

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

RECEIVED
SEP 13 1967
RINES AND RINES
POST OFFICE SQUARE, BOSTON

THE FINNEY COMPANY, a partnership,)	
)	
Plaintiff,)	
)	
v.)	CIVIL ACTION NOS.
)	
JFD ELECTRONICS CORPORATION, a corporation,)	65 C 220
)	
and)	and
)	
THE UNIVERSITY OF ILLINOIS FOUNDATION, a non-profit corporation,)	65 C 671
)	
Defendants.)	(Cons1.)

PLAINTIFF'S REPLY BRIEF
IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT

Defendants have failed to present any sound reason why plaintiff's motion for a summary judgment holding the Isbell and Mayes et al. patents in suit invalid should not be granted.* Even admitting all of the facts in the fact showing accompanying defendants' opposition to plaintiff's motion, plaintiff is clearly entitled, as a matter of law, to the requested judgment of invalidity of both of those patents. The absence of any material issue of fact and the controlling law requiring such disposition of the motion are explained in detail in the succeeding sections of this brief.

* Only the Foundation defendant has opposed plaintiff's motion. Therefore, in this brief, it should be understood that all references to "defendant" are to the Foundation defendant.

ISELL PATENT NO. 3,210,767*

Invalidity of Isbell patent No. 3,210,767 is predicated by plaintiff on publication of the patented invention more than one year prior to the application for patent, in contravention of 35 U.S.C. 102(b). Such premature publication, in the form of PX-4** (referred to by defendant as "Q.E.R. 2"), had two facets:

- (a) availability of PX-4 to the public in the "Local Library," Electrical Engineering Department, University of Illinois, and
- (b) availability of extra copies of PX-4 to the public, for the asking, at the "Publications Office," Electrical Engineering Department, University of Illinois.

Either facet, alone, is enough to render the Isbell patent invalid as a matter of law.

* Since the filing of plaintiff's Motion for Summary Judgment, this same Isbell patent has been held invalid in view of the prior art by Judge Stephenson, U.S.D.C., S.D.Iowa, in The University of Illinois Foundation v. Winegard Co. (Civil Action No. 3-695-D), in a Memorandum Opinion dated June 23, 1967, supplemented by an order of July 18, 1967, modifying a detail of the Memorandum Decision, but not the result. Plaintiff in that case has filed a notice of appeal.

** The sufficiency of the disclosure of the Isbell invention in this report is established by the Stipulation PX-C and has not been challenged by defendant.

Facet (a)

Defendant's only fact showing relative to the grounds for invalidity of the Isbell patent is an affidavit of Harold B. Lawler (Defendant's Brief, Appendix A), which does not contradict any fact relied upon by plaintiff to establish facet (a), above, and asserts additional facts relevant only to facet (b), as discussed below. Nothing in that Lawler affidavit even mentions the availability of at least one copy of PX-4 in the "Local Library" by April 30, 1959, or even implies that it was not available there on that date.*

The availability of PX-4 to the public, as well as to students and faculty of the University of Illinois, in the "Local Library" is established by the Stipulation PX-C, by the affidavit of Marjorie Johnson (PX-D), and by the deposition of the same Harold B. Lawler (PX-E) and stands unchallenged. The uncontradicted evidence of such availability is detailed on pages 26-31 of plaintiff's prior Memorandum filed with its motion and is positively corroborated by the oral testimony of Johnson and Lawler in the Winegard suit (PX-DD

* Note that paragraph 11 of the Lawler affidavit, submitted as Appendix A with defendant's brief, refers only to a few specific copies of PX-4 "distributed to several individuals and organizations on the campus" about the time copies were distributed to the sponsoring agency (May 5, 1959) and not to the earlier availability of that report in the "Local Library" from April 30, 1959, when copies were in the possession of the Librarian of that library, Miss Marjorie Johnson, as stipulated in PX-C. Also note that paragraphs 6-10 of that affidavit refer only to a "policy" on the availability of "extra copies" for distribution outside the E. E. Department. Obviously because he could not honestly do so, Lawler did not deny the availability of a copy or copies of PX-4 in the "Local Library" of the E. E. Department for reference or borrowing by anyone on and after April 30, 1959.

and PX-EE. See particularly, PX-DD, p. 243, lines 8-14, and PX-EE, p. 676, lines 20-23). As to that evidence, there is no factual issue, material, genuine, or any other kind.

