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Is There Life after Forty: The John Marshall Law School's Fortieth Annual Conference on Intellectual Property, 29 J. Marshall L. Rev. 841 (1996)

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IS THERE LIFE AFTER FORTY?: THE JOHN MARSHALL LAW SCHOOL'S FORTIETH ANNUAL CONFERENCE ON INTELLECTUAL PROPERTY

DONALD W. BANNER, ESQ.*

INTRODUCTION

The title of my address suggests I shall talk about what the past forty years here have known and then make some suggestions to keep the next forty years a period of dynamic contribution and growth. At the outset, I would like to tell you that this splendid series of Conferences would probably never have happened had it not been for two people, Dean Noble Lee and his Associate Dean, Helen Thatcher. These were people with vision, strong in will and great in ability, dedicated to strengthening and improving the legal profession and especially that part of it which relates to what we now call intellectual property law. Their names should be associated with each of the forthcoming February programs because there probably would have been none without their contribution.

I. HISTORY OF PATENT CONFERENCES AT THE JOHN MARSHALL LAW SCHOOL

It was a great pleasure for me to look back over the programs of the last forty years to see what happened here in these rooms at The John Marshall Law School. The first program was under the leadership of Beverly W. Pattishall and the second was led by

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George Frost. Messrs. Pattishall and Frost alternated in subsequent years in leading these programs. Then, George Frost took over all of the programs until he left Chicago in 1966. At that time, I took over the leadership of the programs.

The first printed program I was able to find was from the 1959 conference. On that program was John Paul Stevens, who subsequently became a Justice of the Supreme Court of the United States,¹ as well as Casper W. Ooms, a former United States Commissioner of Patents. I remember him very well for his saying "[y]ou ought to look at the statute, there is a lot of good law in the statute." Subsequent years brought papers on substantially every aspect of patent, trademark and copyright law including addresses by Arthur Smith of the Court of Customs and Patent Appeals (CCPA),² Giles S. Rich, then of the CCPA, and, of course, Howard Markey, at that time Chief Judge of the CCPA. Prominent in the papers were discussions of the relationships between patents, patent licenses and the antitrust laws,³ the *Walker Process*⁴ case and the antitrust aspects of know-how acquisitions.⁵

From the Federal Republic of Germany we had Arved Deringer, a member of Parliament of that country, to discuss the Rome Treaty and the European Economic Community (EEC) antitrust laws.⁶ On the same program we had Kyozo Yuasa, the head of the largest law firm in Tokyo, discussing patent litigation and procedure under Japanese law.⁷

1. President Gerald Ford appointed John Paul Stevens to the United States Supreme Court in 1975. 2 ASPEN LAW & BUSINESS, ALMANAC OF THE FEDERAL JUDICIARY 18 (1996).

2. The CCPA, created in 1929, played a critical role in the development of patent law until the 1982 Federal Courts Improvement Act, P.L. 97-164, 96 Stat. 25 (Apr. 2, 1982), merged the CCPA and the Court of Claims into a new Article III appellate court, the Court of Appeals for the Federal Circuit.

3. See Thomas E. Fisher, Patent Licenses and the Antitrust Laws, Address Given at The John Marshall Law School Patent Conference (Feb. 1967) (transcript available at The John Marshall Law School Library).

4. *Walker Process Equip., Inc. v. Food Mach. and Chemical Corp.*, 382 U.S. 172 (1965). In *Walker*, the U.S. Supreme Court held that the enforcement of a patent procured by fraud on the patent office may be violative of the Sherman Act, provided other elements are necessary to a Sherman Act case are present. *Id.* at 174.

5. John C. Stedman, The Antitrust Aspects of Patent and Know-How Acquisitions, Address Given at The John Marshall Law School Patent Conference (Feb. 1967) (transcript available at The John Marshall Law School Library).

6. Arved Deringer, The Rome Treaty and the EEC Antitrust Laws, Address Given at The Lawyers Institute of The John Marshall Law School Patent Conference (Feb. 1968) (transcript available at The John Marshall Law School Library).

7. Kyozo Yuasa, Patent Litigation and its Procedure Under Japanese Law, Address Given at The Lawyers Institute of The John Marshall Law School Patent Conference (Feb. 1968) (transcript available at The John Marshall Law School Library).

