

“As Time Goes By - Learning Patent Law from Players Past” by Dale Carlson

There is much to learn from our predecessors in our profession. This is especially so to the extent we can see and touch artifacts from our “past” that were part-and-parcel of their “present”. Thanks to the good graces of our Association’s Board member, Phil Shannon, we have an opportunity to do a virtual Star Trek-ean Mind Meld with members of our Association who are long gone, including one who practiced patent law way back in the late 1880s.

During his tenure at Pennie & Edmonds, Phil inherited various pamphlets published in the 1930s and 1940s under the auspices of our Association, then called the “New York Patent Law Association” (NYPLA). Although somewhat yellowed by time, the pamphlets are in excellent condition. They serve to enliven our understanding of the problems and proposed solutions affecting patent law that were being bantered about back then.

Prof. John Lienhard, of NPR’s “Engines of our Ingenuity” fame, put the learning to be derived from artifacts, such as the NYPLA pamphlets, thusly: “So, think about ghosts. If we visit the original place, or we hold the artifact in our hand, and, if we find the right frame of mind, then something happens. Combine knowledge of the past with the physical object, and we can get much more than the sum of two parts. If the circumstances are right, we share something with those who once touched -- or who saw -- what we now touch or see.”

One of the NYPLA pamphlets is entitled “Sore Spots in the Patent System” and was written by W. Houston Kenyon, Jr. in 1942. Mr. Kenyon is a Past President of our Association. One of the “sore spots” he identifies is that the “majority of issued patents are for petty details of routine improvement and not true inventions”. If this criticism of the patent system has a familiar ring to it, consider Jaffe & Lerner’s finger-wagging against

“patents on inventions that are trivially obvious” in their 2004 tome tediously titled “Innovation and its Discontents: How Our Broken Patent System is Endangering Innovation and Progress, and What to Do About It”.

While attempting to point blame at the Federal Circuit, Jaffe & Lerner’s book reveals their lack of understanding of the patent system as we know it. Moreover, to the extent that there is an analogy to be drawn between the “trivially obvious” inventions that they allude to, and the “petty” inventions that Mr. Kenyon refers to, the Federal Circuit cannot possibly be the culprit. The reason is that the Federal Circuit didn’t exist at the time of Mr. Kenyon’s article. Indeed, it took another four decades before the Court came into being.

That is not to say that a glimmer of hope in favor of the Federal Circuit’s creation wasn’t in some practitioners’ minds early on. Apropos of this, another of the NYPLA pamphlets is entitled “Discussion of the Single Court of Appeals at Dinner Meeting of the New York Patent Law Association”. The discussion took place on December 9, 1936 at the Hotel Roosevelt. The presentations of several speakers, including Judge Augustus Hand, are reproduced in the pamphlet.

One speaker at the 1936 event, Mr. Henry D. Williams, pointed out that he began his practice at Winter & Kenyon, a predecessor of Kenyon & Kenyon, in 1888. Reflecting a forceful yet pragmatic tone, Mr. Williams declared: “Now, our clients want a single Court of Patent Appeals, and we are going to get it whether we want it or not. That you may be assured of. And the question is whether this Association is open-minded enough and broad-minded enough to consider the thing from the proper standpoint.”

Mr. Williams’ remarks presaged an event that would take place a half-century later. His comments, together with those of Mr. Kenyon, offer a sense of perspective on the ebb-and-flow that takes place when it comes to changes being considered for our nation’s patent system.

In order for our Association to help insure that future changes are forward-thinking, it may be helpful to reflect on what our “elders” might think of our plans. This will bring insight that is not constricted by the time-span of our individual careers, and will allow us to be thinking in time-frames of half-centuries and more. To do that, we can continue to Mind Meld with our predecessors. Hopefully, Mr. Spock will be there when we need him.



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