Defendant even agrees with plaintiff's "description of the 'Local Library'", noting only the fact (not in dispute) that its library character "had no official status as a University Library" (defendant's Brief, p. 6). Obviously, the function and availability of the library are controlling, as defendant also seems to admit in the same paragraph of its brief.

None of the decisions on "publication" referred to in defendant's brief stated whether publication results from deposit in a library. All of those decisions and the dictionary definitions cited by defendant must be distinguished from the library deposit cases. Defendant, itself, has admitted this in its brief (pp. 14-15), stating--

"Thus, the deposit or filing of a copy in a library is sufficient publication, since the publisher relinquished control of at least one copy, intending that copy to be available to the public."

In the paragraph bridging pages 6-7 of its brief, defendant argued that there is no evidence that the wrapped packages of PX-4 were unwrapped or physically added to the "Local Library" files or display rack until after May 3, 1959. That is immaterial under the law. Miss Johnson was the Librarian of the "Local Library," and she was in actual possession of the "Local Library copy.*" As held in Gulliksen v. Halberg v. Edgerton v. Scott,

* A complete discussion of this point is contained in plaintiff's main Brief at page 38.

75 USPQ 252 (Pat. Off. Bd. App., 1937), it is the library receipt date of the document that controls, and--

"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."

Moreover, as explained in the Johnson affidavit [PX-D, par. 35(b)], reports received from the printer would have been locally distributed by April 30, 1959, and must have been unwrapped for that purpose.

Thus, no fact necessary to establish publication by deposit in the "Local Library" prior to May 3, 1959, is lacking from plaintiff's fact showing; and defendant has raised no issue, either as to any such fact or as to the applicable principle of law. Even the cases cited by defendant on granting summary judgment in patent cases confirm plaintiff's right to a summary judgment of invalidity when, as here, the controlling facts are not in dispute, are clear, and, therefore, require no interpretation by expert testimony. Accordingly, a declaration that the Isbell patent is invalid for premature publication within the meaning of 35 U.S.C. 102(b) seems to be required by all applicable precedent.

Facet (b)

Defendant's attack on plaintiff's motion, as far as the Isbell patent is concerned, is restricted to the facts involved in facet (b) of the matter of premature publication. Since the undisputed facts of facet (a) are alone sufficient to invalidate the patent under the law acknowledged in the above quotation from defendant's brief, the facts of facet (b) become immaterial. However, we nevertheless wish to make clear that there is actually no genuine dispute as to any material fact involved in facet (b).

The Lawler affidavit submitted by defendant was drafted to give an appearance of contradicting material facts relied upon by plaintiff. However, it does not actually raise a material fact issue, as might appear at first blush. A number of circumstances make this clear on careful analysis.

Paragraphs 6-8 of the Lawler affidavit explain a "policy" of unrestricted availability of research reports after mailing of the reports to the sponsoring agency. The Lawler affidavit then attempts to imply, without stating it as a fact, that distribution of extra copies prior to such mailing would have been in violation of some unstated extension of that policy. Neither the Lawler affidavit nor defendant's Brief dared go so far as to allege an established policy against freely distributing "extra copies" of such reports before mailing them to the sponsoring agency.

Without stating affirmatively that requests for such reports from members of the University faculty or student body or the general public would be refused, those paragraphs actually state only that--

"There was no established policy which permitted premature distribution of research reports, and no implication that permission for premature distribution of copies to anyone outside the Department or the sponsoring agency would be granted in any particular case."

The affidavit does not state that there was a policy of restricting release of extra copies; nor does it state that copies of such research reports were not in fact distributed by Miss Johnson to any responsible persons asking for them from the date they were

physically available (April 30, 1967, in the case of PX-4), so long as the supply of extra copies would permit; nor does it state that Miss Johnson was ever informed of Lawler's implied limitation on free distribution of reports. Most important, the Lawler affidavit does not state that Miss Johnson ever observed any such implied limitation on the admitted policy of freely distributing reports.

Lawler could not have had anything more substantial than an opinion as to how Miss Johnson actually performed her duties, as defendant's counsel acknowledged (defendant's Brief, sentence bridging pp. 8-9). Clearly, the Lawler affidavit represents a contrived effort to raise a fact issue by implication and by stating a conclusory opinion, while circumventing the controlling facts that he had previously corroborated.