By 1969, we were discussing proposals to change the U.S. patent laws. We had a paper on the effect of the new German Patent Act by Dr. Negendank from the Federal Republic of Germany,⁸ and a discussion of the proposed Patent Cooperation Treaty.⁹ The following year, 1970, we had an extensive discussion of the Patent Cooperation Treaty by George Clark¹⁰ and Dr. Klaus Pfanner¹¹ of BIRPI, the forerunner of the World Intellectual Property Organization (W.I.P.O.). In 1971, the Honorable Edward Armitage, Comptroller General of the U.K. Patent Office, spoke of developments in European patent matters.¹² George Clark discussed post-diplomatic conference analysis of the new Patent Cooperation Treaty.¹³ Tom Arnold discussed the progeny of the *Lear* case¹⁴ in the following year,¹⁵ while Gabriel Frayne dis-

8. Ing. H. Negendank, *Effect of the New German Patent and Petty Patent Act on the Granting Procedure and the Infringement Suit*, Address Given at The Lawyers Institute of The John Marshall Law School Patent Conference (Feb. 20-21, 1969) (transcript available at The John Marshall Law School Library).

9. Wm. R. Woodward, *The Present Status of the Proposed Patent Cooperation Treaty*, Address Given at The Lawyers Institute of The John Marshall Law School Patent Conference, (Feb. 20-21, 1969) (transcript available at The John Marshall Law School Library). The Patent Cooperation Treaty emerged from a 1970 conference among members of the 1883 Paris Convention. DONALD S. CHISUM, 4 PATENTS § 14.02[4], at 14-22 (1995). The purpose of the treaty was to reduce the duplication of effort involved for applicants and national Patent Offices in the filing and processing of patent applications for the same invention in different countries. *Id.* at 14-23. The treaty, whose procedures are optional, allows an inventor to file an international application designating one or more member countries. *Id.* at 14-23,24.

10. George R. Clark, *The Patent Cooperation Treaty: Panacea or Puzzlement; Solution or Sellout?*, Address Given at The Lawyers Institute of The John Marshall Law School Patent Conference (Feb. 19, 1970) (transcript available at The John Marshall Law School Library).

11. Klaus Pfanner, *The Main Features of PCT*, Address Given at The Lawyers Institute of The John Marshall Law School Patent Conference (Feb. 19, 1970) (transcript available at The John Marshall Law School Library).

12. Edward Armitage, *Future Developments in European Patent Matters*, Address at The Lawyers Institute of The John Marshall Law School Patent Conference (Feb. 18-19, 1971) (transcript available at The John Marshall Law School Library).

13. George R. Clark, *The Patent Cooperation Treaty: A Post-Diplomatic Conference Critical Analysis*, Address Given at The Lawyers Institute of The John Marshall Law School Patent Conference (Feb. 18-19, 1971) (transcript available at The John Marshall Law School Library).

14. *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969). In *Lear*, an inventor brought suit against the licensee of a patent for alleged breach of a patent licensing agreement. *Id.* at 660. The U.S. Supreme Court granted certiorari to reconsider, in light of recent decisions emphasizing strong federal policy favoring free competition in ideas which do not merit patent protection, the validity of a rule of estoppel denying a licensee the right to prove that his licensor was demanding royalties for the use of an idea which was in reality, a part of the public domain. *Id.* at 656. The Court held the case invoking that rule of estoppel, *Automatic Radio Mfg., Co. v. Hazeltine Research*, 339 U.S. 827 (1950), should no longer be regarded as sound

cussed the proposed Trademark Registration Treaty.¹⁶ Jacques Gevers from Belgium discussed the new Benelux trademark law.¹⁷ In 1974, Dr. Arpad Bogsch, then Director General of W.I.P.O., discussed the structure and operation of that organization,¹⁸ while the Honorable Edward Armitage joined us

law and thus, overruled the estoppel holding of that case. *Lear*, 395 U.S. at 671.

15. Tom Arnold and Jack C. Goldstein, *The Jurisdictional Progeny of Lear*, Address at The Lawyers Institute of The John Marshall Law School Patent Conference (Feb. 24, 1972) (transcript available at The John Marshall Law School Library).

