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

THE FINNEY COMPANY,  
a partnership,

Plaintiff,

-v-

JFD ELECTRONICS CORPORATION,  
a corporation,

and

UNIVERSITY OF ILLINOIS FOUNDATION,  
a non-profit corporation,

Defendants.

CIVIL ACTION NOS.

65 C 220

and

65 C 671

(Consl.)

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ROSEN, KOLENMAN, RATHBURN & WYSS  
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CHICAGO 2, ILLINOIS

BRIEF OF DEFENDANT UNIVERSITY OF ILLINOIS FOUNDATION IN OPPOSITION TO PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT

Plaintiff's motion for a summary judgment holding Isbell patent 3,210,767 invalid, and Mayes et al. patent Re. 25,740 invalid and unenforceable should be denied, not only because genuine issues exist regarding critical facts, but also because plaintiff is not entitled to a judgment as to those legal issues in which no fact question is present.

To summarize our position at the outset, it is that a summary judgment is a completely inappropriate

method of resolving the issues in this case, the ultimate resolution of which will depend primarily on controverted issues of fact. As plaintiff has pointed out in its brief, the patents attacked are involved in several related infringement suits. While a holding of patent invalidity will, indeed, have the practical effect of disposing of several issues in these related suits, by the same token the patents involved herein are of greater than average importance and defendant should not be deprived of a full hearing with an opportunity to present expert testimony relating to the factual matters involved.

Summary judgment is particularly inappropriate in a patent case involving technical subject matter, with respect to which the court should have the benefit of explanatory expert testimony. Hazeltine Research v. General Electric Co., 183 F.2d 3, 5-6 (7 Cir. 1950). As the Court of Appeals said in Homan Manufacturing Co. v. Long, 242 F.2d 645, 656 (7 Cir. 1957), in which a summary judgment was reversed:

"A summary judgment proceeding is not a substitute for a trial, but rather a judicial search for determining whether genuine issues exist as to material facts [citing cases]. The lower court cannot try out factual issues on a motion for summary judgment because once such an issue is found, the court's function on that aspect of the case ends."

Also appropriate is the decision in Karl Kie-  
fer Mach. Co. v. United States Bottlers Machinery Co.,  
113 F.2d 356, 357, (7 Cir. 1950):

"The decision in each case must depend on its own facts. Time and expense may be avoided, through a motion to dismiss, if the facts be clear and the conclusion inescapable. Unless the case is clear, however, delay and added expense, rather than speed and economy, result from an attempted disposition of a case on a motion to dismiss." (Emphasis added)

See also, to the same effect, Paragon-Revolute Corp. v. C. F. Pease Co., 239 F.2d 746 (7 Cir. 1957).

In support of its motion, plaintiff has presented many documents and much discussion purporting to be relevant to the issues under consideration. Much of this material, while possibly of interest to the court as background, has no immediate bearing on the specific issues. Thus, although there are many controverted points in such background material, which defendant will vigorously contest at the trial of this case, no mention need be made of them at the present time.

Many of the facts contained in plaintiff's recital are true, but irrelevant for purposes of deciding the present motion. Other facts are relevant, but con-

tested by us. In the following sections, we shall deal only with the essential facts necessary for consideration of plaintiff's motion, and will show that material issues of fact remain unresolved. We shall also show that in those areas where no issues of fact remain, plaintiff is not entitled to a judgment as a matter of law.

I. ISBELL PATENT 3,210,767

Plaintiff has alleged that the Isbell patent is invalid under 35 U.S.C. 102(b) on the ground that Quarterly Engineering Report No. 2\* (PX-4) was a printed publication as of April 30, 1959, and hence a statutory bar against the Isbell patent, the application for which was filed on May 3, 1960.

We do not controvert the fact that Q.E.R. 2 was printed in a total run of 148 copies and that these copies were physically present in the Publications Office of the Electrical Engineering Department of the University of Illinois, on April 30, 1959. Plaintiff, on the other hand, has stipulated (PX-C, par. 10) that the earliest distribution of these copies to the individuals and

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\*Hereinafter abbreviated as Q.E.R. 2

organizations on the distribution list specified by the Air Force, the sponsor of the work described in the Report, occurred on May 5, 1959.

It is apparent that, with respect to the existence of a possible statutory bar against the Isbell patent, the critical period here involved is the interval between April 30 and May 2, 1959. Plaintiff alleges that the effective publication date of Q.E.R. 2 occurred within this 3-day period, and in fact on April 30, 1959, by reason either of the accessibility of this document in the "local library" of the Electrical Engineering Department or by reason of its availability to the public by sale or gift from the Publications Office. Neither of these contentions can be supported on the uncontroverted facts of this case.

