

IPLS PROCEEDINGS

STATE BAR OF MICHIGAN

Hot Topics and Cool Surroundings: The 33rd Annual Intellectual Property Law Summer Institute on Mackinac Island

By Denise Glassmeyer

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The upcoming 33rd Annual Intellectual Property Law Summer Institute, cosponsored by IPLS in conjunction with ICLE, presents some new innovations and offerings together with many of the features favored by section members. This year's Institute will be held at the Grand Hotel on Mackinac Island from Thursday, July 12 to Saturday, July 14. The Grand Hotel fills up fast, so be sure to register soon—over 200 of your colleagues have already signed up. Visit www.icle.org/ip to register. Be sure to use the hotel reservation form located on the lefthand side of the web page for the Institute; hotel reservation forms need to be faxed or mailed to the Grand Hotel, while the seminar registration is online with ICLE.

The Institute will continue its practice of providing the popular Updates in Patent, Trademark and Copyright Law as the Friday sessions. Kate Spelman of Cobalt LLP will return to provide the copyright update. Tom Irving of Finnegan Henderson will update attendees in current developments in patent law. Leslie Lott of Lott and Friedland, Coral Gables, Florida, will provide the trademark update.

New this year to the Institute are two-hour advanced-level sessions available at no cost to attendees on Thursday afternoon. This year's advanced sessions feature Tom Irving speaking on the subject of "Drafting and Prosecuting Patents for Subsequent Litigation and Licensing" and Michael Lisi of Honigman Miller speaking on the topic "How to Help Clients Survive a Tax Audit on IP Valuations." This year's moderator, council Chair-Elect Laura Slenzak, explains, "For the past few years we have offered advanced sessions opposite the update sessions. Our attendees enjoy the advanced sessions but dislike having to choose between a valuable update and an advanced session. Offering advanced sessions on the opening afternoon of the Institute permits us to accommodate all interested attendees at no extra charge."

Other topics being offered include a panel discussion on *KSR v. Teleflex* by James Dabney, counsel of record for KSR, and Catherine Nyarady, of Paul Weiss Rifkind Wharton & Garrison. (See her article in this issue regarding the *Med-immune* decision.) For those interested in trademark law, there will be a panel discussion, "Trademark Dilution Law—2006 and Beyond," by Theodore Davis of Kilpatrick Stockton and Trademark Update speaker Leslie Lott. John Steele of Fish & Richardson will discuss "Conflicts of Interest when Obtaining Intellectual Property Interests."

Continued on page 4

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New PCT Rules as of April 1, 2007

By David L. Wisz

A block of PCT rule changes went into effect April 1, 2007. Some important changes are facilitated by a new request form. The electronic filing program (PCT-SAFE) will automatically provide the updated form; however, if you do not use PCT-SAFE, you may obtain the new request form at <http://www.wipo.int/pct/en/forms/april2007/index.htm>.

The new request form implements two important rule changes. The first rule change allows incorporation by reference of the priority document in the event that portions of the PCT application are inadvertently not filed. As an example, if a drawing or a few pages from the specification are not filed, this omission can be corrected. Essentially, you are incorporating the priority document by reference, and thus can claim that the missing portions were actually filed. The new request form fulfills the requirement for such corrections with the necessary incorporation by reference statement.

The other major change is a dramatic—and beneficial—departure. You now have the opportunity to request restoration of the right of priority to an earlier priority document, even if the international application was not filed within a year of that priority date. The maximum extension is two months, and there must be a statement of the reasons for failing to comply. Again, the new request form facilitates such restoration request.

Although a number of important countries have objected as both receiving offices and designated offices to these changes, the benefit of this new request form outweighs the administrative burden of assuring its usage. ?

David L. Wisz is an attorney with Carlson, Gaskey & Olds, P.C. in Troy, Michigan. Mr. Wisz prepares and prosecutes patents in the U.S. and foreign patent offices in a variety of aerospace, mechanical, and system-related technologies.

Calendar of Events

June 14, 2007

Council Meeting at 9:30 a.m.*

July 12-14, 2007

33rd Annual Intellectual Property Law Institute
Grand Hotel on Mackinac Island
Registration and event details at
www.icle.org/summerip

July 14, 2007

Annual meeting, including election of council members and officers 8:00 a.m.
Grand Hotel on Mackinac Island

* Contact a council member for the meeting location.

Coming This Summer—New Online Option for Copyright Registration

This summer (2007), the Copyright Office will offer the option to file a copyright registration online through www.copyright.gov. Advantages will include:

- Lower filing fee of \$35 for a basic claim (for online filings only)
- Fastest processing time
- Earlier effective date of registration
- Online status tracking
- Payment online by credit card or Copyright Office deposit account

Alternatively, the office will also continue to offer the option to complete an application online, print it out, and mail it to the Copyright Office. Current forms will be replaced by new forms on or after July 1. With new scanning software, the office will be able to process these forms more efficiently and faster.

Note that the current \$45 fee for a paper application will be retained. (Read more about filing options). For applicants without access to the website, the office will also continue to offer blank forms to be completed with a typewriter or by hand.

Online service is at the heart of improvements coming to the Copyright Office as part of a major re-engineering effort. In addition, streamlined internal processing using better-integrated information technology systems will result in faster service overall and better tracking of work in progress.

These improvements will extend to many Copyright Office services, including registration, the recordation of documents, and the provision of information and copies of Copyright Office records.

Filing Options — beginning in Summer 2007

Option 1: File online and pay a lower fee

- Go to www.copyright.gov and submit your application online.
- Pay the filing fee online by credit card or Copyright Office deposit account.

• Deposit options:

- *Unpublished works:* Wherever possible, attach an electronic deposit copy of your work (e.g. song, artwork, poem, or other literary work). Otherwise, send a hard copy deposit.
- *Published works:* Hard copy deposit(s) must be sent when necessary to comply with the “best edition” requirements of the Library of Congress. For works published only online, and for certain other categories of published works, an electronic deposit is acceptable. For more information about deposit requirements, please visit www.copyright.gov.