16. Gabriel M. Frayne, *The Trademark Registration Treaty (TRT)*, Address Given at The Lawyers Institute of The John Marshall Law School (Feb. 24, 1972) (transcript available at The John Marshall Law School Library). Mr. Frayne focused on the changes likely to result, at that time, in domestic practice and law if the United States adhered to the TRT. *Id.*

The TRT was signed in June 1973, by eight countries, including the United States. J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 29.10[3], at 29-47 (3d ed. 1996). By December of that same year, 14 nations had signed. *Id.* Despite the fact that the TRT officially came into effect in 1980 by the accession of the former Soviet Union and four African nations, the treaty has no practical international value because the United States has yet to ratify it. *Id.* It is doubtful whether or when this will happen. *Id.* United States approval and participation in the TRT would have been an alternative way for the United States to allow registration to be secured based on an intention to use the applied-for mark; because a major aspect of the treaty is that each nation can require that the owner declare an intention to use in that nation. *Id.* at 29-48. This feature is highly supported, as well as highly criticized. *Id.* at 29-48, 49. President Gerald Ford noted this division of opinion when he sent the TRT to the Senate in 1975. *Id.* at 29-49 n.17. The President explained to the Senate that the TRT was not self-executing and that Senate ratification would not occur until domestic implementing legislation was considered and enacted. *Id.* at 29-40. No such proposed legislation was made public until 1978 and has yet to be introduced as a bill. *Id.*

The TRT would establish a multinational filing arrangement for securing, administering and maintaining national trademark registrations. *Id.* at 29-47. The main feature is that applications for registration of trade and service marks may be filed with W.I.P.O. in Switzerland. *Id.* at 29-48. This international filing would have the same effect in each nation that is party to the treaty which the applicant designates, as would exist had the applicant filed in each of those nations. *Id.* However, the TRT would not create an international trademark. *Id.* Rather, the TRT is a filing treaty. *Id.*

17. Jacques Gevers, *The Benelux Trademark Law in Operation*, Address Given at The Lawyers Institute of The John Marshall Law School Patent Conference (Feb. 24, 1972) (transcript available at The John Marshall Law School Library). The Benelux Treaty was signed in Brussels on March 19, 1962. *Id.* at 1. The Treaty provided that the Benelux Law would come into force January 1, 1971. *Id.* The Law provided for a transitional time of twelve months during which trademark owners in each country involved — Belgium, The Netherlands, Luxembourg — could confirm their rights to a trademark by filing confirmatory or maintenance applications in order to maintain the rights they had. *Id.* Prior to the law, each country had completely different concepts of the facts which created trademark rights, whereas after the law, they were bound by one unique law. *Id.* Mr. Gevers hoped that the Benelux Trademark Law would become the pace setter in new international legislation. *Id.* at 2.

18. Arpad Bogsch, *WIPO in the 1970s*, Address Given at The Graduate School

again to discuss further European patent developments.¹⁹ In 1975, Jim Davis, formerly a judge of the U.S. Court of Claims, discussed the trial of Patent and Copyright cases in that Court.²⁰ In that same year, Tom Hofstetter discussed the rebirth of federal unfair competition law by § 43(a) of the Lanham Act.²¹ In 1976,

Intellectual Property Division of The John Marshall Law School Annual Conference (Feb. 14-15, 1974) (transcript available at The John Marshall Law School Library).

19. Edward Armitage, European Patent Developments, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Annual Conference (Feb. 14-15, 1974) (transcript available at The John Marshall Law School Library). One of the major developments referred to in the address was the Munich Diplomatic Conference which set up a new European Patent effective in as many member states as the applicant cared to designate and pay designation fees for. *Id.* at 2. When the European patent was granted, it would have the effect of a national patent in each designated state. *Id.* The patent would have a uniform term of twenty years, whereas national patents vary as to term, and the validity could be judged only on criteria adopted at the Conference. *Id.*

