

IN THE
UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT

No. 17153
University of Illinois Founda-
tion.

Plaintiff and Counter
Defendant-Appellee,

v

Blonder-Tongue Laboratories
Inc.

Defendant and Counter
Claimant-Appellant,

v

JFD Electronics Corporation,

Counterclaim-Defendant-
Appellee.

Petition For Clarification, Reconsideration and Rehearing Before
The Court En Banc

Now comes the defendant and counter claimant-appellant, Blonder-Tongue Laboratories, Inc., and petitions this Court for clarification of its decision of February 13, 1970, and for reconsideration and rehearing of the same, preferably before the Court en Banc.

The reasons for requesting such further proceedings en banc are threefold:

First, the issue of due process of law in the trial of this case, under circumstances where the defendant, through no fault of its own, was deprived of any witnesses at all during the presentation

of the plaintiff's case (including its all-important patent expert), is believed to have been decided contrary to all previous principles of American jurisprudence.

In addition, the treatment of the defendant's patent in its counter claim by both the District Court and this Court of Appeals appears to fly in the teeth of the recent mandate of the Supreme Court with regard to the requirement for ^{VERY} specific findings in patent cases where the issue of obviousness is in question.

Secondly, the conclusion of the validity of the Isbell patent in suit appears contrary to a very recent pronouncement of the Supreme Court on combination patents.

Thirdly, this Court appears to have overlooked the mandate of the Supreme Court in connection with the application of the doctrine of unclean hands in patent causes.

THE MATTER OF DUE PROCESS AND FAIR TRIAL

This Court has rejected the defendant's allegation that it has been deprived of due process in terms of fair trial, upon the ground that supposedly Mr. Blonder was available as a witness at the trial and "did testify", and that supposedly "counsel has not shown the relevance of testimony expected" from the patent expert and "not otherwise available". These holdings are, however, factually in error and appear to be based upon certain misapprehensions of this Court.

In the first place, the record shows that it was not possible to obtain the presence of even Mr. Blonder until after the plaintiff's case-in-chief on the Isbell and Mayes et al patents, and after whatever defense defendant could present in opposition thereto (which consisted of cross examination of plaintiff's witnesses and an attempt to

use the Foundation's inventor Mayes himself as a witness for the defendant, which attempt was thwarted, as explained at the bottom of page 8 on the main brief of the defendant on this appeal).

The record shows that ~~the~~ reasons were presented by motion and affidavit (R. 63 through 76) as to why the defendant's patent expert, Professor Chu, and Mr. Blonder could not be available at the start of the postponed trial. It was explained that the technical aspects of the litigation were matters that had been prepared for over a period of a year with Professor Chu. The record shows that this technical information involved the presenting of expert testimony with regard to specific prior-art patents (R. 19 and appendix B hereof -- many not cited by the Patent Office ^{or} as in the Winegard litigation) which were asserted by defendant against plaintiff's patents and as to which the record shows the defendant was deprived not just of the testimony of its expert, Professor Chu, but of any witness whatsoever to explain this prior art and its bearing upon the anticipation of plaintiff's patents.

Repeatedly, the defendant made profert of this essential testimony in this complicated patent case and complained about being handicapped by not having any witnesses (R. 74-75; 90,153).

At R. 90, plaintiff made profert of what was to be proved by its witness; namely that "the subject matter of the ^{claims of the} two university patents was fully anticipated by the prior art". The subsequent colloquy with the Court clearly delineated the defendant's concern that this is what he would prove if defendant was "going to have witnesses". Defendant further made profert that such testimony would show that "these two patents were clearly obvious to the ordinary skilled worker".

The record further shows that the defendant had no opportunity to have its day in Court on the issue of the prior art which it asserted against the patents in suit and the issue of obviousness, being unable to secure even Mr. Blonder's return until after plaintiff's case-in-chief and defendant's defense.

In Graham v. John Deere Co., 383 U.S. 1, 17, ⁽¹⁹⁶⁶⁾ the United States Supreme Court recently defined what constitutes the issues in cases of this sort and what kinds of proof are necessary, including evidence relating to "the 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".

Defendant was deprived of its right to present its own evidence on any of these issues.

In addition, in connection with defendant's counter-claim on its own patent, both the District Court and this Court have declined to follow the mandate of the Supreme Court as to the above specific findings required in order to invalidate a patent as "obvious".

Certainly, as this Court agrees, the District Court made no such findings; and this Court also failed to make these specific findings required by the Deere case, and refused even to remand the case to the District Court to comply with the law. Failure of this Court either to make those findings or to remand the case in connection with the Blonder-Tongue patent counter-claim, deprives defendant of requirements that the Supreme Court has said must be met.

