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PRESIDENT - SCHEDULING (FUTURE) FILES FOR  
1974 and 1975 are in Mr. Buchen's closet.



THE WHITE HOUSE

WASHINGTON

SCHEDULE PROPOSAL

DATE: January 8, 1976

FROM: Philip W. Buchen *P.W.B.*

VIA : William Nicholson

cc: Dick Cheney  
Doug Bennett

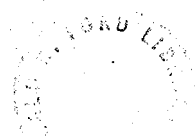
MEETING: Appearance by the President at the offices of the Federal Maritime Commission.

DATE: As soon as possible after the nomination of Robert Casey as a Member of the Commission is reconfirmed by the Senate.

PURPOSE: To have the President fulfill his commitment to participate in the swearing-in of Robert Casey and to give due recognition at the same time to the recent appointment of Karl Bakke as Chairman of the Commission.

When Karl met with the President on January 3, 1976, the new Chairman pointed out to the President that due to an overcrowded schedule, the President had been unable to participate in his swearing-in, that as a result the new Chairman had assumed office without any ceremony, but merely by having his oath administered in private by a member of the Commission staff. Chairman Bakke made the point that if the President were now going to become involved in the swearing-in of Robert Casey, a Democratic appointee, it would put the Chairman at a disadvantage in respect of the other Commission members and the Commission staff.

Thus, the Chairman would like to have a joint swearing-in with the President participating for both the Chairman and Mr. Casey. (It occurs to me that a second swearing-in at this date for the Chairman would look somewhat contrived and an alternative would



be that the President, while participating in the ceremony to install Mr. Casey, could devote a substantial part of his remarks to Chairman Bakke without going through another swearing-in for him; but I would leave this point to your discretion.)

FORMAT: Location -- The Office building of the Federal Maritime Commission, 1100 L Street, N. W., where there is a meeting room.

PARTICIPANTS: Messrs. Bakke, Casey and their families, along with other members of the Commission and staff of the Commission who would be in the audience.

CABINET  
PARTICIPATION: None

SPEECH  
MATERIAL: Brief remarks by the President.

PRESS  
COVERAGE: Pool coverage with photos.

STAFF: Philip W. Buchen

RECOMMEND:

OPPOSE:

APPROVE \_\_\_\_\_ DISAPPROVE \_\_\_\_\_



THE WHITE HOUSE  
WASHINGTON

*Pres.  
Scheduling*

January 9, 1976

MEMORANDUM FOR: WILLIAM NICHOLSON  
FROM: PHIL BUCHEN *P.*

Attached is a copy of a telegram from Robert Herring who is a good friend of mine.

You will note that he expresses an interest in having Mrs. Ford appear if the President cannot do so. If it is the case that the President will not appear, I would appreciate your checking with Mrs. Ford's Scheduling Office as to her views on the matter.

I believe you should reply directly to Mr. Herring, but I would appreciate your advising me of what response you plan to make.

Attachment



The White House  
Washington

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10 PMS PHILIP W. BUCHEN  
11

12 COUNSEL TO THE PRESIDENT  
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14 THE WHITE HOUSE  
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23 YOU WILL RECALL THE INVITATION TO PRESIDENT FORD TO ATTEND A  
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APPEAR BEFORE SOME TWO THOUSAND PEOPLE AT THE 27TH ANNUAL AWARDS  
DINNER FOR THE NATIONAL CONFERENCE OF CHRISTIANS AND JEWS FOR  
WHICH I AM SERVING AS CHAIRMAN THIS YEAR. IN THE EVENT THE  
PRESIDENT'S SCHEDULE WILL NOT ALLOW FOR HIS APPEARANCE, WE WOULD  
LOVE TO HAVE MRS. FORD AS THE SPEAKER. WE DO NEED, HOWEVER, TO  
KNOW IN THE NEXT TWO WEEKS TO GIVE US TIME TO ARRANGE SOMEONE  
ELSE IF THIS IS NOT POSSIBLE. I WILL APPRECIATE WHATEVER HELP

WILSON R. FORD LIBRARY

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YOU CAN GIVE US IN THIS REGARD. REGARDS.

BOB HERRING

NNNN





THE WHITE HOUSE  
WASHINGTON

*Pres.  
Schindler*

January 9, 1976

MEMORANDUM FOR

WILLIAM NICHOLSON

FROM:

PHIL BUCHEN *P.*

As one who attended the Red Mass held early in 1975, I can report that the occasion was used by the participating clergymen to propagandize the President concerning the Roman Catholic's position on abortion. Therefore, I hesitate to recommend having the President accept the invitation to attend the renewal of the event on Sunday, January 25.



THE WHITE HOUSE

WASHINGTON

January 7, 1975

MEMORANDUM FOR:

~~PHILIP~~ BUCHEN  
WILLIAM BAROODY

FROM:

WILLIAM NICHOLSON *WUN*

SUBJECT:

Invitation to the President to attend  
the Red Mass, a traditional service  
for lawyers, on Sunday, January 25

I would appreciate your comments and recommendation on the  
attached invitation from Archbishop Baum.

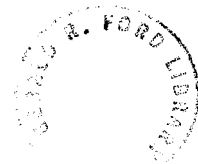
Thank you.

COMMENTS:





*The Lawyers Committee  
of the John Carroll Society  
respectfully invites you to attend the  
Votive Mass of the Holy Spirit  
historically known as  
The Red Mass  
to be concelebrated in  
St. Matthew's Cathedral  
on Sunday, the twenty fifth of January  
Nineteen hundred and seventy-six  
at ten o'clock in the morning  
His Excellency William W. Baum, S. T. D.  
Archbishop of Washington  
principal concelebrant  
His Excellency Eugene A. Marino, S. I. J., D. D.  
Auxiliary Bishop  
of the Archdiocese of Washington  
will preach*



# GENERAL ELECTRIC

KNOLLS ATOMIC  
POWER LABORATORY  
*President's*  
*Scheduling*  
WINDSOR SITE OPERATION

GENERAL ELECTRIC COMPANY . . . BOX 545 WINDSOR, CONNECTICUT 06095  
Phone (203) 688-4951

47 Alden Road  
Windsor, Conn. 06095  
January 11, 1976

The Honorable Philip W. Buchen  
General Counsel to the President  
The White House Office  
1600 Pennsylvania Avenue  
Washington, D.C. 20500

Dear Sir:

On August 2, 1965, I graduated from the United States Merchant Marine Academy, Kings Point, New York. Shortly before Graduation I was approached by the Alumni Association of Kings Point and asked if I would become Chairman of the Alumni Committee for a Presidential Visit to Kings Point. This was a project upon which I had worked in my senior year at the Academy and I very willingly accepted chairmanship of this committee. Due to the fact that I was out of the country during most of 1965 and 1966, the Committee was unsuccessful in persuading President Johnson to visit Kings Point. Now, unfortunately, I find myself terminally ill with malignant melanoma with a projected life-span of a couple of years. I now feel stronger than ever that I must complete the task of obtaining a presidential visit to Kings Point.

Kings Point is over thirty-one years old and it has the unfortunate "distinction" of being the only federal academy which has never been honored with a Presidential visit. In these times when the need for an improved U.S. Merchant Marine is more and more evident, it is only logical that the Merchant Marine Academy should be recognized. Kings Point is, without a doubt, the most vital link in supplying qualified Merchant Marine officers for the United States in war and peace. During World War II, two hundred and ten of her Cadets and Graduates gave their lives while serving on U.S. merchant vessels. Yet many Americans are unfamiliar with the Academy and for that matter with the American Merchant Marine. A Presidential visit would focus public attention upon both.

This, then, is why I am writing to you and all other members of Congress and the Cabinet. As an alumnus of U.S. Merchant Marine Academy and a father who wishes to leave his children the legacy that America is a country where one individual can be counted, I am asking you to help me in persuading President Ford to be the guest speaker at the Commencement Exercises to be held on June 21, 1976, at Kings Point. I can only say that I would be most honored and appreciative for any assistance which you might give me in this matter.

Yours truly,

*Richard F. Cole*  
Richard F. Cole



THE WHITE HOUSE  
WASHINGTON

January 22, 1976

*Pres. Scheduling*

GREET HONORABLE KARL BAKKE, CHAIRMAN, FEDERAL MARITIME COMMISSION, AND HONORABLE ROBERT (BOB) RANDOLPH CASEY (D-TEXAS)

Friday, January 23, 1976  
12:00 p.m. (10 minutes)  
The Oval Office

Via: Douglas P. Bennett *DPB*  
From: John A. Shaw *JAS*

I. PURPOSE

Swearing-in ceremony for Robert (Bob) Randolph Casey as Commissioner of the Federal Maritime Commission with expression of support for Karl Bakke's leadership.

II. BACKGROUND, PARTICIPANTS AND PRESS PLAN

A. Background

1. Bob was born in Joplin, Missouri on July 27, 1915 and moved to Houston, Texas in 1930.
2. He graduated from San Jacinto High School and attended the University of Houston and the South Texas School of Law at night.

He was admitted to the State Bar of Texas in 1940 and opened a law office in Alvin, Texas and served as city attorney and also a member of the school board.

He returned to Houston as an assistant district attorney in Harris County and was in charge of the civil department.

3. In 1948 he was elected to the State House of Representatives and served in the regular and special sessions of the 51st Legislature.



4. Bob was elected county judge of Harris County in 1950 for a 2-year term and was re-elected in 1952 and 1954 for a 4-year term.
5. He was elected Representative of the 22nd District of Texas in 1958, thus serving as a Member of Congress in the 86th, 87th, 88th, 89th, 90th, 91st, 92nd, 93rd, and 94th Congresses.
6. Bob served on the House Appropriations Committee and was Chairman of the Legislative Subcommittee.

- B. Participants: See Attached Sheet
- C. Press Plan: Announce to Press  
White House photographer only

### III. TALKING POINTS

..I am glad to have this opportunity to publicly welcome Karl Bakke to the Chairmanship of the Federal Maritime Commission. My plans to swear him in at the time of his confirmation unfortunately had to be abandoned because of the press of events but we have since met and had a chance to discuss at length the cross-section of problems facing the Commission.

..The wealth of experience which he brought to the Chairmanship from the Commerce Department has provided him with the kind of new perspective for the Commission which I had hoped for in nominating him, and I want to re-emphasize my confidence in the steadiness of his hand on the helm over there.

..It is with equal pleasure that I have the opportunity to welcome Bob Casey aboard at the Maritime Commission and to express my confidence not simply in him personally but in the extent to which his own wide experience with problems in the maritime field will be supportive of the Chairman's efforts.

..The President may wish to expand on the above noted facts of Casey's background and add any personal reminiscences or expressions of confidence which he thinks are appropriate to their relationship.



Participants:

The President  
Mr. Robert R. Casey  
Mr. Karl E. Bakke, Chairman  
Federal Maritime Commission  
Mrs. Anne-Rosseau Bakke (wife)  
Shelley Bakke  
Karl Bakke  
Mrs. Hazel Casey (wife)  
Mr. and Mrs. Robert R. Casey, Jr.  
and four children: Robert Casey,  
Christopher Casey, Michael Casey,  
and Katherine Casey  
Kevin Casey  
Mr. and Mrs. D. Gayle McNutt (staff)  
Mr. Brien Kehoe (staff)  
Pauline Reeping (staff)  
Judge and Mrs. Byron Skelton  
Mr. O. R. Crawford  
Mr. and Mrs. Kenneth Cunningham  
Florence Timko  
Tom Loeffler (White House staff)

UNION BANK AND TRUST COMPANY

NATIONAL ASSOCIATION  
200 OTTAWA N.W.,  
GRAND RAPIDS, MICHIGAN 49502

President's  
scheduling  
7/4/76

January 22, 1976

EDWARD J. FREY  
Chairman

Mr. Philip Buchen  
The White House  
Washington D.C. 20500

Dear Phil:

The enclosed correspondence speaks for itself.  
Anything you can do to have the President accept  
this speaking engagement will be appreciated.

Very best regards,



EJF:lw  
enclosures





CLARK, STROUP, BROWN, MACKENZIE & POINTNER

ATTORNEYS

FIRST NATIONAL BANK BUILDING  
PETOSKEY, MICHIGAN 49770

JOHN S. CLARK  
NATHANIEL W. STROUP  
PAUL W. BROWN  
BARBARA B. MACKENZIE  
THOMAS D. POINTNER

TELEPHONE  
AREA CODE 616  
347-3907

January 21, 1976

Mr. Edward J. Frey  
Chairman of the Board  
Union Bank & Trust Company  
200 Ottawa N.W.  
Grand Rapids, MI.

Dear Ed:

Last August and September you were great in contacting the President about his coming to Philadelphia next July 4 and speaking at the "Justice 76" conference of citizens which American Judicature Society is putting on that date.

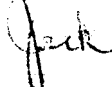
I am now Immediate Past President of American Judicature Society.

I enclose copy of my last letter to Mr. Nicholson in the White House. The President and the Chief Justice have both agreed to serve as Honorary Chairmen and I enclose for your information a copy of the actual committee which we have formed and which is in charge of the planning for this event.

If there is anything further you can do to help us get the President to accept our invitation, I would be most grateful. Hope to see you soon.

Best regards.

Sincerely,



John S. Clark

JSC/bh  
Encl.



THE WHITE HOUSE  
WASHINGTON

*Pres.  
Scheduling*

January 23, 1976

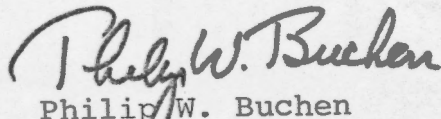
Dear Mr. Cole:

Many thanks for your letter in which you urge my support to obtain the appearance by President Ford at the U. S. Merchant Marine Academy in Kings Point, New York on June 21, 1976.

I appreciate your deep interest in this matter and regret your personal circumstances that compel your feeling of urgency to arrange a Presidential visit to the Academy. You can be sure that the President's advisors on scheduling matters will give your request full consideration, but you must understand that especially during this year of the Bicentennial and the election, demands on the President's time are extraordinarily heavy.

I do commend you for your loyalty and enthusiasm in regard to the U. S. Merchant Marine and the Members of the Academy.

Sincerely,



Philip W. Buchen  
Counsel to the President

Mr. Richard F. Cole  
47 Alden Road  
Windsor, Connecticut 06095



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January 11, 1976

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General Counsel to the President  
The White House Office  
1600 Pennsylvania Avenue  
Washington, D.C. 20500

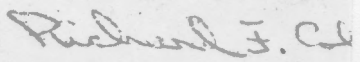
Dear Sir:

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Yours truly,

  
Richard F. Cole



THE WHITE HOUSE

WASHINGTON

January 27, 1976

MEETING WITH W. CLEMENT STONE

Wednesday, January 28, 1976

12:30 p.m. (20 minutes)

The Oval Office

From: Philip Buchen *P*

*Pres  
scheduling*

I. PURPOSE

To allow Mr. Stone to have a courtesy visit with you.

II. BACKGROUND, PARTICIPANTS & PRESS PLAN

Background: In the event Mr. Stone should raise the question with you of pardoning Otto Kerner, Jr., the attached (Tab A) will give you the necessary background.

Participants: W. Clement Stone. (You may also want Mr. Cheney present and if Mr. Stone should raise the question of a pardon, you may want to ask me to step into the meeting.)

Press Plan: David Hume Kennerly photograph only. Meeting will not be announced.

III. TALKING POINTS

(If question of pardon is raised, see Tab A.)



THE WHITE HOUSE

WASHINGTON

January 27, 1976

MEMORANDUM FOR THE PRESIDENT

THROUGH: PHILIP BUCHEN

*T.W.B.*

FROM: KENNETH LAZARUS

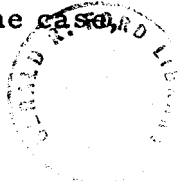
*KL*

SUBJECT: Otto Kerner, Jr.

You have requested a memorandum setting forth the considerations, both favorable and unfavorable, involved in granting a Presidential pardon to Otto Kerner, Jr., who was convicted of conspiracy, mail fraud and income tax evasion and on April 20, 1973, sentenced to three years' imprisonment and fined \$20,000. He was released from prison on parole in March 1975 after serving more than seven months and will be on parole until April 1976. He has paid the fine.

Under the normal rules governing petitions for Executive clemency, Mr. Kerner will not be eligible to apply for a pardon until March 1980. However, in order to permit immediate consideration of his application, he filed a petition for pardon on October 16, 1975 and requested that he be granted a waiver of the rule requiring a person convicted of income tax evasion to wait five years from the date of his release from confinement before applying for pardon. He pointed out, correctly, that the regulation is a permissive guide and not mandatory. He cited as reasons for present consideration of the petition his age (67) and health, which was described as substandard. As a principal reason for granting the petition he stated that a pardon would constitute an appropriate recognition by his country of acknowledged good service to society. While acknowledging that the verdict of guilt in his case is final, he suggested that the essential dispute was a moral one involving proprieties, rather than venality or corruption in its usual sense.

Mr. Kerner's request for a waiver was presented to the Attorney General, who recused himself from consideration of the case.



and requested the Deputy Attorney General to consider it. On December 16, 1975, the Deputy Attorney General denied a waiver of the five year waiting period.

### Favorable Factors

(1) Public Service: Mr. Kerner has a long record of dedicated and distinguished public service, as a United States Attorney, state judge, Governor of Illinois and finally as a Federal judge. A pardon certainly could be justified as recognition of the importance and significance of his many contributions to his state and the Nation.

(2) Age and Health: It is understood that Mr. Kerner has experienced many health problems. His petition filed in October stated he had recently suffered a malignant cancer of the lung and had undergone surgery which left him in a weakened condition, that he had a chronic heart condition and had suffered coronary incidents of moderate severity, and had a mild diabetic-arteriosclerotic condition. If Mr. Kerner is required to wait until 1980 before applying for pardon, he may not live long enough to enjoy or possibly even to receive it. Although age alone has never been considered a basis for early pardon consideration, there have been instances in the past in which waivers of the usual waiting period have been granted in cases of terminal illness.

(3) Rehabilitation: One of the undoubted principal reasons for requiring a waiting period of applicants for pardon is to afford them an opportunity to demonstrate their rehabilitation. In some cases the concept of rehabilitation is meaningless, as in the case of Mr. Kerner. As pointed out in his request for a waiver, there is "no question but that he will at all times be not merely a law-abiding citizen but an actively useful citizen."

(4) Waiting period requirement is not mandatory: The rule requiring a waiting period is not mandatory in its terms and it is well established that it is intended only as a guide for officials in the Department of Justice who are charged with responsibility for processing petitions for pardon. It has been held that the President's action in granting clemency cannot be challenged on the ground that the President did not comply



the procedures for consideration of petitions for Executive clemency as contained in the Code of Federal Regulations. Hoffa v. Saxbe, 378 F. Supp. 1221 (D.D.C. 1974). (The decision has been appealed but not yet decided by the Court of Appeals.) See also Yelvington v. Presidential Pardon and Parole Attorneys, 211 F. 2d 642 (D.C. Cir. 1954).

### Unfavorable Factors

(1) Ineligibility: As previously indicated, Mr. Kerner is not eligible to apply for pardon at this time under the rules governing petitions for Executive clemency. His request for a waiver of the waiting period was considered in the Department and ultimately denied by the Deputy Attorney General. The fact of Mr. Kerner's application for a waiver was well publicized, particularly in the Chicago area media. The fact of denial also has been equally well publicized. Thus, a pardon would necessarily emphasize that the Department and the White House were in disagreement.

(2) Effect on Watergate Offenders: At a press conference on February 26, 1975, you were asked about the possibility of pardons for former top Administration figures who had been sentenced in the Watergate case. You replied in part: ". . . If and when the time comes, the proper thing for them to do would be to apply in the regular procedure or process, which is through the Pardon Attorney in the Department of Justice." (Weekly Presidential Documents, Vol. II, No. 9, p. 221). A pardon for Mr. Kerner could revive the controversy surrounding the pardon of former President Nixon and other "Watergate" issues.

(3) United States Attorney's Opposition: The present United States Attorney in Chicago, during consideration of Mr. Kerner's request for a waiver, made clear his emphatic opposition to favorable consideration of the request.

(4) Public indignation: It is difficult to believe that a pardon of Mr. Kerner at this time would not arouse sustained and vociferous denunciation in the press and among a substantial portion of the public once it became generally known, as, of course, it would, that special consideration had been given to Mr. Kerner which is rarely given to others.



THE WHITE HOUSE  
WASHINGTON

January 30, 1976

MEMORANDUM FOR: WILLIAM BAROODY

FROM: WILLIAM W. NICHOLSON *WWR*

SUBJECT: Approved Presidential Activity

Please take the necessary steps to implement the following and confirm with Mrs. Nell Yates, ext. 2699. The appropriate briefing paper should be submitted to Dr. David Hoopes by 4:00 p.m. of the preceding day.

Meeting: National Association of Realtors (the National President and two or three top officers)

Date: Mon., Feb. 2, '76      Time: 12:00 p.m.      Duration: 10 mins.

Location: The Oval Office

Press Coverage:

Purpose: To make presentation of an original painting of "Uncle Sam".

cc: Mr. Cheney  
Mr. Hartmann  
Mr. Marsh  
Dr. Connor  
Dr. Hoopes  
Mr. Nessen  
Mr. Jones  
Mr. O'Donnell  
Mrs. Yates  
Mr. Orben  
Mr. Buchen  
Mr. Mitler





*Pres -  
Scheduling*

THE WHITE HOUSE

WASHINGTON

January 31, 1976

PARTICIPATION OF CHIEF JUSTICE BURGER  
IN SWEARING-IN OF ELLIOT RICHARDSON

Monday, February 2, 1976

2:00 p.m.

The East Room

From: Philip Buchen *P.*

I. PURPOSE

The Chief Justice will be here in the White House for the purpose of swearing-in Elliot Richardson as Secretary of Commerce. However, he would also like to talk to you very briefly on the subject of the Commission on Executive, Legislative and Judicial Salaries. (If you agree, it may be most appropriate if the Chief Justice were invited to meet alone with you for five minutes before you both go to the East Room.)

II. BACKGROUND & PARTICIPANTS

A. Background: The Chief Justice is looking to the Commission on Executive, Legislative and Judicial Salaries as a means of assuring Federal judges that the problems created by the present level of judiciary salaries will be corrected through the operation of this Commission. On January 30, the Chief Justice had delivered to you the resignation of Judge Bell from the Fifth Circuit Court of Appeals, and this resignation was prompted solely by salary considerations. The Chief Justice will cite this resignation as being indicative of what will surely happen in an increasing number of cases. Judge Bell is only 55 years old, has served 14 years on the bench, is a most qualified judge, and now finds himself unable to meet his family obligations from his judicial salary. Thus, he is leaving to take a position with a private law firm.