20. James F. Davis, Trial of Patent and Copyright Cases in the U.S. Court of Claims, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Annual Conference on Intellectual Property Law, (Feb. 20-21, 1975) (transcript available at The John Marshall Law School Library). The U.S. Court of Claims was the only federal court in which the United States can be sued for patent and copyright infringement. *Id.* The U.S. waived its immunity for patent and copyright infringement in 28 U.S.C. § 1498 (1948). Davis, *supra* at 1. See, e.g., Autogiro Co. of America v. United States, 384 F.2d 391 (Ct. Cl. 1967) (involving a claim for infringement of patents covering rotor structures and control systems on rotary wing aircrafts); Calhoun v. United States, 453 F.2d 1385 (Ct. Cl. 1972) (involving patent owners' action against the government for compensation for patent infringement); Bowser v. United States, 420 F.2d 1057 (Ct. Cl. 1970) (deciding scope of jurisdiction of Court of Claims over third parties impleaded under the Contract Settlement Act of 1944).

21. W. Thomas Hofstetter, The Rebirth and Development of Federal Unfair Competition Law under the Aegis of Section 43(a), Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Annual Conference on Intellectual Property Law (Feb. 20-21, 1975) (transcript available at The John Marshall Law School Library). Section 43(a) of the Lanham Act, 15 U.S.C. § 1125 (1946) provides in part:

(a)(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which-

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association or such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is likely to be damaged by such act.

Id.

Dr. Arpad Bogsch returned to the Conference to discuss the proposed revision of the Paris Convention,²² while Arved Derringer further discussed antitrust developments in the EEC concerning intellectual property.²³ Morton David Goldberg discussed copyright and new technology.²⁴ The following year, Bill Meredith, from Canada, discussed the proposed changes in Canadian law,²⁵ while Peter Dirk Siemsen discussed developments in Brazilian licensing and transfer of technology.²⁶ In 1979, Homer Blair discussed the U.N. International Code of Conduct on the transfer of technology.²⁷ I discussed the proposals for revising the Paris Convention²⁸ and Tom McCarthy discussed trademarks, anti-trust and the Federal Trade Commission.²⁹ Donald Dunner discussed the new reissue practice.³⁰ In 1980, Sydney Diamond dis-

22. Arpad Bogsch, *The Revision of the Paris Convention*, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School (Feb. 20, 1976) (transcript available at The John Marshall Law School Library). In 1883, a number of countries (France, Belgium, Brazil, Guatemala, Italy, Netherlands, Portugal, Spain, Serbia, Salvador and Switzerland) adopted the Convention of Paris for the Protection of Industrial Property. CHISUM, *supra* note 9, at 14-3. Mr. Bogsch discussed the Act of Stockholm of 1967, the most recent revision of the Convention at the time. Bogsch, *supra* at 1.

23. Arved Derringer, *Antitrust Developments in the EEC Concerning Intellectual Property*, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School (Feb. 20, 1976) (transcript available at The John Marshall Law School Library).

24. Morton David Goldberg, *Copyright and New Technology: 1976*, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Annual Conference (Feb. 20, 1976) (transcript available at The John Marshall Law School Library).

25. William R. Meredith, *Proposed Changes in Canadian Patent Law*, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Twenty-First Annual Conference (Feb. 24-25, 1977) (transcript available at The John Marshall Law School Library). Mr. Meredith stated that the Canadian patent law was in massive need of revision because the last major change in the law occurred in 1935. *Id.* at 1.

26. Peter Dirk Siemsen, *Recent Developments in Brazilian Licensing and Transfer of Technology*, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Twenty-First Annual Conference (Feb. 24-25, 1977) (transcript available at The John Marshall Law School Library).

27. Homer O. Blair, *U.N. International Code of Conduct on the Transfer of Technology*, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Twenty-Third Annual Conference (Feb. 22-23, 1979) (transcript available at The John Marshall Law School Library).

28. Donald W. Banner, *The Proposals for Revising the Paris Convention*, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Twenty-Third Annual Conference (Feb. 22-23, 1979) (transcript available at The John Marshall Law School Library).

29. J. Thomas McCarthy, *Trademarks, Antitrust and the Federal Trade Commission*, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Twenty-Third Annual Conference (Feb. 22-23, 1979) (transcript available at The John Marshall Law School Library).