It is our respectful hope that this Court will see fit en banc to reconsider and clarify its position sustaining the District Court's

treatment of defendant in the above particulars, and will restore the confidence of defendant, the people, and the bar in the fair ~~part~~ of our judicial system.

THE LATEST PRONOUNCEMENT OF THE SUPREME COURT ON COMBINATION PATENTS

The latest pronouncement of the Supreme Court on combination patent ^{is} Anderson's-Black Rock, Inc. v. Pavement Salvage Co., Inc. ^{24L. Ed. 2nd 258 (December 18, 1969)} calls for a change in this Court's decision on the Isbell patent.

In this case, the Supreme Court unanimously has modified the old principle of law to the effect that a combination of old elements for producing a new result is patentable.

While that principle of law still stands, it has been modified. The modification consists ~~ex~~ in the following particulars:

If the new combination consists of an old combination plus a new element, and if that new element operates in the new combination the same way as in the prior art (being an old element in the prior art), then the new combination is not patentable.

This Court of Appeals in its decision herein has held the Isbell combination to consist of an old combination plus the additional element of the log-periodic contribution. This log-periodic construction ^{however,} operates in the new combination, ^{log periodic} in precisely the same way as in prior art antennas, to provide broadband response.

Since this Court of Appeals did not have this new decision before it, rehearing and reconsideration is requested of the holding of validity of the Isbell combination claims.

which log periodic construction this element is not to be old per se in the prior art

OTHER REASONS FOR INVALIDITY OVERLOOKED BY THE COURT
OF APPEALS

Defendant wishes to apologize to this Court for not having called its attention to highly germane prior art bearing on anticipation and obviousness, simply because defendant felt it had not had its day in court to make complete proofs of the prior art and the issue of obviousness, having no patent expert or witness at all at the trial of plaintiff's patents. As matters turned out, this Court chose to use the prior art of the Winegard trial as a substitute; but, in fairness, defendant could hardly have anticipated such a novel ~~at~~ tack.

Since it now appears that this Court (unless it now agrees with the showing above as to lack of due process) will not permit defendant to have a trial with a patent expert, it is desired to call attention to items in the record that have apparently been overlooked by this Court and that show complete anticipation of what this Court has held that Isbell contributed --- evidence adduced in defendant's partial case as developed on cross-examination.

This Court has found the Isbell simple dipole array to be old except for the making the lengths and spacing of the successive dipoles successively geometrically progressively smaller (to produce the less than unity ratio of successive lengths), the so-called log-periodic concept. While this Court correctly found that the concept of such log-periodicity "was known in the prior art", it concluded that since not every logarithmically periodic ⁿantenna has the desired frequency independent broadband characteristics", it would not have been obvious to apply the same to such a simple old dipole array.

In the first place, not all the Isbell patent claims even call for this geometric progression in both "the lengths of successive dipoles and the spaces between the dipoles", which this Court has held defined Isbell's contribution. ^(dictum - correct but also known in prior art) Claims on their face, call only for successively

tapering lengths, and have no requirement for spacing.

this is perfectly

This Court is requested to classify if it intended to say that mere tapering lengths alone was an invention, and whether such claims are valid since they do not respond to the geometrical progression of lengths and spaces which this Court has held ^{to} ~~is~~ necessary ^{to} ~~is~~ invention.

of the Isbell
~~But~~ ^{fraction} the record shows, in the admission of plaintiff's own expert, Mr. Harris, that long prior to Isbell, ^{however,} prior inventors had proposed to make this geometrical progressive variation and for the very purpose of getting broadband (frequency independent) performance.

With regard to the prior-art Katzin patent simple dipole antenna (Patent 2,192,532, D. Ex. 3~~8~~ ^{, copy of which is annexed as appendix 4} Mr. Harris admitted (R.170-172) (1) that the dipole lengths were "continuously tapering in lengths from one end of said antenna to the other"; (2) that even the spacing was to be made shorter ^{and longer between the longer elements} between the shorter elements, and (3) that the very purpose of this was to get a "wider band" characteristic.

Since this Court found everything to be old except the concept of applying the geometrical progression of dipole lengths and spaces for obtaining wideband response, this clearly shows anticipation.

^{misleadingly} This Court has recognized that Jasik, writing in 1961, pointed out that the Isbell structure could be derived by "letting the tooth width and the angle (beta) approach zero and then folding the two-half structures about the horizontal axis so that the angle (psi) approaches zero".