B. Participants: Chief Justice Burger.



III. TALKING POINTS

1. I understand that the Commission on Executive, Legislative and Judicial Salaries is to be appointed in sufficient time to permit its recommendations for salary adjustments to be considered by the President and included with the President's budget to be submitted to the Congress in January 1977.
2. I believe the Commission members should be selected as soon as possible so that they can begin their deliberations in July of this year or very soon thereafter. Three of the members are to be appointed by me, two by you as Chief Justice, two by the President of the Senate, and two by the Speaker of the House. Therefore, it is important that all four appointing officials agree upon a date by which all of the appointments will be made.
3. I know that you are ready to act promptly and I shall talk to the Congressional leaders about their views on the matter.
4. I believe the members of this Commission should be carefully chosen and should be persons who will command the respect of the public and the confidence of all three branches of government.

cc: Peter McPherson



UNITED STATES COURT OF CUSTOMS  
AND PATENT APPEALS  
717 MADISON PLACE  
WASHINGTON, D.C. 20439

*Pres  
Schubert*

CHAMBERS OF  
HOWARD T. MARKEY  
CHIEF JUDGE

February 3, 1976

Honorable Philip W. Buchen  
Counsel to the President  
The White House  
Washington, D. C.

Dear Mr. Buchen:

In accord with your generous suggestion, I enclose a copy of our letter to the President regarding our Third Annual Judicial Conference. We are neophytes when it comes to inviting Presidents and hope you can forgive any shortcomings in the letter.

I also enclose a copy of the Proceedings of our first conference. Pages 172-174 give a flavor of the Court. We have not yet received those of our second conference, but will forward a copy when it comes in.

Our main hope, of course, is that the President will consent to be our Luncheon Speaker. With exports-imports rising from about \$15 billion in 1956 to about \$100 billion in 1975, with the International Trade Commission newly launched under the Trade Act of 1974, and with apparent foreign concern over anti-dumping and counter-vailing duty actions, it may be that Treasury would view the Conference as an appropriate forum for a Presidential statement.

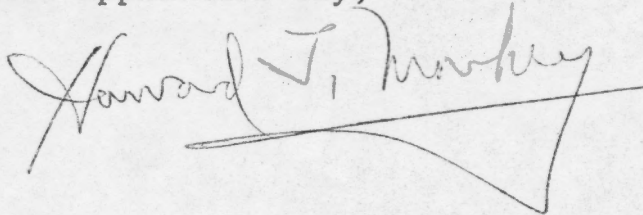
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- 2 -

We will be prepared to welcome the President at any time he decides to come. About 1 April, we must begin to line up the luncheon speaker, but I'm sure whomever we engage will be pleased to step aside if the President decides after 1 April to be our speaker.

Most appreciatively,

A handwritten signature in cursive script, reading "Howard T. Moskley". The signature is written in dark ink and is underlined with a single horizontal line.

Enclosure



THE WHITE HOUSE

WASHINGTON

February 4, 1976

*Pres. Abernathy*

MEMORANDUM FOR

BILL NICHOLSON

THROUGH:

JACK MARSH *J.M.*  
PHIL BUCHEN *P.W.B.*

FROM:

MIKE DUVAL *Mike*

SUBJECT:

REQUEST OF RALPH ABERNATHY TO  
MEET WITH THE PRESIDENT CONCERNING  
THE FBI SURVEILLANCE OF MARTIN  
LUTHER KING

I recommend against the President meeting with Mr. Abernathy concerning the FBI surveillance of Dr. King.

This matter is currently under investigation by the Justice Department, and I believe it would be inappropriate for the President to discuss this, even in broad terms.

I recommend that Mr. Abernathy be referred to the Attorney General and that we ask Ed Levi to meet with him.



THE WHITE HOUSE

WASHINGTON

January 30, 1976

MEMORANDUM FOR:

✓ MIKE DUVAL  
JOHN CALHOUN

FROM:

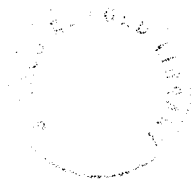
WILLIAM NICHOLSON *wnn*

SUBJECT:

Request of Ralph Abernathy of SCLC to meeting  
with the President to discuss domestic surveillance  
of Dr. Martin L. King, Jr. and other matters

I would appreciate your recommendations on how to handle the  
attached request.

Thank you.



ACTION  
 T/D \_\_\_\_\_  
 SCHEDULE BD. \_\_\_\_\_  
 DATE RECEIVED \_\_\_\_\_  
 JAN 30 1976  
 MESSAGE \_\_\_\_\_  
 SPEAKERS BUREAU \_\_\_\_\_  
 OTHER \_\_\_\_\_

HONORABLE GERALD FORD  
 WASHINGTON DC 20500

WE KNOW THAT YOU HAVE A TERRIBLY BUSY SCHEDULE, LEADING THIS ~~POINT~~ AND:  
 FURNISHING LEADERSHIP FOR ALL OF THE PEOPLES OF THE WORLD, BUT WE ARE  
 SURE THAT YOU ARE KNOWLEDGEABLE OF THE SENATE AND HOUSE COMMITTEE'S  
 WORK DEALING WITH DOMESTIC SURVEILLANCE ON AMERICAN CITIZENS. IT IS  
 BECAUSE OF THESE COMMITTEE'S REPORTS ON THE SURVEILLANCE OF OUR FOUNDER  
 AND THE YOUNGEST NOBEL PEACE PRIZE LAUREATE, THE FIRST IN THE STATE OF  
 GEORGIA-DR MARTIN LUTHER KING JR-THAT WE REQUEST A MEETING WITH YOU AS  
 SOON AS YOUR BUSY SCHEDULE PERMITS. WE WOULD BRING WITH US THREE OTHER  
 PERSONS TO DISCUSS A COURSE OF ACTION IN LIGHT OF THE SENATE AND HOUSE  
 INTELLIGENCE COMMITTEE'S FINDINGS

RALPH DAVID ABERNATHY NATIONAL PRESIDENT  
 AND JOSEPH E LOWERY CHAIRMAN OF THE BOARD  
 SOUTHERN CHRISTIAN LEADERSHIP CONFERENCE  
 334 AUBURN AVE NORTHEAST  
 ATLANTA GA 30303

23:50 EST

MGMWSHT HSB

*Pres.  
Scheduling*

February 5, 1976

Dear Judge Markey:

Many thanks for your letter of February 3 in which you express your interest in having the President address the Third Annual Judicial Conference of the U. S. Court of Customs and Patent Appeals.

As you probably realize, the President's schedule during the coming months involves unusually heavy demands on his time. However, I know that the people in a position to help arrange his overall schedule will give careful consideration to your invitation and will advise you as soon as possible as to whether the President can respond favorably.

Sincerely,

Philip W. Buchen  
Counsel to the President

The Honorable Howard T. Markey  
Chief Judge  
United States Court of Customs  
and Patent Appeals  
717 Madison Place  
Washington, D. C. 20439

bcc: Wm. Nicholson  
NOTE: If it is not possible for the President to accept this invitation, I recommend that he send a message to be read at the Conference.







UNITED STATES COURT OF CUSTOMS  
AND PATENT APPEALS

717 MADISON PLACE  
WASHINGTON, D.C. 20439

CHAMBERS OF  
HOWARD T. MARKEY  
CHIEF JUDGE

February 3, 1976

Honorable Philip W. Buchen  
Counsel to the President  
The White House  
Washington, D. C.

Dear Mr. Buchen:

In accord with your generous suggestion, I enclose a copy of our letter to the President regarding our Third Annual Judicial Conference. We are neophytes when it comes to inviting Presidents and hope you can forgive any shortcomings in the letter.

I also enclose a copy of the Proceedings of our first conference. Pages 172-174 give a flavor of the Court. We have not yet received those of our second conference, but will forward a copy when it comes in.

Our main hope, of course, is that the President will consent to be our Luncheon Speaker. With exports-imports rising from about \$15 billion in 1956 to about \$100 billion in 1975, with the International Trade Commission newly launched under the Trade Act of 1974, and with apparent foreign concern over anti-dumping and countervailing duty actions, it may be that Treasury would view the Conference as an appropriate forum for a Presidential statement.

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- 2 -

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Most appreciatively,

*Howard T. Mackey*

Enclosure



UNITED STATES COURT OF CUSTOMS  
AND PATENT APPEALS

717 MADISON PLACE  
WASHINGTON, D.C. 20439

CHAMBERS OF  
HOWARD T. MARKEY  
CHIEF JUDGE

February 3, 1976

The President  
The White House  
Washington, D. C.

My Dear Mr. President:

I have the honor, Mr. President, of speaking for all of our judges in inviting you to participate in our Third Annual Judicial Conference, at the Sheraton Park Hotel in Washington, D. C., on May 10, 1976.

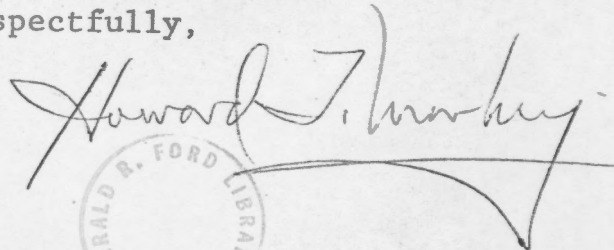
Your presence with us would add immeasurably to the Conference and to its purpose, the improvement of the administration of justice in the fields of international trade, patents, trademarks, and customs.

We are aware of the monumental tasks confronting you and of the incessant demands upon your time, but we are hopeful that you can squeeze us in, for a few moments at least, on May 10. We would be overjoyed, of course, if you could be our Luncheon Speaker. We would be equally honored if you find it only possible to drop by and merely wish us well, as our luncheon guest or at anytime between 9:30 and 4:30 on May 10.

Notification of your decision to visit us will be welcome at any time, up to and including the day of the Conference itself.

I beg the liberty of enclosing a fact sheet on our Judicial Conferences and await your decision with cheerful expectation.

Respectfully,



Enclosure



UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

FIRST ANNUAL JUDICIAL CONFERENCE:

Date: April 30, 1974

Place: Statler-Hilton, Washington, D.C.

Attendance: 600

Luncheon

Speaker: Senator Roman Hruska

The attendance of 600 lawyers from throughout the country at this first Judicial Conference in the 65-year history of the Court made it the largest judicial conference in the land. It also produced the largest gathering of customs lawyers in history. The Chief Justice dropped by and wished us well during the morning session.

SECOND ANNUAL JUDICIAL CONFERENCE:

Date: May 29, 1975

Place: Sheraton-Park, Washington, D. C.

Attendance: 814

Luncheon

Speaker: J. Fellers, Pres. American Bar, Association

With even greater attendance, the Conference remained the largest. The Chief Justice and three Associate Justices of the Supreme Court, the Deputy Attorney General, the Commissioner of Customs and the Commissioner of Patents and Trademarks were at the head table for lunch. The Chief Justice gave a greeting prior to Mr. Fellers' talk. The Chairman of the International Trade Commission, all Federal Judges in Washington (save two) and high level members of the Executive Departments were our guests for lunch.



THIRD ANNUAL JUDICIAL CONFERENCE:

Date: May 10, 1976

Place: Sheraton-Park, Washington, D. C.

Attendance: (expected) 1,000

Luncheon

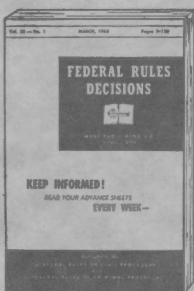
Speaker: To be determined

The Chief Justice and the other VIP guests of last year will again be invited. Work is underway with the State Department toward the attendance of counter-part international trade, customs, patent and trademark judges and officials from England, Germany and Japan.



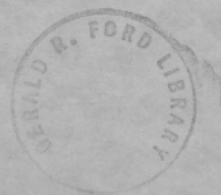
**PROCEEDINGS OF THE  
FIRST JUDICIAL CONFERENCE  
OF THE  
UNITED STATES  
COURT OF CUSTOMS  
AND PATENT APPEALS**

APRIL 30, 1974



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**FIRST JUDICIAL CONFERENCE  
of the  
UNITED STATES COURT OF CUSTOMS  
AND PATENT APPEALS**

**April 30, 1974**

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### Morning Plenary Session

CHIEF JUDGE HOWARD T. MARKEY: Welcome, ladies and gentlemen, to the First Judicial Conference in the 65-year history of the United States Court of Customs and Patent Appeals. The theme of the conference is "Improvement in the Administration of Justice" in the court. A subtheme is an effort to pierce, in a proper and productive manner, what I have called the "iron curtain" between the bench and the bar. The presence of almost 600 prominent lawyers, who specialize in customs, patent and trademark law, from all over the country and even from foreign branches of United States companies, testifies to your recognition of the importance of these themes.

Notice that I referred to "the" court. The United States Court of Customs and Patent Appeals is not the Markey court. It is not the judges' court. It is not the Government's court. It is, as its title states, a court of the United States. And that means you and me and 210,000,000 Americans.

You are entitled, therefore, to a report on stewardship of this public institution, which I have had the honor to head since June, 1972. At that time the court's backlog was such that decisions were handed down almost three *years* after appeals were filed. We set a goal. We would become current in our work by June, 1974. We were told by experts that five years, plus a miracle or two, would be required. Through the magnificent cooperation of the judges and the fine staff of the court, I am pleased to announce that the court fully expects to be current on June 30, 1974! Eight weeks of work remain until that magic day, but we are exactly on the power curve. If no unforeseen events occur, our goal will be achieved. If we miss, it cannot be by more than a case or two.

In these two years the court has written and, after review by the bar, promulgated its first new rules in 20 years; it has adopted many new procedures, in order to preserve old values; it has acquired, for each of its chambers, the first dictation equipment it ever had; it has replaced two outmoded copiers with three new machines; it has acquired Selectric typewriters for each of its secretaries; it has arranged for emergency interchange with the judges of the Court of Claims; for the first time, all of the court's judges are scheduled (next December) to sit with a Circuit Court of Appeals; the court has a full staff for the first time in many years; it has supplied each judge with an extra set of report volumes, for his use at home in the

evenings and on weekends; it has eliminated unproductive and expensive practices of the past; for the first time in history, the court is scheduled to sit outside of Washington, D.C.; and today it conducts the first Judicial Conference in its history.

As taxpayers, you will be glad to know that, in doing all of this, the court *returned* to the Treasury of the United States a portion of the budget which had already been provided by the Congress for fiscal year 1972-73 and then requested from the Congress for the current fiscal year a budget totaling substantially *less* than that provided the year before. I am told by congressional friends that this was a totally unique event in these inflationary days!

This short outline cannot reflect all of the unusual and overly strenuous efforts of the judges who, as you know, are faced with questions not only of law, but of extremely complex technology in almost every case. The abnormal pace of the past two years cannot be expected forever from mere human beings. The court, which has struggled for 65 years with a single assistant for each judge, while its work load multiplied, is currently requesting from the Congress the authority to hire a second technical advisor for each judge as the need arises. In 25 years, the court has added only 7 people to its staff, the last, a librarian, being requested 8 years ago. The second law clerk provided some years ago to the Courts of Appeals of the Circuits proved to be a most economical means of substantially reducing the interval from appeal to decision in those courts and we know such action will have the same effect in our court.

We have no illusions that we have found all the answers. As an officer of the court, each of you, along with each of the more than 5,000 other members of our bar, has not only the right, but the *duty* to develop and to suggest new ways by which this court can meet its obligation to the people, whose court it is. Help us to achieve the goal—which haunts the days and dreams of every judge—of deciding every case as correctly and as promptly as possible. Justice delayed is justice denied, as we all know. But we want no "production line" attempt at justice. As I see it, justice-rushed is justice-roulette. Hence, when we say "as correctly and promptly as possible" we simply mean that we be *just* in every case.

Similarly, we all, judges and lawyers, whose lives are devoted to public service, have the duty to exert ourselves toward an increased capability and capacity to accept additional burdens and to make that additional capacity known to the Congress



and others attempting to solve the public service problem of massive backlogs in the courts.

We all have themes we live by. I have a favorite, which originated with B. W. Jackson and which you may like because it refers to the area of the unknown, where you spend your professional lives. My version is:

"In all that man does, we are still camped on the beach-heads. The future is unknown and unknowable. But this time is meant for men who dare greatly—and dream greatly—and let our work catch up—with our dreams."

And now we have a great program today—with expert lecturers and with Senator Roman L. Hruska as our luncheon speaker. So let's get to it.

And now, ladies and gentlemen, I have the pleasure of introducing the first speaker of the morning, a man who is recognized as an authority on the operations of our court. He has published many articles concerning the court and the law of patents and is the author, with Paul Janicke, of the recent two-volume study *COURT REVIEW OF PATENT OFFICE DECISIONS*. He is Professorial Lecturer of Law at the George Washington University Law School. It is a pleasure and an honor to present, and I know you are going to enjoy, Mr. Donald R. Dunner.

DONALD R. DUNNER: Those of you who have practiced before the court know that a major revision of the court rules has been long overdue. For twenty years we have hobbled under a set of makeshift rules which have had no basic, fundamental changes during that period. There have been redundancies in these rules; there have been conflicts; there are many areas of practice that were not covered in the rules. In short, the rules were just waiting for somebody to come along with the proper push, the proper organizational talent and the desire to change them, and that, of course, happened when Judge Markey came onto the scene. It is the greatest tribute to Judge Markey that the rules are not only clear, concise and uncomplicated, but that he had the power to get the Government Printing Office to produce on time. If he does nothing else during his tenure of office, he will at least be remembered for that.

The most significant rule change in the new rules is probably that covered by Rule 5.6, dealing with the printing of the transcript of the record. As most of you know, the old rules required the court to do all of your work for you. The record

came up from below, either from the Patent Office or the Customs Court or what have you, and from that point on a series of steps took place with the appellant doing very little more than paying—sending a check to the clerk's office. And low and behold, six, seven, eight months—maybe a year later, you received a printed transcript. That is all over. Now the burden has been shifted to the appellant, as it should have been a long time ago, and as it is in most, if not all, federal courts. Ninety days after the filing of the record in a customs case and after the docketing of an appeal in an appeal from the Patent Office, you, as the appellant, are required to file with the court 25 copies of a printed transcript of the record. At the same time, at least 5 copies of the transcript must be served on all adverse parties or their counsel.

And, at this point, we might as well get the terminology clear: What you file with the court is called a "transcript." What comes up from below is called a "record." That's how it appears in the rules, and that's how it will be designated hereafter.

Now, how do you determine what goes into the transcript? First of all, the rules require that within 20 days after the docketing of the appeal in a patent or trademark case, or the filing of the record in a customs case, the appellant must serve on the appellee, unless they have agreed beforehand, a designation of those portions of the record that he wants in the record. If they have agreed beforehand, nothing is required, although they may want to reduce their agreement to writing. Within 10 days after service on him of the appellant's designation, the appellee counterdesignates to the appellant, pointing out what he feels should be in the record. These designation and counterdesignation papers need not be filed in court.

The rules do not provide terribly much guidance as to what it is that should be designated. Rule 5.6(d) sets forth certain formal requirements. It talks about a table of contents in the beginning, that immaterial formal matters such as headings and the like can be omitted. It wants pages of the original record indicated. Over and above that, Rule 5.6(a) specifies 5 different items which must be included, some of them applicable only to customs matters, others applicable to patent and trademark matters. You can get those out of Rule 5.6(a), but the key language in 5.6(a) is the sixth item which calls for any other parts of the record to which the parties wish to direct the particular attention of the court. This really is the key to what goes in

the transcript. The goal is not to err on the side of putting in everything you can. First of all you are doing a disservice to your client by requiring additional things to be printed. Secondly, the rules specify positively and clearly that the court can look at anything in the record whether or not it is printed. So you are not going to be done out of a victory if you fail to include something in the transcript.

On the other hand, those of you who want to save lots of money should not walk out of here feeling that you might as well not print anything since the court can look at everything. What you want is the judges and their technical advisors to be able to sit back in their chairs, not to have to go to the clerk's office, to look at the papers necessary to decide your case.

Now one would think that the only papers which would come up from the tribunal below would be those papers which you want to print. However, astute counsel will probably more often than not err on the side of caution in including things in the record coming up from below, because you are paying there only for certification, not for printing. Even so, there are a number of things that don't need to be included in the record coming up from below such as testimony only portions of which you will want the court to look at. So your record from below may include materials which you won't have printed.

Now, how do you get the record in order to print it? Well, you get the record through the clerk's office. After the appeal is docketed in a patent or trademark case or the record filed in a customs case, if you appear in person, the clerk will give you two forms or, if you file your papers by mail, the clerk will send you two forms. One is to permit you to pick up the necessary portions of the record in person, and the other is to permit you to have the necessary portions of the record mailed to you by the clerk's office. In either case you are responsible for getting what you need.

Now after you get these materials and all your designations are complete, you as the appellant will file the printed transcripts of the record and serve the necessary copies on your adversary. If either party needs an extension of time to file the designations, he can obtain it by filing a motion with the court.

Now who pays for the materials? The rules say that the appellant pays for and has to print everything. However, that's a conditional everything because if the appellant feels there is unnecessary material in the transcript which he has had to print because the appellee urged him to print it, he can file a motion

with the court to have costs assessed against the appellee, and the court will assess the costs at final decision. The appellant will have to file a statement of costs covering the expenses that he feels should be assessed against the appellee, and the matter presumably will then be briefed by the parties in their main briefs. The test which will determine how the court will decide who pays is probably that set forth in *Myers v. Feigelman*. I won't spend much time on it. It is printed at 172 USPQ 580, and all that case held is that the appellee has to pay for those portions of the transcript relating to issues raised below on which the lower tribunal didn't rule or on which he lost and which are not relevant to the appellant's appeal. Basically, therefore, it depends whose issue is involved. If it is the appellee's issue, he's going to end up paying. If it is the appellant's issue, he probably is going to end up paying.

The rules also specify in Rule 5.6(e) that if you had wanted to print material in the transcript and neglected to print it and the material is relevant, you can file a motion, and the clerk has the authority to allow the printing of the material either as a supplement to the brief or as a supplement to the transcript. The fact is that this really is not a provision which should be used very much, if at all, since, as I said, the court has access to the entire record. Furthermore, you can always put something in your brief that is in the record if you want to and, therefore, this rule probably will not be resorted to very often.