30. Donald R. Dunner, *The New Reissue Practice*, Address Given at The Gradu-

cussed the Geneva Diplomatic Conference on the revision of the Paris Convention,³¹ as well as the Patent and Trademark Office (PTO) "Agency Paper" for the domestic policy review of industrial innovation.³² Robert Edell reviewed section 337 actions before the International Trade Commission.³³

There were many more topics, of course, truly too numerous to mention. Extending throughout most of them were the contributions of Homer Schneider and Jerry Rose, who on almost every program for many years gave an update on the various aspects of law which had happened during the past year. Jerry set a standard of excellence for all of us and he is the person memorialized in the award given here at the Conference.

II. PROBLEM TODAY

Winston Churchill said "[h]istory, with its flickering lamp, moves along the trail of the past—trying to reconstitute its scenes, to revive its echoes—and to rekindle, with its pale gleams, something of the passion of former days."³⁴ It was great fun for me to review the history of these programs, particularly to remember the wonderful people who made such substantial contributions here in this very room. It will be of interest for you to know that of all the years in which I was in charge of these programs we had twelve speakers, six each day at each Conference. Never once was I turned down when requesting someone to present a paper

ate School Intellectual Property Division of The John Marshall Law School Twenty-Third Annual Conference (Feb. 20-23, 1979) (transcript available at The John Marshall Law School Library).

31. Sidney A. Diamond, *More Developments in Intellectual Property Law: The Geneva Diplomatic Conference on the Revision of the Paris Convention*, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Twenty-Fourth Annual Conference (Mar. 20-21, 1980) (transcript available at The John Marshall Law School Library). The Geneva Diplomatic Conference on the Revision of the Paris Convention ran from February 4 until March 4, 1980. *Id.* at 1.

32. Sidney A. Diamond, *Patent and Trademark Office "Agency Paper" for the Domestic Policy Review of Industrial Innovation*, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Twenty-Fourth Annual Conference (Mar. 20-21, 1980) (transcript available at The John Marshall Law School Library).

33. Robert T. Edell, *Outline of Section 337 Actions Before the United States International Trade Commission*, Address Given at The Graduate School Intellectual Property Division of The John Marshall Law School Twenty-Fourth Annual Conference (Mar. 20-21, 1980) (transcript available at The John Marshall Law School Library).

34. Jack B. Weinstein, *After Fifty Years of the Federal Rules of Civil Procedure: Are the Barriers to Justice Being Raised?*, 137 U. PA. L. REV. 1901, 1923 n.11 (citing Winston Churchill, *Tribute to Neville Chamberlain* before the House of Commons (Nov. 12, 1940), reprinted in 1 THE WAR SPEECHES OF WINSTON S. CHURCHILL 299 (C. Eade compiler 1951)).

here at these many conferences and never once did anybody fail to come to present his paper; no substitutes were ever sent. Those were great times, those were great people. Needless to say, no one was paid. The overriding concept was a desire to somehow make things better and the realization that when we were young we sat under the shade of trees which we did not plant, and as mature people we felt the duty to plant trees whose shade we would never enjoy.

I am not sure that same spirit prevails in our profession today. It would appear to me, that today we have a plurality of politicians who are very good at acting for themselves and for their clients, while less real consideration is given to the welfare of others or the patent system itself. There are many examples of this nonsense. For example, in the recent *AIPLA Quarterly Journal*, we are told that "[t]he new 20-year patent term was required not only by GATT, but also by a bilateral executive agreement between United States and Japan."³⁵ That is totally false. The GATT requirement for patent term is: "[t]he term of protection shall not end before the expiration of a period 20 years counted from the filing date."³⁶ In other words, GATT set only a *minimum* patent life; it did *not* require or suggest a *maximum* patent life. The "bilateral executive agreement" was merely a letter between the Patent Commissioners of Japan and the United States, which was neither approved by the State Department nor the Senate.