This Court has found this observation "correct", but deemed it "a hind-sight analysis, and not an indication that it would have been obvious to modify previously known figures in the manner indicated".

What this Court inadvertently overlooked, however, is that the DuHamel and Ore patent 3,079,602, ^{filed on —, long prior to Isbell and} Feb. 26, 1963 ~~is~~ referred to in footnote 13 of this Court's decision, actually specifies those very

modifications, ~~and~~ long before Isbell; and Dr. DuHamel had to admit this on cross-examination following his statements of "surprise" ~~x~~ quoted by this Court:

1. angle (psi) approaches zero - DuHamel et al patent 3,079,602, D. Ex. 14 Col. 6 - "angle psi" may be "zero".
Dr. Hamel cross-examination: Model D. Ex. 24 "corresponds to...Fig. 5 of defendant's Exhibit 14... angle psi approaches zero" R. 375.
2. angle (beta) approaches zero - DuHamel cross-examination re the DuHamel et al patent 3,079,602:
"Q: The angle beta has, in fact, been reduced to zero in Fig. 5, has it not.
A: Yes..."
3. tooth width approaches zero - DuHamel cross-examination re the DuHamel et al patent 3,079,602:
"Q: And at the ends of the triangular teeth is not the thickness reduced almost to zero?
A: It's quite small, yes..."

*(Dude - 4/10/61
3,079,602
Hamel's in the
1961, 1962)*

Thus the record contains the clear teachings of the DuHamel et al patent (long preceding Isbell), and the admissions of DuHamel on cross-examination following his statement of "surprise" on direct examination, that the very changes which this Court has held would anticipate Isbell (except that Jasik wrote in 1961 ^{with what the Court termed} "hindsight"), were actually conceived and suggested by DuHamel and Ore long before Isbell, all with precisely the same log-periodic variation in dipole length and spacing with exactly the same "tau"/value referred ~~by~~ to by this Court. (R. 375)

No speculation is thus needed about "obviousness" -- there is an exact teaching anticipating Isbell.

TIME
THE COURT HAS CONSIDERED THE WRONG KIND IN CONNECTION
WITH OBVIOUSNESS

This Court has correctly stated that, at one time, in the early development of log-periodic antennas "shortly after 1954," ~~stated by the Court, (or~~ ^{and} at the 1958 date of the DuHamel paper quoted by the Court) there was "no set of principles by which to predict the presence or absence of such characteristics " of frequency independent broadband response.

It is for this reason that this Court concluded that applying the old log-periodic concept to old simple dipole arrays of the Isbell type was "unobvious".

But the law is clear that we must look not at the condition of obviousness years before an invention, but, rather, to what was obvious at the time of the invention (Deere case, supra).

The record in this case is unequivocal that at the ~~late 1950~~ ^{later} date when Isbell was first proposing his dipole array ("zero tooth width," D. Ex. 7) the log-periodic art had advanced to the point where principles did exist to predict broadband operation.

Indeed, because the log-periodic art had advanced to such a state where "The experimental results which have been obtained for the multielement log-periodic antennas are found to be predictable"... (p. 2, emphasis added, D. Ex. 7), Isbell was able to propose in this ^{very} same report that he build his antenna!

If this Court does not concur that this shows obviousness at the time of the Isbell work, then clarification is requested as to what the Court holds to be the time period when ~~the~~ log-periodic performance

Advanced unpredictable

OF THE ISBELL ANTENNA
THE PRIOR PUBLICATION IN REPORT NO. 2

It is believed that this Court has overlooked the fact that the District Court made a specific finding of fact that the above-mentioned report, ^{fully} ~~further~~ disclosing the Isbell concept, "was in the Publications Office on April 30, 1959, and was ^{therefore} ~~to have~~ 'available for distribution upon request on that date'".

The District Court stated its finding that this was true; and said that if this were a library,

"even a very small or highly specialized library, ^{court} this/would be compelled by the weight of authority ^{to} ~~to~~ hold that such availability constitutes 'publication' within the meaning of Sec. 102" (R. 829). It is believed that this Court has failed to give the required finality to this finding of the District Court in substituting its own speculation that

"It is unlikely that a copy of the report in question reached the 'library' before May 3".

Throughout its decision, this Court has stated that it was not in a position to upset the findings of the District Court unless clearly erroneous.

^{therefore,} ~~therefore~~ ^{Accepting the above finding of the District Court,} it is ~~therefore~~ requested that this Court apply the law, since it has indicated that this was indeed a "library".