Option 2: Complete your application online and mail it in

- Go to www.copyright.gov, complete your application online, and print it out.
- Pay the filing fee by check or money order, or charge it to your Copyright Office deposit account (credit cards not accepted).
- Mail the application, fee, and hard copy deposit(s) in a single package to the Copyright Office.

Option 3: Complete a paper form by typewriter or by hand and mail it in

- Print out a blank form from the website, or request one by writing to the Copyright Office or calling the 24-hour Forms Hotline at (202) 707-9100.
- Complete your application by typewriter or legible hand printing in ink.
- Pay the filing fee by check or money order, or charge it to your Copyright Office deposit account (credit cards not accepted).
- Mail the application, fee, and hard copy deposit(s) in a single package to the Copyright Office. ?

Source: U.S. Copyright Office—<http://www.copyright.gov/ecol/index.html>

Submissions to *IPLS Proceedings*

Articles of interest to the membership are actively solicited for publication on the *IPLS* website. If you have recently researched a topic of interest to our membership, or have been involved in a case, please consider a submission.

Submission Deadlines:

- August 14, 2007 for the September 2007 issue
- January 15, 2008 for the February 2008 issue
- April 15, 2008 for the May 2008 issue

Submissions should be sent to:

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Plenary sessions on Saturday include a discussion of proactive protection of intellectual property interests in China by Douglas Clark of the Lovells firm of Shanghai. The Saturday offerings will conclude with a presentation on “E-discovery in Federal Court” presented by the Honorable Gerald Rosen, U.S. District Court, Eastern District of Michigan.

Other offerings of interest include the 5th Annual Corporate Counsel Luncheon. This year, Mary Gail Gearns of Bing-ham McCutcheon will discuss the novel attorney internship program offered by her firm in conjunction with Citigroup. Ms. Gearns will also be the featured speaker at the Women in IP Networking Breakfast.

The annual business meeting of the IPLS will be held on Saturday, July 14 at 8 a.m. at the Grand Hotel, immediately before the beginning of the Saturday speaker offerings. Receptions for attendees and guests will be held on Thursday and Friday evenings at the Grand. This year’s firm sponsors include Dickinson Wright PLLC, Clifford Chance LLP, Carlson Gaskey & Olds PC, and Reising Ethington Barnes Kisselle PC. ?

Denise M. Glassmeyer is a shareholder with Young Basile P.C., in Troy, Michigan. Ms. Glassmeyer’s practice focuses on patent prosecution with special emphasis on domestic and foreign patent prosecution in chemical, mechanical arts, materials applications, and IP portfolio development.

Letter From the Chair—Beverly Bunting

It was great seeing over 350 of our colleagues at the Spring Intellectual Property Law Section seminar that was held in East Lansing on March 19. The council thanks those of you who took the time to fill out an evaluation form and will use your comments in planning future events. To improve feedback, we are looking into the use of an electronic survey format. Many of us were disappointed that John Love was not allowed by the PTO to discuss the new patent rules on continuation and claims practice. When the council originally planned the seminar last September, everyone believed that the new rules would be published by the end of 2006. He did mention privately that the rules are now on a fast track to being approved. This was confirmed by John Doll’s recent announcement that they expect to publish the rules package this summer.

The 2006-2007 IP Section year comes to a close at the annual meeting in July. One of our accomplishments over the past year has been an enhanced newsletter, and we are looking at ways to further improve the content of the newsletter next year. I appreciate having had this opportunity to participate on the council the past seven years, and I am looking forward to handing over the gavel to Laura Slenzak at the meeting on Mackinac! ?

Where Do We Get Our Information?

The Internet has opened up a world of opportunity to locate just about any type of information you can imagine. A couple of links you may find interesting and helpful to your practice are:

www.ice.gov/partners/cornerstone/ipr/IPRForm.htm—The National Intellectual Property Rights Coordination Center (IPR Coordination Center) works to protect the United States and its people by deterring, interdicting, and investigating threats arising from the movement of illegal goods into and out of the United States. The IPR Coordination Center serves as the focal point for the collection, analysis, and dissemination of intelligence involving copyright and trademark infringement, signal theft, and theft of trade secrets. When reporting a suspected violation to the IPR Coordination Center, provide as much detailed information as possible.

www.wcoomd.org—World Customs Organization “customs websites” section of the website provides a portal to access customs administration websites worldwide, along with other valuable information regarding customs.

<http://ep.espacenet.com>—Allows you to search the EP, WIPO, and worldwide patent databases. Coverage of the EP database enables you to search the patent applications published by the European Patent Office over the last 24 months. Coverage of the WIPO database enables you to search in the patent applications published by WIPO (WO publications) in the last 24 months. Coverage of the worldwide database enables you to search for information about published patent applications from over 80 different countries and regions. ?

MedImmune v. Genentech: Unanswered Questions

By Catherine Nyarady

On January 9, 2007, the U.S. Supreme Court held in *MedImmune, Inc. v. Genentech, Inc.* that a patent licensee has Article III jurisdiction to seek a declaratory judgment of noninfringement, patent invalidity, or unenforceability against the licensor-patentee, even if the licensee continues to pay royalties under the license agreement.¹

The decision reversed the U.S. Court of Appeals for the Federal Circuit, which previously ruled that no Article III controversy exists between a licensor and licensee in good standing.

Case Facts

Genentech held a patent for a process of synthesizing “chimeric” monoclonal antibodies for use in medication (“the Cabilly I patent”). MedImmune developed Synagis, a “humanized” monoclonal antibody used to prevent a respiratory virus in infants and young children. In 1997, MedImmune licensed the Cabilly I patent, as well as any future related patents, from Genentech. In 1998, the FDA approved Synagis. MedImmune concluded that the Cabilly I patent did not cover Synagis, and MedImmune did not pay royalties for Synagis. In 2001, Genentech was awarded a second, broader patent (“the Cabilly II patent”).