Now the rules also say in Rule 5.6(g) that you can submit on the record without a transcript if the court authorizes you to do that. There is no counterpart in the old rules for this proposition. However, it is something which all of you should consider. There may be cases when all you have is an issue of law. For example, your question may be whether or not the reissue statute permits claiming reissuing to claim the priority of a foreign case, a case like the *State of Israel* case, which those of you who are in the patent field know was in the District Court for the District of Columbia. That kind of case doesn't require a record. All it requires is a brief recitation of the facts, which presumably could come up under Rule 5.5, which covers agreed statements. It does not require any extensive materials, and you can save a lot of money by taking your case up to the CCPA in that manner.

Now what about the appearance of the printed transcripts, briefs, motions, and what have you. There are a few items to consider on this subject. Basically, the old rule has been carried over with certain significant items worthy of note. One is that

the court will not accept plastic or ring-type bindings. Carbon copies are not permitted. The rules talk about a clear black legible copy or corresponding language. Technically, that could be satisfied with the ribbon original of a typewritten copy. However, since you need multiple copies of everything—you even need two copies now of motion papers—it really would not serve any practical purpose to file a typewritten original because you are going to have to do something to get a non-carbon extra copy, which presumably would be xerographic if you are not using standard typographic printing. Also, Rule 5.8(b) sets forth for the first time a specified set of colors which must be used in filing papers in court. For example the appellant's brief will always be blue; the appellee's brief will always be red; and so on. You must follow these requirements of the rules. The clerk has the authority to refuse to accept papers which are filed and which are not in compliance with the rules. He has been rather nice up to now because the rules are new, but the point will come, I would guess, when the clerk is going to be more rigid in enforcing the exact details of the rules. Keep in mind that the rules provide that any provision of the rules can be waived by the court. So everything is not fast and hard. On the other hand, waiver requires dispensation from the court on written motion. So, you can't just ignore what the rules say.

Now, how about the briefs? Well, briefs are covered in Rule 5.9. I previously mentioned color covers. The rules also talk about the content of the briefs. The appellant's brief in all cases is supposed to have five compartments. The format of briefs under the new rules is really much better than it is under the old rules. First of all, a table of contents and a table of cases is required in every appellant's brief. This used to be required only in briefs of 15 pages or more. It is now required in all cases. Immediately following that a statement of the issues is required. This usually is required in the briefs of most appellate courts, and I think it is a good thing to have in this court. Following that is a statement of the case, which parallels what you used to put in your old briefs and which basically includes the background of facts, how the case arose below, how it was decided, and the like. Then the argument follows. Now the only thing significant about the requirements for the argument is that, and I have noticed many briefs filed after the new rules went into effect which do not comply with this, it must start with a summary of your entire argument, which need not be a long summary. The summary which you use should then be used as the title of each succeeding section in your argument.

Thus, if your summary consists of 7 sentences, that suggests that you will be having 7 compartments in the argument portion of your brief, each one headed in boldface, italics or the like with that particular sentence or something corresponding substantially to it. Then, of course, the conclusion follows the argument.

The appellee's brief is basically the same as the appellant's, except that you don't need a statement of issues or a statement of the case unless the appellee doesn't like the appellant's statement of the issues and the statement of the case; and what appellee ever likes the statement of the issues or the case that an appellant writes?

For the first time you have a right to file a reply brief. This is a significant change. You always ran a risk under the old rules. The practice then was to file a motion after you got copies of your brief printed and you prayed that the court would accept it for fear that you would have to face an irate client who'd want to know why you sent him the \$700.00 bill for printing a brief that the court was not going to look at. The new rules permit you as a matter of right to file such a reply brief; however, no further responses will be permitted in the way of briefs without special permission of the court.

Now, how about the length of the brief? There weren't really any requirements under the old rules. In fact I remember one case in which I filed briefs in an interference appeal. There were 100 pages in the main brief and about 105 in the reply brief, which elected the wrath of the court. I was given special mention in an opinion by Judge Smith, in a footnote in which he bemoaned the fact that he had to read 205 pages. He ruled against me no less. Perhaps that was the reason.

Principal briefs cannot exceed 50 pages and reply briefs cannot exceed 25 pages. Now this is exclusive of tables, appendices, indexes, and what have you, and that's a lot of pages. If you can't say it in that many pages, you haven't done enough work. It takes a little work to hone down a brief, but it can always be honed down if you need to do it.

When must briefs be filed? Here again there has been a change. It used to be 40 days and 30 days, respectively. Forty days after the transcript was printed, the appellant's brief was due; 30 days thereafter the appellee's brief. No longer. Now 60 days after the transcript is filed, the appellant's brief is due, and 40 days after service of the brief (and everything must be served, incidentally, under the new rules, both ex parte and inter

partes things), the appellee must file his brief, and 14 days after service of the appellee's brief a reply brief may be filed provided it is not later than 5 days prior to hearing which, of course, will rarely, if ever, happen. No further briefs may be filed without leave of the court.

Briefs are filed in numbers as is the transcript: 25 copies get filed with the court, and rather than the three which used to get served, you now have to serve five copies on each adverse party. Now, the new rules have several provisions which are going to have to be tested and somebody is going to test them. Question has been raised as to whether or not these rules are authorized by the statute, and there is at least one question as to whether or not certain of these rules would be a denial of due process. What I'm talking about are Rules 5.12(c), 5.12(d), and 5.12(f), and no doubt I'm contributing to the court's business next year by telling you about this. Rule 5.12(c) talks about disposition on briefs. If the court feels that an oral argument is unnecessary, either sua sponte or when the parties ask the court to dispense with it, the court can dispense with oral argument. Now, in the case where it dispenses with oral argument, it will afford the appellee an opportunity to file a response to any reply brief which has been filed. The questions which arise in this case are those where the court, without agreement of the parties, dispenses with the oral argument. It comes up principally in the patent area. I don't know whether it arises in the other areas. Title 35, § 144 and § 143 talk about the fact that the court shall hear and determine such appeal and the court shall give notice of the time and place of the hearing. Query. Does this require a hearing? Rule 5.12(d) talks about disposition on the record. It goes one step further, authorizing the court to dispense with briefing, whether or not the parties agree, and to decide the case on the record. Here you have not only the statutory question, but a constitutional question. Do you have a right to at least be heard on paper or otherwise in support of your argument?

Finally, Rule 5.12(f) dealing with frivolous appeals, permits the court to dismiss the case entirely if it has a case which it deems to be frivolous. I guess that raises the same kind of questions, but having clerked up here and having seen cases that I think everybody in this room would agree were frivolous, I can sympathize with this rule because it is awfully difficult to deal with a frivolous appeal.

The court also has a rule which talks about the facts that the court may dispense with a full opinion in a case. If an opinion

would not add significantly or usefully to the law or would not have precedential value, the court will not publish it. Now, there is a kicker to that, and that is: you cannot cite unpublished opinions as precedent. It won't be accepted as precedent except in three situations—a res judicata situation, collateral estoppel, or a law of the case situation.

What about oral argument? Significant changes have been made in the area of oral argument. If you look at Rule 5.13(c), you will see that all of the times have been changed to maxima, not guaranteed times. The court can cut you off in the middle of an argument or before the argument if it feels that you are not entitled to the full argument. I won't go through the times now because you can read them in Rule 5.13(c), but the maximum times have been cut very significantly from the times you used to be allotted. You can, however, get additional time in Rule 5.13(d). You can ask for additional time, on motion, not exceeding 15 minutes as long as you ask for it more than 10 days prior to the hearing, but the court probably will not be receptive to such a request unless you have a darn good reason for needing additional time because most cases can be argued within the time you are allotted if you make efficient use of your time. And the court urges you in the rule, in fact, not to feel you have to use all your time merely because you may be allotted that maximum time.

Another very significant provision is Rule 5.13(g), *in camera* proceedings. Under the old practice under *In re Sackett*, there was no such thing as an *in camera* proceeding in a patent case. The court took the position that if you wanted to come up from the Patent Office, you had to go public. There were no ifs, ands, buts, or maybes about it. A different rule was followed in the customs area—*Slumberger Oil Company v. the United States*, sometime ago, permitted a party to seal a portion of the record—I guess it was an importer in that case—because the subject matter involved trade secrets, and it really was not relevant to the issues on appeal. Now, perhaps he shouldn't have brought that material up to the CCPA at all, but the fact is that the issues focused on something other than the trade secret—the technical content of that subject matter—and the court was receptive. However, now under Rule 5.13(g) you can get an *in camera* proceeding and/or have your record sealed in any case before the court, provided the court finds that the interests of justice require, and you have to have a convincing showing that either or both of those is needed. I can tell you that the court will not seal its record and hold *in camera* proceedings very lightly.

The kinds of cases you can expect that to happen in are cases such as existed for some period of time in the patent area involving computer programs, involving a question of whether or not any programs were patentable subject matter in light of the Supreme Court decision in *Gottschalk v. Benson*. In that type of case, where you are not even sure you have statutory subject matter, the court might be receptive to sealing the record or holding an *in camera* proceeding or both. But, nevertheless, you are going to have to play that on a case by case basis.

The court now requires not legal size papers on the papers you file, but 8½ by 11, regular letter size papers, and they must be bound only at the upper left-hand corner without backing and must be double spaced. And, as I told you, they can't have bindings of the type which have been used in the past.

Fees have been changed slightly. The main fee differential is a \$50.00 fee for filing a case instead of a \$15.00 fee.

There are some changes in petitions for rehearing. The principal changes have to do with limitations on pages—10 pages if it is standard typographic printing—15 pages if it is type-written.

A few things about time and motions, and then I will use what little time I have left for answering questions. A significant change is covered by Rule 5.2(a). If the time for taking action is less than 7 days, you don't count intermediate Saturdays, Sundays, and holidays. But you do count the last day unless it is a Saturday, Sunday, or holiday. You don't excise any days for periods 7 days or over unless it is the last day. If you are required to do something after you get served by mail, you get three extra days for responding. Keep in mind that the old rule said that if you did the serving by mail, you got five extra days, which meant that if you goofed, if you forgot to file it yesterday, you could solve your problem even if you lived across the street from the CCPA by mailing it to the court, which got you five extra days. You can't do that any longer. It's only when you get served by mail that you get three extra days.

If you need an extension of time, you no longer can do it by stipulation. You have to do it by motion. The court is going to be current probably by the end of this year. And the court is not interested in having long delays between the filing of one paper and another paper. If you ask for an extension of time before your time expires, you must show good cause; if you ask

for it after it expires, you have to show something more than that. What that is I don't know, but the rule talks about it being "excusable."

I might also direct you to the numbers of other rules you should be looking at—

5.3(b) dealing with motions and replies to motions;

5.3(e) dealing with procedural motions that the clerk can handle;

1.4(a) mentioning that the Federal Rules of Appellate Procedure apply where the court rules don't specify;

1.4(c) dealing with waiver;

6.2 dealing with mandates, very critical in the patent area to maintain continuity of applications in the event you want to file a continuing application.

There have been some changes in Rule 2.1 about admission to the bar, some changes in Rule 5.5 about agreed statements and in 5.7 dealing with visual aids. I definitely suggest you check that because you have to clear with your adversary things that were not in the record below.

Rule 2.2 about appearances: There has been a modest change there. You can see what the differences are by looking at this pink booklet.

Now to answer your questions: Here is a statement: "Xerox is a trademark. It designates one brand. Photocopy is the generic term." Signed: Xerox Corporation. Actually this is in the form of a complaint. I accept the correction. That is completely right.

Next question: "What is the status of the use of photo offset printing in briefs and transcripts?"

Completely acceptable. You could have used it under the old practice. You can use it under the new practice. The rule talks about clear, black, legible type, or the equivalent. You can even type it and then Xerox it. That would be completely acceptable. Type it and use a xerographic technique. Is that acceptable? Xerographic is a generic term. Well, old habits are hard to kill.

"Can typewritten briefs be filed as a matter of right, using a ribbon original with Xerox copies of the same? Are there any special requirements?" Now, I read that. I just read it; you see we are all guilty. It just shows you, you have got us all locked in. Even when we want Multilith, we ask for Xerox.

The answer is: you can use a typewritten original as a matter of right as I read the rule. You might get some flack from the clerk's office. But the rule clearly specifies, and George Hutchinson can correct me when he gets his turn at bat, that a typewritten original would be accepted as long as there are no carbon copies, because it fits within the generic language of the rule.

"How would the court ever have occasion to dismiss an appeal as frivolous under Rule 5.12(f)? The court doesn't even know about the appeal until the record is filed in the court, and at that point the court could dismiss on the record under Rule 5.12(d), which is at least arguably legal, unlike 5.12(f)."

You can guess who asked me that question. There is only one person who knows enough to ask that kind of detailed question. That is my co-author.

Rule 5.12(f) says if upon review it shall appear to the court the appeal is frivolous and entirely without merit, the appeal will be dismissed. I have seen a case where there was no record in the Patent Office. There was a gentleman in 1955 or '56 who used to first file his case with the Attorney General and then he used to name each succeeding person as a defendant in a form of indictment. There was no record, there was not anything in those cases, and that is the kind of case that I would guess would be a frivolous case, where there would be no record and nothing else to look at.

"Why are 25 copies of the transcript and brief needed? What does the court do with so many copies?"

Well, first of all, there are five judges, there are five technical advisors, that makes 10. There is a chief technical advisor, and his assistant; that makes 12. There has to be at least one copy in the clerk's office. That makes 13. And, I think the court uses copies for emergency situations when people need copies of briefs or records. You will occasionally find that you are out of records in which you are a party. One place to get them is the clerk's office. There are various other needs. They may not need 25. I guess that particular number may be an excess of caution number. But, nevertheless, they do use quite a number of copies.

"How does one get copies of the Rules? In the past we have attempted to do this through the clerk's office without much success. Generally only a few copies are available."

I have never had that problem. I was there yesterday and there were loads of copies all over. George Hutchinson is the

guy you have to shoot, if you can't get copies, but he's very good about this. I don't know why you have had a problem.

"How does one find out where the rules have been changed or amended?"

Well, if the rules are changed or amended, I feel certain that the U.S. Patent Quarterly will publish it. I believe there probably would be an amendment in the Federal Register, and if there are any other ways that one finds out about it, George Hutchinson can mention it when he gets up.

"Please amplify your remarks on constitutionality of Rule 5.12(d) with particular reference to status of cases in the circuit courts of appeal where such procedure has been followed."

Well, first of all, I don't know, I can't comment on the procedure in the circuit courts of appeal where it has been followed. My point is that if you cannot have a record, if you cannot have a brief and if you cannot have an oral argument, how do you get your argument to the court? It seems to me that your right of appeal becomes a questionable right. If you can't make the argument at that point, I can see somebody arguing that that denies him due process. Now if the question has already been decided in other courts and/or by the Supreme Court, I guess that would resolve the issue. I don't know about those cases.

**CHIEF JUDGE MARKEY:** Our next speaker, beginning at the age of 14 as a page in the Supreme Court, is just completing his 38th year of outstanding service to the Judiciary and the Nation. A past president of the Federal Court Clerks Association, he has served as secretary, as I indicated earlier, of the Planning Committee of this Conference. Here's the best Clerk of Court I know, George E. Hutchinson.

**GEORGE E. HUTCHINSON:** This part of our program is directed to "The operation of the Clerk's Office." But rather than talk about how records are maintained or how we carry out certain aspects of our work, I think it would be more useful to discuss our operation in relation to procedures under the new Rules. Specifically, what are some of the problem areas that have developed in which we in the Clerk's Office can assist you and thus advance the prompt and efficient administration of justice. Perhaps a good sub-title would be: "Helpful Hints to the Practitioner before the CCPA."

Before we examine some of these areas, a general observation is in order. As many of you know, the Court during the last few months has been somewhat lenient in applying provisions

of the new Rules. But as we move on in time, it becomes necessary that we adhere to their specific provisions.

**Filing of an Appeal:** A good place to begin is, naturally, at the beginning, the filing of an appeal. A recent change is found in Rule 4.1, where it is now required that the Petition of Appeal in a patent case be served on opposing counsel. The term "Opposing Counsel" is meant to include the Commissioner of Patents. Our office has noted that many times recently petitions of appeal have not included proof of service on opposing counsel.

**Notice of Appearance:** Another important matter which occurs at the very beginning of the prosecution of a case is the Notice of Appearance. The main provision of Rule 2.2 is directed to the fact that no notice is required when counsel filing the case is a member of the bar or the government is a party. But the rule does include the provision that in an inter partes appeal counsel representing an appellee, unless it is the government, *must file and serve* a Notice of Appearance not later than 10 days after an appeal is docketed. This may be done by a short letter or on a form which we will be happy to supply you on request.

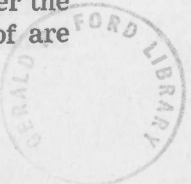
**Filing and Designation of the Transcript:** After the filing of the record, you will note that under Rule 5.6(b), there is the requirement for a designation of the record to be printed. This is in the absence of an agreement between the parties as to the contents of the record and this designation is not to be confused with the designation of the record to be transmitted by the Patent Office or the preparation of the record by the Customs Court under Rule 3.1. Of course, if the parties agree as to what is to be printed, no designation is necessary.

**Printing of the Transcript:** One of the major changes brought about by the new Rules is the printing of the transcript. Under the old Rules this printing was done under the supervision of the clerk—now it is the responsibility of the appellant. During these past few months we have noted certain things which I would like to call to your attention. *First*, what was once called an index at the front of the transcript should now be correctly termed a "Table of Contents." Although the table was prepared by the Clerk's Office in the past, this is the responsibility of the appellant. Since the new Rules suggest that not everything transmitted to the Court need be printed, any reference to material not printed should be made in the brief; or, perhaps, this material may be printed as an appendix to the brief if later it is

deemed to be essential. *Second*, Rule 5.6(d) mentions that the transcript shall indicate pages of the original record as transmitted to the court. In patent cases, these numbers are put on at the time the record is certified to the Court and may be an important item should the Court need to refer to the original page of the record at a later time. *Third*, particular attention is being given by our office to the size of printed matter in transcripts. As Rule 5.8 states, printed matter within the transcript must be in 11 point type with proper margins as indicated. Our office cannot accept transcripts which do not substantially comply with this provision. This is also a good time to caution counsel not to have their printer use plastic or spiral type bindings on any papers. Also, if counsel print less than what has been certified to the court and choose to print only partial pages, please be sure that the material to be printed has complete sentences. One final thing, please inform your printer that he must return the original record to us after printing. We have found several instances in the last few weeks whereby the printed transcript arrives without the original record. The printer should be asked to transmit it at the same time he sends us the printed copies. Counsel for both sides are notified of the date of the filing of the transcript.

**Printing of Exhibits:** Under the old rules, exhibits were not to be printed unless a specific request was made in writing to that effect. The new Rules do not specifically mention the matter since this is for counsel to decide. Perhaps it should be said at this point that it is still the general feeling of the Court that it is unnecessary to print them. However, if counsel do decide to print any exhibits, it will be necessary for appellant's counsel to file a motion under Rule 5.3 requesting release of such exhibits to the printer for that purpose. This should be done at the same time a request is made for the release of the remainder of the record. Since January 1, our notice to counsel, sent at the time a case is filed, has set forth this procedure.

**Form of Briefs and Other Papers:** As I said previously in connection with the printing of the transcript, this office does and will look carefully at all papers to see that there is compliance with the Rules. Where briefs are concerned, the things we are looking for are: (1) whether the color of the cover of each brief conforms to Rule 5.8(b), (2) whether the page size, including the typed matter on a page (that is, the proper margins are provided), conforms to Rule 5.8(c) or (d); and, (3) whether the provisions of Rule 5.9 as to the cover and contents thereof are



followed; for example, the title of the particular paper being filed must be at the top of the front cover; also the address and phone number of counsel must be shown. If counsel cannot comply with these specific requirements, then a motion must be made requesting a waiver of these provisions. Of course, soft copies of references in patent cases are an exception to the size of typed matter on a page. Another thing the Court itself is concerned with are the various provisions of Rule 5.9 having to do with content of briefs. For example, note the provision in Rule 5.9(c) that appellee's brief should *not* include a restatement of the issues or a statement of the case unless appellee disagrees with them.

**Proof of Service:** A problem area under the new rules appears to be the requirement of proof of service. Every paper being filed must show proof or acknowledgment of service thereon or attached thereto. We have sometimes found that there is a statement of service but unfortunately it carries no date. As you can see, it is essential that this date be shown. Assuming the service is by mail, the period for filing another paper runs from that date. It is wise, therefore, for counsel to make sure that the printer, or whoever is making the service of a particular paper, put the date of the service, or mailing date, thereon; or do it by a separate paper. Or, if there is a personal delivery, such date must appear on the acknowledgment.

**Correction of Errors in Printed Papers:** As to correction of errors in papers *which are already on file*, we have set up this procedure. If the errors are minor in nature; that is, a wrong citation or a misspelling of a word or two, we will, within time limitations, make such changes with our office staff. However, if the errors are substantial in nature, we will require that counsel or a representative thereof come into our office to make the corrections. Counsel should also consider the possibility of having their printer actually reproduce or reprint matter if the error is of a substantial nature.

**Time Computation:** One of the many inquiries received by this office since the adoption of the new rules, and even before, is how time is computed—especially under the three-day period mailing provision of Rule 5.2(c). *First*, reference should be made to Rule 5.1(a) which states that service of a document by mail is complete on mailing. *Second*, we have the requirement of Rule 5.2(c) that there must be service of a paper upon you and if the service upon you is by mail, then three days are added from the date of the mailing. A note of caution. There are two

papers that may be filed in which this 3-day provision does not apply. One is the appellant's brief. This is due to the fact there is no service of a paper upon the appellant since the transcript of record is filed by the appellant himself and served only upon opposing counsel. Therefore, appellant has 60 days only to file his brief from the date in which the transcript is filed in the Court. Another paper in which there is no 3-day provision is the Petition for Rehearing under Rule 6.1. Here again, there is no service of a paper upon the person filing the petition; the date of the decision starts the period running and since there is no service as such the 3-day provision cannot apply.

A further comment regarding filing and service. If a paper is due to be filed, such as appellee's brief, within a certain period (40 days plus a three-day period for mailing), if the paper cannot be so filed in that time period, then a motion for an extension of time to file that paper *must be filed within the period prescribed* and this does *not* include the three-day period. The Court never anticipates that a paper is not going to be filed within the time required or that it will be mailed to the Court rather than personally delivered.

