyer, Zachary T. Webensmith, II, of Philadelphia, clarifies, in the Patent Interference field, the *Mason v. Hepburn* doctrine in contrast to the Abandoned Experiment rule, and he also treats at length the rule of corroboration of inventor's testimony, a pitfall of many an inexperienced interference lawyer. An interesting discussion is found on the tamper-proof value of a witnessed and dated negative of an original disclosure, as well as the illusory value of the self-addressed registered letter, sometimes called the "poor man's patent."

A corporate attorney, Howard I. Forman, of Rohm & Haas Company directs attention to problems of vital interest to all attorneys and corporations in the chapter on "Inventors and Their Relations to Others." This section reflects laborious and painstaking collection of charted evidence on employee agreements and thoughtful consideration to the problems of corporate handling of "outside ideas" characterized as "dynamite." H. Gordon Dyke, of International Latex Corporation, suggests a six-point rule for the disclosure problem in his discussion following Mr. Forman.

In the field of Design Patents, Henry Paul of Philadelphia, discusses the origin and legislative development with a brief history of decisions leading to the case of *Palmer v. Luden's* [111 U.S.P.Q. 1, 236 F.2d 496 (1956)] in which he was the successful plaintiff's advocate in a fact situation involving the "slavish copying" of chocolate animal figures. The subsequent discussion led by Kennard N. Ware, the losing advocate in the same case, lends a personal note to a brief but highlighted review of the law of design patents.

The fifty-page chapter on "What is Prior Art?" by Virgil E. Woodcock provides rewarding reading for all practicing patent attorneys. Here is a historical development of the law carefully documented by concise statements of the facts and brief analysis of the opinions in many landmark cases arranged to jibe with the various divisions of section 102 of the Patent Act. The question of what constitutes a printed publication is considered, *e.g.*, a single copy of a partly handwritten and partly typewritten Ph.D. thesis deposited in the library of a state university. The intriguing problem of when an invention is "on sale" is developed, *e.g.*, can an idea which is completely on paper but not yet constructed be on sale? Mr. Woodcock demonstrates here his ability to deal capably with a major subject of the Patent Law field in which he labors so effectively not only for his clients but for his fellow lawyers.

The penultimate chapter on "Contributory Infringement" by Judge Giles Rich, of the Court of Customs and Patent Appeals, exhibits a mastery of the subject borne of long study of the case law and the statutes. This chapter is overlapped considerably by the last chapter on "Misuse of Patents" by John Hoxie, since the two topics are now historically joined not only by case law but by section 271 (d) of the Patent Act of 1952.

While none of the various contributors pretends to a comprehensive view of his particular topic and each may deal with his favorite cases in the field, yet each has joined with his fellows to produce a compendium alive with personal slants and experiences which brighten the reading of the basic law review forming the foundation of each chapter.

Judge John Biggs, of the Third Judicial Circuit of the United States, says in his Foreword to the text: "I have never read franker discussion, and frank discussion of the law is the mother of invention therein." Villanova University School of Law and the many participants who have contributed time and thought to this volume are to be commended for this fresh approach to the field of Patent Law. *Dynamics of the Patent System*, legibly printed on fine quality paper, is attractively bound with a suitably modernistic cover design. The Central Book Co., long a source of patent law books for the profession, has added another valuable book to its list.

*Robert A. Choate,
Detroit, Michigan*