Genentech demanded MedImmune pay royalties under the 1997 license based on the Cabilly II patent. MedImmune began paying royalties, and continued to do so, but “under protest and with reservation of all of [its] rights.” MedImmune then sued Genentech seeking a declaratory judgment that the Cabilly II patent was not infringed, invalid, and unenforceable. The district court dismissed for lack of subject matter jurisdiction. MedImmune appealed to the Federal Circuit.

Earlier Federal Circuit cases, such as *Gen-Probe*, clearly held that a licensee must cease royalty payments, thereby materially breaching the license agreement, before challenging patent validity to satisfy subject matter jurisdiction under Article III of the Constitution.² However, such an act would allow the licensor to terminate the license, exposing the licensee to a patent infringement suit, with a threat of treble damages and an injunction.³ MedImmune urged the court to overturn its precedent. The Federal Circuit declined, reasoning that a licensee in good standing could have no “reasonable apprehension of suit”—the test to establish Article III jurisdiction that the Federal Circuit articulated years earlier.⁴

The Supreme Court rejected the Federal Circuit’s “reasonable apprehension of suit” test as an absolute test for jurisdiction and determined that a controversy existed between MedImmune and Genentech sufficient to satisfy Article III. The court did not dispute that the continued payment of royalties under the license made the threat of an infringement suit “at least remote, if not nonexistent” and “eliminate[d] the immi-

nent threat of harm.”⁵ However, the payments did not negate the underlying controversy between the parties.

The Supreme Court’s decision is narrow, addressing only the Article III jurisdictional issue. Importantly, the court expressly declined to decide the lurking licensee estoppel issue.

Licensee Estoppel

Before 1969, licensee estoppel was law—a patent licensee could not challenge the validity of the licensed patent. This was true even when a licensee ceased payment and the licensor sued to collect royalties. While arguably this equitable doctrine was slowly being narrowed through exceptions, it was not until 1969 that the Supreme Court, in *Lear v. Adkins*, eliminated in part the doctrine of licensee estoppel based on patent policy considerations.⁶ The Court embraced a licensee’s strong economic incentive to challenge patents and, as later discussed by the Supreme Court, made clear that “an accused infringer [may] accept a license, pay royalties for a time, and cease paying when financially able to litigate validity, secure in the knowledge that invalidity may be urged when the patentee-licensor sues for unpaid royalties.”⁷ Significantly, *Lear* did not address important questions such as whether licensee estoppel arises when a licensee continues to pay royalties or when the licensee initiates the lawsuit, as in the *MedImmune* case.

The circuits split regarding the implementation of *Lear* under varying circumstances.⁸ The circuit court decisions lacked precedential effect after the creation of the Federal Circuit in 1982, which now hears all appeals in cases arising under the patent statute. The Federal Circuit construed *Lear* narrowly and several times declined to apply the *Lear* doctrine under varying fact patterns. The question of whether a licensee must stop paying royalties before challenging a patent’s validity was directly addressed in 1997. In *Shell Oil*, the Federal Circuit held that a licensee must stop paying royalties to invoke the *Lear* doctrine.⁹ While the *Shell Oil* facts varied significantly from those of *MedImmune*, in 2004 the Federal Circuit, in *Gen-Probe*, made clear the *Shell Oil* holding’s broad reach.

In *Gen-Probe*, where the licensee continued to pay royalties under protest, the Federal Circuit went one step further than *Shell Oil*. The court essentially converted the *Lear* doctrine into an Article III jurisdictional bar, finding that a nonrepudiating licensee has no reasonable apprehension of suit:

In *Shell Oil*, this court decided that a licensee is liable for unpaid royalties that accrued under the terms of the license before invalidation of the subject patent’s

Continued on next page

claims. While that case did not discuss jurisdiction under the Declaratory Judgment Act, this court stated: “[A] licensee...cannot invoke the protection of the *Lear* doctrine until it (i) actually ceases payment of royalties, and (ii) provides notice to the licensor that the reason for ceasing payment of royalties is because it has deemed the relevant claims to be invalid.” *Shell Oil*, 112 F3d at 1568. This language posits that a licensee must, at a minimum, stop paying royalties (and thereby materially breach the agreement) before bringing suit to challenge the validity or scope of the licensed patent.¹⁰

Contrary to *Gen-Probe*, the Supreme Court’s analysis in *MedImmune* clearly establishes that Article III jurisdiction and licensee estoppel are separate considerations. Unfortunately, despite resolving the jurisdictional issue, the court refused to comment on the applicability of *Lear* to the *MedImmune* fact pattern. Indeed, the Court mentions *Lear* several times and distinguishes a “repudiating licensee” from a “nonrepudiating licensee.” The Court clearly stated it expressed no opinion on the applicability of *Lear* under the *MedImmune* facts, or *Lear*’s impact on the breadth of the licensee estoppel doctrine.¹¹

Genentech argued, based on *Commodity Credit Corp. v. Rosenberg Bros. & Co.*, 243 F2d 504, 512 (9th Cir. 1957) and *Kingman & Co. v. Stoddard*, 85 F. 740, 745 (7th Cir. 1898), that a license is a type of “insurance policy” and, based on the pre-*Lear* common-law rule, argued that a licensee cannot reap the benefits and immunity of a license while bringing suit. The Court placed great weight on the fact that the dispute revolved around the proper interpretation of the contract, and expressed doubt as to whether the common-law rule of licensee estoppel could apply in this situation. At the same time, the Court quoted, without apparent disapproval, the Federal Circuit’s *Lear* analysis in the *Shell Oil* decision. The Court expressly left the door open to licensee estoppel arguments, stating that, if Genentech is correct that licensee estoppel “precludes this suit, the consequences would be that [Genentech, et al.] win this case *on the merits*—not that...Article III jurisdiction is somehow defeated. In short, Article III jurisdiction has nothing to do with this ‘insurance policy’ contention.”¹² The Court concluded by stating that the lower courts are in the best position to decide whether discretionary dismissal or “merits-based arguments” warrant the denial of declaratory relief.