**Motions:** This may be covered quickly since I think the new Rules are clear. One thing should be emphasized—motions are still being received on legal size paper and, as can be noted in Rule 5.14, if motions are typewritten they must be on 8½ x 11 inch paper, with no backing. Also, all motions must be submitted in duplicate under Rule 5.3(c). At the risk of belaboring the obvious, an order and proof of service must accompany each motion.

You may also have noted that the words "stipulation for extension of time" no longer appear in the rules. This was on purpose. For although there was a time where extensions could be considered automatic, this is no longer the case. Thus, although the clerk may still sign procedural motions, the Court wants a sufficient reason given which would warrant a delay be it in the filing of a transcript, a brief or any other paper.

Another point: as we have suggested to many attorneys, consent of the other party to a motion may be obtained in advance and a statement to that effect included in the motion itself will expedite the action on any motion. On procedural motions, it is requested that as part of the order which accompanies the motion that, after the language of the order, the words "FOR THE COURT" be placed and below that a line for a signature.



Thus, either the clerk or a judge may sign the motion, depending on the nature of the motion.

**Visual Aids:** The provision for visual aids under Rule 5.7 prompts a comment on the time in which such aids should be placed in the custody of the clerk. If the aids were used below, subdivision (a) provides that they be placed in the custody of the clerk at least 10 days before the case is heard or submitted. The question has arisen concerning whether these times can be shortened; that is, allow them to be filed with the clerk within a shorter period of time before the hearing than is provided. Our practice is to require that if counsel desires such a change that he must file a letter request with the clerk giving specific reasons why the period stated cannot be complied with. If there is good cause, and there is no opposition, the request will most likely be granted.

If the visual aids have not been used below, subdivision (b) of the rule requires that opposing counsel be advised 15 days before the hearing so that opposing counsel may have time to object. If there is no objection, then they may be used. If there is objection, the matter will be decided by the Court just prior to or at the time of the argument. Such aids may be brought into the Court at the time of the hearing, or before, at counsel's discretion.

**Mandates:** Under Rule 6.2(a) the mandate or final order of the Court is issued on the 22nd day after the decision or judgment is rendered. Since decisions are handed down on Thursday, this means that the mandate will issue on a Friday, unless a petition for rehearing is filed under Rule 6.1 or a stay is requested. It should be noted that Rule 6.1 requires that the petition for rehearing be filed within 20 days after date of the decision or judgment.

**Post-Hearing Memoranda:** There are no provisions in the Rules for papers or memoranda to be filed after the hearing of an appeal. An exception to this, of course, is a request by the Court itself during the argument that a certain paper be filed within a stated period. Thereafter, we will not file or consider any paper transmitted to the Court after the hearing of an appeal unless a motion is filed which is, in turn, granted by the Court. If the Court does request something of counsel during the oral hearing, a transmittal letter should accompany the material stating this fact.

Question, "How difficult will it be to get an extension of time to file a brief?" A showing will be needed and I think we will

be looking for good cause. I can sign procedural matters such as this, but I as well as the court will be looking for good cause because, as I say, very soon we will be current, and there will have to be a good reason for extension of anything. I think personally, as a lawyer, that the court has probably established in its new Rules the longest periods of time to file papers in the Federal system. They are certainly longer than those provided by the Federal Rules of Appellate Procedure and most local rules of other circuits that I'm familiar with. So I think that there would have to be, we might even say, a substantial showing for an extension of time. Now we can't talk to illness and things like that which certainly happen, but I hope that answers your question.

Question, "In your experience what is the least expensive technique for printing the briefs and transcripts?" That's a hard one because I have seen briefs, papers or transcripts that have been typewritten and have looked excellent—they have met every rule requirement. Yet I've seen others that have employed a photo offset where they photographed the page itself and the print, the type on the pages, was just not large enough. Of course, as I said, we lived with this for about two years, as you well know, and we did this on purpose, because we knew the new rules were coming in. I did accept papers that were maybe 7 or 8 point type, but no longer. So I would say that I can no longer be the judge of that. The thing we are looking for is 11 point type and proper margins and you go from there and rely on what Mr. Dunner said.

Question, "Do U.S. patent copies appearing in print in the transcript comply with the print size of rule 5.8?" Now, this is an exception. I think you will note that if you have soft copies of reference patents and you put them in a page, we still allow those. They will not show the proper margin, because of the arrangement of the patent itself. We are waiving that, so that you do not have to concern yourself if you incorporate a patent. We did that when we supervised the printing of the record. Feel free to get references from the Patent Office, or similar documents which might apply to the Customs side of our jurisdiction. Get the 35 or how many copies you are going to need and give them to your printer and let him incorporate them right into your printed transcript as we used to do.

Question, "When is a paper filed? On the date stamped by the Clerk's Office or when it should have been delivered in the normal course of mails?" I think the word "filed" is when it is filed. It means when we put the stamp on it. It is then filed

and that's it. I might say that there have been a number of decisions, one fairly recently, on this point. If you ask me I'll give you the citation.

Question, "Do you have any preference on proof of service, a separate certification or is it sufficient to add as a paragraph of the paper?" I have no particular preference one way or the other. We will look at the last page of whatever paper it is. Actually, I think if you ask me which came in the most—is it by a separate paper or is it more in the paper itself?—I would say the former. I would say that in most instances we find a separate letter sitting on top of the package as it comes in, assuming it is mailed. I would add that either one is acceptable—we look for both—but the emphasis again is please show it and please have the date. We have had instances in which the acknowledgement or proof of service is in the paper itself and the date is lacking. We have found, more times than not, that the date is absent when a separate paper is used. So please don't forget the date on such separate papers.

Question, "Is the table of contents, this is in Rule 5.6(b), for the complete record or for the record portions in the transcript?" Well, the table of contents is what is included in that printed paper in the transcript. If you wish to cite some papers that are in the complete record that came over, you have to make a decision. You may wish to print it as an appendix, if it is that important. If not, just state perhaps in a footnote, that there is such a paper on file in the Clerk's Office.

Question, "Should appellee in an interference case insist on printing a relevant exhibit in the form of drawings to be considered by the court?" Perhaps I'm not the best one to answer that. Again it goes back to my observation about exhibits. The court is not going to say to anyone do not print them or do print them. They don't think it is that necessary, perhaps, but if there is an insistence on printing it and you have the consent of the other side, that's fine. If the emphasis is in the form of drawings, of course they are readily receptive to photo offsetting and therefore can come in and I think the court would waive the provisions for type, margins, and so forth.

**CHIEF JUDGE MARKEY:** Ladies and gentlemen, The Chief Justice of the United States:

**THE CHIEF JUSTICE:** Thank you very much Chief Judge Markey, members of the Customs Court and the Court of Customs and Patent Appeals and ladies and gentlemen members of the bar.

I know you are engaged in serious business here this morning and will be this afternoon on this really unique occasion and it occurred to me as I was running over here that I ought to tell you about my own career in your field of specialty—particularly because if I don't tell you, no one else ever will. Only a few of the old timers here will remember that something over 20 years ago I came to Washington as Assistant Attorney General, as so many people do for two years and stay a lifetime, and at that time I had the Civil Division of the Department of Justice, of which Customs Division was a separate division. In the reorganization the Customs Division was added as a major section of the Civil Division. I had argued one patent case in my life and the only reason I dared to do that, on the Court of Appeals level, was that it didn't have too much to do with patents and, therefore, it was thought I could be trusted with it. This was at the hey-day of the "flash of genius" doctrine, which I was opposing and happily opposed successfully. And then I suddenly found myself thrust into the midst of all this enormous amount of litigation in the Customs Court and the Court of Customs and Patent Appeals. And so I really made a great career out of it and I'll tell you the secret of how I did it. I appointed the ablest men I could find in the career service who were experts in these fields and then I kept out of their way and let them carry on their work and I suspect that I wouldn't find much disagreement in this company—that that's what more lawyers ought to do with customs and patent matters. Well, now to be serious for a moment, and I'll only detain you for a moment.

This is perhaps a more important occasion than many of you here realize, although even that suggestion is contradicted by the fact that you are here in such large numbers. Years and years ago, when there were few judges and the operation of courts was a simple matter, we didn't need meetings and conferences of this kind, but times have changed along with the kinds of machinery and ideas that you deal with, for example, in the patent area. This isn't the same world as it was 30 or 40 or 50 years ago, and no court can function unless it functions with a close cooperation with the bar that appears before it. I am frankly, not just surprised and delighted, I am utterly astonished by the size and representative aspect of this gathering. I have been very much encouraged, observing that in very recent times the court under the leadership of Chief Judge Markey has moved towards re-examination of rules and I'm sure you're going to devote a great deal of your attention to problems of that kind while you're here at this meeting. There is simply no sub-

stitute, if we want progress, if we want just basic efficiency in the functioning of the court system—there is no substitute for having the men and women who deal with it in the bar meet with and work with the judges who must deal with the same problems from the bench. Increasingly, as you may have noticed in recent years, going back at least 10 years now, the judges are being drawn in increasingly to re-examine old propositions which they have accepted for a long time, to re-examine procedures and to entertain suggestions from members of the bar. I do not know how formally and how extensively you intend to make these gatherings, but I can assure you that from where I sit, with a certain over-view of the entire system of justice and the working of all the courts, this gathering and this move is one of the most encouraging things that I have encountered in a long time. I congratulate you, and I congratulate you Chief Judge Markey, and the members of your court and the members of the Customs Court. I hope you will continue this fine work.

Thank you for letting me interrupt your program.

#### CHIEF JUDGE MARKEY:

Thank you, Mr. Chief Justice, not only for your visit but for your outstanding leadership and encouragement.

Here is a most eminent jurist in the field of interrelated technology and law. Associate Judge of the United States Court of Customs and Patent Appeals, the Honorable Giles Sutherland Rich.

JUDGE RICH: I will begin by recommending that you read the two articles in the February 1974 ABA Journal by the Chief Justice and Chief Judge Irving Kaufman of the Second Circuit, both deploring the large number of lawyers appearing in court who lack the skills of advocacy. Not every lawyer has what it takes to be a good advocate.

Let me say right now that the most obvious thing to me as a judge for 18 years on the CCPA is that if you expect to win in this court you had better be on the right side of the case. If you are not, about all you can do is make the best and most honest presentation you can and learn to live with the idea, as my first employer taught me, that losing cases is all part of the job, albeit a somewhat unpleasant way of making a living.

If you will look at the facts, you will see that most of our decisions are by a unanimous court; there isn't much chance that the case could have gone the other way, no matter how it was presented. Only a relatively small percentage of the appeals are

in such delicate balance that the quality of presentation is the determining factor. Yet, there definitely is that type of case.

On the other hand, you would probably be surprised if you knew the number of cases in which we have to struggle on our own to come up with what we think is the right decision because the lawyer on neither side did a good job. Such cases are probably about as frequent as the evenly balanced cases which could go either way, and where a good argument really can win out over a poor one.

It happens several times a year that we face a situation where the party clearly has a good case but a poor lawyer. What happens then is that someone on the court resignedly declares that the briefs aren't very helpful and digs in to draft an opinion to reach the right decision—in effect arguing the case within the court as it should have been argued in the first place. It has always been my personal feeling that a party should not lose because of the mistakes or shortcomings of his lawyer. So don't expect to win just because your opponent has flubbed it. Rely on the strength of your own case, if it has any, and not on the weakness of your adversary's presentation. We just might bail him out.

And another thing you should not pin your hopes on, in a case where the "lower tribunal" has reached a correct result, is that it may have said some unfortunate things in explaining why. If you will observe closely what we do, you will note that we regard appeals as being from *decisions*, not from opinions. One is not a judge for many years before discovering that a distinction has to be made between decisions and opinions and I recommend that you bear this distinction in mind. It will be helpful.

Years ago, as a result of a discussion I had with Commissioner Daphne Leeds, it came to pass that the TTAB labels its decisions as such. That was a bit of cross-fertilization from our customs cases where appeals were taken from "judgments," documents separate from opinions. I have been working on the Board of Appeals to do as the TTAB does and matters have progressed to the point where their opinions, which always used to be called "decisions," are now labeled "opinion and decision." Try distinguishing the two, you'll profit from it and please us.

I guess what I would really like to do is to persuade you lawyers to persuade yourselves and your clients to give up when you are fairly licked and stay out of our court. We don't need

business. But of course I know that the psychological and economic pressures that inevitably exist assure the futility of such an effort.

So, enough of generalities. Now to get down to business.

I do not propose to say much about writing briefs. Hopefully you can write. Equally important, hopefully you can be brief and make your argument *march* logically from point to point to a conclusion. Give us the materials of decision.

We have just prepared our new Rules, about which you have been hearing, and under the heading PRACTICE we have included, in Rule 5.9, requirements which we hope will force you into a concise, orderly presentation of specific points, which you have been compelled to formulate and set down, thus avoiding the type of brief that wanders aimlessly. When you have finished, the Table of Contents should turn out to be an outline of your case, as you see it. Anyway, that is the use we would like to be able to make of the Table of Contents.

It may help you to be brief if I suggest that you omit the palaver and all attempts to flatter the court or individual judges. You need not call us "Honorable" every time you turn around; you need not even capitalize "court"; nor point out that I wrote a quoted passage. If I did, I will probably recognize it. If it's something my law clerk wrote, you aren't helping yourself with me at all. And you might give a thought to the reactions of the *other four* judges when you single out one of them!

I think of a brief that repetitively said "The attention of the Honorable Court is directed \* \* \*." It is quite enough to say simply, "Attention is directed to." Perhaps the short word "Note" will do. Strunk & White's rule "Omit needless words" is a great rule. I trust you have read Strunk and White, "The Elements of Style." It is only 71 pages long and a good investment of your time.

On oral argument, I have put into your kits the classic Decalogue or Ten Commandments of John W. Davis with the main points of his lecture summarized under each commandment. (See Appendix.) He said it better than I can. I heard him give that lecture in 1940 at the Bar Association of the City of New York. I have given a similar summary to numerous students over the years, and in reviewing it recently I still agree with every word he said.

Please add to it a more convenient citation: 26 ABA Jour. 895, Dec. 1940.

Let me state just the commandments:

1. CHANGE PLACES, IN YOUR IMAGINATION, WITH THE COURT
2. STATE FIRST THE NATURE OF THE CASE AND BRIEFLY ITS PRIOR HISTORY
3. STATE THE FACTS
4. STATE NEXT THE APPLICABLE RULES OF LAW ON WHICH YOU RELY
5. ALWAYS "GO FOR THE JUGULAR VEIN"
6. REJOICE WHEN THE COURT ASKS QUESTIONS
7. READ SPARINGLY AND ONLY FROM NECESSITY
8. AVOID PERSONALITIES
9. KNOW YOUR RECORD FROM COVER TO COVER
10. SIT DOWN

The rest of what I have to say this morning has to do with the First Commandment: CHANGE PLACES, IN YOUR IMAGINATION, WITH THE COURT, which Davis called "the cardinal rule of all." It is a great rule.

Throughout my judicial career, my principal criticism of lawyers has been their apparent lack of imagination. Of course they have imaginations but they resemble the wings of an ostrich; they enable them to run but not to soar, to quote Macaulay. They manifest this lack in many ways: Though our biographies are public—Who's Who, Congressional Directory, etc.—they don't seem to know who we are and what we are likely to know—or not to know. They waste time telling us things we already know. They recite to us serial numbers and patent numbers which are not important and which we can't remember. They talk over our heads in technical terms. I remember a lawyer talking for ten minutes about a "color kinescope" until I asked him—sensing that nobody on the bench knew what he was talking about—if the thing was perchance a color TV picture tube. It was! From then on we were on the same wavelength. If you are talking about "Teflon," don't call it polytetrafluoroethylene and don't call "Nylon" synthetic linear polyamide unless you absolutely have to. If your case is cursed with long, unpronounceable, unrememberable terms, invent some acronym or shorthand expression. At least use a drawing.

Even simple terms can be meaningless to judges not familiar with them and argument based on them may be almost totally

lost if you don't explain them as you go along. Reverting to briefs, glossaries can be a great help—just a few simple definitions. We recently had a case involving "satin white" which seems to be well enough known in the paper coating business but we judges are not in that business. It also involved kaolin but we may not all know that kaolin is a kind of clay. It would have been a good idea to tell us that. Another case involved "erionite," which was not explained. I didn't know what it was until the next day.

Then there are lawyers who have some inner compulsion to stand at the podium, after they have finished their arguments and we are trying to move things along, to tell us—if they are for appellant—that in view of what they have just said they "respectfully request that this Honorable Court reverse the judgment below." And if for the appellee—surprise—they want us to affirm! Do they think we are dumb? Or do they think appellate argument is some kind of religious ritual? When the argument is over, sit down! We have known what you want since you first stood up. On this point I disagree with Judge Re.

The key word in Davis's First Commandment is IMAGINATION. What he tells you to do is to try to change places with the court. But you can't do that unless you know something about the court. That is where the ex-law clerks have the advantage. They know a lot. From what I have seen, all courts have much in common. But I have also observed that no two judges are alike. I remember, too, what an older judge said to me at a cocktail party my first winter in Washington: "Judges are all prima donnas, aren't they," he said. "And would you want it any other way?" It behooves the litigating lawyer to get to know these characters. The biggest mistake he can make is simply thinking about "The Court" as some disembodied institution. The Court, my friends, is people.

To help you do your necessary imagining, I am going to tell you something about the CCPA as an organization, how it operates, and what happens from a time just prior to your appearance in the courtroom until just after you have filed that usually perfectly useless petition for reconsideration—or a response to it.

I also suggest that this conference is something of a golden opportunity to look over the court personnel—they are practically all here—and get it fixed in your head that it is made up of real people, even people of both sexes. We have a law clerk on maternity leave right now.

Altogether we are about thirty people. At the top are the five prima donnas, the judges who alone control the votes—the impenetrable crust, as it were. You think of this group as "the court." I think of it as the top echelon of the court. I also think of it realistically in terms of five compartmentalized units which we come to think of as "chambers." Judge X's chambers is a little organization consisting of Judge X, the Technical Advisor or law clerk to Judge X, and the judge's secretary. Each of these units operates in its own sweet way according to how the judge likes to do things. The secretaries are very permanent. Law clerks generally change every two years. Judges are for life.

As I was taught by Ernie Friesen, former head of the Administrative Office of the U. S. Courts and now head of a college to train court administrators, a judge is really the administrative head of a production organization the product of which is judicial decisions. It is like running a small law office with an associate. Each judge runs his chambers in his own style.

Now of course the court decisions are a composite of the decisions of the five judges. The court decision process involves a fair degree of division of labor. If it didn't, we would never get our work done. To begin with, the clerk makes up the monthly calendars of cases ready for argument. The cases on a calendar are divided into categories—chemical, non-chemical, ex parte, inter partes, trademark, customs, etc.—and assigned by the Chief Technical Advisor as evenly as may be to the individual judges so each judge gets about the same mix. A slight amount of swapping around may occur later for various reasons.

The next process step is that each law clerk takes the cases assigned to his judge and prepares short digests stating the issues, decision below, the nature of the subject matter, and the contentions as found in the briefs. There is a sample digest in Dunner's book, "Court Review of Patent Office Decisions—CCPA," Matthew Bender, Sec. 5.04[c]-1, page 5-27. Copies are distributed to the other judges. Thus, every judge has such a digest before he goes on the bench and has probably read it. How much more he has read is speculative and certainly variable. The digest may not have told him what satin white, kaolin, or erionite is. If you'd like us to know, tell us.

Another thing we have on the bench is a list of the day's cases with your name on it. A copy is posted by the door of the courtroom. Unless you are substituting for the person named, you need not tell us who you are. We know.

While I am mentally picturing you standing there in the courtroom, I would like to mention the paper or documentary and possibly the physical exhibits which are on file. The clerk routinely has them in the courtroom on the table beside you in their brown envelope. What frequently happens is that a judge gets the idea he would like to see something, like a specimen of a trademark, a sample of merchandise, a picture or the like which he knows or guesses is in evidence. The lawyer has not had the foresight to be prepared for this. He doesn't know where the exhibit is; he finds the envelope is still stapled shut; he fumbles around and wastes his precious time. The preventive for this is to get organized in the clerk's office before argument and know where things are. And may I remind you that a picture is worth 1000 words. Sometimes a model or a sample or a specimen is worth a dozen pictures. Of course we have easels for your charts, and enlarged drawings and claims, and a green blackboard if you want it.

All of this schoolroom paraphernalia brings to mind what I consider to be your primary role in presenting a case: *A teacher*. A month ago I was talking to one of our recent law clerks about this program. He said, "The trouble is lawyers don't approach judges as human beings. You should tell them the judges don't care about their cases at all and that their job is to make you care. If they will approach their arguments that way, all of the horribly boring presentations would disappear."

You have all been to school. You have all had boring professors who knew a lot but didn't keep you awake. They were professors but not teachers. My idea of the good advocate is that he is a good teacher. He not only knows a lot but he has thought about organizing his knowledge in a way to communicate to another what he wants that other to know. A good teacher has a good bit of the actor in him, at least to the extent of a sense of stage presence—an ability to stand there before five judges, seemingly relaxed, and *converse* with them—not hammer at them—about the case, getting across what he wants them to know—what they need to know to see that he is right.

You know, some lawyers are so agitated about their cases that they emphasize everything they say—like automobile commercials on TV—and the net effect of emphasizing everything is simply to tire the court and to emphasize nothing. We tune you out if you do that. We also tune you out if you *appear* to be reading. Remember the Seventh Commandment.

Practice makes perfect. If you are not reasonably at ease on your feet in a courtroom, get into something to limber you up like amateur theatricals, Toastmasters, or try teaching something. But above all, get over the institutional concepts of "judge" and "court" and think in terms of ordinary human beings who are just anxious to know how to decide your client's case correctly, as painlessly as possible. Take Davis's advice; change places in your imagination with the court. How do you think a judge feels facing experienced lawyers familiar with what may be to the judge a strange field of technology or law or both? Try seriously to imagine that. It may have a surprisingly tranquilizing effect.

That is all I have to say about oral argument. To help make your imagining still more productive I will now return to the process by which we reach decisions.