At the outset, it should be noted that plaintiff does not rely on any evidence showing that actual distribution of Q.E.R. 2 to the public was made prior to May 3, 1959. Rather, plaintiff relies on its showing of the usual operating procedures of the Publications Office and on the opinion of Miss Johnson to establish that this report must be considered a "printed publication" within the meaning of the patent statutes several days prior to

the time it was issued to the sponsoring agency.

Plaintiff alleges that a copy of Q.E.R. 2 was in the "local library" of the Electrical Engineering Laboratory and available for borrowing by the general public not later than April 30, 1959. It is interesting to examine the evidence which plaintiff offers in support of this contention. We will not quarrel with plaintiff's description of the "local library" at the time, except to point out that the "library" had no official status as a University library, but was rather an unofficial collection of publications which emanated from the Electrical Engineering Department and of other publications deemed to be of interest to the Department personnel. Under appropriate conditions, these publications were available for inspection or borrowing by Department members, students and selected members of the general public. There exists no doubt that eventually Q.E.R. 2 would have been incorporated in the collection of publications maintained by the Department in its "local library". The issue, however, is whether Q.E.R. 2 had, in fact, achieved this status on April 30, 1959, as plaintiff contends.

There is no evidence whatsoever that the wrapped packages containing copies of Q.E.R. 2, which were received

from the printer on April 30, 1959, were even opened prior to the mailing which occurred on May 5 (PX-DD, pp. 240, 241). There is no evidence that a copy of this report was added to the collection of material in the "local library" files or that a copy of the report was exhibited in the hall rack near Miss Johnson's office, prior to May 3, 1959. Note that specific "local library" copies of documents were not designated until one or two weeks after receipt from the printer (PX-DD, p. 204).

There is, in fact, no evidence whatsoever that Q.E.R. 2 became incorporated in the "local library" prior to May 3, 1959.

An analysis of plaintiff's argument will show that it ultimately depends on two points: (1) The physical availability of this report in the Publications Office on April 30, 1959, and (2) the allegation by Miss Johnson that the report was available to the public on that date.

It is interesting to note that although in Miss Johnson's affidavit (PX-D, par. 35c), the availability of Q.E.R. 2 to the public is stated as a matter of

fact, her subsequent testimony in the Winēgard litigation (PX-DD, pp. 217, 240) makes clear that it was only her opinion which was being expressed in the affidavit. The fact of the matter is that although it was the general policy of the Department to make available to interested persons the collection of materials in the "local library", this policy did not automatically apply to reports prepared by the Department during the interval between receipt from the printer and dissemination to the sponsoring agency. The principal obligation of the Department was to the sponsor of the work, who was entitled to receive the report certainly no later than the time it became available to the general public. The indeterminate status of publications prior to their issuance by the Department by delivery to the sponsoring agency is undoubtedly the reason for Miss Johnson's qualification of her answers to show that this was only her opinion. Her opinion, however, while of interest, certainly cannot be held to be controlling as a matter of law.

Controverting Miss Johnson's opinion concerning the availability of Q.E.R. 2, prior to its distribution to the full mailing list, is the opinion of Mr. Harold B.

Lawler, the present Business Manager of the Electrical Engineering Department and Miss Johnson's superior in the Department during the months of April and May, 1959. Attached hereto is the affidavit of Mr. Lawler, identified as Appendix A, who avers that the reports prepared by the Electrical Engineering Department were not available to the public during the time prior to their issuance to the sponsor of the work, in this case the Air Force. A request for a report from a member of the public in such a situation presented a policy question to be decided on a case-by-case basis. Since no such request for a report was made with respect to Q.E.R. 2 prior to May 3, 1959, how such a request would have been resolved, remains conjectural. Nevertheless, Mr. Lawler controverts Miss Johnson's allegation that Q.E.R. 2 was available for general distribution prior to May 3, 1959.

There is obviously present a sharply controverted issue of fact, i.e., whether Q.E.R. 2 was available to the public prior to May 3, 1959. Since availability has not been demonstrated by proof of an actual instance thereof, the factual issue can be resolved by the court only after a full opportunity to observe the witnesses and review all the available evidence. Accordingly, summary judgment cannot be granted.