The Court’s failure to address licensee estoppel, and the effect of *Lear* on the doctrine, leaves open substantial questions on remand. A careful reading of *MedImmune* reveals that the Supreme Court overturned only the Federal Circuit’s Article III decision. On remand, the Federal Circuit may

still reject MedImmune’s claims on the merits, based on the court’s interpretation of licensee estoppel.

The Aftermath

There is little doubt that *MedImmune* will create a flurry of increased declaratory judgment actions challenging patents—including between parties who had seemingly resolved their disputes.¹³ How such actions are framed (contract versus patent) and the specific language of the license agreement are clearly important. However, the long-term impact of the *MedImmune* decision remains to be seen. How the courts interpret *MedImmune*, and how the case is handled on remand, is critical. Courts must evaluate the status of licensee estoppel and *Lear*. *MedImmune* does not require modification of the Federal Circuit’s pre-*MedImmune* narrow interpretation of *Lear* as set forth in *Shell Oil*. And, because the Supreme Court did not reach the *Lear* issue in *MedImmune*, the courts can apply a narrow interpretation of *Lear* on remand.

The *MedImmune* decision also will inevitably impact the drafting of license agreements. The language of the license becomes critical—because, as *MedImmune* demonstrates, even Article III jurisdictional determinations are intensely fact-specific. The Supreme Court in *MedImmune* implied that parties can contract away completely the right to challenge patent validity—“no-challenge clauses.” It is questionable whether such a provision would be enforceable under *Lear* and its progeny.

However, one can envision numerous ways a licensor could attempt to contract around *MedImmune* while arguably respecting the spirit of *Lear*: allowing for patent challenges, but making such a challenge trigger a steep increase in royalty payments or a large lump sum payment (to cover the licensor’s litigation expenses); allowing the licensor to terminate the license upon the licensee’s challenge to the patents; limited-challenge, wherein licensee may only challenge patent validity when defending a suit for royalties or patent infringement; specifying that licensor keeps the money from royalty payments made during a successful challenge to patent validity; awarding attorney’s fees to the licensor upon an unsuccessful challenge; and choice of forum or venue clauses should the licensee decide to challenge the patents.

Obviously the parties’ relative bargaining power will greatly impact their willingness to include some or all of these provisions in the license agreement. One can also envision drafting such clauses to cover not only validity challenges, but scope of patent challenges (e.g., whether a “next generation” product is covered by a licensed patent). No case, including *Lear*, has directly addressed the validity of such clauses. It seems likely that the Federal Circuit will accept many of them as valid. In *Barr*, the Federal Circuit discussed a provision

allowing the licensor to terminate the license if the licensee asserted invalidity, implicitly recognizing the validity of the provision.¹⁴

Other considerations involve the timing and types of payments. It is now increasingly advantageous to enter into front-loaded, fully paid-up patent licenses. Such a license structure makes patent challenges of little value to the licensee unless circumstances have changed (e.g., a new product triggers additional payments), because the full fee for use of the patent in the current product(s) is fully paid, and typically contracted to be nonrefundable.

Finally, it is worth noting that there remains uncertainty as to what law—federal circuit or regional circuit law—will be applied in interpreting and enforcing such license terms.¹⁵

Conclusion

The *MedImmune* decision is narrow and reaches only the Article III subject matter jurisdictional issue. Because the Supreme Court chose not to reach the issue of licensee estoppel, on remand *MedImmune's* claims can be rejected on this basis. As a result, *MedImmune*, along with any other licensee seeking to maintain a license while challenging a patent's validity, could have a right with no remedy—having won the jurisdictional battle only to be out of court, courtesy of licensee estoppel.



Catherine Nyarady is a litigation partner at Paul, Weiss, Rifkind, Wharton & Garrison LLP, specializing in patent litigation. Benjamin Warlick, an associate with the firm, assisted with the preparation of this article.

