PATENT PRACTICE

INTERFERENCE WORKSHOP

Importation: A Reduction to Practice?

I. Section 104 of Title 35 of the U.S. Code.

A. In the preceding review of the substantive law, it was brought out that the invention must have been made "in this country". 35 USC Section 102(g). What about inventions made "abroad"? Is there no possibility to rely on a date earlier than the US filing date or the foreign Convention date?

B. Section 104 which is entitled "Invention made abroad" stipulates:

> "In proceedings in the Patent Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title...."

C. Section 104 has been decried by foreigners as unfair and discriminatory. However, the statute does not distinguish between citizens of the United States and foreign countries but between inventions made in the United States and in other countries. (For this reason, Prof. Irving Kayton of the George Washington University has suggested that reference to "extraterritorial" inventors would be more appropriate than reference to foreign inventors.) U.S. citizens residing abroad are also subject to

Section 104 - except for those "domiciled in the United States and serving in a foreign country ... on behalf of the United States" (Section 104) - and foreigners living in the United States are not.

D. Fortunately, there are ways and means to neutralize Section 104 in a perfectly legitimate manner, namely, by importation of foreign inventions. In a manner of speaking, importation is another exception to Section 104. The best known exception, expressly covered in Section 104, is reliance on a foreign Convention application under Section 119. Under this section the foreign applicant, however, can go back only up to one year. Thus, Section 119 is a limited tool. With importation one can go further back in time much like with a domestic invention.

II. Significance and Incidence of Importation

A. There has been a tremendous growth of multinational enterprises and international business relations. Technology transfers take place, joint research and license agreements are concluded and business men and inventors travel back and forth. Foreign companies have operations in the United States and vice versa.

B. Indeed, a high percentage of the applications pending in the U.S. Patent & Trademark Office (PTO) is of foreign origin and of course a high

percentage (more than one third) of the issued patents is of foreign origin and with respect to many of these applications and patents importation opportunities or problems may surface.

C. In many of our interferences involving applications of foreign origin importation has been relied on and where this is done reference is made to reports and samples coming over and trips being made back and forth with knowledge and embodiments of the invention being "imported".

D. And in more recent interferences in which we got embroiled and which also involved foreign applicants, notably, German applicants, acts of importation are now also being relied on by them, i.e., by others. Also, in very recent times there has been an increase in interferences involving importation issues and the momentum appears to be gaining.

E. There are a number of situations and circumstances where importation is indeed advisable and can be of concrete value:

1) When there is delay in filing a foreign priority application.

2) When the priority application is abandoned and refiled and a new priority year is started.

3) When a non-Convention application is filed.

4) When Convention filing is missed. See Schmierer v. Newton, 158 USPQ 203 (CCPA, 1968).

5) When the required certified foreign priority application is not timely filed in the U.S. PTO.

6) When the foreign application has generally insufficient disclosure. See Kawai v. Metlesics, 178 USPQ 158 (CCPA, 1973).

7) When post-dating in Great Britain takes place and Section 119 precludes a claim of priority. See In re Clamp, 151 USPQ 423 (Com. 1966).

F. But even if it is possible to rely on a foreign priority date, and the priority application is good, it can still be helpful to resort to earlier importation. In a priority conflict between two foreign applicants, the one with the later priority date will not get far in an interference unless he can allege earlier importation in his Preliminary Statement. The same is true in an interference between foreign and domestic applicants, where the foreign applicant's priority date is still not early enough to enable him to prevail over the domestic party.

G. In spite of contrary arguments made by opponents, it is clear that one can depend at the same time on the foreign priority application and on acts of importation. There is no need to make an election between one or the other. Wilson et al. v.

Sherts et al., 28 USPQ 379 (CCPA, 1936), Lassman v. Brossi et al., 159 USPQ 182 (Bd./Interf., 1967). Thus, like in an interference involving domestic parties, both courses of action are open.

H. In multi-national companies technology transfers take place on a large scale and importation is taking place frequently though unwittingly. This can have ironic consequences: there is importation as a substantive matter - de facto - but not provable as an adjective matter - de jure. Research reports, models, samples or what-have-you come in from abroad and there are visits back and forth. However, unless proper procedures and safeguards are established, it is unlikely that importation can be proven as a legal or procedural matter. See Rochling et al. v. Burton et al., 178 USPQ 300 (Bd./Interf. 1971).