Under the established law, as admitted by the District Court, ~~to have~~ the Isbell patent ^{to} ~~not~~ ^{be} ~~invalid~~ for publication more than a year before its filing date.

remained unpredictable.

INFRINGEMENT

This Court has concluded that because "it is difficult or impossible to construct the Isbell antenna...so that all dipole elements lie exactly within one plane", the District Court was correct in holding a spacing of two planes "of the order of an inch" to be "substantially coplanar".

But that "order of an inch" only applied to the Blonder-Tongue Dart antenna.

In the Blonder-Tongue Color Ranger antenna, P. Ex. 35, (using the V antenna of the invalidated Mayes et al patent), the spacing is much greater, about a third of a foot -- clearly not dictated by any possible difficulty in constructing the elements in one plane.

Since this Court's reason for upholding "coplanar" was predicated on the "inch" construction only, it is requested that this Court clarify its views with regard to the Color Ranger antenna with almost four times that separation.

The District Court did not, of course, follow the long-accepted procedure ^{and requirements} of making findings of fact as to the response of the language of a single one of the claims of the Isbell patent to a single one of defendant's antenna structures. In fact, plaintiff itself failed to do this, giving rise to an unacted-upon motion for judgment following plaintiff's case #1 (R. 218-229).

Did this Court mean by its statement that "Other issues... will have to be resolved on remand", that the District Court is now to make this determination and make the required detailed findings (as distinguished from ^{conclusion} disclosure) of infringement of the elements of the claims?

^{superficially}
Clarification is requested.

UNCLEAN HANDS

This Court has found that plaintiff was a patent applicant who

"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 than overcome the rejection".

But this Court failed to apply the rule established by the Supreme Court in, for example, Premium^{er} Instrument Manufacturing Co. v. Automatic Maintenance Machinery Co., 324 U. S. 806, 818, (1945)

that such a patentee is to be denied relief of his complete claim, for unclean hands.

The Mayes et al patent and the Isbell patent were inter-related, the former referring to the latter as part of its disclosure; and both patents were contemporaneously ~~presented~~^{presented} in the Patent Office, and were used together in the market place to restrain competition, and both ~~were~~^{asserted together and} sued on as a unit and tried together in this cause by the common owner.

It is believed that, irrespective of the matter of validity, equity requires the denial of relief to plaintiff on its complete cause under the above doctrine and law.

UNFAIR COMPETITION AND ANTI-TRUST VIOLATION

This Court also appears to have overlooked the Supreme Court mandate that where a patent has been obtained by what this Court has called "a half-truth", and that patent is ruled invalid, ^{as here,} and has been used in the market place as a club to restrain competition by the dominant suppliers in the market (D. Ex. 42 - B101, J6), this is a violation of the anti-trust law. (Sec. 2 - Sherman^{Act}; Walker Process Equipment, Inc. v. Food ^{Machinery &} Making and Chemical Corporation 382 U. S. 172 (1968)).

The District Court could not and did not pass on this issue since it did not find the "half-truth" nor the invalidity.

It is believed that this Court ^{having made these findings} should thus apply the law.

The District Court, though ^{it} finding certain acts to have occurred, moreover, concluded that none were themselves unfair competition or anti-trust violations. This Court agreed.

But this Court failed to speak on the well-established law that even if none of these acts of themselves constituted violations, the series or pattern (which the District Court found did occur) is, as a matter of law, at least unfair competition. *Electrolux Corp. v. Kai North* Tex. stat. 161 N.E.2d 197 (1959); *American Tobacco Co. v. United States*, 328 U.S. 781, 809.

Conclusion: →

Particularly in view of what appears ^{to be} ^{the} applications of legal principles and procedures contrary to a series of the more recent pronouncements of the Supreme Court with regard to due process, ~~and~~ necessary findings in patent causes, and the treatment of unclean hands, unfair competition and anti-trust matters in patent causes, it is believed that this case is worthy of consideration by the Court en banc to avoid ^{the} conflicts in the law between ^{the Circuit Courts and the} Circuits in connection with the Isbell patent ~~here~~ in suit, and conflicts with the ~~clear~~ more recent pronouncements of the Supreme Court. Clarification ^{is thus respectfully requested, as is} ^{deemed} as indicated, reconsideration and rehearing, if ~~determined~~ desirable, ~~are respectfully requested.~~

Appendix A

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Katzin Patents

Appendix B

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List of Exhibits
March 27, 1967
(if this involves in-
tended prior art)

Appendix C

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List of witnesses
(if this shows what
they would testify
to).