When we come off the bench, anywhere from 11:30 to 1:30, we sit down in a conference room behind the courtroom and spend a few minutes taking what we call a "straw vote" on the cases just heard. Each judge makes a note of the votes on each case and when he gets back to his chambers his law clerk, who has probably listened to the arguments, is eagerly waiting to see what we thought. The straw vote is taken without much discussion and is considered in no way binding. Many of the votes are simply "question mark." This vote serves to show the judge to whom the case is assigned which way the wind is blowing, or whether there is no wind at all. What it also does, if it is strongly one way or the other, is to serve as a warning at the next stage of the decision process, if an opinion should come around directly opposed to a strong initial reaction.

The next stage is the utterance from the chambers of the judge to whom the case was assigned of a complete proposed opinion. It may come soon after the hearing or months after, depending on the nature and complexity of the case. The opinion—since about a year ago—may be either in unpublished or published form. How it got written is the business of the judge whose name is on it. The result reached is his decision. I hope no lawyer here is so naive as to think every judicial opinion is wholly the handiwork of the judge. Those days ended, perhaps, with Judge Learned Hand. I was once at a dinner with some of his former law clerks who were reminiscing about how he always wrote his own opinions. One of them said he remembered one which he did not write in its entirety. He said the judge gave him a draft and told him to finish it and the law clerk

added the word "Affirmed." How judges work is highly variable. I will tell you how I work. My law clerk and I talk over the cases on hand and I decide which I will work on and which he will work on. For each of us this involves careful study and independent writing. Discussion takes place as necessary during the process. Hopefully, the briefs supply the needed tools of decision. Possibly the tape of the oral argument gets replayed. We put them on cassettes now and we can play them anywhere.

When my law clerk has produced a draft I go over it with a red pen. As one clerk described it, he judged the success of the draft by how badly it was "bleeding." It very likely gets shortened. I submit my own drafts to my clerk for debugging, and they usually need it. Every piece of writing can benefit from a fresh point of view. My wife sometimes settles grammatical disputes. The production of an opinion can take anywhere from an evening to a month. When finished, it is reproduced and copies go to the other chambers with a vote sheet. The Chief Technical Advisor also gets a copy. Then the fun begins.

I referred to the five judges as the top echelon of the court. I call the law clerks the second echelon. From what I have already said, you can see that in writing digests and drafting opinions they have become very much involved. Moreover, the judges use them to pass suggestions back and forth for improving circulated opinions. One of the blanks on the vote sheet which may be checked says "See law clerk." Controversial points and cases engender a large amount of discussion, debate, and productivity at this second echelon level. This is a stimulating kind of ferment from which the law greatly benefits. So you see what you think of as "the court" may, in a particular case, have ten people involved in the process of decision. If the Chief Technical Advisor, Mr. Kreider, gets involved, as he often does, there may be eleven.

Incidentally, it is this fact which makes it so improbable that the court has "overlooked or misapprehended" anything, which is the prerequisite to a rehearing under our Rule 6.1. That explains why over the past five years better than 95% of petitions for rehearing are promptly denied. Failure to discuss a point in an opinion by no means indicates that it was overlooked. Merely rearguing a case in a petition will avail you nothing. Even judges who have dissented will usually join in denying such a petition for rehearing. In five years we have granted only five petitions. We reheard 2 cases and made minor language changes in 3. Please so advise your clients in discussing whether to file one. That is all I will say on that subject.

Getting back to the decision-making process, when each of the four judges gets an opinion from the fifth he can do one of the following:

1. Join it,
2. Agree to join it if changes are made,
3. Concur only in the result, because of some disagreement,
4. Concur with an opinion,
5. Merely dissent, or
6. Dissent with an opinion.

Three or more dissents will mean the case gets assigned to another judge by the Chief Judge, unless the author wants to recant and write it up the other way—which sometimes happens. Concurring opinions sometimes get incorporated in the original and are then dropped. More often than not, some changes are made and many initial disagreements are thus taken care of. Changes are circulated in writing. New votes may be obtained.

The court formally confers on cases about once a month. For the most part, the results you see in the opinions handed down have been arrived at through the voting procedures, second echelon activities, and revisions I have described. Only a small number of cases seem to require detailed conference discussion. Occasionally the details of an opinion get worked out in conference but more often it is revised and recirculated afterward. Judges, of course, sometimes discuss opinions with one another individually and with one or more of the technical advisors. Ultimately, we the judges, agree or agree to disagree and the clerk hands down the opinions on a Thursday.

I hope what I have said will enable you to do more constructive imagining and that in changing places with the court and seeing the other fellow's point of view you can better present your own. When Mr. Dunner gets out the third edition of his book on practice in the CCPA I hope he can delete the statement (§ 8.03 [e] n. 1) that "the quality of presentation of cases before the CCPA \* \* \* is on the average quite low."

I will now abide by the Tenth Commandment of Mr. Davis.

## APPENDIX

## THE ARGUMENT OF AN APPEAL

## THE "DECALOGUE" OF JOHN W. DAVIS

(who argued 138 cases in the United States Supreme Court)

The Ten Commandments are reproduced verbatim and the other points are briefly summarized from a lecture delivered Oct. 22, 1940, at the Bar Association of the City of New York, published first in the New York Law Journal, Oct. 29, 20, 31, 1940, and republished in a collection of legal essays, "*Jurisprudence in Action*," pp. 171-188, Baker Voorhis & Co., Inc., 1953. Dunner's "*Court Review of Patent Office Decisions: CCPA*," at § 504 [c], note 3, reproduces the commandments per se. [GSR for 1974 CCPA conf.]

1. CHANGE PLACES, IN YOUR IMAGINATION, WITH THE COURT

"The cardinal rule of all." Courts are men and have their weaknesses. Know your court. They know nothing of the controversy except what they are told. Give them the "implements of decision." Figure out what you would want to know, how you would want the story told, if you were the judges. Don't tire or irritate. Speak loudly.

2. STATE FIRST THE NATURE OF THE CASE AND BRIEFLY ITS PRIOR HISTORY

Get the court oriented in the proper field. Tell it how and why the case came to it and from where. Judges judge each other as well as the law.

3. STATE THE FACTS

The facts are not merely a part of the argument but often the argument itself. A case well stated is far more than half argued. The court is in complete ignorance of the facts when you start. Chronology, candor, clarity. The statement should show forth the essential merit in justice and in right of your client's cause.

4. STATE NEXT THE APPLICABLE RULES OF LAW ON WHICH YOU RELY

The law may be elementary or may be a disputed doctrine. Be prepared to meet any challenge to the doctrine of your cases and support it by original reasoning. Barren citation is a broken reed.

5. ALWAYS "GO FOR THE JUGULAR VEIN"

Minor points can be left to the brief. Bear down forcefully on your best point. Don't be tempted to try to cover every point in argument. More often than not a case has a cardinal point around which the others revolve.

6. REJOICE WHEN THE COURT ASKS QUESTIONS

They give vitality to the argument. It shows interest. It gives you a chance to penetrate the mind of the court and to dispell doubts. Don't evade. Don't reply "I'm coming to that" unless you really are and right there indicate what your answer is going to be. The judge's mind is seeking help. I have observed that judges are sometimes more annoyed with each other than by counsel.

7. READ SPARINGLY AND ONLY FROM NECESSITY

There is something about a sheet of paper between speaker and listener that walls off the mind. It obstructs the passage of thought as a lead plate bars x-rays. If something, like a statute, must be read, have a copy in the hands of the court when you do so. Reading lengthy extracts from cases is a sheer waste of time.

8. AVOID PERSONALITIES

About lower court or adversary. Useless as a method of argument. Distract court from the issues. Dislike criticism of other judges. Denunciation may arouse sympathy for the accused. Such things can irritate; they can never persuade.

9. KNOW YOUR RECORD FROM COVER TO COVER

*Sine qua non* of effect argument. At any moment you may be called on to correct misstatement of adversary or answer a question. (A handy tab index or table of contents may prove a valuable aid to memory and help quick location.)



## 10. SIT DOWN

When you round out your argument and are satisfied that you have presented all points on your outline—of course you have one—and you finish ahead of time, the court will be pleased. It has other work to do!

“The need for an appellate process arises from the innate realization of mankind that the human intellect and human justice are frail at their best. It is necessary, therefore, to measure one man’s mind against another in order to purge the final result, so far as may be, of all passion, prejudice or infirmity.”

CHIEF JUDGE MARKEY: Ladies and gentlemen, I am proud indeed to present to you the United States Senator from the sovereign State of Nebraska, the Honorable Roman L. Hruska.

SENATOR HRUSKA: It is my great pleasure to speak today before the first Judicial Conference of the United States Court of Customs and Patent Appeals.

I am honored by the invitation extended to me for this purpose. Frankly, I must admit that although I have been wedded to the Senate Judiciary Committee for a number of years, my knowledge in the field of customs and patent law is far below that of those gathered here today. To attempt to speak with any authority is somewhat embarrassing—a little like *Mrs. Henry Kissinger* addressing the United Nations!

Undaunted, however, by my own limitations, I would like to offer my thoughts to you on the immense progress that has been made in the past few years in the administration of customs and patent law.

First, a few comments on the Customs Court, under the present leadership of a man with great ability, Nils Boe. Too few people are aware that the U.S. Customs Court is an article III court and that it is one of the busiest courts in the federal judicial system. The issues it decides affect the economic well-being of many Americans. Nevertheless, customs attorneys normally project a low profile and are hard to find. I am astonished, frankly, to see so many of you here in open daylight at high noon! Seriously, I am informed that this is the largest gathering of those devoted professionally to customs law in this nation’s history.

We can all recall the circumstances which led to congressional passage of the Customs Court Act of 1970, 84 Stat. 274. Senator

Tydings and I introduced this legislation, S. 2624, on July 14, 1969. Soon thereafter, the Senate Subcommittee on Improvements in Judicial Machinery held three days of hearings on the proposal.

During the hearings, it became apparent that very little had been done since 1926 to revise the Customs Court and to reduce the time-consuming, inefficient and unnecessary practices required to process a customs case. Until 1970, the Customs Court used the same procedures it had used since the establishment of the Board of General Appraisers, an administrative agency, in 1889.

The problems confronting the court were revealed by statistics showing the extremely large annual input and output of cases.

As we all know, developments other than the outmoded procedures and rules of the court itself helped to create this situation. First, there was a significant increase in the volume of imports into this country. Second, a new set of tariff schedules had been adopted. Third, a more aggressive attitude had been adopted by American importers and manufacturers in challenging customs decisions.

The Customs Court Act became effective October 1, 1970. Its provisions, as you all know, required the Customs Court to “retool” virtually all of its practices and procedures.

The result of the many important changes in customs procedures, I believe, has been dramatic. I understand that the pending case load of the Customs Court has, in the past three years, been reduced by more than 50 percent and that a further reduction is anticipated in the future. At the same time, the court has been able to reduce the number of personnel by 10 percent. I am confident that further significant improvements will continue to occur in this important area of federal law.

In the future, for example, it may be possible for the Customs Court to utilize electronic data processing and thereby allow prompt and complete access to vital information about the thousands of pending cases. The groundwork for this important development has already been laid.

The benefits to be derived from the use of a computer system in this court have been demonstrated by the experience of the Department of Justice. The Customs Section of the Civil Division has a computer terminal available to it in New York City. Each docketed case in the Customs Court is fed into that computer. When the need for information arises, the computer can

be tapped by the government attorneys to find other customs cases which involve, for example, the same issue, merchandise, importer, or country of export.

I understand that the use of this computer has permitted the government attorneys to consolidate a number of customs cases for trial. Additionally, it has served as a good management tool, permitting the government to keep abreast of each docketed case and the developments which are occurring in the field of customs law.

In my view, these are benefits which prove the worth of an electronic data processing system for this court.

I would also like to mention and commend current efforts to revamp the federal patent laws. It is quite possible that the Senate this year will pass a bill which will be the most sweeping reform of patent laws since 1836. Generally, the reforms are designed to modernize the procedures of the Patent Office to permit greater participation by the public in the process of patenting new products, and to make the Patent Office function much like a traditional federal agency.

The current center of legislative activity is the Senate Judiciary Subcommittee on Patents, Trademarks and Copyrights, chaired by my distinguished colleague, Senator John McClellan.

Three reform bills have been introduced and referred to that subcommittee. An intensive review has been conducted by the subcommittee staff in recent months. Although I am not a member of that subcommittee, it is my understanding that the members will be meeting within the very near future to consider the administration bill, S. 2504, introduced last October by Senator Hugh Scott. Before the introduction of this measure, a very intensive study was conducted by both the Justice Department's Antitrust Division and the Commerce Department.

Many of the conflicting viewpoints between the two agencies have been resolved. Although certain issues remain open for debate, I am hopeful that this important legislation can be brought to the attention of the entire Senate within the near future.

There is no dearth of other proposals relating to patent law. The literature continues to grow rapidly. The problems of judicial administration in this field are viewed by some as persistent and serious. I recently had occasion to study a paper presented by Roy H. Wepner earlier this year at a Seminar on the Federal Court Appellate System given at the University of Pennsylvania Law School under the direction of Professor A. Leo Levin.

Mr. Wepner undertook to examine the function of various appellate courts in the area of patent law, a subject not unknown to members of this audience. I mention this paper not only because it is certainly one of the most recent works in the field, but also because of its timely and direct connection to the work being done by the Commission on Revision of the Federal Court Appellate System, of which I am Chairman and Professor Levin is Executive Director.

Mr. Wepner reviews the problems encountered by generalist judges in dealing not only with what are viewed as esoteric doctrines of patent law, but also with complex technical issues—without even the benefit of Technical Assistants as are provided to Court of Customs and Patent Appeals judges. He argues that appellate review of patent issues places severe strains on the courts of appeal, already overburdened. In addition, he discusses the problem of inter-circuit conflict on questions of patent validity. Some circuits, he notes, are much more likely than others to hold patents invalid.

Prior to 1971, a patentee could bring unlimited infringement actions on the same patent because the mutuality doctrine prevented different defendants from pleading an estoppel. Thus, a patent might be valid in some parts of the country but invalid in others. In 1971, the Supreme Court, attempting to correct this long-standing problem, handed down its decision in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation*, 402 U.S. 313, 91 S.Ct. 1434, 28 L.Ed.2d 788 (1971), which stringently limited the mutuality doctrine in patent infringement actions. Thus, a patentee is now bound by the first judgment of invalidity rendered against him, assuming, of course, that he has received a full and fair hearing.

This development, I understand, has resulted in forum shopping, and in the words of Judge Friendly, "mad and undignified races \* \* \* between a patentee who wishes to sue for infringement in one circuit believed to be benign toward patents, and a user who wants to obtain a declaration of invalidity or non-infringement in one believed to be hostile to them."

Therefore, Wepner points out that neither allowing relitigation, nor eliminating the mutuality doctrine is a sufficient answer. He suggests that a better cure to the problems of inter-circuit conflicts is to have one court ultimately decide all patent cases: the Court of Customs and Patent Appeals, with ultimate power of review in the Supreme Court.

Let me refer briefly to another area of potential change. Today, as you know, there are alternate routes for obtaining judi-

cial review of Patent Office action—appeal to the Court of Customs and Patent Appeals or what is termed trial de novo in the U. S. District Court for the District of Columbia. This dual system of review, in my judgment, has not made for uniformity or dependability in the federal patent law. It has been urged that the best solution in this area is to abolish the civil action against the Patent Commissioner in the district court, and vest jurisdiction of all judicial review on Patent Office actions in the Court of Customs and Patent Appeals.

In my view, these are matters which should be given serious consideration. They are subjects appropriate for study and recommendation by the Commission on Revision of the Federal Court Appellate System.

I believe, speaking for the Commission, that each of you should be partners in our work, giving us the benefit of your own rich experience and long consideration of the problems as they affect you, your clients and the citizens of this country generally, for whose ultimate benefit the patent system was devised.

We have already received from the judges of this court a detailed and thoughtful analysis of possible solutions to these problems and of the capability of the Court of Customs and Patent Appeals to deal with them. The memorandum to which I refer was prepared in response to a specific request by the Commission through its Executive Director. I should like to pay tribute at this time to Chief Judge Howard T. Markey, a highly distinguished jurist, and all of the other members of this court as well for the help they are providing the Commission on this matter. Indeed, let me extend that tribute to encompass the remarkable achievement reported by Chief Judge Markey earlier today: the success of this court in virtually eliminating its backlog.

As I indicated earlier, the members of the Commission seek the advice of the bar, as well as of the judiciary, in proceeding with the task assigned us by the Congress. In a very real sense, we think of this venture as a partnership designed to improve the operation of the federal court appellate system. Perhaps the nature of that partnership, as I envision it, can best be indicated by a brief report on the work of the Commission up to this time, for we already have had the benefit of significant input from lawyers all over the country. Let me elaborate.

Congress, in establishing the Commission, divided its task into two major assignments. The purpose of Phase I, now completed, was to study the circuit court geographic boundaries. The Commission held hearings in ten cities. Many valuable ideas and opinions were presented to the Commission by judges and mem-

bers of the bar. Pending in the Senate are bills containing the Commission's recommended changes for boundaries of the several circuits—notably in the 5th and 9th, and perhaps in the 8th.

Phase II, the more ambitious and challenging assignment, is now underway. For the next several months—and hopefully longer—the Commission will be studying the structure and internal procedures of the Federal courts of appeal and preparing recommendations for change in those broad areas. I might indicate that our next series of hearings is scheduled to be held in Washington, D.C. on May 20 and 21. I would encourage any of you who wish to offer comments on this subject to contact Professor Levin. We heartily welcome your able assistance in tackling this most important project.

I would like to mention in passing a few of my own thoughts on expanding the jurisdiction of the Court of Customs and Patent Appeals to other important areas of federal law. For example, the field of atomic energy or disputes which arise out of the "most favored nation" rule. In the latter instance, perhaps thought should be given to having appeals from the Tariff Commission go to the Court of Customs and Patent Appeals on an expanded jurisdictional basis, instead of to the White House, where they are presently docketed.

An example of this type of approach can be found in a law, the Plant Variety Protection Act, authored by Jack Miller, while a member of the Senate in 1970. This law protects the inventor of new species of plants. In the case of a dispute over authorship, the Secretary of Agriculture makes an initial determination which an aggrieved party can appeal directly to the Court of Customs and Patent Appeals. I understand that no appeals have yet been taken under this new law, but the procedure is there if such an instance arises. In my view, it is a good procedure, one which adds certainty and uniformity to the administration of federal remedies.

These ideas and many others, I believe, are worthy of thorough exploration with a view toward expanding the operations and responsibility of the Court of Customs and Patent Appeals in such a way as to more fully utilize this court and its valuable resources.

At this, the first Judicial Conference of the Court of Customs and Patent Appeals, it is appropriate, I believe, to refer to a history of the court, one which was published some years ago as part of the larger study, *The History of American Customs Jurisprudence*. The author, William H. Futrell, details the prob-

lems which led to the creation of what was earlier known as the Court of Customs Appeals. In many ways, the problems he describes, with respect to customs litigation at the turn of the century, read as though it were an account by a contemporary patent lawyer. More important, he reports on the success which the new Court achieved.

I mention this not only to applaud the wisdom of those who acted in the early years of this century; I mention it because today, too, we are examining the wisdom, or lack of wisdom, inherent in a variety of proposals for change. The ultimate test of a pudding is at the table. Likewise, the ultimate evaluation of any change must lie in what it achieves. The judgment can only come in the perspective of history. Whatever changes may result with respect to patent law, customs law or the scope of litigation entrusted to the Court of Customs and Patent Appeals, I hope that they prove as wise as did the creation of this court.

I have greatly enjoyed the opportunity to offer these comments at this important point in the history of the Court of Customs and Patent Appeals and I am pleased to have played some small role in the significant accomplishments which have been made to date in the area of customs and patent law.

I wish you well in the proceedings of this First Judicial Conference. It is a wholesome and ambitious undertaking, one which has the prospect of developing into a valuable tradition. I maintain the highest confidence that this event will serve that important purpose.

CHIEF JUDGE MARKEY: Thank you, Senator Hruska, for that excellent address.

In small token of our appreciation, I hope you'll accept this plaque, in commemoration of this event. It reads:

"In appreciation, to Senator Roman L. Hruska, FIRST JUDICIAL CONFERENCE of the UNITED STATES COURT OF CUSTOMS and PATENT APPEALS, APRIL 30, 1974."

And we're counting on you to be with us, in some capacity, in many of our future conferences.

#### Afternoon Session—Patent and Trademark Appeals

CHIEF JUDGE MARKEY:

I'm pleased to introduce as our Moderator of this afternoon's program devoted to appeals in patent and trademark cases, the Solicitor of the Patent Office, Mr. Joseph Nakamura.

MR. JOSEPH NAKAMURA: We have with us Associate Solicitor Fred E. McKelvey. He will introduce the next topic to you. It will be "Settlement of Cases."

ASSOCIATE SOLICITOR McKELVEY: I'd like to discuss today a little bit about settling cases in the Patent Office. Now the term "settle" is a little loose because really when we settle a case, we lose and you win. There's really no middle ground. It's not like a negligence suit where you have a \$10,000 claim and you can settle for \$5,000. Either you get the claim or you don't get it.

Commissioner Schuyler published a notice which is still in effect which outlines the procedure for reopening a case after a decision by the Board of Appeals. And really that's what it's all about. Trying to reopen the case in the Patent Office and avoid proceeding in the court and putting the court to decide a case which really it shouldn't have to decide. There are three types of cases covered in that notice and for those of you with paper and pencil, it appears in 868 O.G. 1058. In the first type of case, where the Board of Appeals indicates in its opinion, as opposed to its decision, that a claim is unpatentable because it lacks a specific limitation, and further the Board suggests that with a limitation, I should say the Board reasonably suggests with a limitation the claim might be patentable, one might file a petition with the Commissioner to reopen the case for the purpose of making the suggested amendment. The same applies for a situation where the Board suggests that a claim might be patentable if the record contains certain evidence. A third type of situation where we will reopen a Board decision is where the Board bottoms its opinion and decision on the basis of a precedent which is overruled or if there is a change in practice after the Board decision.