I. Thus, this subject is a very practical one and of ever greater significance. And note that it presents interesting implications not only in interference practice but also in patent prosecution, i.e., Rule 131 practice - see Ex parte Pavilanis, 166 USPQ 413 (Bd./App., 1969) and file history of U.S. Patent No. 3,448,200 - and in validity studies. Re the latter it can not be taken for granted that a

foreign priority date relied on in a U.S. patent is the very earliest date beyond which the patentee cannot go to overcome a reference or establish an invention date. Query: Importation of a foreign invention even in cases where no U.S. application is filed or U.S. patent taken out could also be useful in patent infringement litigation as a defense of prior invention under Section 102(g), could it not? Applies to CIP subject matter as well!

III. Importation of Foreign Disclosures

A. Before a set of appropriate procedures and safeguards can be suggested the case law should be reviewed and the legal principles that can be deduced therefrom established. As regards the case law, however, the cases dealing with importation of foreign disclosures and starting with a 1880 decision, Thomas V. Reese, 1880 C.D.12, are too numerous to discuss here in detail. Suffice it to refer to my prior importation talks and papers, e.g., 10 C.P.R. (2d) 272 (1973); CIPA, p. 191, March 1975 and to the appended chronological list of importation cases.

B. Also, this presentation, as the title reveals, is to turn on reduction to practice, i.e., the issue of whether importation of an embodiment of a foreign invention is tantamount to reduction to practice in this country and

the point of law that importation of a foreign invention disclosure is tantamount to conception in this country is well-settled and hardly controversial - note that Rule 217 and Form 45 of the Rules of Practice countenance Preliminary Statements alleging importation of foreign disclosures - except perhaps for the rather novel principle enunciated by the Board of Interferences in the most recently published decision in this area, Clevenger v. Kooi, 190 USPQ 188.

C. It may be interesting to recount at least one unusual case in addition to the Clevenger v. Kooi decision discussed further below.

General Talking Pictures Corp. v. American Tri-Ergon Corporation et al., 36 USPQ 428 (3d Cir. 1938). The inventor, a United States citizen, sailed from New York on October 6, 1918, aboard a ship of British registry. On October 12, 1918, while at sea, he had a conversation with his patent attorney, Samuel E. Darby, who was also on board the ship and reduced the conception of the invention to writing and later corroborated the story. The inventor was entitled to the date of his re-entry into the United States as his date of conception.

D. The legal principles that can be deduced from the line of cases dealing with importation of disclosures excepting Clevenger v. Kooi, is that

the "extraterritorial" inventor may establish a U.S. priority or an early invention date by reference to activities in the U.S. by persons acting on his behalf. Such inventor is awarded a conception date as of the day when the invention is first disclosed to and understood or possessed by his representatives in the U.S. or brought back by a resident to whom the invention was disclosed abroad. The inventor himself does not have to go to the United States. Introduction of the knowledge or description of the invention is thus conception or tantamount to conception in the U.S. when it is read and understood by someone in the U.S. capable of doing so. The disclosure must, of course, be adequate and full.

E. At this point and in this context mention should be made of the Disclosure Document Program of the PTO. Insofar as foreigners are concerned this could be construed as providing for importation of disclosures of foreign inventions. Filing of a Disclosure Document would establish of course only a conception date. Query: is it even that much since it is not read and understood by someone who could corroborate this and is kept only for two years and then thrown away unless a patent application has been filed and reference to the disclosure document has been made? Clevenger v. Kooi seems to provide an affirmative answer.

IV. Clevenger v. Kooi

A. Does Clevenger v. Kooi, supra, or the rather novel and almost startling principle enunciated in it, dictate any change in the rules distilled from the line of prior cases and in any importation procedure based thereon?

In Clevenger v. Kooi, involving an interference between Texas Instruments and U.S. Philips, it was held that the introduction into the United States of a copy of an original invention disclosure which was prepared by the Philips parent company in Holland and which contained an enabling disclosure of the invention of the counts, constituted a conception of that invention in the United States and that it was not necessary that the disclosure in question be both communicated to and understood by someone in this country in order to constitute such conception.