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Endnotes

1. *MedImmune, Inc. v. Genentech, Inc.*, 549 US—, no. 05608, slip op. at 18 (Jan. 9, 2007).
2. *Gen-Probe, Inc. v. Vysis, Inc.*, 359 F.3d 1376, 1380 (Fed. Cir. 2004).
3. While the Supreme Court's recent *eBay* decision reversed the general rule that permanent injunctions will issue against patent infringers absent exceptional circumstances, it by no means eliminated the risk of a permanent injunction. *eBay Inc. v. MercExchange, L.L.C.*, 547 US—, 126 SCt 1837 (2006).
4. *MedImmune, Inc. v. Genentech, Inc.*, 427 F.3d 958, 962 (Fed. Cir. 2005).
5. *MedImmune*, no. 05-608, slip op. at 9.
6. *Lear, Inc. v. Adkins*, 395 US 653 (1969).
7. *Blonder-Tongue v. University Foundation*, 402 US 313, 346 (1971).
8. See, e.g., *Geni-Chlor Int'l, Inc. v. Multisonics Dev. Corp.*, 580 F.2d 981 (9th Cir. 1978); *Warner-Jenkinson Co. v. Allied Chemical Corp.*, 567 F.2d 184 (2d Cir. 1977); *Milprint, Inc. v. Curwood, Inc.*, 562 F.2d 418 (7th Cir. 1977); *Hanes Corp. v. Millard*, 531 F.2d 585 (D.C. Cir. 1976); *Atlas Chem. Indus., Inc. v. Moraine Prods.*, 509 F.2d 1 (6th Cir. 1974); *Thiokol Chem. Corp. v. Burlington Indus., Inc.*, 448 F.2d 1328 (3d Cir. 1971); *Product Eng'g & Mfg., Inc. v. Barnes*, 424 F.2d 42 (10th Cir. 1970).
9. *Studiengesellschaft Kohle, mbH v. Shell Oil Co.*, 112 F.3d 1561, 1568 (Fed. Cir. 1997).
10. *Gen-Probe*, 359 F.3d at 1381.
11. *MedImmune*, no. 05-608, slip op. at 5, 16.
12. *MedImmune*, no. 05-608, slip op. at 17, emphasis in original.
13. The Federal Circuit previously held that the importance of upholding and enforcing settlement agreements and consent decrees outweighed the policy in *Lear* of promoting patent challenges. See *Foster v. Hallco Mfg. Co.*, 947 F.2d 469 (Fed. Cir. 1991); *Hemstreet v. Spiegel, Inc.*, 851 F.2d 348 (Fed. Cir. 1988).
14. "In the event BARD asserts invalidity of any of the said Patents within the scope of this Agreement and refuses to pay royalties on account of such asserted invalidity, then GRANTOR may terminate this Agreement as to the Patent or Patents as to which invalidity is asserted." *C.R. Bard, Inc. v. Schwartz*, 716 F.2d 874, 881 n. 5 (Fed. Cir. 1983).
15. See *Holmes Group, Inc. v. Vornado Air Circulation Sys., Inc.*, 535 U.S. 826 (2002); *Advanced Card Techs. LLC v. Versatile Card Tech., Inc.*, 410 F. Supp. 2d 158, 161 (SDny 2006).

Missed Something?

Back copies of *IPLS Proceedings*
can be found at
<http://www.michbar.org/ip/archive.cfm>

Confused about what the court really said in *KSR Int'l Co. v. Teleflex Inc.* about how to respond to an obviousness rejection for a combination of elements? See the letter sent by The Deputy Commissioner to the Patent Examining Corp as a result of the decision.

Date: May 3, 2007

To: Technology Center Directors

From: Margaret A. Focarino, Deputy Commissioner for
Patent Operations

Subject: Supreme Court Decision on *KSR Int'l Co. v Teleflex, Inc.*

The Supreme Court has issued its opinion in *KSR*, regarding the issue of obviousness under 35 U.S.C. § 103(a) when the claim recites a combination of elements of the prior art. *KSR Int'l Co. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). A copy of the decision is available at <http://www.supremecourtus.gov/opinions/06pdg04-1350.pdf>. The Office is studying the opinion and will issue guidance to the patent examining corps in view of the *KSR* decision in the near future. Until the guidance is issued, the following points should be noted:

- (1) The Court reaffirmed the *Graham* factors in the determination of obviousness under 35 U.S.C. § 103(a). The four factual inquiries under *Graham* are:
 - (a) determining the scope and contents of the prior art;
 - (b) ascertaining the differences between the prior art and the claims in issue;
 - (c) resolving the level of ordinary skill in the pertinent art; and
 - (d) evaluating evidence of secondary consideration.

Graham v. John Deere, 383 U.S. 1. 17-18, 148 USPQ 459, 467 (1966).

- (2) The Court did not totally reject the use of “teaching, suggestion, or motivation” as a factor in the obviousness analysis. Rather, the Court recognized that a showing of “teaching, suggestion, or motivation” to combine the prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. § 103(a).
- (3) The Court rejected a rigid application of the “teaching, suggestion, or motivation” (TSM) test, which required a showing of some teaching, suggestion, or motivation in the prior art that would lead one of ordinary skill in the art to combine the prior art elements in the manner claimed in the application or patent before holding the claimed subject matter to be obvious.
- (4) The Court noted that the analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit, and that it was “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. The Court specifically stated:

Often, it will be necessary ... to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an **apparent reason** to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis **should be made explicit**.

KSR, slip op. at 14 (emphasis added).

Therefore, in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.

Thoughts on Patent-Bashing, Obviously

By Roberta J. Morris, Esq. PhD¹

Patent-bashing is in fashion again.

People blame the usual suspects: business method patents, the differences between pharmaceuticals and software,² and that hardy perennial, poor patent quality, but I observe two other influences. They relate to the changing sociology of patent litigation and scholarship.

Influence One: A misplaced defense bar mentality.

A defense bar mentality has been creeping into discussions of patent issues in the courts and the media and general conversation. I believe it comes from the increasing presence in patent litigation of general practice litigators. These excellent lawyers differ in significant ways from those of the old patent boutiques; their clients and their cases are different, too.

First: the lawyers themselves. The general practice lawyers have honed their skills in antitrust, securities, and tort cases. The boutique lawyers have always specialized in patent law. They may litigate contracts and other intellectual property causes of action (trademark, trade secret, copyright) but patents are their main focus.

The general practice attorneys' understanding of the patent system is not based on years of familiarity because they just haven't been involved very long. They are intelligent and capable, but that can take them only so high on the patent law learning curve.

In a patent lawsuit, what is at stake or lying in the weeds may not be completely apparent to someone unfamiliar with patent prosecution and counseling. Experience is not necessarily necessary, if the litigator has partners or friends with a fund of stories to tell. But without that kind of rich resource, lawyers may have an idea of the big picture that is, well, small.

Second: the clients. In a big firm general litigation practice, much of the work is for corporate defendants. When these firms are hired in a patent case, the clients are those who want, and can afford, to hire prestigious Washington counsel.

Boutique litigators, on the other hand, are usually in firms that have prosecution clients, who in turn bring in both plaintiff and defendant work. The litigators' reputations rest on knowing all the angles from both sides. The clients run the gamut in size, too.

Infringement defendants, regardless of which lawyer they hire, usually have patents of their own, very often in crowded arts. But the boutiques may be more likely to have clients whose budgets and temperaments incline them toward early settlement, clients for whom patent lawsuits are neither once-in-a-lifetime nor win-or-die affairs. Such companies want a patent system that is even handed, because they know themselves to have two hands.