To my knowledge we've had cases fall in all three of these categories where petitions have been filed and have been granted. It's my further understanding that in connection with this type of petition, about one third are granted, so you have one chance in three of succeeding on something like this. But I think from the practical point of view, something more ought to be said about this type of petition. Such a petition is decided by the Commissioner. However, just as the judges use law clerks, the Commissioner uses a solicitor and invariably a petition of this type ends up on the desk of one of the law examiners. If you're going to succeed on this type of petition, I'd say 99% of the time you're going to have to convince the law examiners. And

I don't want to say that we're particularly tough or obnoxious or ornery, but the Board gets after us if we try to reverse them. That's left for the court, see? So we are mindful of the fact that the statute charges the Board of Appeals with deciding appeals from the decisions of examiners. The best way, in my opinion, to be successful on a petition of this kind—or perhaps I ought to tell you some of the ways not to be successful first. The first way not to be successful, now I'm sure this applies, the judges would probably all agree with me, in connection with appeal on this point, too, is not to come in with a shotgun approach. I once went to a court of appeals hearing in Richmond and I was sitting there listening to this criminal case before the patent case came on and the presiding judge said something to the effect, "Don't tell us about anything more than three errors. There are three judges, one error per judge." Well, there's only one Commissioner. He probably can handle more than one error, but I'll tell you when there's one error and it's clear, or if it fits into one of these categories, and it's clear, your chances of success are markedly improved.

There is another way that a case can get settled as it's called, and it has happened rather infrequently but it does happen. When the associate solicitor or the assistant solicitor is preparing a brief for court sometimes he'll see something that he doesn't think has been seen anywhere along the line and such a situation may lead to a case where the appeal does not go forward. Of course the applicant under these conditions is very happy but he doesn't hear about it until the Solicitor is ready to move for a remand. But there's usually not an objection inasmuch as he's going to get what he wants insofar as the rejection made in the Patent Office is concerned. I will point out, however, sometimes a new ground of rejection surfaces after that and of course we won't take too much credit for discovering any such new ground of rejection. Now if there's questions, I'll take them at this time.

It's come to my attention that I left out one little step here. In connection with the granting of a petition to settle pursuant to former Commissioner Schuyler's notice, the Commissioner always obtains the concurrence of the Board of Appeals. In this connection, it points out all the more the reason why the petition must be clear and concise and to the point because when you have a lot of people reviewing a matter where you want success, especially where you don't have opportunity for oral hearing, you want to come right down to the point.

Here's a question. "Please describe interest in role of the Solicitor's office if any in interference settlements." The Solicitor's office normally doesn't get involved in an interference settlement of any kind. You all know there are inter partes cases. The Commissioner's sole function in interference is to determine who is the prior inventor, and having made that determination, if anybody wants to contest it, they may seek judicial review. I will point out, however, that under Section 135(c) of the statute, agreements before termination of the interference should be filed in the Patent Office. However, the Solicitor per se never gets into the deliberations on such an agreement.

Another question. "Where the CCPA opinion suggests that if claims were amended to contain a certain limitation and would be allowable, would the Patent Office entertain a request to reopen prosecution for that limited purpose and if so, what procedure would be followed?" Well, of course the premise here is a little speculative because it suggests that the CCPA would indicate in its opinion that a claim would be allowable if the limitation were there. The court has jurisdiction to review adverse decisions of the Board of Appeals. And the court has traditionally not gone the step suggested inasmuch as it would exceed the jurisdiction of the court to indicate what subject matter might be allowable. In this connection, based on my limited experience of writing decisions, I will say that it's often very difficult to write one without in effect making a suggestion that a certain claim would be allowable, but the mere fact that a CCPA opinion or a Board decision for that matter indicates that because of limitations not there we find the claimed subject matter obvious, let's say, does not mean that if it were there it would not be obvious. However, if the court were to indicate that certain subject matter might be allowable the Commissioner might entertain a petition to reopen the case for the purpose of inserting the limitation. You must also remember, of course, that you can refile the case pursuant to Section 120 in any event and get the claims if you're entitled to them.

Here's another question. "Suppose the Board points out in its decision that the claims fail to recite structure that appellant thought was in the claim. Is this a good ground for petition?" Well, really this is a specific question under the notice. The notice requires that the Board reasonably suggests that if the structure, as the question asks, were present in the claims the petition would be granted. So in the abstract the question can't be answered, but I would refer the person who asked to the notice, bearing in mind what it contains.

Here's another question, undoubtedly from one of my colleagues. "Considering the CCPA attitude re res judicata based on the Board decision, why not simply refile a case?" That's where the question ends, I suppose, as opposed to filing a petition to reopen. I'd say in general you probably could refile the case and in a lot of situations that may be the fastest way to get what you want rather than try to knock heads with us. Because if we don't see your point right off the bat, we're going to have to go to court on the case. On the other hand, the examiner will probably give it one or two actions and he may be able to handle it on a refile, but as far as I can see there's nothing that would impede a refile or that there's no particular benefit obtained by filing a petition vis-à-vis a refile. Although bearing in mind a particular case there may be some benefit.

Here's a question. "Tell us something about the organization of the Solicitor's office, number of lawyers, secretaries, etc." This really doesn't have much to do with settlement, so-called, but nevertheless, there are 9 lawyers the last time I counted, there is the Solicitor who is the administrative head of the Solicitor's office, the deputy solicitor under him, and the various associate and assistant solicitors. The work is assigned by the Solicitor to the various people. About three law examiners share a secretary. In this connection, there is an article, a recent article in one of the JPOSSs, I don't know the volume and the page citation, but it's within the last three or four months, written by Ray Martin who was a former associate solicitor, now retired, which pretty much describes all the functions of the various people, or the various functions we perform. The article doesn't necessarily say who does it, and I would suggest that the person who asked the question take a look in those JPOSSs.

Here's a question. "Will the Patent Office rely on an unpublished opinion at all as precedent?" I take it somebody's going to ask, are we going to commit insubordination here in connection with the new rule. Insofar as I'm aware, there's no policy one way or the other in the Patent Office. Of course the court rule extends to practice in the court. And I suppose there's nothing that would preclude a board member or an examiner or the Commissioner in an appropriate decision from citing a so-called unpublished decision of this court. I was informed by Mr. Bjorge of our office today that in a recent opinion Judge Rich mentioned an unpublished decision and in this connection I believe the rule reads the opinion will not be cited as precedent and Judge Rich mentions the decision, and *In re Facius* explains

the difference. In direct answer to the question, the Patent Office may well in an appropriate case cite a decision, but there's no firm policy one way or the other to do so. The second part of the question, would we cite the decision if the case is related to one appealed to the CCPA? Well, of course the rule itself, the court rule provides for citing the case for the purposes of res judicata, estoppel, and the like. If that's what "related" in the question means, then of course the case would be cited. If the subject matter of an unpublished decision was very similar to another one on appeal, we might be inclined to bring that to the court's attention. After all, if the same judge were assigned the case, the second case, it might save in the administration of justice by eliminating the need for a second judge to get completely familiar with the subject matter. But in any event we'd have to abide a specific situation to see how that would develop.

Here's a question. "Does the Solicitor have the power to reverse on petition?" I take it, to reverse the Board's decision, or only to remand to the Board of Appeals? The Board of Appeals in the Patent Office has the final decision on whether the subject matter is patentable or unpatentable. The Solicitor's function in this particular chain is to defend the Board's decision if it does go to appeal. And in our office, we do not reverse the Board. In connection with the remand, if there's a petition to reopen the prosecution and it's granted, the Solicitor will move the court to remand the case. The reason for the motion, of course, is to restore jurisdiction in the Board of Appeals.

"Are petitions to the Commission to reopen acceptable after or before the actual appeal to the CCPA?" Now this is a good question and a point I forgot to cover. We're not going to entertain any petitions prior to the filing of an appeal. Such inquiries are normally in the nature of asking us to reverse the Board which we can't do, as I pointed out before. Pursuant to the Commissioner's notice, an appeal must be in progress, or civil action for that matter. The second part of the question is, "If an appeal is taken to the District Court, is the possibility of compromising with the Solicitor greater than if an appeal is taken to the CCPA?" I would say the possibilities are the same. The Solicitor's function in either case is identical. The only difference being the forum and, of course, the possibility of new evidence in the District Court. He used the word compromise. I think I'll repeat. You know there are not very many compromises. You win and we lose if the claim gets allowed. Of course, presumably, that's in the public interest.

In the past, a continuation or continuation-in-part application directed to an appealed subject matter could be expedited in its examination through the Solicitor's office. That's the statement. The question is, "Is there any plan to revive this practice?" I think what the person asking the question must be referring to is a case in the District Court. It would often happen that an applicant would refile his application. In the interim, the civil action would be stayed provided the court agrees, which I believe it does in most cases, pending the outcome in the continuation. If the continuation is allowed, then the parent case is dropped and of course the civil action is dismissed as moot. The only influence, you might say, that the Solicitor would be a conduit similar to a petition to expedite examination in effect and because it affects a court matter, the examining groups will, for the most part, take up a continuation filed while the parent is in litigation and is being stayed pending outcome of the continuation.

"What is a petition for settlement properly called or entitled?" I guess if I were going to write one I'd—Petition to reopen after a Board decision—How would you style it? The same as the title in the notice issued by Commissioner Schuyler.

"As a form of settlement, is the Solicitor's staff prepared to confess error in a case it concludes should be reversed?" I won't say that there aren't a few I'd like to get up and walk away from, you know, and just leave them. Every lawyer has that experience. I would not want to rule out the fact that we would confess error in an appropriate case. It was done in *The Hoover Company v. Cole* in the Supreme Court when Commissioner Cole was Commissioner. But normally, I wouldn't get my expectations up too high along that line. I'd be prepared to finish the case.

If there are no further questions. I don't have anything further to say. I certainly enjoyed participating here today and I thank you all.

MR. JOSEPH NAKAMURA: Our next topic is a rather esoteric subject. It deals with *in camera* proceedings. The new rules provide for it, Rule 5.13(g). I have asked associate solicitor, Ray Lupo, to come up here and brief you on that topic.

MR. RAY LUPO: It is true that the rules for the first time provide for an *in camera* proceeding. The rules for the first time provide that the record may be sealed. Of course, under the

old rules there was nothing to preclude one from making the very same motions. Review of at least three cases that have come up before the CCPA or its predecessor will show, I believe, why this rule isn't a great departure from old practice.

In 1894 in the case of *In re Draubough* (I assume that's the correct pronunciation) 2 App.D.C. 404, in the Court of Appeals for the District of Columbia, the predecessor at least in terms of patent jurisdiction to the present Court of Customs and Patent Appeals, the appellant there moved that the files relating to the above appeal be preserved in secrecy. Now there had been no hearing in the case. The motion in fact was filed concurrently with the request for the transcript. The rationale argued by appellant was that since he had secrecy protection in the Patent Office and he had something that he wished to maintain in secrecy, here would be a logical extension for the court to extend the secrecy cover. The court did not agree. The court held that the files of the court relating to an appeal from the Commissioner of Patents are subject to public inspection. The record or transcript of any case in review in an appellate court of record and all documents pertaining thereto upon being filed with the clerk of the court become public judicial records subject to public inspection and exemplification. The court had thus determined that the public right to inspect the records of the court outweighed the petitioner's private interest in trying to maintain whatever it was he was trying to keep as a secret.

Now the CCPA, as we presently know it, got its first bite of the apple in 1943, in the case that is cited in your little pink book, *In re Sacket*. It's a very unusual case because it's a perfect example of trying to close the barn door after the horse is out. Nineteen days after the court's decision appellant moved the court to seal the record and its decision or "take whatever steps are necessary and sufficient to prevent publication." He was worried, the appellant said, that those familiar with general chemistry would immediately understand and possess his invention if there was a publication and apparently he was concerned, although it does not explicitly so state in the opinion, with protecting a trade secret. Again, the court refused to seal the record. They held that here is no authority which would warrant a court such as this one in making an order denying public inspection of a record. If appellant had a trade secret it was his privilege to practice it in the usual manner. But when he asked for a patent on his alleged invention and brought the same into the public forum of the court, a trade secret was

not such a right as this court is authorized to protect. And they cited with approval the 1894 decision that I mentioned earlier, *Draubough*.

The third, and I think most interesting, decision in this line of cases is *In re Ellsworth Mosher* a 1957 case. It's interesting because most of us know Ellsworth, for one. But also because Mr. Mosher was not a party to the litigation, he alleged no special interest in the litigation, he simply went to the clerk of the court and informally asked for copies of the Patent Office decisions that were involved in the appeal. He was turned down. He made a formal request and was turned down and he moved the court to direct the clerk to provide the papers. No hearing had been held in the case as yet. Again, the court held that these papers could be made available to the public. Any member of the public in the court's language is entitled to obtain a copy of the board's decisions as set forth in record filed in a patent appeal before the court. And it is immaterial that the appeal is pending before the court and has not yet been heard. Now here the court again cited *Draubough* and *Sackett*, and observed that those two decisions as well as this decision were in agreement with the common-law principle, that inspection of records of judicial proceeding kept in courts of this country is the right of any citizen. Before I forget, the cite on the *Mosher* case which you can again add to your pink book, is 45 CCPA 701, 1957. What is really significant though about the *Mosher* case, is a bit of dicta contained in a footnote. The footnote says we are not unmindful of the fact that, in isolated cases, reason may appear for the invocation of a secrecy order, as in the Atomic Energy Case decided by the District Court of the District of Columbia and discussed in a news article of the "Washington Post" for Saturday, April 20, 1957, at page 3. However, no such reasons appeared in the *Mosher* case.

Thus, while the court recognized the right of the citizen to these public records, it recognized that this right may not be absolute. There may be reasons to grant a secrecy request, for sealing the record.

To conclude, prior to this new rule, 5.13(g), I think the following points are evident. The CCPA has refused to seal any court records including an instance wherein it was alleged that a trade secret needed to be protected from disclosure. The CCPA has followed the common-law rule that the public has a right to access to judicial records. It has held it immaterial whether the cases have yet been heard and it has noted that there may be nevertheless, an exception when a record can be sealed.

Now in my opinion new rule 5.13(g) therefore does not change the old interpretation of the old rules by the court. True, it is a new rule and it says you can do something, but my point is that you could have done it before without that rule. Further the wording of the rule emphasizes that it has to be a proper case, has to be where the interest of justice requires it, and there has to be a convincing showing. That indicates to me that there's going to be a heavy burden on the appellant who tries to move to have his record sealed or moves for an *in camera* proceeding because again you have this recognized right of the public's ownership, I guess is the word, of the court's record. For that reason I think it's unlikely that a mere allegation that a trade secret is involved is going to carry any weight. Again this is my opinion. Because you can see the logical extension, I think that in probably a third to two thirds of the cases that come before any court dealing with patents, an argument could be made that a trade secret is involved. And certainly if it were lightly granted, that the court would seal records whenever trade secrets were merely alleged, two-thirds of the court's work may end up being secret, and I don't think that that's exactly what anyone has in mind.

There is an alternative, mentioned earlier I think by Don Dunner, and it's one that certainly should be considered. If you're worried about a trade secret involved in your application, make a determination early in the game as to whether or not the disclosure of that section of your record is really necessary for the court's determination. If you don't feel it's necessary, there's no reason to ask that it be certified as part of the record or at least that it be reproduced as part of the transcript to the court. And of course this is an alternative that's been around for quite a while and it has been availed of several times. The Solicitor can look at that omission and make his own determination. He may, of course, feel that it is necessary to have that included and he'll take appropriate action.

I guess in conclusion the thing to say about this topic, at least on behalf of the Solicitor's office, is that we view this as a new rule. When the first motion is made for either an *in camera* proceeding or sealing the record, we'll of course weigh the specific facts in view of the new rule and also in view of these three cases which we still regard as controlling law. Any questions? I add, before answering the questions, if I find that any of them are not on the topic, I'll save them out and perhaps Mr. Nakamura, the Solicitor, can answer them.



"In view of your interpretation of holdings of the court's decisions how do you reconcile your position contra to that of Mr. Dunner?"

Mr. Dunner is wrong. No, Don just has a little different view of it than I do. Certainly, as I've said I really don't see anything different that's provided by this rule than what could have been done by an appellant before this rule came into effect and in fact was done. Other appellants did try to move to have the records sealed and on the facts before the court the court just did not grant the motion. It doesn't mean that they wouldn't have granted it particularly in view of the footnote in the *Mosher* case. There's another observation here. That the new rule appears to open the door. If not, what's the purpose thereof, if the right already existed?

This is a good question. Not having been involved in the formulation of the rules, I really can't say what the purpose of the rule is. But I think my observation still holds.

"What do I foresee as a convincing showing and example?"

A secrecy case involving an Atomic Energy consideration perhaps. Don Dunner has suggested perhaps that *Gottschalk v. Benson* situation where it had not yet been determined whether or not computer programs could be patented. I really have difficulty to be very honest with you of thinking in the abstract of a convincing showing.

"In general civil practice, orders sealing the files are granted on the mere consent of the parties. Your cases are only relevant if the court is asked to seal over one party's objection. Will the Solicitor agree or will he require a motion to the court?"

I'm not sure I understand the question. If it means will the Solicitor consent to whether or not the record can be sealed, I believe that the court rule says that a motion must be made. The best that can be done is that we would not object to it. As far as consenting ahead of time to it, I don't know. Of course, again there is the danger here of answering the question in the abstract. Certainly we ought to see the facts involved before we can really give an opinion.

"Do you feel that the desire of an appellant ex parte to maintain his patent application secret unless the CCPA reverses is an adequate showing for the CCPA to have the proceedings *in camera*, as a personal opinion?"

I don't quite understand what is meant by "unless the CCPA reverses," it almost puts the question in the double time frame.

Because you're talking about the argument being held *in camera* yet the question says "unless the CCPA reverses," which indicates that a decision has come down. Let me just say that the decisions that I cited, *Sackett* and *Draubough* and *Mosher*, indicate that there's no distinction as to what time you bring your motion to seal or your *in camera* motion. The consideration should be the same. Of course, in an *in camera*—in camera as Black's Law Dictionary defines it means that it's a closed hearing before the court. It's not necessarily synonymous with sealing the record or the decision of the court.

"How early in an appeal may one request and expect to receive a decision in whether or not the CCPA will (a) allow proceedings *in camera* or (b) agree to seal part of the proceedings?"

Well, I would suggest that if you have any intention of bringing this type of motion that you bring it concurrently with your filing of your appeal right away, because the more time that lapses the more time that those papers are in the court the greater the likelihood that someone may have had a chance to see them. As far as answering when the CCPA is going to make a decision on your motion, of course I can't speak to that.

MR. JOSEPH NAKAMURA: I have a couple of comments to make in connection with the *in camera* proceedings. First of all, it should be understood that Ray's comments were directed to ex parte proceedings in the Court of Customs and Patent Appeals where the Commissioner may be involved on a motion.

The second point I would like to make is this—that the *in camera* proceeding rule is in essence a conflict with the policy of open public records of the court. It would seem to me that if you have a situation which calls for reliance on the *in camera* rule, that rather than go broadcast and try to seal the entire record that you might think in terms of sealing only those portions of the record which contain the material which you would not like to see made public. Perhaps just the claims or perhaps in your record any particular part of the description that you feel is vital to your trade secret. If that is the point that is involved and the appeal can be decided without reliance on that material, perhaps you could direct your motion to just that portion of the record.

Now, going on to our next topic. Rule 5.5 of the court provides for an "agreed statement" of the case. I've asked deputy solicitor Jere Sears to address himself to this point.

MR. SEARS: You all have this pink pamphlet that Don Dunner was gracious enough to provide, I believe and it provides a

pretty good springboard for comparing rule 5.5 with its predecessor, old rule 25(3), subsection e. Now as Don points out, and I should give credit to his co-author also, Paul Janicke, there is one significant change wrought by the new rule 5.5. It doesn't appear necessary anymore to obtain the approval or consent of the Commissioner to get by with one of these agreed statements. This could cause some trouble in inter partes appeals. If you'll note the parenthetical portions 1 and 2 in rule 5.5 you will see a parallel with the first sentence of rule 10(d) of the Federal Rules of Appellate Procedure. But beyond that point we have a radical departure. It is always necessary to get the approval or concurrence of the District Court Judge. He must be satisfied that the agreed statement reflects the truth and he's in a position to add to the agreed statement himself. As far as ex parte practice is concerned I don't foresee any problem here particularly. Don refers to the certification problem the possible conflict with section 143, which requires the Commissioner to certify copies of all the necessary original papers in evidence in the case. Well, I would suggest that parties who wish to proceed on the basis of an agreed statement, particularly inter partes, that they lodge a copy of this or file it formally in the Patent Office and request that it be certified along with the decision below and any supporting opinions. Also, the word "necessary" appears in the statute. I submit that very possibly the agreed statement may make the inclusion of other papers in the record unnecessary. So I think the problem with the statute could be overcome.

Now this morning Don referred to the *State of Israel* case as a good candidate for this sort of treatment. Of course that appeal was taken to the Court of Appeals, D. C. I agree that the issue involved could have been handled in this way. However, it was not. The record was quite short, and furthermore nobody in our shop particularly cared to go back and talk with the Judge.

There have been some solid examples of agreed statements in ex parte cases under the predecessor rule 25(3)(e). And if you ever have occasion to proceed in this manner, you might look at the records of these appeals. One is very well known, a consolidated appeal, *In re LeGrice*. It concerned 2 applications for plant patents. The issue was legal in essence. There was no particular need to certify copies of the applications, for instance. I think you can appreciate the possible difficulties in accurately reproducing the colored drawings, for example. You'll find a rather formal stipulated agreement at page 6 of that record, that is in no. 6727, and 6728, consolidated transcript. In this instance

the Solicitor at that time, Denny Moore, and attorney for the appellant, John Leonard, entered into the agreement. Furthermore it appears that Chief Judge Worley, at the time, also consented. I am not sure that the new rule would require that.

The more recent example occurred in a concurrent use trademark appeal. Actually we regard these as two ex parte appeals. In *re Fairway Foods* and I think the companion case was *Beatrice Foods*. You can find a copy of the stipulated agreement in record No. 8295, I believe, at page 55. In this instance Ed Reynolds and the counsel for the two parties entered into it. Now that's about all there is to say, I think, about rule 5.5 at this time. It has a very wholesome ring, Agreed Statement. But unfortunately you find very little agreement in many of these appeals. The vast majority of ex parte appeals involves some factual question. So I think the use of this rule will be rather slight as far as we're concerned.

MR. NAKAMURA: Again I'd like to make a comment that Mr. Sears' remarks are directed mainly to the ex parte practice insofar as the office of the Solicitor is concerned. One other point that I would like to stress is that the solicitor's office is not likely to enter into a stipulated or agreed statement of facts if there's any fact that's in dispute. If there's a dispute of fact of course we won't stipulate and that will have to be left out of the picture.

Now I notice there were a couple of questions that came up. Apparently one deals with the Solicitor's office and who to contact there and this might be a good time for me to answer that question.