According to this decision, importation of a disclosure of a foreign invention which is tantamount to conception in the US is established when a disclosure is received here and filed away without having been read by anybody, the only requirement being that it contains an enabling disclosure. This raises immediately the question of whether it was necessary to continue to "import" foreign invention disclosures by reading them and annotating them as

having been read and understood by at least one person and preferably two persons capable of reading and understanding them which is the procedure that I recommend and that we have followed for years.

B. My first reaction when I read this decision was that the Board had really gone out on a limb. I thought that this decision put foreign inventors in a better position than U.S. inventors because a U.S. inventor could not simply prepare a disclosure and have it filed away without anybody having read it. If this was possible why the universal and conventional practice of witnessing or even notarizing conception records or invention disclosures? I also thought that Mortsell v. Laurila, 133 USPQ 380 (CCPA 1962), did not support the position taken by the Board in Clevenger v. Kooi, because in the Mortsell case a disclosure from abroad, namely, a draft patent application was being translated in this country, revised and worked up into a final U.S. text which is an entirely different situation from the one found in Clevenger where a disclosure was simply put away to collect dust.

C. Incidentally, there exists an earlier (1967) but unpublished Board Decision, Scheer v. Kincl (U.S. Pat. No. 3,390,157; Interference No. 92,644 involving Syntex and Johnson & Johnson). Here too, a Mexican invention disclosure was simply filed

away after it was received in the US and here too the Board held that reading and understanding of the foreign invention disclosure was unnecessary. In spite of this holding, Syntex lost the interference however for lack of "attorney's diligence".

D. On further reflection, I am convinced that Mortsell v. Laurila is being extended by the Board in a way unwarranted by its facts. Besides, the Board relies too heavily on specific language of the CCPA which is dictum and not decision. Also, the cases relied on in Scheer v. Kincl do not support the Board in the position they take. This is especially true of the Levy v. Gould (32 USPQ 397) decision in which there was so much frantic activity by the inventor involving disclosures to elicit interest, witnessing and notarizing and whatnot so that the facts in that case are a far cry from the facts in Scheer v. Kincl where a Mexican disclosure was simply filed away in Palo Alto. Also, I am not sure that it is sufficient for a US inventor to simply hand his disclosure over to a third person who puts it away without even looking at it. At best, this is still an open unsettled question; at worst, the case law would seem to militate against such a rule. If pro cases exist, why didn't the Board rely on them; Mortsell is no authority, as explained above.

V. Importation of Embodiments of Foreign Inventions

A. While the law is well-established that importation of a disclosure of a foreign invention is tantamount to conception in the U.S., it is not nearly as well appreciated that importation of an embodiment of a foreign invention is tantamount to reduction to practice, especially with respect to complex inventions, e.g., chemical compounds and electronic apparatus. I have always maintained that it should be as it was simply and manifestly clear even from the few cases which are on the books that in proper cases, properly proven, importation of the physical object or embodiment of an invention made abroad accompanied by full and clear disclosure of its nature and identity and its mode of production and use, is tantamount to reduction to practice in the U.S. No separate and independent reconstruction, reidentification and retesting should be necessary in the U.S. For me, the question mark in the title is an exclamation point.

B. On this issue, a more detailed review of the cases is indicated.

1) In Swan v. Thompson, 28 USPQ 77 (CCPA 1936), Swan made the invention which related to safety razors and blades therefor in England. He brought samples to the United States - later exhibits in court - and with intention to sell his

invention showed them in the U.S. to Thompson of Gillette and others, some of whom shaved with them. Swan introduced testimony taken in England and here to show, among other things, that when he brought the razors and blades into this country he was in complete possession of the invention. The court, reversing the Interference Examiner and the Board of Appeals, ruled for Swan.