In that same issue of the *AIPLA Journal*, a PTO official said that the twenty year from filing provision was "[s]trongly supported by a broad cross-section of our patent user community."³⁷ The foundation for that statement was the fact that fourteen people provided testimony and twenty people wrote letters, but only three were opposed.³⁸ This was hardly a broad cross-section of our patent user community.³⁹

35. Mark A. Lemley, *An Empirical Study of the Twenty-Year Patent Term*, 22 *AIPLA Q.J.* 369, 422 n.7 (1995). GATT, the General Agreement on Tariffs and Trade, is an international treaty designed to ease international trade barriers by restricting tariffs, banning national quotas and providing an impartial forum for the resolution of trade disputes. *Id.* at n.2. The decision of the United States to adhere to GATT brought about necessary changes to U.S. patent law in order to bring the law into compliance with the new world standard. *Id.* at 370.

36. KARL P. SAUVANT AND JORG WEBER, *LAW & PRACTICE UNDER THE GATT AND OTHER TRADING AGREEMENTS: THE INTERNATIONAL LEGAL FRAMEWORK FOR SERVICES* 20 (1994).

37. Lois E. Boland, *GATT/TRIPS: A Response from the United States Patent and Trademark Office*, 22 *AIPLA Q.J.* 425, 441 (1995).

38. *Id.*

39. *Id.* Three out of 34 people or organizations providing comments on the issue of the 20-year patent term were opposed to measuring patent term from application filing date. *Id.*

When the twenty year patent period was widely criticized, the PTO stated that it was necessary to prevent "submarine patents."⁴⁰ In a joint hearing in August 1994, the Commissioner stated that he had "discovered 627 cases" in the PTO during a certain period where the pendency had exceeded twenty years. Subsequent investigation indicated forty-one percent of those patents were owned by the United States Government, while another twenty-one percent while not owned by the government, were under secrecy orders issued by the United States Government. Combined, this totals sixty-two percent of the 627 cases. Congress was never told any of this. However, even using the Commissioner's own figures, only twenty-eight one thousandths of one percent of the patents issued in that period could possibly have been submarine patents.

It is interesting that in last year's issue of the *Manual of Patent Examining Procedure*, section 201.11 states there is no limit to the number of prior applications through which a chain of copendency may be traced.⁴¹ Further, a simple statutory change stating that no claim could have a prior date more, for example, than five years before it was filed could have been made if there were troublesome submarine patents.

I believe these changes came about because many multinationals, who do not need the patent system, and many foreign corporations worked to reduce the term of the U.S. patent. Even Senator Packwood's diaries, which contained many other more interesting matters, make it clear that Senator Packwood was urging his colleagues to adopt the Japanese patent system and shorten the U.S. patent term at the bequest of Mitsubishi. There is nothing wrong, of course, with Mitsubishi wanting to change the U.S. patent system so that it could ship products into the United States earlier than it would otherwise; that is perfectly appropriate and understandable. I believe, however, it was reprehensible for Senator Packwood to urge changes in the U.S. patent system to his colleagues without referencing their origin.

Why would multinational U.S. companies want to shorten the patent life? Here I turn to Judge Markey's statement to a Federal Judicial Center Workshop for District Judges:

[m]any giant corporations have no need of a patent system. They may obtain patents, but only as a defense against some little machine shop operator who might otherwise invent and patent some-

40. Submarine patents are those which are refiled multiple times, thereby keeping the application pending for a long period of time. Lemley, *supra* note 35, at 391.

41. PATENT AND TRADEMARK OFFICE, UNITED STATES DEPARTMENT OF COMMERCE, *MANUAL OF PATENT EXAMINING PROCEDURE* § 201.11, at 200-30 (6th ed. rev. Sept. 1995).

thing the public would demand and the big corporation would have to negotiate for, instead of just adding the item to its product line. Many large corporations would be glad to compete on size, nationwide service, high volume, strong finance, and prompt delivery. They can kill off smaller competitors on any of those bases, unless the small competitor has a patent on a product somebody wants to buy.⁴²

This is in accordance with the finding of the Office of Technology Assessment of the U.S. Congress published in a booklet called *MULTINATIONALS AND THE NATIONAL INTEREST - PLAYING BY DIFFERENT RULES*.⁴³ In that publication they have a "Finding 8," which states:

The interest of U.S.-based (multinationals) frequently diverge from the U.S. national interest at least in part because the U.S. Government has not specified what that interest is . . . [s]everal high ranking corporate officers told (the Office of Technology Assessment) that in order to survive, they are taking actions which they believe are not in the national interest, including selling key U.S. assets and placing R & D facilities and advanced manufacturing plants abroad.⁴⁴

