

## **Fourth Biennial Patent System Major Problems Conference Saturday, May 22, 1993**

### **INTRODUCTION**

Karl F. Jorda

On May 22, 1993 Franklin Pierce Law Center (FPLC), in cooperation with the Kenneth J. Germeshausen Center for the Law of Innovation and Entrepreneurship and the PTC Research Foundation, both of which are located at FPLC, held its fourth conference on the major problems of the patent system in its biennial series of Patent System Major Problems Conferences started in 1987 by former FPLC Professor Homer O. Blair.

The conference attendees included faculty from FPLC and invited guests from the judiciary, academia and the private and corporate patent bars.

The conference was chaired by Robert Benson, chairman of FPLC's Advisory Committee on Intellectual Property, and formerly President of Bancroft Corporation, Chief Patent Counsel of Allis Chalmers, President of the American Intellectual Property Association and Chairman of the IP Section of the American Bar Association. The 1993 conference featured such topical subjects as Abolition of Jury Trials in Patent Cases; New Specialized Patent Court in England; Prior User Rights; PTO as Independent Government Corporation.

The 1991 conference covered such patent law harmonization subjects as Secret Prior Art; Prior User Rights; Section 104; and Publication of Pending Applications. The 1989 conference dealt primarily with Patent Trial Simplification and Dispute Resolution and the discussions in the first and inaugural conference focused on such diverse topics as New Forms of Patents, Litigation Cost Reduction Measures, and First-to-file v. First-to-invent systems.

#### ATTENDEES:

Robert A. Armitage  
Upjohn Company

Kalamazoo, MI  
Washington, DC  
Norman L. Balmer  
Union Carbide Chemicals & Plastics  
Danbury, CT  
Heinz Bardehle  
Bardehle, Pagenberg, Dost, Altenburg, Frohwitter, Geissler & Partner  
Munich, Germany  
Robert B. Benson  
Bancroft Corporation  
Waukesha, WI  
Erwin F. Berrier, Jr.  
General Electric Company  
Fairfield, CT  
Dr. Robert Bishop  
Belltronics, Inc.  
Newton, MA  
Christopher Blank  
Franklin Pierce Law Center  
Concord, NH  
David E. Brook  
Hamilton, Brook, Smith & Reynolds  
Lexington, MA  
William J. Brunet  
Fitzpatrick, Cella, Harper & Scinto  
New York, NY  
Frank S. Chow  
Buchanan Ingersoll  
Princeton, NJ  
    Robert G. Crooks  
  
    Durham, NH  
  
    Donald R. Dunner  
  
    Finnegan, Henderson, Farabow, Garrett & Dunner  
  
    Washington, DC  
  
    Larry W. Evans  
  
    William, Brinks, Olds, Hofer, Gilson & Lione  
  
    Chicago, IL  
  
    Rochelle Ferber

Franklin Pierce Law Center

Concord, NH

Thomas G. Field, Jr.

Franklin Pierce Law Center

Concord, NH

Charles L. Gholz

Oblon, Spivak, McClelland, Maier & Neustadt

Arlington, VA

Steven J. Goldstein

Proctor & Gamble Company

Cincinnati, OH

Gary L. Griswold

3M Company

St. Paul, MN

Francis Gurry

Director-Adviser - WIPO

Geneva, Switzerland

William O. Hennessey

Franklin Pierce Law Center

Concord, NH

Karl F. Jorda

Franklin Pierce Law Center

Concord, NH

Dr. Walter Juda  
Lexington, MA  
Maurice H. Klitzman  
Arlington, VA  
Judge Alan D. Lourie  
US CAFC  
Washington, DC  
Leonard B. Mackey  
Davis, Hoxie, Faithfull & Hapgood  
New York, NY  
William J. Murphy  
Franklin Pierce Law Center  
Concord, NH  
Ronald E. Myrick  
Fish & Richardson  
Boston, MA  
John B. Pegram  
Davis, Hoxie, Faithfull & Hapgood  
York, NY  
B. R. Pravel  
Pravel, Hewitt, Kimball & Krieger  
Houston, TX  
Robert H. Rines, Chairman  
Franklin Pierce Law Center  
Concord, NH  
Gary A. Samuels  
W. L. Gore & Associates  
Newark, DE  
Sue Shaper  
Pravel, Hewitt, Kimball & Krieger  
Houston, TX  
Robert Shaw

Franklin Pierce Law Center  
Concord, NH 03301

Sylvie A. Strobel

Max-Planck Institute

Munich, Germany

William S. Thompson

Caterpillar, Inc.

Peoria, IL

Robert M. Viles

President and Dean

Franklin Pierce Law Center

Concord, NH

Herbert W. Wamsley

Intellectual Property Owners, Inc.

Washington, DC

Ogden H. Webster

Eastman Kodak Company

Rochester, NY

Harold C. Wegner

Director, Intellectual Property

George Washington University

Washington, DC

Richard C. Witte

Morgan & Finnegan

Cincinnati, OH

Alan Young '94

Franklin Pierce Law Center

Concord, NH

The purpose of the conference was to elicit opinions of people knowledgeable about patent systems as to what could be done to solve or alleviate what some see as major problems in the present U.S. patent system.

The format of the conference was in-depth discussions and exchanges among the attendees, without prepared speeches.

The attendees were also given, prior to the conference, the following background materials:

1. Abolition of Jury Trials in Patent Cases

- a. The Wall Street Journal - Can Juries Do Justice to Complex Suits?, p. 1

- b. Alan W. Young - Jury Trials in Patent Cases (Draft Paper), p. 3

- c. California Computer Products et al v. IBM - Defendant's Memorandum in Support of Its Motion to Strike the Jury, p. 29

- d. California Computer Products et al v. IBM - Plaintiff's Memorandum in Opposition to IBM's Motion to Strike the Jury, p. 50

- e. Hugh H. Bownes - Should Trial by Jury be Eliminated in Complex Cases?, p. 60

2. New Specialized patent Court in England

- a. Judge Peter Ford - Mid-Winter Meeting Luncheon Speech, AIPLA Bulletin January-February-March 1993, p. 67

- b. John Peram - Draft Resolution and Report Proposing Parallel Patent Jurisdiction in the U.S. Court of International Trade, p. 72

3. Prior User Rights

a. Rochelle Ferber, et al - Prior User Rights in a Harmonized U.S. First- to-File Patent Law System, p. 77

b. Harold G. Wegner - Prior User Rights Chapter from his New Book on Patent Harmonization, p. 120

c. Robert A. Armitage - "Prior User" Rights Under a "First-to-File" System, p. 135

d. Robert L. Rohrback - Prior User Rights, p. 144

#### 4. PTO as Independent Government Corporation

a. IPO - Considerations in Establishing the patent and Trademark Office as a Government Corporation, (see separate document)

b. Coalition for a Patent and Trademark Office Government Corporation - Patent and Trademark Office Administrative Reform Act of 1993 - a Draft Bill, p. 172

c. AIPLA - Establishing the Patent and Trademark Office as a Government Corporation, p. 194

#### 5. Additional Background Materials:

Re: Jury Trials

Martin J. Adelman - Patents and the Seventh Amendment

Re: Prior User Rights

Heinz Bardehle - Should prior user rights be protected?

The European Experience