The question (there are a number of them): "Could you please comment on the role of the Solicitor's office in (1) unauthorized practice before the office by a non-member of the bar not registered?"

Well about all I can say on that is that the office of the Solicitor is concerned. We do what we can. I might point out that Mr. Sears was in part instrumental in the placement of the recent ads which appear, I believe, in *Mechanics Illustrated*, the May issue. A little advertisement, which the APLA sponsored, advertising the fact that the Patent Office would supply information to any inventor who chose to write in. This is an attempt to counter the advertising practice of the non-registered practitioner.

The second question is: "Could you please comment on the role of the Solicitor's office in unethical practice by a registered

practitioner?" This is a function of our office. It's been mainly handled by Mr. Sears. What we do here is to investigate complaints. We can't do much without a written complaint. But if somebody does complain about a registered practitioner, then we look into the matter to determine whether charges should be preferred or not.

The next question is: "How much of this goes on? We hear of patent brokers defrauding people. Is the Solicitor's office the place to complain about alleged fraud by a broker?"

As to the first part of the question, how much of this goes on, there is apparently quite a bit. At least we hear quite a bit about it. Is the Solicitor's office the place to complain about alleged fraud by a broker? Well we can't ourselves do too much about that, but if we do have the information we can forward it presumably to the Justice Department for action.

Another question reads: "Why should timing of when the record is available to the public differ from the District Court? There it's at trial time. In an appeal, on the other hand, it's a little different. Your coming up on the record made below, and the application and the file in the Patent Office is part of the record which goes up on appeal.

Another question here is on agreed statements: "Will the Solicitor enter into an agreed statement except as to one or several points in dispute, thus narrowing the number of issues?"

We might do that. I can't state a hard and fast answer at this time. I believe it would depend upon the case.

I see we have a little more time before coffee break. I'd like to bring up one topic at this time. It concerns the praecipe, the order that you place with the Patent Office for the record to be sent up to the court. In particular, I'd like to address myself to when this must be filed. Now under Patent Office rule 301, the order should be filed in the Patent Office no later than 15 days after the notice of appeal is filed. If more time is needed, the only way we can do this is by extending your time for filing the appeal in court. That's the 40-day period which is set by court rule 4.1(b). So if there is a need for additional time to file the praecipe, then what you should do is request an extension of time for filing the appeal under rule 4.1(b) and that would come to the Solicitor's office where the Solicitor could grant the petition for the Commissioner. Now if the question is whether a supplemental praecipe is needed, we would suggest that this ought to be filed before the original record is filed in the court. By that I mean before the appeal is docketed. The

reason for this is that after the appeal has been docketed the proper procedure is to proceed by way of correcting or modifying the record and this would be under court rule 4.2(c). Now that can be done by way of stipulation or by way of motion on your part.

And that's about all I have on that point. Do you have any questions on that one that you would like to bring up here?

I have another question that came up here. It goes back to the question I answered a short while ago.

"With respect to the earlier question of what the Solicitor's office could do about unethical patent brokers, would it be worthwhile to mention the current FTC investigation of patent brokers?"

Yes, that's a point I could have mentioned. I forgot about it. But on April 4, there was a news announcement which appeared in the major newspapers of this country, announcing that the FTC was engaging in an industry-wide investigation of patent brokerage firms.

Another topic this afternoon, a point of interference law, the distinction between the way the winning party's application is treated when the interference decision is on appeal to the CCPA as against the way the application would be treated if the action were under Section 146 in the District Court. I've asked Mr. George Boys, Chairman of the Board of Patent Interferences, to fill you in on this part.

MR. BOYS: Actually, my work is before this happens, not afterward, but it isn't directly concerned with the decision in the interference itself, which is my primary concern. However, the question is one which is of fairly long standing and I believe it is pretty well clear-cut, based on decisions in the courts. The distinction arises from, well, there are two aspects of the situation, one of them is the difference in jurisdiction which occurs in the two different tracks of review which may be sought. When there's an appeal to the CCPA, it's pretty well settled that the Patent Office loses jurisdiction of the case, of the entire case, when that notice is filed. This was stated by the Court of Customs and Patent Appeals itself in the ex parte case of *In re Allen*, which was referred to in the case of *Loshbough v. Allen* at 53 CCPA 1214 or 149 USPQ 633, where it is stated: "In disposing of this motion it becomes incumbent upon us to examine again *In re Allen* as it relates to procedures to be followed after a notice of appeal has been filed in the Patent Office. As is generally known, *Allen* stands for the proposition that once the

notice has been filed, jurisdiction of the cause is transferred to the court and there is nothing left for the Commissioner to do other than to certify the record and transmit it to the court." Then the court goes on to note some exceptions, such as *In re Grier*, dealing with purely ministerial matters, correcting an error and that sort of thing, which are exceptions to that rule. However, the District Court has held, and been affirmed in the Court of Appeals, that the language of 35 U.S.C. § 135 authorizes the immediate issuance of a patent where the losing party takes the route of civil action under Section 145. The part of Section 135 which is relied on, after saying the matter of priority will be determined by a Board of Patent Interferences, says: "Whose decision, if adverse to the claim of an applicant shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor." All this is after the decision by the Board of Patent Interferences, and the Court of Appeals for the District of Columbia has said that means the Commissioner can issue the patent. That was in the case of *Monaco v. Watson* at 122 USPQ 564. In referring to that portion of the statute, the court there said: "We think this means just what it says. We see nothing to suggest that applicants, who like these appellants, are adjudged not to be prior inventors, can require the Commissioner to withhold the patent while they sue for it under Section 146." I misspoke. I said 145. That's the *ex parte* section. Section 146 is the *inter partes*. This was again referred to in a later case treating the other side of the question, and I should emphasize the fact that this part of the statute says: "If adverse to the claim of an applicant." In the case of *Monsanto v. Camp* and repeated in the case of *Celenese Corporation v. Brenner*, it was emphasized that it's a different thing where the losing party is a patentee. Reverting to *Monaco v. Watson*, the policy of the statute is clear. The decision of the Board is presumably, although not conclusively, correct. If the party to whom the Board awarded priority gets the patent, he gets no more than is presumably his. To withhold the patent from him for the benefit of applicants, who presumably are not entitled to it, would serve no useful purpose. If appellants win their suit under Section 146, their rights will be protected even if the Commissioner has issued the patent in the meantime, for Section 135 provides that if final judgment is adverse to a patentee it shall constitute cancellation of the claims involved from the patent. The court seemed to think that that was operative even if the patent was not a patent at the time of the Board's

decision. That is just about the situation, fairly simply stated, and I don't know quite how to elaborate on it any farther. Since nobody's brought up any questions, I'll sit down.

MR. NAKAMURA: We have a few more minutes. If you all have any questions to send up on any of the topics that we've covered, we'll entertain them now.

Well, here is a question on interferences. The question is, "In a recent case an appeal to the CCPA involved decisions on ancillary motions at final in connection with a patent, with two patent interferences. The Board dissolved both. The court affirmed one decision, reversed the other, and remanded the interference for a determination of priority. (1) Does the court approve of decisions on ancillary matters prior to any attempt to determine priority?" Well, the answer would have to be, at least from our standpoint, in terms of what the court has done in past decisions. And I believe the court has ruled on ancillary matters prior to any attempt to determine priority and I could ask George Boys, perhaps, to expand on it if he wants to.

MR. BOYS: So far as from the office standpoint, there are occasions when the Board of Patent Interferences notes an ancillary matter, such as a question of support in either the involved application or prior application so as to provide a constructive reduction to practice, and the Board feels that a holding on that particular question may dispose of the case. It's been our practice that if we think that it's clear and that there's a pretty good chance that we'll be affirmed, we may act pursuant to instructions from our first Assistant Commissioner, to decide the case on the merits and not take the time to go into priority testimony or priority evidence. There have been occasions where the Court of Customs and Patent Appeals has found the matter not so clear as we thought it was and reversed us. Not having a further decision, they quite properly remanded it to us for decision. It's a question of what is proper to decide. That the matter is ancillary to priority is I think unquestioned, because if the application which is necessary to provide the particular party its priority date is held not to support the count or counts, he cannot possibly get an award of priority and, if so, that disposes of the matter just as surely as a consideration of priority evidence. It's a question of whether, for the sake of completeness, the Board should in all cases examine both ancillary and priority matters. I don't think there's any question but what we have to consider ancillary matters as well as the priority evidence itself.

MR. NAKAMURA: This is the second half of the question that was just answered. "Since a favorable decision on an ancillary motion may render the entire record on priority academic, since the issue won't be reached, why should the parties be put to the substantial expense of testimony which is ultimately unneeded? Should not there be a method, as by mandamus, to reverse a decision on motion that is clearly in error prior to testimony?"

MR. BOYS: That's a question which has received some consideration by us at the Board. The reason why it has not been done dates back to the second decade of the century when there was a case in which just that was done. There was a decision made on an ancillary matter and it was appealed. It's been some time since I explored the matter, but there were about three different trips between the Patent Office and the court. Ever since that time the office has been reluctant to do anything other than wait until final hearing and dispose of all matters at final hearing to avoid piecemeal appeals of that character. There is some degree of merit to the question raised and there is a question whether it would be more desirable to dispose of the case on the ancillary matter immediately. If that would stick, it would be fine, but if it didn't stick, then you'd have to go ahead and take your testimony and there would have been the further delay in the case. There is something to be said on both sides and we're aware of that situation but so far as I know there has been no great pressure from the practitioners to change the practice, although there has been a rumbling or two of this sort. I think I better close it with that.

The question is "In re 35 USC 135(c), that's relative to filing settlement agreements, when is an interference terminated? When a party files an abandonment of contest or concession or when the Board of Interferences acknowledges receipt of that paper?" Our practice has been to regard it as the latter. The interference is not terminated until there is a paper signed by the appropriate authority, if it's a contest of priority, then there'll be an award of priority signed by three Board members or, if it's abandonment of the contest ending in dissolution, an order stating that the interference is dissolved signed by the Patent Interference Examiner. The reason is that the mere filing of the voluntary paper under Rule 262 is insufficient. The paper may be defective and so that interference is pending until that paper has been examined and found to be correct and the correctness has been acknowledged in the record. That has been the practice so far as accepting the agreement for filing. Of course, what the court might hold ultimately as to the validity of a

patent in relation to which this has been brought in question is beyond our scope of prediction at this point.

Here's another question, also dealing with the difference in treatment of the winning party's application. "If the losing party before the Board of Interference Examiners appeals under 35 U.S.C. § 145, and the winning party then has the case transferred to the District Court, will the Patent Office issue the patent to the party prevailing in the Patent Office?" I assume that means that the appeal was filed initially in the CCPA and then the winning party transfers the case to the District Court under notice, or rather the case is transferred to the District Court by notice of election from the winning party. Thereafter, the proceedings would be in the District Court and I would think the Patent Office would be free to follow the *Monaco v. Watson* case.

Among the other questions that came up, here is one that may be of interest. "Is there any of settlement of a trade-mark appeal after decision by the Trademark Trial and Appeal Board in ex parte cases?" There's no specific provision for it but I would say, "yes". If the case came up, ex parte trade-mark case, under circumstances which are analogous to those which appear in the Commissioner's notice of October 16, 1969, we would consider it.

MR. NAKAMURA: We have a question here which deals with a recent decision of the Court of Customs and Patent Appeals on a motion seeking to mandamus the Commissioner, the decision is *Duffy v. Tegmeyer*, and I wonder if Mr. Deputy Solicitor Sears would like to speak to that one.

MR. SEARS: I proposed the question!

MR. NAKAMURA: Well, for my answer, I would say I'm not sure. It's open to doubt anyway. The question is really, "What impact does *Duffy v. Tegmeyer* have on ex parte practice?" And I don't think it's all that clear, from the decision, what impact it will have.

The second question on the same case is, "Could the CCPA issue a writ of mandamus compelling an examiner to file an answer with the Board of Appeals, in aid of the CCPA's prospective ex parte jurisdiction?" This also is an iffy one. I think it probably goes a little too far down the line. My answer would be No.

"Is there an effective remedy for perjury in a Patent Office interference?" Well, no remedy within the Patent Office. Per-

jury would be a violation of a criminal statute. The only thing that we could do is to refer the matter to the Department of Justice as a possible violation of a criminal law. Perjury in an interference case would certainly be one form of fraud on the Patent Office and would justify striking the application under Rule 56, I think. So far as the application goes, of course, there would be no personal punishment about it, but striking the application would be about the only thing that the Patent Office could do within the proceeding itself.

The next question on the same card is, "We have heard it said that there has been no prosecution for perjury in a Patent Office interference in thirty years." I don't have the statistics at hand, and maybe George does.

MR. BOYS: Well, I'm afraid that this is a question that's directed to, if I understand it correctly, criminal prosecution. I've been involved in interferences only for about 17 years, so I cannot vouch for anything before that, but I'm not aware of any case. Well, to my own personal knowledge, I know of only one important decision involving perjury and that was in connection with an oath to an application.

Mr. NAKAMURA: The final question on this card is, "Will the Solicitor's Office take any action. The Department of Justice seems quite uninterested." The Solicitor's Office would not directly, only indirectly. If there is an action to be taken as Mr. Boys pointed out, it would be in the way of a proceeding under Rule 56 to strike the application. The jurisdiction to administer Rule 56 is in the Assistant Commissioner for Patent Examining. The office of the Solicitor gets into it in an advisory capacity in that proceeding.

Now here's a question. "How important is an oral hearing before the CCPA versus just briefing the case?" I think this is mainly a question for the court and I would rather defer to the court on that one. I see our time is up and we'll have to promise that the remaining questions which remain unanswered will be answered by mail.

CHIEF JUDGE MARKEY: Thank you, Mr. Nakamura and members of the Patent Office team for making this presentation this afternoon.

There have been a great many questions about the whole subject of unpublished opinions. Let me say first that there is an opinion. It isn't published but it is a public record, in the Clerk's office and available. Some people have said we are handling

cases without opinions. That's not true. Every case has an opinion. Some are published. Some are not. How do we decide that? In the first place, it is a unanimous decision. The screening committee composed of the Clerk and the Chief Technical Advisor have recommended in each case whether the opinion should be published or unpublished. That recommendation goes to the five members of the court and if one judge on the court says "I think the opinion should be published in this case" that's the end of the discussion. So you can feel perfectly safe that the decision not to publish isn't based on whim and just doesn't happen accidentally.

I have a note handed up. "Since the judges use USPQ at home, why do the Rules still require CCPA citations?" Because they are extremely helpful to the court. The judges have the court's own books immediately handy in chambers, and it's a great help to us. We haven't jumped on anybody who has failed to include the CCPA citation, and of course, as time goes on there won't be any more CCPA reports to cite. But I'll take the question with me and we'll take it up for consideration as a possible change.

Many have pointed out to me that we said nothing about the important field of trademarks today. We keep talking about Patents and Customs. That's purely accidental. I apologize to the trademark people for not using the word "Trademarks." There was no program on Trademark law, just as there was no program on Patent law and no program on Customs law. This is a Judicial Conference of the Court of Customs and Patent Appeals. It is therefore directed to appeals and not to the merits of the various laws. We could very well have said Patents and Trademarks on our invitations and other literature. From the court's title, "Customs and Patent Appeals," we list both patent and trademark cases under "Patent Appeals." There was and is no intent whatever to downgrade or to in any way disregard the important field of trademarks.

Here is another question, the one asked earlier of Joe Nakamura. "How important is an oral hearing before the CCPA versus just briefing the case?" In my view, and I speak only as one judge, it depends on the case. An oral hearing in some cases is extremely important. This morning Don Dunner discussed whether the court would ever deny oral hearing sua sponte. We might very well also, as our new Rules say, insist on an oral hearing in a case where there was indication that the lawyers were not going to argue. Oral hearings can be extremely important. I admit readily that I have had my mind changed by

oral argument. It can be extremely important. In other cases, gentlemen, it may be a total waste of time. What is an oral argument? It is not a vestigial right, a religious exercise, a required ritual. Of course not, it is a decisional conference of the court at which you gentlemen have a voice but no vote. That's what it is. Your oral argument is an effort to help us decide. That's what we get paid for, deciding cases. If you can help us decide with oral argument, by all means make one. If an oral argument would not help us decide, then, of course, it would not be important. And incidentally, as you know, we are accepting cases voluntarily submitted on brief. Interestingly, when we first started it, people said, no, that won't do. Nobody will do that. So we surveyed the next forty cases that we would not have gotten to and, in twenty-two of the forty, both lawyers agreed readily to submission on brief. All got an earlier decision, some by more than a year earlier.

#### **Report of the Afternoon Session—Customs Appeals**

Chief Judge Nils A. Boe commenced the Customs Breakout Session of the First Judicial Conference of the United States Court of Customs and Patent Appeals with the preface that the interest evidenced by the participants was a good indication that future conferences would be in order, and that much useful material would result from such conferences.

The afternoon program, as explained by Chief Judge Boe, was divided into three broad subject matters: Litigation Aspects, Appellate Procedure, and Suspension Practice. A brief discussion on the operation of the Clerk's Office, by the Clerk of the Court, was to follow.

#### **Litigation Aspects**

The discussion on litigation aspects was divided into three areas: Trials, Motion Practice, and Protective Complaints and Reserve Calendars; each area was discussed by one panelist from the private bar and one panelist from the Government bar.

Mr. Ellsworth F. Qualey, of the firm of Rode & Qualey, discussed trials, notice of setting, possible calendaring, and the frequency of trials. Mr. Qualey commented that the provision in the rules of the Customs Court which provides for the setting of cases for trial is Rule 9.1, which requires that a notice of at least 30 days be given the opposing party and the court as to the proposed trial date. Rule 9.1 also gives the opposing party, which, Mr. Qualey noted, is usually the Government, 15 days in which to object or suggest an alternative time or place for the trial.

Mr. Qualey then pointed out the obstacles which might arise to hinder this smooth operation as dictated by Rule 9.1. He used as an illustration the problem of gathering witnesses to insure their availability on the same date and at the same place, and then requesting trial at the place and on the date at which the witnesses will be able to appear. At that point, if the Government objects, or if the court finds the set date and place inconvenient, the plaintiff then must go through the entire procedure again.

Mr. Qualey suggested as a possible solution to this problem an informal conference between the parties to ascertain a mutually agreeable date prior to the noticing of trial. He suggested that such a procedure either be formalized through an amendment to the rules, requiring the trial judge to hold this informal conference, or through an imposition upon himself by plaintiff's counsel to confer informally with his opponent in the Department of Justice, and with the court, before filing notice. The setting of the trial would be determined by the court, which would have the benefit of the knowledge obtained through this informal conference. Mr. Qualey summarized his proposal by describing it as "a balancing of interests."

Mr. Qualey described the calling of calendars which was prescribed in the old rules of the court, and which was held periodically for the disposition of cases on the court's calendars. Without such a procedure in the current rules, Mr. Qualey explained the difficulty in knowing just how many cases would be covered in a particular location. To remedy this problem, he suggested that the court propose a possible target date for cases which were to be tried at a particular location.

The last topic covered by Mr. Qualey dealt with the frequency of trials, which, as he noted, has been much reduced under the new rules of the court. Mr. Qualey attributed this reduction in the number of trials to two factors: Early disposition through motions for summary judgment, motions for judgment on the pleadings, or various other methods now available, rather than through actual litigation, and also to the great cost of bringing a case to trial.

The process, required under the Customs Courts Act and the Rules of the Customs Court, which must be followed in order to try a case can be quite consuming in both time and money, and it is impractical for a private practitioner, in cases where the amount of money or the significance of the issue is minimal, to expend both the time and the money. As Mr. Qualey stated,

unless a substantial amount of money is involved, a case cannot be tried.

Mr. Qualey suggested the implementation of a simpler method whereby cases involving small sums could be tried without great expenditures of time and money.

Mr. Gilbert L. Sandler, representing the Customs Section for the Government, addressed himself to those topics which Mr. Qualey had discussed.

Mr. Sandler commented first on the frequency of trials. He pointed out that in the last few years during the existence of the old rules, there were approximately 200 trials a year; under the new rules, after the initial 18-month "gearing-up" period which saw less than 30 trials, there were approximately 70 trials a year. During fiscal years 1972 and 1973, Mr. Sandler said that the number of cases disposed of due to motions for judgment on the pleadings, and motions for summary judgment increased greatly. In 1972, 9 cases, and in 1973, 35 cases, were decided on summary judgment. In 1972, 8 contested cases, and in 1973, 20 contested cases, were disposed of through judgment on the pleadings. As Mr. Sandler pointed out, no comparable figures are available under the old rules, as no such procedures were available under the old rules.

Mr. Sandler attributed the reduction in the frequency of trials under the new rules to two factors: Many cases are abandoned due to the fact that they are not good cases on the merits, and are conceded by the government at times because there is no real defense; also, there are fewer retrials of old decided issues. (Under the old rules, many cases were decided on failure of proof, which led to additional trials when the party attempted to fill in the missing gaps in his proof, and under the new rules many entries are consolidated for decision at one time rather than presented separately.)

Mr. Sandler agreed with Mr. Qualey's suggestion that informal conferences take place before a case is noticed for trial, and noted in this regard that pre-trial conferences already being held by a number of the judges of the court have proved to be of great benefit. Mr. Sandler suggested that perhaps a simple amendment to the rules requiring a statement by the party serving the notice to the effect that he has consulted with his adversary would resolve the problem, for such an amendment would serve as the vehicle by which the parties would confer with each other. Mr. Sandler noted that the amendment merely should call for con-

sultation, rather than agreement, between the parties, as agreement may not always be reached.

Mr. Glenn E. Harris of the Customs Section, discussed motion practice. Motions, according to Mr. Harris, are the necessary byways to the final destination of a case—a final determination.

Although there are, as he pointed out, an ever-increasing number of motions (1,115 in fiscal year 1972 and 3,556 in fiscal year 1973), fears by both the private and Government bars of being strangled by paperwork may be allayed by close examination of the reasons behind these motions.

45% of the increase in motions filed from fiscal year 1972 to fiscal year 1973 can be accounted for by motions for extension of time, and, in fact, 45% of all motions filed in fiscal year 1972 were for extensions of time. Motions for suspensions of actions accounted for the second largest category. Mr. Harris said that these two types of motions are a necessity to the management of court business.

Filing of more substantive motions has also increased, and it is these which Mr. Harris said are of concern to the members of both sectors of the bar, as they are more consumptive of time due to the preparation which must go into them.