Third: the issues. General practice litigators are often hired for an appeal or a cert. petition. Boutique litigators usually handle a case from before the first threatening letter is written or before the possible design-around is tooled up (and patented itself).

So what? These factors foster a population of lawyers, and even clients, who find it hard to shake off the defense bar mentality. But shake it off they should. It interferes with clear thinking about patent issues and patent policy.

* * *

My own experience has not been limited to a particular side, and when I teach, my sympathies shift back and forth, depending on the facts. Some accused infringers are rotten stinkers and some patent owners are greedy sleazebuckets. And many of each are honorable and are trying to do the right thing in a situation with no obvious right answers. (Of course, those will often settle their cases early, if the cases even begin.³)

One reason I have always liked patent law is that it didn't have a plaintiffs' bar and a defendants' bar. Today's patent owner is tomorrow's accused infringer and vice versa. It's inevitable: a patent is a right to exclude but not to do.

In mainstream litigation, by contrast, prejudices and generalizations may lead to the belief that lawsuits are brought by either (a) little guys seeking redress from a big guy who has deeply wronged them, or (b) little guys looking for a big guy with a deep pocket whose spare change can put them on easy street. In patent infringement litigation, neither size nor legitimacy correlates with a particular side of the *v.*, regardless of preconceived notions. Little guys sue big guys for infringement, sometimes rightly, sometimes wrongly, and big guys sue little guys, ditto. Even more often, same-sized guys sue each other, and patents are but one of the many weapons they brandish in their ever-continuing combat.

Traditional patent plaintiffs cannot entirely avoid being defendants. Proprietary drug companies, who often charge generics with infringement, can be sued by competitor proprietaries. Even individual inventors and non-practicing patent investors have to contend with prior art patents from which potential licensees will want indemnification. To negotiate intelligently, those patent owners need to understand defense issues.

Nor can defendants ignore the plaintiffs' perspective for long. Almost all big companies have plenty of their own patents. And regardless of size, it is the very rare enterprise that, defending its first infringement suit, does not start thinking

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about filing an application or acquiring an issued patent. Even the generic drug companies now own patents.

Despite the fact, then, that accused infringers should not wish for changes in the law that will harm them when they wear the patent owner's hat, the defense bar view is more and more popular. I see it in the press and I hear it when I mention to someone that I teach patent law.

That word *troll* does not help. An opposing noun is needed. *Pirate* is too attractive: Johnny Depp immediately comes to mind. *Thief*, while appropriately pejorative, is too ordinary. Of course, not all accused infringers are thieves, inasmuch as neither intent nor knowledge of the patent is part of the cause of action, but then, whatever troll means, it does not apply to all patent owners, nor even to all non-practicing patent owners. Perhaps IP TODAY will sponsor a contest to level the linguistic playing field. [Sure. See next month's issue. — Eds.]

Many of the people who love to talk about trolls are, I am afraid, people in law schools. Which brings me to the second influence in the renewed respectability of patent-bashing.

Influence Two: The huge volume of patent law scholarship

Twenty-five years ago, you would be hard pressed to find an article about patent law in a student-edited law review. If you did, it was probably a student note.⁴ Equally rare were amicus briefs from professors of patent law, although there was one in *Graham v. John Deere Co.*, 383 U.S. 1 (1966), see below. The amicus brief supporting the petition for certiorari in *KSR v. Teleflex* signed by 24 law professors (see <http://www.supremecourtus.gov/docket/04-1350.htm>) is a sign of the times.

A generation ago almost the only people teaching or writing about patent law were practitioners, and they rarely published in student-run law reviews. Nowadays several hundred articles about patent law appear annually in the law school reviews, both the standard ones and the 20-odd new ones with technology or intellectual property in their names.

The authors are mostly young academics whose knowledge of patent law is limited to a patent course or two and legal research for a seminar paper or summer job. Maybe they clerked for a judge or spent a few years at a big firm, but they are not exactly seasoned patent lawyers. They don't know what they don't know, and many of their criticisms and suggestions are comically naive or wrong headed. Yet criticize and suggest they do, sometimes even without having read the statute. (Citations omitted to protect the all too innocent.)

They propose theories about what is wrong with the patent system and patent law decisions, and they give authority (the citable kind) to patent bashing. Their views are taken seriously not only by their fellow young academics, but also by the press and even by practicing lawyers, in house and out, who do not know much about patent law themselves.

The ranks of the patent bashers are thus swelled.

Triumph of the Bashers? Notes about KSR, Graham, and Dembiczak

By the time you read this, *KSR v. Teleflex* will probably have been decided by the Supreme Court (Docket 04-1350). It is *not* likely that the case will be dismissed on the grounds that certiorari was improvidently granted, although there would be some justification for that.

In the appeals court decision under review, *Teleflex, Inc. v. KSR Int'l Co.*, 119 Fed. Appx. 282 (Fed. Cir. 2005) (unpublished), the Federal Circuit vacated and remanded a holding of obviousness on the grounds that the trial court had made insufficient findings of a teaching, suggestion or motivation (TSM, or simply *suggestion*) in the prior art to make the claimed combination.

This posture⁵ is hardly ideal for analyzing TSM's propriety, wisdom, flexibility, or practicability. That doesn't prevent the justices from ruling on the question presented (briefly, whether the federal circuit erred in requiring the trial court to look for a suggestion at all, see <http://www.supremecourtus.gov/qpl/>

04-01350qp.pdf), but it certainly makes their job harder. Indeed, the irritation some of them expressed during oral argument may stem more from the lack of findings than the merits or demerits of TSM.

The justices can of course look at the findings in past obviousness decisions, but the exposition of facts in judicial opinions is limited. Dissents and concurrences help only so much. Nothing substitutes for a complete record, including findings on all the facts about obviousness.