The above argument also applies with equal force to the second part of defendant's argument, i.e., that copies were available for sale or at no charge from the Publications Office. Although accessibility of copies in this matter would probably have been the policy after May 5, 1959, Mr. Lawler's affidavit clearly establishes that there was no such policy prior to this date. Again, an issue of fact remains and prevents the granting of a summary judgment.

Although we believe that the discussion above adequately disposes of this portion of plaintiff's motion, consideration of the legal aspects of "publication" might be of interest to the Court.

In this connection, the dictionary meanings of "publish" and "publication" are pertinent. Webster's New International Dictionary, 2nd Edition, defines "publication" as:

"1. Act of publishing, or state of being published; public notification, whether oral, written or printed; proclamation; promulgation; as, the publication of the law at Mount Sinai of the gospel, of statutes.

"2. The issuing to the public of copies, now usually printed or similarly produced copies, of a book, engraving, or the

like; hence, the business of printing, etc., such copies; as, to defer or to announce the publication of a book; engaged in the publication of text books.

"3. That which is published; esp., any book, pamphlet, etc., offered for sale or to public notice."

while "publish" is defined as:

"1. To make public announcement of; to make known to people in general; to divulge; to disseminate; as, to publish one's opinions far and near.

"2. To make known (a person, situation, discovery, etc.), as by exposing or presenting it to view, or by openly declaring its character or status;...

"3. To bring before the public, as for sale or distribution; esp.: (a) To print, or cause to be printed, and to issue from the press, either for sale or general distribution, as a book, newspaper, piece of music, engraving, etc."

Similarly, Black's Law Dictionary, 3rd Edition, defines "publication" as:

"The act of publishing anything or making it public; offering it to public notice, or rendering it accessible to public scrutiny. Linley v. Citizens Nat. Bank of Anderson, 108 S.C. 372, 94 S.E. 874, 877. An advising of the public; a making known of something to them for a purpose. Associated Press v. International News Service (C.C.A.) 245 F. 244, 250. It implies the means of conveying knowledge or notice. Daly v. Beery, 45 N.D. 287, 178 N.W. 104, 106."

These definitions implicitly contain a requirement that some positive action be taken towards rendering the thing published accessible to the public. Otherwise, the mere act of printing would constitute publication. In this case, the fact that copies of Q.E.R. 2 may have been physically available on April 30, 1959, at Miss Johnson's office when they were received from the printer, does not mean that they were "published" on that date within the meaning of the statute. There is no evidence that any active steps were taken to circulate these copies among the public or to inform the public of their availability prior to May 3, 1959.

The distinction set forth above is followed by the decisions relating to the time of publication within the meaning of the patent laws.

In a recent decision, I.C.E. Corp. v. Armco Steel Corp., 250 F.Supp. 738, 743 (D.C.N.Y. 1966), the Court held that a document must be disseminated in order to be a "publication", saying:

"After reviewing the cases, in this area, it might be said that the term 'printed publication' as contemplated by Congress in 35 U.S.C. 102 can include a document printed, reproduced or duplicated by modern day methods, including microfilming, upon a satisfactory showing that such document has been

disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it, and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation." (Emphasis added).

Further, in order for a printed document to constitute a printed publication under 35 U.S.C. 102(b), it has been held that numerous copies must be made accessible to the general public. Thus, in Badowski v. United States, 164 F.Supp. 252, 255 (Ct. Clms. 1958), the Court said:

"But defendant urges that the Russian document is a prior publication. The statutory language, 'printed publication,' implies that numerous copies were printed and were made accessible to the general public." (Emphasis in original).

In Browning Mfg. Co. v. Bros. Inc., 126 U.S.P.Q. 499, 503 (D.C. Minn. 1960) it was held that the exhibition of drawings of a machine at a trade show was not a publication:

"And to be a publication, also a requirement under Section 102(b), 35 United States Code, there must be a distribution of a substantial number of the documents to the public generally, at least more than one; mere evidence of ability to mass produce is not enough. There is no evidence adduced relating to the number of drawings made and observed by the public. No other

similar drawings have been proven to have been distributed or otherwise published prior to November 17, 1948. It seems clear that there has not been a disclosure in a printed publication within the meaning of Section 102(b)." (Emphasis added).

In Camp Bros. & Co. v. Portable Wagon Dump & E. Co., 251 F. 603, 607 (7th Cir. 1918), the Court held:

"Public disclosure or publication to be effective as such must be a revelation of an invention so publicly published or disclosed as to raise a presumption that the public concerned with the art would know of it." (Emphasis added).