Lawler unequivocally testified in his deposition (PX-E), that he had only administrative responsibility for the distribution of such reports, whereas Marjorie Johnson had the "primary responsibility" (PX-E, p. 4, lines 2-20); that it was common practice to fill requests for copies from private industry (PX-E, p. 24, lines 15-24); that he didn't "know of any case that a request was not honored if a report was available" (PX-E, p. 9, lines 10-24); that he knew of no reason why a request would be refused "other than making sure***that we are not distributing outside the continental United States" (PX-E, p. 26, line 13, to p. 27, line 4); and that no restriction had been imposed in this case by the

sponsoring agency on distribution within the United States of "extra copies" printed at University expense (PX-E, p. 5, line 18, to p. 6, line 6).

Referring to the processing of research reports during his direct examination by counsel for the Foundation in the Winegard suit, Lawler testified in Court that (PX-EE, page 676, lines 20-23)--

"A Once these were approved for printing, they would be printed, come back to Miss Johnson's office and be distributed by her and her staff in accordance with the distribution lists she would have."

Marjorie Johnson, the person who had primary responsibility in this area, stated in her affidavit that (PX-D), par. 16)--

"As soon as copies of such reports were received in the Publications Office, the extra copies were freely given to any responsible party requesting a copy."

And it had been stipulated (PX-C) that the copies of PX-4 were all received by her in the Publications Office by April 30, 1959.

Specifically referring to the reports, PX-4, Miss Johnson further stated in her affidavit [par. 35(d)]--

"(d) The extra copies of said Quarterly Engineering Report No. 2 were available to be given to any member of the public requesting same no later than April 30, 1959."

Defendant has sought to minimize the factual reliability of the two last quoted statements from paragraphs 16 and 35 of the Johnson affidavit by making them appear to be statements of opinion rather than statements of fact (defendant's Brief, pp. 7-9). Since Miss Johnson was referring to what was her own practice in the discharge of her duties, she obviously was stating what was a fact, to her direct personal knowledge.

Had Lawler later believed that his own deposition or Miss Johnson's affidavit was in error in any of the foregoing respects, this could readily have been stated in his later affidavit submitted with defendant's brief. That was not done so as to raise "a genuine issue for trial" as expressly required by Rule 56(e), F.R.C.P.

Clearly, no facts have been presented which negative the fact of availability of PX-4 to anyone, for the asking, on April 30, 1959. The uncontroverted facts are that Miss Johnson, as the person in charge of the Publications Office and Librarian of the "Local Library," would have given a copy of PX-4 to any responsible citizen asking for one at any time on and after April 30, 1959 [Aspect (b), above], in addition to furnishing the "Local Library" copy for reference or borrowing by anyone [Aspect. (a) above]. Availability in either of those ways (independently of the other) constituted publication as a matter of law, and the Isbell patent must be invalid for that reason.

MAYES ET AL. REISSUE PATENT NO. Re. 25,740

Mayes et al. Did Not Themselves
Invent the Subject Matter of the
Patent as Required by 35 U.S.C. 102(f)

The main thrust of defendant's argument against this ground for holding the Mayes et al. reissue patent invalid is based upon a complete misstatement and/or misunderstanding by defendant of the basic legal principle involved. Therefore, clarification of

the principle and of the limited extent to which the patent interference cases, cited by both parties, are applicable, seems necessary lest the Court be misled.

The principle on which this ground of plaintiff's motion is based is the most fundamental principle of our patent law, namely, that one is entitled to a patent for an invention only if he, himself, made the particular invention claimed in the patent. If he did not, a patent granted to him for such invention is invalid by the express terms of 35 U.S.C. 102(f).

The undisputed facts, shown by the evidence presented with plaintiff's motion, and the absence of any showing of additional relevant facts by defendant, demonstrate that what Mayes and Carrel (the named co-inventors) did relative to the invention claimed in their reissue patent could not constitute the making of that invention. That is the only legal conclusion necessary to the granting of this part of plaintiff's motion. As will appear, nothing to the contrary in defendant's argument and nothing in the cases cited by defendant is properly applicable to the undisputed facts.

By either of two approaches, the conclusion is inescapable that Mayes et al. did not make the invention claimed in their patent in suit, which covers a particular antenna structure capable of different modes of operation. Taking one approach, the claimed antenna structure was suggested to Mayes et al. by Turner for use according to one of its inherent modes of operation, i.e., the half wavelength mode of the prior Isbell invention.

All Mayes et al. did was to determine that the same antenna structure suggested by Turner was also inherently capable of operation on higher modes at higher harmonic frequencies (at which the dipole lengths are three half wavelengths, five half wavelengths, etc., up to nine half wavelengths or more--patent specification, PX-B, col. 1, lines 40-55, and col. 2, line 67, to col. 3, line 34).