It is singularly difficult to think about principles of patent law without a concrete case, or better yet, several of them, in mind. Who would want to resolve in the abstract questions like: Is a particular obviousness formulation good or bad at furthering the constitutional purpose of Art. I, sec. 8, cl. 8 ("To promote the Progress of Science⁶ and useful Arts")? Does that formulation work intelligently for inventions in crowded fields and brand new ones, in high tech and low tech areas alike? The justices, who have little experience with the obviousness standard⁷, are more to be pitied than censured, whatever they do in *KSR*.

The current attacks on the *suggestion* test feed and are fed by the patent-bashers. (Some in the blogosphere agree: see e.g., http://www.patentlyo.com/patent/graham_factors/index.html.) The test is *not* some new-fangled pro-patent silliness. It predates *Graham* and it predates the 1952 Act's codification of obviousness in 35 USC 103, a codification that, as the Supreme Court stated in *Graham*, did not change the "general level of patentable invention." (383 U.S. at 17).

In 1983, just after the federal circuit's first birthday, in *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983), Howard T. Markey, the circuit's first chief

judge and the former chief judge of the Court of Customs and Patent Appeals (CCPA), explained why a conclusion of obviousness required a finding of a suggestion in the prior art: such an analysis would prevent the evaluator from wrongly using “the claims as a frame [and taking] individual naked parts of separate prior art references [to make] a *mosaic*,” at 1552 (emphasis mine) and would guard against the “insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher,” 721 F.2d at 1553. Markey’s concern to avoid hindsight also led him to say: “That evidence [objective evidence, also called the secondary considerations] can often serve as insurance against the insidious *attraction of the siren hindsight when confronted with a difficult task of evaluating the prior art*” (721 F.2d at 1551, emphasis mine).

Neither sirens nor mosaics (those memorable Markey metaphors) were mentioned in the parties’ briefs in *KSR*, nor was *Gore* itself. This important case was cited directly only in five amicus briefs, two from bar groups (New York Intellectual Property Law Association (NYIPLA) and American Intellectual Property Law Association (AIPLA)) and three from industry/corporate filers (United Inventors Association, Biotechnology Industry Organization, and Ford and DaimlerChrysler). Only AIPLA mentioned the mosaic; nobody mentioned the siren. A slightly different six amici mentioned the “insidious effect,” but most relied on cases more recent than *Gore*,⁸ possibly contributing to the mistaken view that the *suggestion* test is part of a recent federal circuit tendency to uphold patents that royally need a good bashing.

Among the most bashable seems to be *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the pumpkin garbage bag case. But surprise: the bag was never patented. The case was on appeal from a rejection by the Patent Office. The bashers also conveniently forget that, as in *Teleflex*, the federal circuit in *Dembiczak* did not find nonobviousness. Rather, it found that the record lacked evidence of suggestion.

Although petitioner, respondent and 18 of the 38 amicus briefs cited *Dembiczak*, only two amici noted that no utility patent has ever issued.⁹ When the application returned to prosecution, the examiner must have been able to show that the prior art indeed suggested making the claimed invention. This should satisfy those who laugh at the notion of patenting the pumpkin bag, people who would never describe it with the patent word “nonobvious” or even the copyright word “original,” whether or not they would admit that, the first time they saw one of those bags sitting by the curb, they grinned and said “Well, will you look at THAT!”

The Supreme Court undoubtedly will read *Gore* and the cases from the Court of Customs and Patent Appeals (CCPA), such as those cited in the NYIPLA amicus brief, and will learn that *Gore* and the suggestion test rely on precedent going back to at least 1943. Decisions of the CCPA are, of course, binding on the federal circuit, *South Corp. v. United States*, 690 F.2d 1368, 1369 (Fed. Cir. 1982), until overruled by the circuit in banc or the Supreme Court.

In *Gore*, Judge Markey cited the same 1961 CCPA case as NYIPLA, *In re Bergel*, 292 F.2d 955, 956-57, and contrasted it with a post-*Graham* CCPA case from 1969, *In re Spon-noble*, 405 F.2d 578, 585. The first case does not find a suggestion in the prior art, the second does. With such concrete, contrasting examples, it is easier to ponder the value and rightness of the *suggestion* test, but maybe it is harder to bash it.

How *KSR* Might Begin, and Thoughts on the Court’s Friends, Old and New

Here are two ways the Court might begin its *KSR* decision.¹⁰ They neither bash nor bless, but the second brings us back to bashing.

1. “Opinions about obviousness are to a certain extent a function of time.” This was said by the most famous patent examiner of all, Albert Einstein, although the context was not patent law.¹¹ This quote is not yet in the patent literature. It should be.
2. “After a lapse of many years, the Court again focuses its attention on the patentability of inventions”

These are the opening words of *Graham*, except that the number 15 was used instead of “many” years. Almost three times 15 years have passed since *Graham*, and many things have changed, among them the number and sources of amicus briefs, and so I return to patentbashing.

In *KSR*, 38 amicus briefs were filed after the cert. petition was granted. By my count, 10 were from lawyers and bar associations, 6 from professors (2 law only, 2 non-law only, 2 mixed), 1 from the solicitor general, 4 from other nonprofits, 6 from trade groups, and 11 from companies.

The last 17 friends of the court, which in a non-patent case would likely side with the defendant, went 11:5 for the plaintiff patent owner-respondent (with 1 brief designated as for neither side). On the pro-plaintiff side was a brief jointly signed by 3M, GE, Procter & Gamble, duPont, and Johnson & Johnson. They are not trolls, nor are they traditional enemies of the defense bar.