In Protein Foundation, Inc. v. Brenner, Comr. Pats., 151 U.S.P.Q. 561, 562 (D.C.D.C. 1966); the Court held that publication of a printed magazine did not even occur when the magazine was mailed, but rather when it was received by the addressees.

While we have no quarrel with the cases cited by plaintiff on the question of publication, a few comments would be in order. In every case, without exception, there was some act by the publisher of the work in question which indicated his intention that thereafter the work was to be freely available. 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. Similarly, an advertisement of the present availability of a work may constitute publication without the necessity for an actual sale, since the advertisement itself indicates an intention to make the work available to the public. In the present case there is no evidence that a copy was actually filed in any library, including the "local library", or that any announcement of the availability of the Report was made prior to May 3, 1959.

Only a few minor points remain to be touched on. In paragraph 14, pages 33 and 34 of its brief, plaintiff argues that the prospective availability of Q.E.R. 2 was announced in an earlier report (PX-5) which was available prior to April 1, 1959. Neglecting the factual issues of whether the statement given in PX-5 describes Isbell's antenna with sufficient particularity, it is quite clear that no announcement of the availability of a report is disclosed, only that certain work would be done. When the work would be reported remains indefinite. Moreover, mere announcement of a forthcoming publication certainly does not amount to publication of the work any earlier than the actual publication date.

On pages 36 and 36a of its brief, plaintiff argues that the University acknowledged that Q.E.R. 2 was published in April, 1959 on the basis that a project report prepared by Dr. Mayes listed Q.E.R. 2 with the designation "April, 1959". Publication is a matter of intent, as indicated by the cases cited above, and there is no evidence of an intent to publish Q.E.R. 2 at any time prior to May 3, 1959, regardless of Dr. Mayes's mistaken designation.

#### Summary

The burden of establishing invalidity of the Isbell patent by reason of prior publication, like other attacks on the validity of a patent, is on the proponent (35 U.S.C. 282). Even neglecting the factual controversy which exists, we believe that plaintiff has not discharged its burden by showing that publication of Q.E.R. 2 occurred prior to May 3, 1959. The facts that the Report was printed and was physically available prior to this date are conceded, but there is no evidence of an act of publication or an intention to publish prior to May 3, 1959. For this reason and because of the controverted nature of the facts, the motion cannot be supported and should be denied.

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

A. Mayes Et Al. Were the Inventors of the Invention Covered by Patent Re. 25,740

In its argument that patent Re. 25,740 is invalid because Mayes et al. did not invent the subject matter covered by the patent, plaintiff improperly combines otherwise valid principles of law to arrive at an unsupportable conclusion and, in so doing, neglects several issues of fact which remain unresolved.

The reasoning by which plaintiff arrives at its conclusion is interesting, even if erroneous:

Turner's question concerning possible variation in the angles of a straight dipole antenna renders "old" as to Mayes et al. the log-periodic V-dipole antenna, even though Turner had no conception of the fact that antennas of this type required frequencies above the half-wave mode in order to exhibit improved gain and directivity. Even though Turner did not have any conception of this aspect of the invention, plaintiff's reasoning continues, the unexpected advantage of the V-dipole antenna in the higher mode operation constituted merely a new use of an "old" device by Mayes et al., for which they are not entitled to a patent.

The fallacy in plaintiff's argument can best be seen by reversing the order of plaintiff's presentation and considering first whether the law cited by plaintiff pertaining to the new use of an "old" device is applicable in this case. It is clear that it is not.

The cases cited by plaintiff stand for the admittedly valid proposition that the discoverer of a new and previously unrecognized advantage in an old device is not entitled to a patent on the device itself. The important language of this statement of the law is "old device", the rationale behind the law being that once a device is in the public domain (i.e., "old"), the public's right to use that device cannot be removed or limited by the discovery that it has some unobvious property not previously appreciated.

If a device is truly "old", it cannot be patented by anyone, regardless of the nature of the unobvious property. In other words, an "old" device is no longer patentable subject matter.

Considering the present facts, it is clear that the V-dipole antenna was not "old", in the sense contemplated by the cases cited by plaintiff. The specific construction of the antenna was clearly novel, never

having previously been made. The most closely related prior art antenna (Isbell's log-periodic array) was clearly distinguishable.

It is clear that plaintiff is not arguing that the V-dipole antenna was "old" and therefore unpatentable to anyone in view of the prior art, since such an argument presents the factual question of whether the clearly novel construction of such antennas was, nevertheless, obvious in view of the prior art, a question requiring expert testimony and one which this court should not decide on a motion for summary judgment.