2) In French v. Colby et al., 64 USPQ 499 (D.C. Cir. 1945), cert. denied 326 U.S. 726 (1945), foreign inventors (French et al) sent from their office in England to their U.S. "affiliate" a letter dated January 27, 1939 describing the invention and enclosing a sample (integrally woven ladder web for venetian blinds). The letter was received in the New York office of their U.S. affiliate by one Harris in "early February", who in turn took it "early in March 1939" to one Gibbons, the manager of their mill in Massachusetts who was capable of understanding the invention. The U.S. inventors' (Colby et al) "date of disclosure" was March 6, 1939. The court in reversing the District Court held:

> "We agree with the Patent Office that French is entitled to a date early in February 1939, when his letter was received in New York. [citing Winter v. Latour, supra, and Rivise & Caesar]. The letter specified the problem to be solved described the solution, and enclosed a sample. The

> invention is sufficiently simple... to be understood even by a non-expert person. But in any event, it passes belief that Gibbons, an admitted specialist, who had been working toward a solution of the same problem should have had the slightest difficulty in understanding the invention when the sample was shown to him prior to March 6, 1939."

It is interesting to note that Colby had argued - to no avail - that it was necessary to examine the specimen under a magnifying glass in order to understand it.

3) In Kravig et al. v. Henderson, 150 USPQ 377 (CCPA 1966), a machine for fabricating decorative bows was brought in from Canada by the Canadian Henderson and installed and operated at Plattsburg, New York, by others allegedly in 1955. The Board of Interferences had awarded all four counts to Henderson, even though he had to prove his case byond a reasonable doubt. However, the CCPA on appeal awarded Henderson only two counts because the other two counts did not read on the imported machine. [Two years later the CCPA had this case again before it and it took away those two counts also because new evidence had shown that the machine had not been brought in as early as had been alleged. 157 USPQ 564 (CCPA 1968)].

4) Andre v. Daito, 166 USPQ 92 (Bd./Intf. 1969), manifestly was an importation case even though this is apparent not so much from the decision as from the file history. Andre, a U.S. business man, conceived a design of a desk lamp in this country and went to Japan where he reduced it to practice. He brought back a model and the day when he arrived in San Francisco with the model was the day of his reduction to practice. This was on September 4, 1966. Daito filed in Japan on September 12, 1966; he was senior party inasmuch as Andre had only filed on December 27, 1966. The holding was that "Andre had both conceived and reduced the invention to practice prior to Daito." Id. at 93.

5) In Weigand v. Hedgewick, 168 USPQ 535 (Bd./Intf. 1970), the invention which related to safety caps for containers of medecines, was independently made by two Canadians whose applications were respectively filed on April 5, 1966 and June 27, 1966. The senior party Hedgewick took no testimony but Weigand introduced "a mass of testimony and exhibits" the bulk of which related to "activities occurring wholly in Canada leading up to the asserted introduction of the invention into the United States". However, the only evidence relating to the actual receipt in the U.S. of a

sample and a pamphlet was by one Simmons, the Executive Secretary of the National Association of Retail Druggists, to whom Weigand wrote in an attempt to promote his invention in this country. Unfortunately, Simmons could only recall that he saw the sample and that there was some information that accompanied the sample. He remembered no details and the sample was lost. Under these circumstances, the decision went against Weigand.

6) In Rochling et al. v. Burton et al., 178 USPQ 300 (Bd./Interf. 1971) Shell synthesized compounds in Germany and sent them to California for testing but in an interference failed to prove priority vis-a-vis an earlier filed application of British origin. While Shell were able to establish herbicidal utility by virtue of the California tests, they "failed to establish the identity of any of the compounds tested" or rather "the identification of the compounds in question (was) dependent entirely on information allegedly obtained from the (German) inventors".

Noone in California who handled the imported compounds knew the chemical nature of the compounds other than the code numbers, no analytical data having been supplied by Germany, and the compounds were not analyzed before they were placed in the screens by anybody and there was no dis-

cussion of any specific compounds with one of the inventors while visiting in California.

VI. Foreign Inventions of a Complex Nature

A. Of course in the case of a simple invention like a lamp design, a safety cap and a ladder web for venetian blinds and perhaps even a razor and a machine for making bows, mere visual inspection may reveal the nature of the invention and its mode of construction and use. However, complex electronic apparatus and chemical compounds defy visual identification, but that does not mean that therefore they cannot be imported as a legal matter without being reduced to practice in the United States all over again. It merely means that the burden of proof is different and more onerous. It is then indispensable, in order to establish the nature or identity of the invention, to submit evidence based on actual or stipulated testimony taken abroad or in the United States in case the inventor and his representatives come here for the purpose. A whole chain of evidence may then have to be forged to demonstrate, for example in the case of a chemical compound, that the compound made was the compound analyzed, that the compound analyzed was the compound tested, that the compound tested was the compound shipped and that the compound shipped was the compound received.