Thus, if Mayes et al. invented anything, it was only a new method or process of operating the same antenna suggested by Turner, i.e., at frequencies higher than those contemplated by Turner. This involves no new antenna structure, but only a new method of operating the antenna suggested by Turner. However, Mayes and Carrel never requested method or process claims during the prosecution of their patent application before the Patent Office, and their patent does not, therefore, contain any method or process claim. Consequently, the patent in suit does not cover a method or process but, rather, is directed only to a particular antenna structure, the very antenna structure suggested by Turner. Whether or not the Mayes and Carrel method was patentable was never determined by the Patent Office, and that question is not here in issue.

Taking the other approach, the antenna structure was suggested by Turner; Mayes et al. merely discovered an additional use for that same antenna; and, therefore, Mayes et al. are not entitled to a patent on the antenna per se, which they did not invent.

Both of those two approaches and the applicable law were fully developed by plaintiff in its prior memorandum (pp. 51-58).

The basic error into which defendant has fallen lies in its erroneous assumption that granting this part of the motion would require proof either--

- (a) that Turner, rather than Mayes et al., was the inventor of the patented invention, or
- (b) that the invention of the patent was not patentable to anyone (defendant's Brief, pp. 19-22).

The conclusion that Mayes et al. did not make the invention claimed in their patent does not depend on proving either of those propositions. It is immaterial, for the purposes of this part of plaintiff's motion, whether the claimed invention is patentable or not, or whether Turner, alone, made that invention, or whether the invention was made jointly by Turner and Mayes et al. or by some other party. There is no present need even to speculate as to which of those possibilities is correct. The only issue is whether or not Mayes et al., alone, made the patented invention as claimed.

Defendant argues (defendant's Brief, pp. 22-24) that, because Turner, alone, has not been shown to be the inventor, Mayes et al. must have been the inventor. That involves an obvious non-sequitur. Thus, the interference cases which determine that A rather than B was an inventor go beyond what is required here and, to that extent, are inapplicable. They are applicable only so far as they decide what does not amount to the making of an invention (by B). Whether anyone else (i.e., A) might have made the invention and been entitled to a patent thereon is wholly irrelevant.

With the issue thus clarified and the facts and applicable law put back in proper perspective, only a few further comments on defendant's argument seem to be warranted.

Defendant has raised only one fact question in its Brief, and has done so only by arguing the sufficiency of the fact showing made by plaintiff (defendant's Brief, p. 22). No showing that contradicts or conflicts in any manner with plaintiff's fact showing has been made by defendant. Thus, as far as the facts are concerned, only the following portions of defendant's brief on this part of the motion require clarification.

Defendant argues that (defendant's Brief, p. 22)--

"In the present case, the only demonstrated conception which Turner had was that of changing the angles in the dipoles in some unexpressed manner. It is not shown that Turner even had in mind the direction or the degree to which the dipole should be angled."

As pointed out on page 47 of plaintiff's prior Memorandum, Mayes explicitly testified in his deposition (PX-F, p. 115, lines 15-20) that he understood from Turner that--

"he was referring to moving the dipole arms of the simple dipoles in antennas of the type disclosed in the Isbell 767 patent forwardly so that they would be in effect a V-dipole."
(Emphasis added)

Thus, by Mayes' own admission, the direction of Veeing the dipole elements was understood by him from Turner to be "forward."

As for the amount of Veeing, it is first to be noted that this cannot be critical to the patented invention, since no particular angle or range of angles of the dipole arms is even mentioned in 11 of the 17 claims of the patent. Claims 1, 3-5, 7-10, and ~~12~~¹⁵-17 of the patent require only that the dipole arms of the antennas of the prior Isbell invention be angled forwardly (as Turner admittedly suggested) to produce the claimed antenna of the Mayes et al. patent. Thus, the patent is not limited to any particular V-angle or range of V-angles.

The particular V-angles recited only in claims 2, 6, and 11-14 represent the only parameter or detail of the antenna structure of the Mayes et al. patent not admittedly suggested by Turner. It is the only parameter to which Mayes could have been referring, therefore, when he stated in his deposition (PX-F, p. 117, line 22, to p. 18, line 7) that a parameter of the antenna was determined after referring to "some of the references of previous literature." As explained on pages 49-50 of plaintiff's prior memorandum, this parameter, as claimed in only 6 of the 17 claims of the Mayes et al. patent, covered a range of angles that had been conventional in the design of V-dipoles at least since the handbook PX-34 was published in 1943. This fully supported fact stands uncontradicted and unchallenged. For the purposes of the motion, therefore, it must be deemed admitted by ~~plaintiff~~^{DEFENDANT}.