For purposes of this motion, it must be conceded that the V-dipole antenna represented patentable subject matter and, therefore, all of the law cited by plaintiff relating to the new use of an old device is not pertinent. Assuming that there is patentable subject matter in the V-dipole antenna, the pertinent issue is whether Turner or Mayes et al. made the invention, as a matter of law, i.e., priority of invention. This, of course, is the issue which is present in the contests (called "interferences") within the Patent Office in which priority must be established between two

competing inventors, both claiming to be the inventors of the same subject matter. Also pertinent is the law relating to "derivation of invention", in which one party claims that the other did not independently make the invention, but rather derived it from the first party. It is, therefore, to the law relating to priority of invention and derivation that we should look for a resolution of the present issues.

At the outset, it should be appreciated that the invention disclosed and claimed in the Mayes et al. patent, has two aspects: (1) A modification of the previous Isbell structure using V-dipoles opening toward the front of the antenna rather than straight dipoles, and (2) the realization that the modified structure had unexpected advantages at higher order frequencies. The latter concept is explicitly set forth in the disclosure and in at least claims 8 (lines 61-63), 9 (lines 18-21), 10 (lines 50-53), 12 (lines 31-39), 14 (lines 48-52), 15 (lines 10-15), 16 (lines 50-52), and 17 (lines 29-30), and implicitly in the other claims of the Mayes et al. patent. Both of these concepts are essential for a completed patentable invention, since the small mechanical change involved in angling the dipoles, which had only an adverse

effect (PX-F, p. 117) on the operation of the antenna as conceived by Isbell, presented nothing of an unexpected or unobvious nature on which to base a claim of patentable invention.

The law is quite clear that in order to establish derivation of invention, it must be shown that the person from whom the invention was purportedly derived had a complete conception of the entire invention prior to the time of the communication to the other party. King v. Burner, 90 F.2d 343, 348 (C.C.P.A. 1937); Tolle v. Starkey, 255 F.2d 935, 938, 939 (C.C.P.A. 1958); Honer v. Stine, 95 U.S.P.Q. 373, 384 (Pat. Off. Bd. App. 1952).

The case of O'Donnell v. Hartt, 75 F.2d 195 (C.C.P.A. 1935), is particularly pertinent, since the factual situation was similar to that here involved. In that case, it was held that a casual question by Hartt to O'Donnell, concerning the possible use of a hot gas as a heating means, did not make Hartt the true inventor, even though the only patentable feature of the invention lay in heating by blowing a hot gas, and it was conceded that Hartt's question stimulated O'Donnell into experimentation with heating with hot gas. As the court held (p. 199):

"...We are without proof that at the time Hartt asked the question he had anything more in mind than the hazy notion that hot air or hot gas, if applied in some way, might bring about the desired result....If confined to the above statement of facts it seems to us that at the time Hartt claims to have disclosed his invention to O'Donnell, he did not have a conception of the completed invention of the counts at bar. If he did not have a complete conception of the invention, he could not have disclosed it to O'Donnell."

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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. He had, therefore, only the "inchoate idea" or "intellectual notion" which the court in the O'Donnell case found to be insufficient (p. 199) for conception. This is not a situation in which, after the suggestion made by Turner, it was clearly within the ability of one ordinarily skilled in the art to complete the invention, as in the Stearns v. Davis, Smith v. Nichols, Atlantic Works v. Brady, and Barba v. Brizzolara cases cited in plaintiff's brief. The reference pertaining to the properties of single V-dipoles cited by plaintiff (PX-34) obviously

*see also  
Main Body*

does not expressly relate to log-periodic antennas and it is not apparent that one ordinarily skilled in the art would find it obvious to apply the teachings of these references to log-periodic arrays, a type of antenna not even invented until twenty-five years after the references were published. Moreover, in the present case, plaintiff admits that Turner had no conception of the use of the V-dipole antennas at elevated frequencies. There exists, therefore, the factual issue of whether these contributions make Mayes et al. and not Turner, the true inventors of the V-dipole log-periodic antennas. Because of this unresolved factual issue, a summary judgment is not appropriate and should be denied.

#### Summary

Regardless of which approach in argument is used by plaintiff, it will be seen that a summary judgment should not be granted. The argument that the V-antennas were not patentable to anyone (a necessary condition for the application of the doctrine that a new use of an old device does not render the device patentable) raises the factual issue of the obviousness of such antennas over the prior art, an issue which plaintiff

has not treated and which cannot be resolved by this court on the basis of the limited evidence before it.