B. It is perfectly clear that Section 104 does not ban, and never has banned, testimony relating to acts outside the United States where the testimony is used to show merely the identity of an invention introduced into the United States and is not designed to establish dates of invention abroad. Some of the cases cited herein bring this out.

C. As an alternative and a desirable backstop to such "foreign corrboration", an independent analysis in the case of chemical compounds could be carried out in the United States so that one or more persons know of their own knowledge the identity of an imported compound. In most cases, however, it would be a tall order to make a complete analysis. Perhaps one reliable test, a so-called finger-print test, as for example, an X-ray determination, to at least corroborate the structure, is all that is needed. Even this is a tall order if hundreds of compounds are being imported from abroad.

D. In these cases, it might perhaps be sufficient to keep a sample or sub-sample of every compound and do analytical work at a later date for those few compounds only which are tagged as commercial candidates or when an interference or other conflict erupts. There should be no

problem of nunc-pro-tunc reduction to practice which is frowned upon by the courts [Heard v. Burton et al., 142 USPQ 97 (CCPA,1964)]; perhaps such practice can be brought under the rule of General Motors v. Bendix, 102 USPQ 58 (D.C. Ind., 1954) to the effect that subsequent tests are admissible to corroborate and supplement evidence relating to prior reduction to practice.

E. In discharging the burden of proof regarding the identity of the invention whether it be by forging a chain of evidence from preparation abroad to receipt in this country or by making an independent analysis in this country or both, one must keep in mind of course that corroboration should not "be based on facts the truth of which depends upon information received from the inventor [Thurston v. Wulff, 76 USPQ 121, (CCPA 1947)] as was the case in Rochling v. Burton, supra.

VII. Breuer et al. v. DeMarinis

A. The latest very significant "importation" case which is very relevant in this context, is Breuer et al. v. DeMarinis, 194 USPQ 308 (CCPA 1977), in which Squibb and SmithKline were the protagonists. In this case, the CCPA overruled the Board of Interferences, recognizing "the realities of technical operations in modern day research

laboratories" and hence taking a "rule of reason" approach as they are wont to do nowadays in determining the type and amount of evidence necessary for corroboration. Specifically, the Court held, albeit in a Rule 204(c) context, that it would be "unreasonable" to require a second, domestic chemical analysis of a compound introduced into the United States by the junior party when, based on a previous analysis performed abroad (IR spectrum which the Court considered to be a "fingerprint"), professional researchers are able to state that the compound corresponds to the subject matter of the interference count. The Court stated (at p. 313):

> "Clearly, 35 USC 104 does not preclude using evidence of the inventor's knowledge from a foreign country for all purposes, but only where it is used to 'establish a date of invention.' See Hedgewick v. Akers, 182 USPQ 167 (CCPA 1974). Here, the knowledge of the inventors, embodied in the Transmission Record, is admissible evidence to prove the chemical structure of the compound introduced into this country. Cf. Rebuffat v. Crawford. ... 20 USPQ 321, 324 ((CCPA) 1934)."

The Board had found that "no person analyzed the compound in the United States to determine or confirm its structure" as the subject compound and, citing Rochling v. Burton, supra, held that "(i)inasmuch as applicants have failed to prove knowledge of the structure in the United

States prior to patentee's filing date, they have not made out a prima facie case ...".

B. The question comes up with the Breuer case as to whether or not an independent analysis to determine or corroborate the nature or structure of the foreign invention object is still necessary. It really should be possible to eliminate any costly duplication in this country in view of this case. Though the Breuer case did relate to a 204(c) showing, the legal principle enunciated therein is sound and authoritative coming as it does from the CCPA. Apart from the mechanics of foreign corroboration and the problem of doing it adequately, the only differences, as far as legal principles are concerned, between the Breuer (204(c) situation and a full-blown priority contest is that in the former a prima facie case has to be made with respect to the opponent's filing date and in the latter there is a burden to prove priority with respect to the opponent's invention date. In the latter case the testimony is subject to cross-examination and this may change the procedural aspects without affecting the legal principle.