Thus, Mayes et al. merely supplemented Turner's suggestion with conventional design parameters taken from prior art V-dipole practices in producing all of the structure even of

claims 2, 6, and 11-14 of their patent. As the Court must surely recognize without the aid of expert testimony, an admitted use of prior art handbook design data could not have been inventive (i.e., unobvious under 35 U.S.C. 103) so as to make Mayes et al. inventors of the resulting antenna structure. Had the claimed V-angles of the dipoles been outside the range conventionally used in the prior art, a different conclusion could be required. However, even defendant does not assert any such difference from the prior art.

Finally, defendant argues that Mayes et al. contributed the concept that the antenna could be operated at elevated frequencies in the higher modes of operation mentioned above. Since that concept involved no change in the antenna structure suggested by Turner, it did not involve the invention of a new antenna, but only a new method or process of using the very antenna suggested by Turner, which method or process the Mayes et al. patent does not claim.

This leaves only the ultimate legal question, i.e., if Mayes et al. invented only a new method or a new process of using an antenna which they did not conceive, but derived from the suggestion of Turner, are they entitled to a patent on the antenna per se, which they did not invent? Under long established law, traced in its numerous variations on pages 51-58 of plaintiff's prior memorandum, the answer is clearly and positively "No."

As is clear from the quoted portions of several of the decisions cited by plaintiff, the "suggestion" of the patented antenna to Mayes et al. by Turner left no possibility for Mayes et al. to become original inventors of that antenna. They could not become inventors of that antenna merely by reducing it "to practical use," or by perceiving a "new use" or "advantage," or by contributing "a detail of construction" that admittedly was taught by the prior art literature and, therefore, "could have been worked out by one skilled in the art." Stearns v. Davis, 22 Fed. Cases 1182, Fed. Case No. 13,338 (Cir. Ct., Dist. Col., 1859); Smith v. Nichols, 88 U.S. 112, 22 L.Ed. 566, 567 (1875); Roberts v. Ryer, 91 U.S. 150, 157, 23 L.Ed. 267, 270 (1875); Atlantic Works v. Brady, 107 U.S. 192, 27 L.Ed. 438, 442 (1882); Ansonia Brass & Copper Co. v. Electrical Supply Co., 144 U.S. 11, 36 L.Ed. 327, 329 (1892); Barba v. Brizzolara, 104 F.2d 198, 202-203, 41 USPQ 749, 752-753 (C.C.P.A., 1939); Finch v. Dillenback, Jr., 121 F.2d 459, 466, 49 USPQ 731, 738 (C.C.P.A., 1941); General Electric v. Jewel Incandescent Lamp Co., 326 U.S. 242, 249 (1945); B.&M. Corp. v. Koolvent Aluminum Awning Corp. of Indiana, 257 F.2d 264, 267, 118 USPQ 191, 194 (C.A. 7, 1958); Armour Research Foundation of Illinois Institute of Technology et al. v. C. K. Williams Co., Inc., 107 F. Supp. 871, 884, 121 USPQ 3, 13 (D.C., N.D. Ill., 1959), aff'd., 280 F.2d 499; Armour & Co. v. Wilson & Co., 274 F.2d 143, 150, 124 USPQ 115, 120-121 (C.A. 7, 1960); Applegate et al. v. Scherer et al., 332 F.2d 571, 141 USPQ 796, 798-799 (C.C.P.A., 1964)

The principle of those cases is also involved where the claimed device was widely known or in actual prior use, or where the party making the suggestion had a complete conception of proven value, as in some of the cases cited by defendant. However, as shown by the long list of cases above that were cited in plaintiff's prior memorandum, the application of the principle has never been limited to such situations and cannot logically be so limited as defendant has argued.

Clearly, Mayes et al. did not invent what their reissue patent claims; the patent is invalid for that reason; and summary judgment to that effect is warranted.

Unclean Hands of Defendant in Procuring
the Mayes et al. Reissue Patent

The factual basis for this part of plaintiff's motion also stands uncontradicted and unqualified. Defendant made no showing of additional or contradictory facts. Thus, again, all of the facts shown by plaintiff must be deemed admitted for the purposes of the motion. Again, defendant bases its argument solely on an alleged insufficiency of plaintiff's fact showing to bring the case within the proper scope of the law relied upon, namely, the equity doctrine of "unclean hands." Clearly, therefore, this issue is as appropriate for disposition by summary judgment as after trial, and defendant does not appear to contend otherwise.