If, on the other hand, it is conceded that the V-dipole antenna constituted patentable subject matter, the issue is then to determine the true inventor, as between Turner on the one hand and Mayes et al. on the other. As we have shown, the law on derivation or priority of invention requires either a conception of the complete invention for priority to be established, or conception of at least so much of the invention that completion thereof is a routine matter. In the latter case, there is presented the factual issue as to whether completion of the invention in any given case is within the skill of the art. Again this is a factual issue which cannot be decided in this court on the basis of the facts before it. Since Turner did not have a complete conception of the invention, as plaintiff admits, he cannot be considered the prior inventor as a matter of law, on the basis of the facts which have been established by plaintiff. For these reasons, plaintiff's motion for summary judgment that Mayes et al. were not the true inventors, should be denied.

B. Mayes et al. Were Not Guilty of "Unclean Hands" During the Prosecution of Patent No. Re. 25,740

In this section of its attack on the Mayes et al. patent, plaintiff alleges that the inventors were guilty of inequitable conduct during the prosecution of the application by not calling the attention of the Patent Office to two University of Illinois reports (PX-4 and PX-17) as prior references.

At the outset, it must be appreciated that plaintiff is not alleging that these reports are anticipating or invalidating references in themselves, since if this could be shown, the Mayes et al. patent would be invalid regardless of how the conduct of Mayes et al. is characterized. Under these circumstances, we believe the proper approach to the issue is that taken by the court in Technograph Printed Circuits, Ltd. v. Bendix Aviation Corp., 218 F.Supp. 1, 47 (D. Md. 1963):

"The court considers it to be unnecessary to characterize the conduct of the prosecution of the United States Patent applications. The Pilkington, Whilens and Paragon patents have previously been discussed. If they negate novelty, they support the conclusions of invalidity; if they do not, plaintiffs' conduct, however denominated, was ineffective and therefore harmless."

Since the issue has been raised, however, we will discuss it as presented by plaintiff. In order for plaintiff to succeed with its argument, it must establish both of the following:

1. That Mayes et al. were under an obligation to cite these references to the Patent Office, assuming that they knew of their existence as "publications."

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.

Both of these points must be established and if either cannot be supported, plaintiff's argument must

fall. Clearly, if there was no duty to disclose, the failure to do so, whether intentional or accidental, cannot be considered "unclean hands". Even if there were such a duty, good-faith ignorance of the facts cannot be considered inequitable conduct.

Plaintiff's argument falls on both of these points.

In the first place, it is clear that Mayes et al. did not misrepresent any fact to the Patent Office during the prosecution of the Mayes et al. patent. All of the allegations made were true, and even plaintiff has not alleged otherwise. Their affidavit under Rule 131 swearing back of a reference cited by the Patent Office contains no allegation that they knew of no other reference with an equivalent disclosure of an earlier date. nor do the rules of the Patent Office require any such allegation.

The question which really underlies the issue raised by plaintiff is the obligation of an applicant for a patent to disclose his knowledge of the existence of references not cited by the Patent Office which may possibly be pertinent to the prosecution of his application. The law on this point is clear that, with the

exception of references disclosing the identical invention (i.e., references which anticipate his invention), an applicant is under no obligation, legal or equitable, to cite references for consideration by the Patent Office. Admiral Corp. v. Zenith Radio Corp., 296 F.2d 708, 716-717 (10 Cir. 1961); Wen Products, Inc. v. Portable Electric Tools, Inc., 367 F.2d 764, 767 (7 Cir. 1966). The duty to disclose references which anticipate his invention arises by reason of the oath which an applicant for a patent must make under 35 U.S.C. Section 115\*, to the effect that he believes himself to be the original and first inventor. United States v. Standard Electric Time Co., 155 F. Supp. 949, 951 (D. Mass. 1957). Obviously, if he knows of an anticipating reference, he cannot believe himself to be the first inventor and therefore violates his oath. With respect to references which might be considered suggestive or pertinent (but not anticipating) by the Patent Office, there is no obligation on the part of an applicant to disclose. As the court said in United

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\* 35 U.S.C. 115:

"The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent;..."

States v. Standard Electric Time Company, 155 F.Supp.