C. None of the cited cases on importation of embodiments decides the ultimate issue in the law of importation of foreign inventions, namely, whether introduction into the US of an embodiment

or the physical object, e.g., by way of a sample or model or prototype, of complex invention made abroad, especially, e.g., electronic apparatus or chemical compounds, is tantamount to reduction to practice in the U.S., where accompanied by a full and clear disclosure of its nature and identity and its mode of preparation and use but where no re-construction, re-identification and re-testing or other work took place in the U.S. This decision is still reserved for the future. It will come. Nonetheless, the Breuer case represents a most significant advance as it clearly enunciates the principle that no additional analytical work in the US is required if the foreign analytical data are adequate to identify the invention and to apprise R&D personnel in the U.S. of the identity of the invention. I think the Breuer case brings us very close to that ultimate decision since earlier cases on mechanical devices established that no separate reduction to practice need be carried out in the U.S. The biggest of the remaining issues was the matter of proof of identity of the invention, especially of complex inventions that defy visual identification. And this the

D. Query: Is the situation different when a method of making or using is involved?

VIII. Diligence

A. In addition to conception and reduction to practice or something tantamount to it, diligence may also be an issue. On the one hand, perhaps, diligence is the most serious problem if there is an importation of knowledge of an invention and nothing further. On the other hand, no diligence problem need arise if a completed invention is imported including a model, sample or prototype or if a patent disclosure is sent to a U.S. attorney who works diligently with it towards filing in the United States or a machine or compound is shipped in for testing or use which is diligently carried out.

B. An interesting legal point here is whether on the diligence issue activities abroad can be relied on if coupled with activities here. Section 104 would seem to preclude it. Rivise & Caesar, Interference Law & Practice, Vol. I, Sec. 187, p. 585 (1940) indicate that it can be done and cite Wilson et al. v. Sherts et al., supra, for this proposition. There the court stated that "activities abroad ... unaccompanied by any activities in the United States may not be considered in establishing diligence..." citing Hall v. O'Connor, Interference No. 51,743, an unpublished decision, where there were activities in the United States and in Canada and the Board

held that the Canadian activities could be relied on although the work done in the United States would have been sufficient

C. In Lorimer v. Erickson, 1916 CP 200 (App. D.C. 1916), evidence of diligence abroad was admissible. Lorimer conceived the invention in the United States in 1904. He then went to France, where he built and operated a successful embodiment. He returned in November 1905 and on November 18, wrote to a patent attorney to begin preparation of an application. The application was filed in April 1906. Erickson's date was December 9-15, 1905, so that Lorimer's diligence was the crucial question. The Court found that he had been diligent, and in so holding clearly considered Lorimer's activity in France, for it said

> "Diligence in the particular case depends upon the special facts and circumstances attending it. It is quite clear that Lorimer never gave up the invention. He carried it to France with him where he was engaged in filling a contract of his employers with the French Government, and there constructed it and tested it completely with the automatic telephone system then installed.
>
> Appreciating the importance of the invention, he immediately upon his return to the United States disclosed it to the patent attorney ... He was not concealing the invention, nor did he show any intention to abandon it ..." Id. at 203.

D. There are no recent CCPA or other Court decisions which expressly permit such coupling by way of an exception to Section 104. But in a recent and unusual case, Rosen et al. v. NASA, 152 USPQ 757 (Bd./Interf. 1966) involving a satellite communication system, the PTO countenanced coupling (citing Wilson v. Sherts, supra) since the system necessarily extended outside the U.S. Admittedly, this is a special situation and while neither the Wilson nor the Hall cases can be considered as sound precedents, coupling as a practical matter may be possible as is illustrated in Mortsell v. Laurila, supra. If the ball bounces back and forth, so to speak, as was the case there with respect to the preparation, review and execution of a patent application, perhaps it can be said that while the ball is abroad there is at least a reasonable explanation for the inactivity in the United States at the moment.

E. However, in a recent as yet unpublished decision in Interference No. 98,504 (Newberry v. Klemm et al.), the Board ruled that mere periodical circulation and perusal in the U.S. of test reports and lab notes regarding a British invention was inadequate to make out a case of diligence during the critical period.

