NYIPLA

HISTORIAN'S CORNER

"As Time Goes By - Recounting Our Association's History and its Relevance to Today"

by Dale Carlson

I am most pleased to be serving as Association historian at the behest of President Ed Vasallo and with the support of the NYIPLA Board. There is much to recount concerning the illustrious history of this organization. Where to begin? Let's begin with a discussion of our Association's role in patent reform initiatives.

An early effort at patent reform began in 1950, and culminated in the Patent Act of 1952. Our Association was heavily involved in the effort. Giles Rich, who in 1950 became President of our Association, was at that time appointed by the former National Council of Patent Law Associations to be part of a two-person drafting team working in coordination with the Patent Office's Pasquale J. Federico to frame the Proposed legislation. Two years later the legislation was enacted.

The 1952 Act has stood the test of time until now, ushering in what Past President Andrea Ryan has called "the golden age of patent law". Giles Rich later went on to become Judge Rich, first with the Court of Customs and Patent Appeals, and later with the Federal Circuit, and sitting on the bench until age 92 – thus becoming the oldest active federal judge on record.

The motivation for patent reform a half-century ago appeared to be a general anti-patent attitude by the courts – aptly captured in the 1949 quote by Justice Jackson to the effect that "the only patent that is valid is one that this Court has not been able to get its hands on".

With that as a back-drop, it's not surprising that former Director of our Association Daniel H. Kane (the brother of Past President David S. Kane and uncle of Past President David H.T. Kane) commented on the bleak state of affairs at a "Forum of the New York Patent Law Association on the Subject of 'Patentable Invention'" held on November 30, 1949. Mr. Kane bemoaned the fact that "the patent system has been operating in an atmosphere of judicial hostility for more than a decade" (published in the February 1950 issue of the Journal of the Patent Office Society).

Today the pendulum appears to have swung in the opposite direction - raising the prospect, at least in some people's minds, that there are too many questionable patents. This perception has led to a new patent reform initiative purporting to make patents easier to attack. This initiative is embodied in a bill introduced into the House on June 8, 2005 as "the Patent Act of 2005".

As pointed out in an article in the July 4, 2005 issue of BusinessWeek magazine entitled "A Patent War is Breaking Out on the Hill", the business community is sharply divided over the new bill. The tech and financial services industry support it, but big pharma and biotech companies oppose it. The BusinessWeek article puts it bluntly: "As this war heats up, all combatants are hiring lobbyists and appealing to a divided academic community for backup. With billions of dollars in property rights at stake, it's a fight neither side can afford to lose."

Federal Circuit Judge Pauline Newman, who back in the late 1960s became the first female member of our Association's Board, recently weighed in on the current reform initiative. Judge Newman suggested that Congress should proceed cautiously in its deliberations regarding patent reform. She observed that "there's this sense [in Congress] that there are flaws in the [patent] system and in the way patents are treated in litigation. The thought that too many patents are being upheld is something that needs a firmer economic and statistical evaluation than I have seen so far."

Coinciding with our Annual Meeting this past May, Past President John Sweeney, together with a select group of other past presidents of our Association, published a fine commentary on the Federal Trade Commission's vision of proposals for patent reform.

As efforts toward patent reform gear up, our Association and its members, past and present, will doubtless play key roles in helping to shape the final result. We should all resolve to have our individual and collective voices heard on this matter of critical importance to our chosen profession.

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