949, 952 (D. Mass. 1957), appeal dismissed, 254 F.2d

598:

"There has been no showing that under any statute, or rule of the Patent Office, or professional custom, or canon of ethics there is any explicit or implicit obligation resting upon an applicant for a patent or his solicitor to disclose to the Patent Office all the material which he has used in evolving the invention he claims. Cf. Becton-Dickinson & Co. v. Robert P. Sherer Corp., D.C.E.D. Mich., 106 F.Supp. 665, 674-675, affirmed 6 Cir., 211 F.2d 835.

The applicant's obligation under 35 U.S.C. § 115 and under former Rule 46 was to state whether to the best of his knowledge and belief the invention has been described in any printed publication. Of course, a putative inventor must disclose any printed publication which he either knows or believes describes the very invention claimed. United States v. American Bell Telephone Co., 128 U.S. 315, 355-356, 9 S.Ct. 90, 32 L.Ed. 450. More than this, if he knows of a printed publication which plainly describes his claimed invention, or comes so close thereto that every reasonable man would say the invention claimed was not original but had been anticipated, then regardless of his personal view that he is the original inventor, he will not be excused for his failure to disclose his knowledge. But the applicant has no duty to cite every publication of which he knows, or which he has used, merely because the publication is one likely to be referred to by a vigilant examiner in the Patent Office,

or by a rival in an interference or other proceeding. It is not the object of the quoted statute or rule to supply all available evidence to the Patent Office, or to force the applicant to set up what he regards in good faith as straw men which he reasonably and in good faith believes he can knock down." (Emphasis added).

In its brief, plaintiff continually alleges that Mayes et al. were guilty of unclean hands because they did not meet the standard of conduct required of applicants in the Patent Office. It is significant, however, that plaintiff does not even attempt to apply the facts of the cases it cites in support of its argument to the specific facts here involved in order to show what the prescribed standard of conduct is. This is quite understandable since the cases cited by plaintiff did not involve factual situations even remotely corresponding to the present one. Thus, in the Hazel-Atlas case, the applicant, in support of his argument that his invention was patentable, brought to the attention of the Patent Office a published article ostensibly written by an independent expert in the field who extolled the advantages of the invention. The fact was that the article had been "ghost-written" on behalf of the applicant

and was not at all the work of the supposedly independent author.

Similarly, in the Precision Instrument case, the party guilty of unclean hands possessed persuasive evidence that deliberate perjury concerning the date of the invention had occurred during the prosecution of the patent application, and had failed to bring this information to the attention of the Patent Office.

Neither of these situations involved the duty of an applicant to cite non-anticipating art to the Patent Office, which is the only issue herein involved. Plaintiff makes no claim that the University reports contained an anticipating disclosure, the only basis on which it could support its argument that defendant was under an obligation to disclose. Accordingly, Mayes et al. had no duty to cite the University reports and therefore could not be guilty of unclean hands for not doing so.

As to point (2), the above discussion assumes that Mayes et al. knew that the University reports were "printed publications" within the meaning of the patent laws, another fact which is crucial to plaintiff's argument and which has not been established. Plaintiff

bases much of its argument on its claim that Dr. Mayes knew of the "publication" of the reports more than one year prior to the filing of his patent application. Regardless of whether these reports eventually achieved legal status as "publications", it should be noted that when issued, these reports did not have the characteristics typical of most printed publications, i.e., books, journal articles, printed pamphlets and the like, which are widely distributed in great numbers. Rather, the reports were limited in number and intended for circulation only among a small select group of individuals. Under similar circumstances, reports of this type have been held not to be "publications," even though there was no restriction on the circulation, and the reports could well have been distributed to the general public. See Ex parte Suozzi, 125 U.S.P.Q. 445, 447 (P.O. Bd. App. 1959):

"At best, even assuming that there was no prohibition against the author of the report, or the named or other official recipients of copies thereof, from giving copies or imparting information contained in said report to others who would be classed as the public in general, this would be merely permissive and would not show unequivocally that there was in fact any publication of the report on the July 15, 1953 date here of concern." (Emphasis added).

*Counsel*

Dr. Mayes undoubtedly knew that these reports had been printed and circulated in accordance with an established distribution list. It cannot be said, however, and it certainly has not been demonstrated, that he therefore knew or should have known that they had achieved legal status as publications at the time the affidavit was made. Accordingly, plaintiff's argument falls on its second critical point, that of showing that Mayes et al. had knowledge of the facts at the time their allegedly inequitable conduct occurred.