Defendant's position (defendant's Brief, pp. 25a-26) is that, for plaintiff to succeed on this part of its motion, it must establish--

1. That Mayes et al. were under an obligation to cite any pertinent "publication" references to the Patent Office, assuming that they knew of their existence as "publications;" and
2. That Mayes et al. knew or should have known that PX-4 and PX-17 were "publications" prior to September 30, 1959 (i.e., a year before the filing date of the Mayes et al. patent application), yet they intentionally or recklessly failed to bring these references to the attention of the Patent Office.

Defendant argues that both of those propositions must be established or this ground of plaintiff's motion must fail.

Defendant's Proposition 1

The first of those propositions is a purely legal one, not a factual one. Because that legal proposition has no proper application to the facts relied upon by plaintiff, it may be quickly disposed of. We are not concerned here with any failure by defendant voluntarily to call the attention of the Patent Office to additional prior art not known to the Patent Office. An applicant should be entitled to refrain from giving the Patent Office an invitation to apply additional prior art against an application. Frequently, the applicant believes a rejection on such prior art would not be warranted for one reason or another, and should not be compelled to set up a straw man and then knock it down. Any other rule would place every applicant in a position such that he could be accused of unclean hands as to every remotely

pertinent item of prior art he might know about but fail to call to the Examiner's attention.

Here we have a far different situation. The Examiner, by basing a rejection of the Mayes et al. application on the Isbell invention (as it was described in a cited printed publication antedating the Mayes et al. application), made it clear on the record that he considered the prior Isbell invention to be pertinent and to warrant refusing a patent to Mayes et al. Mayes et al. did not rely solely upon arguments that, even if prior, the Isbell invention did not support the Examiner's position. Instead, they also filed an affidavit stating, in its practical and intended effect, that the Isbell invention, however pertinent it might otherwise be, was not early enough to antedate the alleged invention of Mayes et al. That was an affirmative act calculated to deceive the Examiner into believing he must drop his prior reliance on the Isbell work as prior art -- not a mere failure by defendant to call such prior art to the Examiner's attention. Hence, Defendant's Proposition 1, above, is clearly inapplicable.

Defendant's Proposition 2

The Mayes affidavit was filed by defendant with certain knowledge by Mayes et al. that the Isbell invention was, in fact, in existence and known to them before their own alleged invention. If the same knowledge was not in fact possessed by the attorneys for defendant and Mayes et al., who had previously also filed the Isbell application, such knowledge was certainly available to them and should have been ascertained while investigating the relative

priority of Isbell and Mayes et al. for the purposes of the Mayes affidavit. While investigating that very question, defendant had a clear duty to ascertain and present to the Examiner all of the facts known or readily available to defendant and/or its counsel, rather than presenting only that portion of the facts which supported a desired conclusion contrary to the truth.

Defendant's response to this part of plaintiff's motion ignores the known priority of Isbell's invention and the admitted familiarity of Mayes et al. with that invention before they conceived their own alleged invention. Defendant seems to be concerned only with whether or not the priority of Isbell could and should have been made known to the Examiner in the particular form of a "publication" describing Isbell's work. The known priority of invention by Isbell made his work prior art against Mayes et al., however such priority might be demonstrated. Defendant does not deny this basic part of the law.

However, even according to defendant's unwarranted, narrow view of what plaintiff must prove (as stated in its proposition 2, above), the undisputed facts establish plaintiff's defense of "unclean hands." This will be clear from a brief review of the unchallenged evidence.

The early existence of the reports PX-4 and PX-17 fully describing the Isbell invention, and the practice of prompt publication of those reports was fully known to Mayes, if not also to Carrel. From about 1957, Mayes, himself, had "primary responsibility for the "review process" for reports by the Electrical Engineering