Similarly, in another "finding", the report states "[m]any multinationals are increasingly "multi" and less "national" than in the past; there appears to be a growing diversity between national needs and the needs of these multinational organizations."⁴⁵ That is a reflection of some corporate thinking to the effect that "we are a global corporation which just happens to have its headquarters in the United States." It is not only in the area of shortened patent life that we are getting confusing information. For example, we are told that all patents issue in nineteen months. I believed that myself when first I was told that. However more careful analysis raises a question. For example, assume you filed a patent application on the second day of January 1991 and four years later, January 2, 1995, you filed a continuation application and abandoned the original application. Then, on March 29, 1995, the continuation issued. Your client would think that his application, pending from January, 1991, to the end of March, 1995, took something over four years to issue. The PTO admits, however, that in computing the average pendency for that

42. Howard T. Markey, *Some Patent Problems - Philosophical, Philological and Procedural*, Presentation to the Federal Judicial Center Workshops for District Judges, 80 F.R.D. 203, 210 (1979).

43. Office of Technology Assessment, U.S. Congress, *Multinationals and the National Interest—Playing By Different Rules*, OTA-ITE-569 (Washington, D.C.: Government Printing Office, Sept. 1993).

44. *Id.* at 14.

45. *Id.*

situation, the PTO average pendency was *two years and 1.4 months*. That is because the PTO counts, as a marker, the abandonment of the original application. Their figures would show a much shorter pendency time than your client would believe.

Similarly, we have to look at what is happening in the Patent Office with respect to small entity patent fees. To obtain and maintain a patent throughout its life in 1990 cost \$1600.⁴⁶ As of October 1, last year, it cost \$3985,⁴⁷ an increase of over 100%. Keeping in mind that the power to tax is the power to destroy, it would seem that the small entity is rapidly becoming an endangered species. Incidentally, over 125,000 issued patents were abandoned from 1991-1994 for failure to pay maintenance fees.

III. PROPOSAL

The John Marshall Law School is in an unique position of being able to probe the often misleading statements which we are frequently fed. The next forty years, or some portion of it, could be directed by The John Marshall Law School to probing for the truth, presenting all sides, informing the profession of the pros and cons of changes being suggested to us.

This can be done, for example, by convening conferences directed specifically at the major issues facing the profession, with speakers knowledgeable and of impeccable integrity, addressing the issues. Those speakers, as was common in the past, would prepare written papers to be exchanged with the other speakers prior to the conference. In that way, the issue could be clearly delineated. At such a conference, differing viewpoints can be debated in special sessions after the speakers prepared statements and adequate audience participation can be provided for. The entire conference can be taped and transcribed for maximum distribution throughout the nation. The misleading statements I spoke of earlier will be corrected by their exposure here.

CONCLUSION

All of these things mentioned above are matters, I believe, that The John Marshall Law School could profitably pursue in the years to come. It will continue to be a great law school, making a significant contribution, if issues of this type are explored thoroughly so that the American people can understand what is happening. It will be a great law school as long as it contributes sig-

46. 35 U.S.C.A. § 41(h)(1) (1990).

47. 35 U.S.C. § 41 (1995). *See also* PATENT AND TRADEMARK OFFICE, UNITED STATES DEPT OF COMMERCE, NOTICE OF FINAL RULEMAKING PATENT AND TRADEMARK FEE REVISIONS (effective Oct. 1, 1995) (summarizing revised rules of practice in patent and trademark cases).

nificantly, as it has in the past, to our national concerns, particularly in the area of intellectual property law. These issues are of crucial importance to the country, its future, the quality of life for our children and their children. The John Marshall Law School plays a role of pivotal importance in that task, and so can you.

I remember a movie called the "Dead Poet's Society." The teacher there showed his students photographs of the older generations that had graduated from that school and told them that all of those people had died, and that they too would die. To reach that end without making the world a better place would be a sad waste of a God-given gift. He gave them a short Latin lesson. He said "*Carpe Diem*," and told them that it meant "seize the day." That is a good thing for all of us to keep in mind. *Carpe Diem, Carpe Diem.*