Although we believe that the issue, for purposes of the present motion, is clearly resolved by the above discussion, a few comments on the allegations in plaintiff's brief are in order. On page 61, plaintiff alleges that the Mayes et al. application "did not state that the work of Isbell was completed or known to Mayes et al. before they made their alleged V-dipole invention." This is presented under the heading "Uncontested Facts", and as a literal statement, it is technically correct

since no such allegation was, in fact, made in the Mayes et al. applications. The import of the statement, however, is grossly unfair and misleading, since, in the first place, as we have pointed out above, there is no requirement that a patent applicant must disclose the materials he used at arriving at his invention, and secondly, there are in the patent (col. 1, ll. 19-39 and col. 2, ll. 45-49) express references to the pending Isbell patent application in a manner which clearly indicates that Mayes et al. knew of Isbell's work and did not claim to be the inventors thereof. Moreover, during the prosecution of the original Mayes et al. application (PX-29, p. 32), the following statements were made on behalf of Mayes et al. at the time the affidavit here under consideration was presented to the Patent Office:

"It may also be stated to the Examiner that the substance of the cited publication [the Isbell article, PX-28] represents work done at the University of Illinois in its Antenna Laboratory, at which location the present applicants, at the time of the filing of their application above identified, were co-workers. Under the circumstances, and surely in view of what is set out in the application papers filed, the Examiner surely must be fully aware of the full and complete knowledge the present applicants had of the Isbell work at the time their application was filed."  
(Emphasis added).

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On page 64 of its brief, plaintiff makes the statement that "Mayes et al. took steps to remove that prior art [the Isbell article] from consideration by the Patent Office rather than rely on an argument that it was not material." Mayes, in fact, presented an extensive technical argument why the combination of references, including the Isbell article, did not render the Mayes invention unpatentable (PX-29, pp. 32-34). Furthermore, it is not at all clear that the withdrawal of the rejection was based solely or even mainly on the affidavit which was filed, rather than on the technical argument which was made. The Examiner's response to the argument and affidavit said only "The Rule 131 affidavit is accepted and the rejection on the Isbell reference is withdrawn." (PX-29, p. 44). The Examiner's statement does not preclude the possibility that the technical argument played a significant part in his decision to withdraw the rejection. When such uncertainty exists, it has been held that there is no reason to believe that the Patent Office was swayed only by one argument to the exclusion of the others. Plax Corp. v. Elmer E. Mills Corp., 106 F.Supp. 399, 416, 418 (N.D. Ill. 1952), modified in part on other grounds, 204 F.2d 302 (7 Cir. 1953).

### Summary

The conduct of Mayes et al., during the prosecution of their patent application, can by no stretch of the imagination be considered inequitable, because:

1. Although Mayes et al. knew of the existence of the prior reports, there is nothing to indicate they knew or should have known that these reports had achieved legal status as "publications".

2. Even assuming that Mayes et al. did know of the existence of these reports as publications, they had no obligation to convey this information to the Patent Office, since the reports did not disclose their invention. An applicant cannot deliberately misrepresent facts to the Patent Office, but he has no duty to call attention to outstanding prior art within his knowledge unless such prior art constitutes an anticipation of the invention.

### CONCLUSION

1. There is no persuasive evidence that any publication of Q.E.R. 2 occurred prior to May 3, 1959,

which might render the Isbell patent in suit invalid. The only pertinent evidence presented by plaintiff (the opinion of Miss Johnson) has been controverted by defendant and, if for no other reason, this factual controversy prevents the granting of a summary judgment.

2. The Mayes et al. patent is not invalid as plaintiff contends on the ground that Mayes et al. did not invent the subject matter. It is clear that the V-dipole log-periodic antenna was patentable subject matter at the time the Mayes et al. application was filed. On the issue of priority of invention between Turner and Mayes et al., Mayes et al. must be considered the inventors entitled to the patent because Turner never had a complete conception of the invention.

3. The Mayes et al. patent Re. 25,740 is not unenforceable because of "unclean hands" in the Patent Office. When the affidavit was filed, Mayes et al. did not know that the prior University reports were legal "publications" and in any event, there was no obligation to cite these reports to the Patent Office since the reports did not anticipate the V-dipole antenna covered by the patent.

Plaintiff's motion should be denied in its entirety.

Respectfully submitted,

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ACKNOWLEDGEMENT OF SERVICE

Receipt of a copy of the foregoing "Brief of Defendant University of Illinois Foundation in Opposition to Plaintiff's Motion for Summary Judgment" is hereby acknowledged this 17<sup>th</sup> day of August, 1967.

Wesley D. McPhee  
One of the Attorneys for Plaintiff

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