IX. Conclusion

A. Based on the given case law which also takes into account the Breuer decision but discounts the Clevenger case, the law of importation of foreign inventions can be summarized as follows:

1) Introduction of a disclosure or knowledge of an invention made abroad by sending or bringing it here and divulging it to someone in this country or by communicating it to a U.S. resident abroad who then brings it with him to the U.S., is tantamount to conception in this country on the day it is read and understood here by someone or brought in by someone, capable of understanding it.

2) Additionally and importantly, introduction of the physical object or embodiment of such an invention (e.g. model, prototype, sample) by sending or bringing it here so that someone here has possession of it who understands its nature, its mode of production and use, is tantamount to reduction to practice in this country.

B. A legally and procedurally adequate and effective "importation" procedure that can be derived from this law of importation, can be outlined as follows:

1) A full disclosure as early as possible of the foreign invention in the U.S., preferably in writing, including detailed information on the mode of preparation, the nature and constitution of the invention and its utility and accompanied, where feasible, by a model or sample or other embodiment of the invention.

2) Prompt and careful study and inspection of these materials upon receipt, preferably by two persons who are capable of understanding the invention and who master the language if a foreign language is employed. Each person dates and signs and annotates each page as having been read and understood by him. Foreign priority applications are to be treated likewise.

3) Preserving these materials, including any sample or sub-sample or other embodiment carefully and keeping good records also abroad pertaining to the production and testing and importation of the invention.

[4) Immediate or subsequent independent exploration of the nature of any embodiment of the invention, e.g., analytical structure corroboration in case of a chemical substance, as a desirable backstop. Immediate testing or use if possible to further strengthen the case for priority.]

Foreign-made inventions which did not fare so well in US interferences in the past because 1) importation had not been resorted to and the foreign priority dates were the earliest dates that could be relied on or 2) the inventions had been imported as a substantive matter but it was not possible to prove it as a procedural matter, should fare much better in priority contests in the future, if the importation opportunities and pitfalls are kept in mind and the above-outlined procedure is followed.

Karl F. Jorda

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Importation Cases

A. Importation of Invention Disclosures

Thomas v. Reese, 1880 C.D. 12

Harris v. Stern et al., 1903 C.D. 207

Gueniffett v. Wictorsohn, 1907 C.D. 377, aff'd 1908 C.D. 367

Winter v. Latour, 1910 C.D. 408

DeKando v. Armstrong, 1911 C.D. 413

Minorski v. Thilo, 16 USPQ 401 (CCPA, 1933)

Rebuffat v. Crawford, 20 USPQ 321 (CCPA, 1934)

Wilson et al. v. Sherts et al, 28 USPQ 379 (CCPA, 1936)

General Talking Pictures v. American Tri-Ergon et al, 36 USPQ 428 (3rd Cir., 1938)

Langevin v. Nicolson, 45 USPQ 92 (CCPA, 1940)

Mortsell v. Laurila, 133 USPQ 380 (CCPA 1962)

Scheer v. Kincl, (available in file of USP 3,390,157, Bd. Pat. Intf., 1967)

Lassman v. Brossi et al., 159 USPQ 182 (Bd. Pat. Intf., 1967)

Ex Parte Pavilanis et al., 166 USPQ 413 (Bd. App., 1969)

Justus v. Appenzeller, 177 USPQ 332 (Bd. Pat. Intf., 1971)

Clevenger v. Kooi, 190 USPQ 188 (Bd. Pat. Intf., 1974)

B. Importation of Embodiments

Swan v. Thompson, 28 USPQ 77 (CCPA, 1936)

French v. Colby et al., 64 USPQ 499 (D.C. Cir., 1945) cert. den. 326 U.S. 726 (1945)

Kravig et al. v. Henderson, 150 USPQ 377 (CCPA, 1966)

Andre v. Daito, 166 USPQ 92 (Bd. Pat. Intf., 1969)

Weigand v. Hedgewick, 168 USPQ 535 (Bd. Pat. Intf., 1970)

Rochling et al. v. Burton et al., 178 USPQ 300 (Bd. Pat. Intf., 1971)

Breuer et al. v. DeMarinis, 194 USPQ 308 (CCPA, 1977)

C. Diligence Re Foreign Inventions

Hall v. O'Connor, Intf. No. 51,743

Lorimer v. Erickson, 1916 C.D. 200 (App. D.C. 1916)

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