Department generated under research contracts, such as PX-4 and PX-17 produced under Air Force contract Af 33 (616)-6079 (Mayes dep., p. 19, line 20, to p. 22, line 17). In this connection, note that Mayes approved and signed the title page of PX-4, and that Isbell, the author of PX-17, in the "ACKNOWLEDGMENT" following the title page, thanked Mayes for his contributions to the report. Mayes and Carrel referred specifically to the report, PX-17, in their own invention record (PX-15) as a prior "publication." Mayes also admitted that, at the time of his affidavit filed in the Patent Office, he knew that the Isbell invention "had been the subject of publications considerably earlier than 31-12-59" [emphasis added], by which time (December 31, 1959), the Mayes et al. V-dipole invention was allegedly completed. In that connection, specific reference was made to PX-4 and PX-17. (Mayes dep., PX-F, p. 171, line 24, to p. 172, line 19) Mayes also admitted knowing that the contents of the publication cited by the Examiner had been "published" earlier in PX-4 and PX-17 and more than a year prior to the filing of the original Mayes et al. application (Mayes dep.; PX-F, p. 173, line 14, to p. 174, line 14).

Regardless of any argument as to Mayes' understanding of what constitutes "publication" in the patent law sense, it is clear from his own testimony that he considered PX-4 and PX-17 to have been "published" long prior to the May 1960 publication antedated by his affidavit and more than a year before the filing of the original Mayes et al. publication.

If such knowledge of the early publication of PX-4 and PX-17 was not, in fact, known also to defendant and its counsel, as well as to Mayes, it was clearly an integral part of the same priority question to which the Mayes affidavit filed in the Patent Office was directed. Clearly, all of that information, directly affecting the very priority issue presented to the Examiner, could readily have been acquired from Mayes and should have been acquired from him and incorporated in his affidavit filed in the Patent Office. The failure to do so can only be attributed to an intent that only part of the relevant facts be revealed to the Examiner or to a reckless disregard for the omitted facts.

As the foregoing summary of the uncontradicted and unchallenged evidence fully demonstrates, everyone concerned with the filing and prosecution of the Mayes et al. application could readily have verified not only the true prior art status of Isbell's work with which they all were familiar, but also the fact that the results of Isbell's work had been "published" in the patent law sense more than one year prior to the filing of that Mayes et al. application (a fact since stipulated by the parties--PXC). Having been so published, it could not properly be removed from consideration by the Examiner as prior art by the express terms of Section 1.131 [Rule 131(a)] of the "Rules of Practice in Patent Cases as Amended to August 23, 1954 [35 U.S.C.A., pp. 685-6]

(See pp. 63-64 of plaintiff's prior memorandum and footnote on p. 64.) Thus, even the narrow proof requirements of Defendant's Proposition 2, above, are abundantly satisfied by the unchallenged evidence presented with plaintiff's motion.

Defendant's Miscellaneous Points

In the light of all of those facts, we are faced with a strange attitude in the response by defendant to this part of plaintiff's motion. Defendant does not deny knowledge on its own part, at the time of filing the Mayes et al. affidavit in the Patent Office, that the Isbell invention was in fact and in law a prior invention relative to the alleged invention of Mayes et al. and a proper reference against their application. Relying on an alleged doubt as to Mayes' understanding of the legal meaning of "publication," defendant does not even deny knowledge on its own part, at the time its attorneys filed the Mayes affidavit in the Patent Office, that the Isbell invention had been legally "published" in PX-4 and PX-17 more than a year prior to the filing of the Mayes et al. application.

Defendant does not deny the intended effect of the Mayes affidavit of removing the prior invention of Isbell from further consideration by the Examiner, despite its proper legal status as prior art. Indeed, that intention could hardly be denied when it was expressly stated to the Examiner in the accompanying argument to be the purpose of the affidavit.

Defendant does not deny that the intended effect of the Mayes affidavit and argument based thereon would have been frustrated had the available and related knowledge of the actual

priority of Isbell also been made known to the Examiner. It merely argues, despite the clear evidence to the contrary in the Mayes et al. file history (discussed below), that the evidence leaves this in doubt.

Instead, defendant seeks to excuse the deceptive act of filing the Mayes et al. affidavit by pointing out that they also presented the Examiner with an independent argument that the invention was patentable over the contents of the cited Isbell publication and other cited prior art (defendant's Brief, p. 34). In this connection, defendant also asserted "uncertainty" that the Examiner's abandonment and withdrawal of the cited publication of the Isbell invention was attributable to the Mayes affidavit, rather than to the independent argument of patentability over all of the prior art.

As to the effectiveness of the Mayes affidavit in accomplishing its improper purpose, the Patent Office Record is clear and eloquent. In the first Patent Office action following the filing of the Mayes affidavit, in the first paragraph dealing with the merits of the case, the Examiner expressly stated (PX-22, p. 44)--

"The Rule 131 affidavit is accepted and the rejection on the Isbell reference is withdrawn."