In *Graham* there were a mere five amicus briefs. Four were from bar groups. (If Chief Justice Roberts had presided back then, his much-reported witticism during the *KSR* oral argument, that the patent bar likes the TSM test because it is profitable, see, e.g., <http://271patent.blogspot.com/2006/11/morning-after-ksr-v-teleflex.html>, might have been, “The patent bar likes 103 because it is profitable for them.” But then statutes always are profitable for the bar, even nonpatent statutes, even for the defense bar, which without the plaintiffs’ bar would be out of a job.)

The fifth *Graham* amicus was a professor: E. Ernest Goldstein of the University of Texas Law School with Dean Page Keeton of counsel. It was titled “Brief Amicus Curiae in Support of 35 USC 103.” (1965 WL 115655) It makes excellent reading even today.

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Optimism for the Future

The good news is that time is on our side. Not just that the pendulum always swings, but that the formerly defense bar litigators will represent more patent owners, and the young academics will become the old guard, mentoring the next generation, and pointing out the errors and omissions of youth and inexperience.

Meanwhile, one can only hope that the Supreme Court will not do too much damage if they try to fix a system that, whether or not it ain't broke, is certainly bashed. ?

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Endnotes

1. Roberta J. Morris, Ph.D., Esq., rjmorris@alumni.brown.edu, member of the patent bar and of the bars of New York and Michigan, holds an AB from Brown, a JD from Harvard, and a Ph.D. (physics) from Columbia, in that order. She has practiced and taught patent law for a long time. From 1991 to 2005 she was an adjunct at the University of Michigan Law School. She now resides in California and is currently a lecturer at Stanford Law School.

Full disclosure: in 2004 Morris was an expert witness for Teleflex in a contract arbitration involving adjustable pedal patents (but not the patent in suit in *KSR* discussed here); she has had no contact with Teleflex or the pedal art otherwise.

She thanks Prof. Rebecca S. Eisenberg, Greg Aharonian, and Prof. Mark A. Lemley for listening to some of these ideas in their infancy. She thanks Philip H. Bucksbaum for editorial advice and Stanford Law Library for its excellent research assistance.

All views, errors, and omissions are solely those of the author.
2. See, e.g., 1/21/07 posting by Prof. Robert Merges on Dennis Crouch's PatentlyO blog, commenting on the e-newsletter of Foley & Lardner's Hal Wegner. http://www.patentlyo.com/patent/2007/01/merges_back_to_.html
3. I have long believed that judicial decisions and newsworthy jury verdicts give a poor picture of how the law works, despite the fact that they are all that most law students and non-practicing law graduates (e.g., politicians) know about. Those cases are not the tip of the iceberg, because with an iceberg it's ice all the way down. A case that settles, and even more, a case that never begins because people behaved differently — early or late, on advice of counsel or not — is a different animal from a case that goes to court and stays there long enough for a judge to publish any written opinions or a jury to reach a verdict.
4. E.g., Alex Kozinski, "A Market Oriented Revision of the Patent System," 21 UCLA L. Rev. 10431080 (1973-1974).
5. Few of the 38 amicus briefs filed after certiorari was granted in *KSR* mentioned the procedural posture of the case. Exceptions include Biotechnology Industry Organization (supporting respondents); Altitude Capital Partners, et al (supporting respondents); the Solicitor General (supporting petitioner); and Cisco Systems Inc. et al. (supporting reversal). All briefs are available on both LEXIS and Westlaw.
6. Many writers, including patent historian Edward C. Walterscheid in the title of his excellent 1998 book, *TO PROMOTE THE PROGRESS OF USEFUL ARTS: AMERICAN PATENT LAW AND ADMINISTRATION, 1787-1836*, divide the constitutional clause's three pairs of nouns between patents and copyrights, putting Science (that is, knowledge) with Authors and Writings.
7. Only Justice Stevens was on the Court the last time it granted cert. on a case involving obviousness. *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809 (U.S. 1986). There the Court ducked the substantive issue, remanding to the federal circuit for failure to make findings sufficient under Rule 52, F.R.Civ. P. The federal circuit subsequently found that the prior art did not suggest making the cable ties claimed in Panduit's patents. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1568 (Fed. Cir. 1987). The parties in *KSR* make no mention of *Panduit*, although 7 of the 38 amici do.
8. The brief of Ford Motor Company and DaimlerChrysler Corporation (supporting neither party) cites *Gore*. The Federal Circuit decisions cited in other briefs are: *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664 (2000), Progress & Freedom Foundation (supporting petitioner) ("insidious effect;" this brief also quotes *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 873 (Fed. Cir. 1985) for its reference to "the tempting but forbidden zone of hindsight"); *In re Kotzab*, 217 F.3d 1365, 1369 (2000), Intellectual Property Owners Association (supporting respondents); *In re Dembiczak*, 175 F.3d 994, 999 (1999), United Inventors Association (supporting respondents) (this brief also includes the internal *Gore* (1983) citation; and *In re Fine*, 837 F.2d 1071, 1075 (1988), American Bar Association (supporting respondents).
9. Only Technology Properties Limited (supporting respondents) and Prof. Lee Hollaar (urging affirming in part and vacating in part) noted that no utility patent ever issued to Dembiczak et al.
10. Regular IP Today columnist Laurence B. Ebert, also willing to second guess the *KSR* opinion, suggested on 1/28/07 that the Supreme Court will do for TSM what it did in *Daubert* for "general acceptance." <http://ipbiz.blogspot.com/2007/01/ipbizproposes-possible-form-of-ksr-v.html>.
11. Ronald W. Clark, *EINSTEIN, THE LIFE AND TIMES* 264 (1971). Einstein did not make this statement while working as an examiner. He said it during the question period following a lecture he gave in Bad Nauheim, one of a series of lectures organized by the anti-Semitic, mostly nonscientist Study Group of German Natural Philosophers, that attacked relativity as "Jewish science." Clark 257-264. Clark notes that there was no transcript of the event, but that *Physikalische Zeitschrift* XXI:666-668 (1920) reported the interchanges.



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