That one sentence statement of the acceptance of the affidavit and withdrawal of the Isbell reference could not conceivably be

construed otherwise than as an acceptance of the affidavit for the purpose for which it had been improperly filed. How defendant can argue otherwise in the face of that statement by the Examiner is beyond our understanding.

However, it avails defendant nothing to seek to excuse its effort to deceive the Patent Office on the ground that the effectiveness of the deception for its intended purpose has not been proven. Such an argument was forcefully rejected by the Supreme Court in the Hazel Atlas case quoted on page 66 of plaintiff's prior memorandum. That quotation now bears repetition.

"Doubtless it is wholly impossible accurately to appraise the influence that the article exerted on the judges. But we do not think the circumstances call for such an attempted appraisal. Hartford's officials and lawyers thought the article material. They conceived it in an effort to persuade a hostile Patent Office to grant their patent application***. They are in no position now to dispute its effectiveness." Hazel-Atlas Glass Co. v. Hartford-Empire Co., 322 U.S. 238, 247 (1944)

Defendant also argued that the deceptive character and purpose of the Mayes affidavit should be excused because, although the whole truth was not told to the Patent Office, what was told was true (defendant's Brief, p. 26). The suppression of relevant facts in dealings with the Patent Office was dealt with forcefully and clearly in the quotation from the Supreme Court's decision in the Precision Instrument case on page 67 of plaintiff's prior memorandum. A portion of that quotation also bears repetition.

"We need not speculate as to whether there was sufficient proof to present the matter to the District Attorney. But it is clear that Automotive knew and suppressed facts that, at the very least, should have been brought in some way to the attention of the Patent Office * * *. Public interest demands that all facts relevant to such matters be submitted formally or informally to the Patent Office, which can then pass upon the sufficiency of the evidence. Only in this way can that agency act to safeguard the public in the first instance against fraudulent patent monopolies. Only in that way can the Patent Office and the public escape from being classed among the 'mute and helpless victims of deception and fraud.'" Precision Instruments Mfg. Co. v. Automotive Maintenance Machinery Co., 324 U. S. 806, 818 (1945)

Defendant seeks to avoid the effect of those decisions by arguing that they involved quite different factual situations. Certainly, the Supreme Court did not intend the principles of proper conduct which it laid down in those cases to be emasculated by restricting their application to closely similar fact situations. The broad and sweeping language of the Court, itself, sufficiently and emphatically rebuts any such thought.

Finally, reference should be made to defendant's argument (defendant's Brief, p. 25) that the issue of improper conduct in suppressing information regarding pertinent prior art during the procurement of a patent should not be considered because, if this could be shown according to defendant's theory of the issue, the patent would be invalid in view of such prior art and the case should be disposed of on that ground. In support of this argument, defendant cites the Technograph Printed Circuits case (218 F. Supp.1, 47, D.C., D.C. Md., 1963).— That decision was rendered after a full

trial on all of the issues. Finding the patent clearly invalid in view of the prior art, the Court merely declined to pass on the question as to whether the patent was also invalid because pertinent prior art was "withheld" from the Examiner. The decision has no application where the issue of improper conduct before the Patent Office is raised in a motion for summary judgment unless, of course, the Court should find the same patent invalid on some other ground advanced in the motion and presented for simultaneous consideration. If the patent in the Technograph case had not been held invalid on other grounds, it is evident that the Court would have felt compelled to rule on its validity in the light of the evidence of improper conduct before the Patent Office.

With the foregoing clarification of the facts that should be controlling on this part of plaintiff's motion, and with the accompanying demonstration that those facts are abundantly proved despite defendant's argument to the contrary, and in the absence of any showing denying any aspect of the improper conduct on which the motion is based, the appropriateness of deciding the issue on the law should now be evident. Therefore, since the law is clear (plaintiff's prior memorandum, pp. 65-68), and requires a holding that defendant was guilty of "unclean hands" in procuring the Mayes et al. patent in suit, such a holding is earnestly requested.

CONCLUSION

Based on the absence of a genuine issue of any material fact, a summary judgment should be rendered holding the Isbell patent in suit invalid under 35 U.S.C. 102(b), holding the Mayes et al. reissue patent in suit invalid under 35 U.S.C. 102(f), and holding the same Mayes et al. patent in suit also invalid because defendant was guilty of unclean hands in its procurement from the Patent Office.

Respectfully submitted,

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