It was Mr. Harris' feeling that familiarity with the court rules will result in a decrease of motions. He also stated that motions are in correct proportion to the total case load of the court.

In order to reduce the number of motions filed, Mr. Harris suggested that self-restraint by the members of the bar be practiced, so that unnecessary motions are not filed, and used as an example the procedure used in the customs section whereby rather than filing a multitude of similar motions, only one motion is filed. The final and dispositive determination from the court on that one motion can then be followed in the other cases which present similar problems.

Mr. Harris advocated that as a solution to the burden of written motions which many attorneys feel, there be a conversion to oral argument on written dispositive motions by right, rather than by motion, as is presently provided for in Rule 11.1. Mr. Harris also asked for greater disposition on the part of the court to entertain oral argument of non-dispositive motions, and at places other than New York.

Mr. Harris also suggested that the moving party on all motions have the last word on that motion, and that the rules of the court be revised to permit the filing of a reply to all motions.



Mr. Donald Paley, of the firm of Sharretts, Paley, Carter & Blauvelt, also addressed himself to motion practice. Although the motion practice, as provided for in the rules of the court, is similar to that used in most federal courts, Mr. Paley pointed out that cases brought before the Customs Court differ from cases usually brought before the other federal courts in that in the Customs Court there are many individual cases which have one common substantive issue, while in the other federal courts, a case is usually the result of a substantive issue separate and different than any other case pending in that court. The result of many individual cases with one common substantive issue pending at the same time in the Customs Court is the filing of motions which prove to be duplicates of motions already filed in similar cases.

Mr. Paley agreed with the suggestion of Mr. Harris that a possible solution to what he termed "paper crunch" might be the presentation of motions which are currently restricted to written form in a motion part which would be oral in nature. Another solution advocated by Mr. Paley calls for closer dialogue between attorneys; such dialogue would reduce the need for motions by informally pointing out errors, which could then be corrected by amendments.

Mr. Earl R. Lidstrom, of the firm of Barnes, Richardson & Colburn, spoke next on the topic of protective complaints and reserve calendars.

Mr. Lidstrom indicated that with the exception of the large number of complaints filed in 1972, which could properly be defined as "protective" due to the unusual circumstances which were present that year, there is in reality no such thing as a "protective complaint" in usual practice. As explained by Mr. Lidstrom, a complaint is filed when there is an intention, and only when there is an intention. It is the first step in the process of litigation. Mr. Lidstrom pointed out that with each succeeding year, the number of complaints has decreased, and along with this decrease in number has been an increase in the filing of meaningful complaints.

Mr. Lidstrom then related the filing of complaints to the reserve files, which reserve files he feels place an arbitrary time limit on an action and restricts the choice of a test case, since an attorney is forced to proceed with a case when the two-year limitation posed by the reserve file is approaching.

As a remedy, Mr. Lidstrom proposed that there be more flexibility in the reserve calendars, elimination of arbitrary time

limits under reserve files, and, also, the elimination of other arbitrary time limits within the rules.

Mr. John A. Gussow, representing the Customs Section for the Government, also spoke on the topic of protective complaints and reserve calendars.

Mr. Gussow defined "protective complaints" as those complaints filed for the purpose of maintaining the status quo while the importer decides what course of action he is to take in an action, and contrary to the opinion stated by Mr. Lidstrom, Gussow feels that the almost 4,275 complaints filed from April of 1973 through March of 1974 reflect a growing problem of protective complaints.

The burden that this problem presents to the Government is the necessity each time to prepare a report indicating the views of the Customs Service concerning the litigation and a response in each instance to the pleading, in accordance with law. As Mr. Gussow explained, after a protest is denied administratively, a period of 180 days exists in which to perfect an action. There is a two-year period following the filing of the summons before there is any need to file a "protective complaint." Therefore, the filing of a "protective complaint" not only consumes time on the part of the Government, it also consumes time on the part of the court, which is forced to sift through these "protective complaints" to see which are of worth.

Mr. Gussow offered as a solution to this problem one remedy currently open under the rules of the court, and one remedy which would require an amendment to the rules. As the rules of the court presently provide for consolidation, a large number of cases, if so warranted, could be consolidated. In addition, as encouragement to avoid the necessity of filing a protective complaint, Mr. Gussow suggested that consideration be given to invoking separate filing fees for each complaint, or increasing the filing fee for the summons itself. Mr. Gussow stated that this would be advantageous to both parties, as well as to the court, as a means of ensuring that meaningful pleadings are filed.

#### Comments

Chief Judge Boe agreed with the panelists that a close relationship between the plaintiffs' Bar and the Government Bar would aid the court in expediting and facilitating trials. He also agreed with Mr. Qualey's suggestion that knowledge on the part of the bar as to when a judge would be sitting at a particular location would be helpful in scheduling trials, and noted that

the court attempts to give as much notice as possible. In this regard, the Chief Judge solicited suggestions which might elicit more participation by the bar in scheduling trials at different ports. Chief Judge Boe also stated his enthusiasm for pre-trial conferences, and added that this topic would be discussed at the monthly meetings of the court. He also stated that he felt every judge of the court would welcome the opportunity of holding pre-trial conferences, and that an attorney need only place a statement on the motion that such a conference, be it formal or personal, in chambers or in court, is desired.

Mr. Davidson then commented that it would be very helpful to the bar if the court would suggest a pre-trial conference if it felt such a conference might prove beneficial.

Judge Maletz suggested that the opportunity for calling a pre-trial conference be left to the bar, and noted that very few of the motions which he saw contained requests for pre-trial conferences, although he felt that in some instances much benefit could have been derived had such conferences been held.

Mr. Robert White, from Los Angeles commented that oral hearings on all motions would place a burden on attorneys not located on the East Coast.

Chief Judge Boe stated that this was a recognized problem, but that it could be alleviated by holding long-distance conferences via a conference phone call. The Chief Judge explained that the Customs Court is equipped to hold such conference calls, and would be glad to do so. The Chief Judge reiterated that the opportunity for any attorney wishing to make an oral argument, in conjunction with his written papers, was available.

Judge Watson indicated his agreement with Judge Maletz that the opportunity for calling a pre-trial conference should be left to the discretion of the bar, and stated that he felt there was opportunity which was not taken advantage of by the bar in requesting oral arguments. Judge Watson also explained to Mr. White that as the Customs Court is a national court, it would travel to any part of the fifty states and Puerto Rico to hear oral argument on dispositive motions. He stated that it would be physically almost impossible for the nine judges to travel throughout the jurisdiction of the court to hear oral arguments on non-dispositive motions.

Mr. Vance described the lack of requests for oral arguments on motions as a result of conformity stemming from the early days of the new rules, when three or four requests for oral arguments had been denied, and it was informally circulated through-

out the bar that the court did not desire oral argument and would, if it desired to hear oral argument, so inform the attorneys. Therefore, continued Mr. Vance, the attorneys conformed to that which they felt was the court's wish.

Mr. Vance also commented on Mr. White's concern as to the problems of attorneys located outside of the East Coast who may desire oral argument on a motion. Mr. Vance said that the proposal for calendaring would aid such attorneys, whose dispositive motions should by right be heard in oral argument. As there are certain ports which are usually visited during the course of a year, an indication at the beginning of the year by the court as to when each port would be visited would aid the bar in working to prepare its cases with that date in mind; so too would they be able to schedule their dispositive motions for hearing by the court in those locations.

Judge Newman stated that oral argument is indeed important, and he would welcome such oral arguments. He also commented that judges would be, in his opinion, prepared when appropriate to try a case on short notice.

Chief Judge Boe noted that it would be advantageous if several cases, as opposed to one or two cases, were tried by attorneys when the court was sitting at outports, and pointed out that this was the purpose of having a calendar structure.

Mr. Lidstrom suggested that there is a necessity for the bar to have more than 30 or 60 days' notice of the court's intention to sit at an outport, which is currently the notice given. As it takes much preparation time to get a case ready for trial, he suggested that a tentative calendar, with about six months notice, be given the bar by the court.

Chief Judge Boe stated that the court would be ready, once a notice of trial was filed by an attorney, to send a judge to sit at an outport to hear one trial, if there was one trial to be heard.

#### Appellate Procedure

Mr. Michael S. O'Rourke, representing the Customs Section for the Government, spoke first on the topic of appellate procedure.

Mr. O'Rourke indicated that because of variations in the Rules of the Customs Court and the Rules of the Court of Customs and Patent Appeals concerning access to papers, the Government finds itself facing a serious problem of confidentiality. Rule 14.3(b) (1) of the Customs Court indicates that any person may, except where restricted by law, or where the court other-

wise directs, have access to such records. The records referred to are those which the Customs Court has forwarded to its appellate court. These might include the entries, commercial invoices, special customs invoices, and others. Such records are received approximately a month before the action is heard in the CCPA, and retained by that court until after the decision is finalized. The Court of Customs and Patent Appeals, on the other hand, stated Mr. O'Rourke, allows anyone to view these particular documents while they are in the possession of the CCPA, with no restrictions. The Customs Court has, through long practice, restricted the viewing of records such as business records, invoices, and customs documents to the parties and their attorneys.

Thus the question is raised that since the CCPA permits anyone to come and view the papers, so should the Customs Court, and this would hinder the pledge of confidentiality which the Government bar gives to the importers, who supply information as to pricing, amounts of material brought in, and various other matters, that such information will go no further than the particular action that is involved.

Mr. O'Rourke also stated that this could present a problem to the plaintiffs' bar, in that they might not desire that relevant information which they have been available to other members of the bar or other parties.

Mr. O'Rourke suggested that as a possible solution, there be kept two files: one covering the pleadings in any of the actions before the court, and one containing the invoices, consumption entries, and other documents of a confidential nature.

Mr. O'Rourke also stated again the need for close cooperation between the bar, both private and Government, and cited as an illustration that area covered by Rule 5.6 of the Rules of the Court of Customs and Patent Appeals. As it is now up to the parties to decide what is to be contained in the transcript of record, there is a necessity for the attorneys of both sides to discuss any potential problems which might arise as to what is to be put into the transcript of record before the 20-day period begins to run, as the CCPA will be very reluctant to grant additional time to get such documents out. Mr. O'Rourke noted that in the morning session of the Judicial Conference, it was stated that the CCPA was desirous of moving trials and appeals, so that it is imperative that there be dialogue between the attorneys to avoid problems and delays.

Mr. Murray Sklaroff, of the firm of Serko and Sklaroff, spoke next on the subject of Appellate Procedure.

Mr. Sklaroff commented on in camera procedures, saying that if the court decided to seal a record, and proceed in camera, it render decisions with sufficient guidelines so that the importing public and Government officials could act in accordance with the meaning of the decision. Mr. Sklaroff also said that the same holds true for unpublished decisions. He stated that it would be very helpful for the importing public and the Government if guidelines and directions accompanied unpublished decisions.

Mr. Sklaroff suggested that perhaps the Court of Customs and Patent Appeals has been unduly harsh in applying the time element within which an appeal may be taken as regards the final decisions of the Customs Court, and also the Tariff Commission. He explained that under Rule 3.1(a), Notice of Appeal, of the CCPA, there are four different areas where the CCPA may review a case. In addition to the two areas already mentioned, there are reviews of the Secretary of Commerce under the Tariff Schedules of the United States pertaining to scientific instruments, and reviews of the Plant Varieties Protection Act. Under the Scientific Instruments Proposal, there is silence as to whether filing is receipt or a receipt is filing; the only requirement is to appeal within 20 days. Under the Plant Varieties Protection Act, the requirement is 60 days, or some other time as determined by the Secretary of Agriculture. In the appeals taken from the Customs Court and the Tariff Commission, however, the time element is 60 days from the final decision, and, as the law states, receipt is filing.

Perhaps, Mr. Sklaroff suggested, it would be more equitable if the Court of Customs and Patent Appeals adopted the so-called Charlson Rule, which has already been adopted by the Court of Claims, and which says that if timely mailing can be proved, timely receipt will be presumed.

#### Comments

Judge Newman commented that the Customs Court had adopted something very similar to the Charlson Rule in a case before it, and this was acknowledged by Mr. Sklaroff, who noted that it was the Tex Mex brick case.

#### Suspension Practice

The discussion on suspension practice was divided into three areas: Nature of Suspension, Suspension Disposition File, and Suspension on Agreed Statements of Fact: Each area was dis-

cussed by one panelist from the private bar and one panelist from the Government bar.

Mr. Walter E. Doherty, Jr., of Boston, Massachusetts, discussed the nature of suspension proceedings, which he characterized as being a unique procedure created by necessity because of the unique character of the Customs Court. He explained that every case begins through a cause of action, which, in the Customs Court, is the entry of merchandise made at the port of importation. Although in most other courts, a judicial determination, once made, settles once and for all, as far as that cause of action being considered is concerned, the rights of all the parties involved, the cause of action which commences a case in the Customs Court is repeated constantly; entries come into the country every day, so that there are innumerable causes of action pending in the court involving identical types of merchandise and involving the same issues, which have to be resolved in the individual actions. As Mr. Doherty stated, it would be a hopeless task to attempt to try each case as a separate action.

It was pointed out by Mr. Doherty that the Board of General Appraisers, prior to the creation of the Customs Court, had found itself faced with this problem of multiplicity of actions, and had, in fact, adopted a practice of suspending cases under a test case.

This procedure has been broadened and today, if a test case is established, not only may cases involving identical merchandise and identical issues be suspended thereunder, but also cases involving identical merchandise and identical cases which have come into the court subsequent to the establishment of the test case.

Mr. Bernard Babb, representing the Customs Section for the Government, also addressed himself to the topic of the nature of suspension.

Stating that it was his opinion that Rule 14.7 of the Customs Court, which governs the suspension of cases, was absolutely necessary and important to the maintenance and control of court files, Mr. Babb explained that the effect of suspension is to put a case into a state of limbo, where nothing further may be done to prosecute the case to its finality unless the case is removed from the suspension file. This temporary stay is removed once the test case is decided or when a motion by one of the parties to remove the case from suspension is granted by the court.

Mr. Babb then pointed out the difference between the old rules of the court and the current rules. Under Rule 16 of the prior rules, a test case had to commence with the offering of

evidence. Under Rule 14.7 of the current rules, after issue is joined, a motion may be made by one of the parties to designate the case a test case.

Mr. Joseph Leibman, representing the Customs Section for the Government, commenced the discussion on the area of suspension disposition files.

He stated that once a case is placed in a suspension disposition file, and is thereby governed by Rule 14.8 of the Customs Court, it probably will be disposed of by one of two methods: The Government will acknowledge the propriety of the plaintiff's claim and there will be a submission on an agreed statement of facts, or the plaintiff will decide not to contest any longer the Government's original administrative determination and voluntarily abandon the case. The choosing of one of these two methods is contingent upon all issues in the suspended case having been resolved in the test case. If there are issues in the suspended case remaining undecided, further litigation may be necessary.

Mr. Leibman cautioned both the private and the Government bar to initiate the process for the removal of cases off the suspension disposition file at the inception of the file, rather than delaying until notice is received from the clerk pursuant to Rule 14.8(d) of the Customs Court. Such notice is intended to merely advise the parties of the terminal date set by the judge, and precious time may be lost if the process of removal is not begun immediately after the establishment of the suspension disposition file, which establishment occurs at the moment the test case becomes final.

Mr. Leibman then pointed out a problem presented by a case which has been suspended after a complaint, and, occasionally, an answer, has been filed. He said that the rules are now unclear as to how and when to remove such a case from the suspension disposition file, but, he added, the Customs Court is presently considering amendments to Rules 14.8 and 14.7, which the Department of Justice has endorsed. He urged the court to adopt these amendments as expeditiously as possible, as they would, in his opinion, clarify any existing ambiguities. He listed two examples of these ambiguities: answers which are immediately necessary to complaints filed prior to suspension, and plaintiff's being held in default for not noticing a case for trial within one year of joinder of issue. The amendments also would permit the parties to an action the flexibility necessary to choose the best method by which to dispose of a case.

Mr. Leibman urged that elimination of a needless strain on the Government and the court be accomplished through the plaintiffs' bar advising if a case is to be abandoned. Government attorneys would then not need to file answers to cases in which complaints were filed prior to suspension, and which, due to the existing uncertainties of the rules, require the filing of an answer within 30 days of the finality of a test case.

Mr. Leibman also applauded the use of submissions on agreed statements of facts by plaintiffs' counsel, as an alternative to having answers filed.

Mr. Robert Glen White, of the firm of Glad, Tuttle, and White, also addressed himself to the topic of suspension disposition files.

Mr. White argued against the limitation of an 18-month period. He explained that on the West Coast, the attorneys, if they are not parties to an action, are not sure if an appeal has been filed until after the 60-day period has run, and they then first have to process a stipulation through the Customs Service, which is a necessary party to any stipulation. This can, and usually does, according to Mr. White, take more than the allowable 18 months. Mr. White asked the court to give their attention to this problem.

Mr. White then noted some conflicts which he has not seen resolved in the Customs Rules Decisions. The first of these conflicts arises among the provisions of Rule 14.7(d) (2), Rule 8.3 (b), and Rule 14.8, and deals with whether the filing of a motion for an extension of time is necessary to maintain an action in a suspension or a reserve file when a motion for suspension has been denied. Another conflict mentioned by Mr. White occurs when a case is suspended under a test case, due to the same issues of fact and law being involved, but in addition there are other issues involved in the suspended case which are not involved in the test case. Mr. White used as an illustration the surcharge issue. He added that he hoped the court would eventually state that suspension be allowed in cases such as this, when there is clearly one similar issue in the case pursuing suspension and in the test case, and when it is evident that suspension is not sought merely as a delaying tactic.

Mr. White then questioned whether a case which has gone to trial and been submitted, but in which no decision is yet pending, can be interpreted under Rule 14.7(c) as a case under which another case may be suspended. Mr. White indicated that it is his interpretation of that rule that a case can be suspended when a test case has been designated, or when issue has been joined in an action.

Mr. Allan H. Kamnitz, of the firm of Siegel, Mandell and Davidson, spoke on the topic of submissions on agreed statements of facts.

Mr. Kamnitz commenced his discussion by explaining that it is stipulations on agreed statements of facts which make customs law practice financially practicable, for once a test case has been decided, the hundreds of cases suspended thereunder may, within a period of 18 months, be disposed. Too often, however, stipulations are pushed away by the Attorney General's Office because there is a more pressing matter which must be pursued. By the time the stipulation has been passed on to the Customs official for his signature, and then passed on again, with much delay, back to the Attorney General's Office, much time and much paperwork (motions for enlargement of time, filing of protective complaints, etc.) has ensued.

As a remedy to this problem, Mr. Kamnitz suggested that some procedure be set up which would move stipulations along as expeditiously as possible. Mr. Kamnitz also advocated the implementation of a time limitation whereby the Attorney General's Office would have to act on a stipulation within the prescribed time, and the implementation of a reminder notice issued by the Clerk's Office to the import specialist, informing that customs representative of the time that he has retained the stipulation, and that action is due on such stipulation.

Mr. Kamnitz emphasized that while the Government and the plaintiff's counsel can afford these delays, the importer cannot, and it is the importer who thus sustains the damages.

The last panelist to speak on this topic was Mr. Frank J. Desiderio, representing the Customs Section for the Government, who commented that the Government is also desirous of shortening the time normally involved in the stipulation process, and noted that in recent months the Government has made great efforts to expedite the processing of stipulations.

Mr. Desiderio enumerated several suggestions which he believed would aid in the resolution of this time problem. He suggested that more care be exercised in the preparation of stipulations by the plaintiffs' bar. Rule 8.1 of the rules of the Customs Court sets forth the requirements of a proposed submission. The inclusion in the submission of a statement that the action was commenced, and that the protest was filed within the time provided by law and the inclusion of all modifications and amendments which may apply when reference is made to items of the Tariff Schedules of the United States under which the merchan-

dise was classified or claimed to be properly classifiable are part of these requirements. Also suggested by Mr. Desiderio as methods which would facilitate the processing of stipulations were the accurate and complete citation of a test case; a limitation on a proposed stipulation to less than 50 cases or entries being listed; submission of a prototype when a large number of stipulations are expected to cover a certain subject matter for approval as to form and language, with a letter included to indicate that it is a prototype being submitted; submission of the original stipulation with a copy, and attached thereto a listing of the schedules including all protests; and, in addition, a copy of the stipulation to go to the individual ports, with a schedule attached thereto covering only those protests filed at the individual ports; and most importantly, the expeditious submission of stipulations.

Mr. Desiderio said that if these proposed solutions were adopted by the bar, a greater number of cases would be disposed of; stipulations could be sent to all ports simultaneously; and congestion caused by the receipt of a multitude of stipulations would be eliminated, thus enabling the stipulation review process in the Attorney General's Office to proceed without hindrance. The end result, according to Mr. Desiderio, would be a great reduction in the filing of protective complaints, and in the filing of requests for extensions of time.

#### Comments

Judge Watson suggested that plaintiffs' bar avail itself of two methods which would enable the speedy disposition of stipulations: filing a motion for summary judgment if it is the belief that the Government is not being timely in processing a stipulation, or requesting that the court order the liquidation of the entries by the Customs Service within a specified time, or face the alternative of being held in contempt.

Mr. Kamnitz commented that while it was possible for plaintiffs' counsel to move for summary judgment, the purpose for which the stipulation was intended would be defeated in that the time involved in moving for summary judgment would be greater than the time involved in processing the stipulation. He added that he thought the suggestion of requesting the court to issue an order of liquidation by the Customs Service had much merit, but he feared that the ultimate result of such an order would be the holding in contempt of district directors, and that all that would be accomplished would be the consumption of the court's time.

Judge Watson responded that that decision be left to the court to decide.

Chief Judge Boe stated that it is the court's desire to act in a supervisory capacity, but that it is incumbent upon plaintiffs' attorneys to initiate requests for affirmative action, as it is incumbent also upon the Government bar. Only then, said the Chief Judge, can the court as a judicial body act.

Mr. Kamnitz commented that it might be a good idea if the court administratively kept tabs on when cases were due back in the court.

Mr. Lidstrom added that what is desired by the private bar is the enforcement by the court of its initial orders, as in cases where papers have been sent by the court to the port, accompanied by the court's request of the Customs Service to return the papers. When the papers are not returned, according to Mr. Lidstrom, the private bar has no way of knowing what action is being taken by the court.

The Chief Judge urged that the plaintiffs' attorneys seek some affirmative relief from the court when they are faced with obstacles such as these.

Mr. Vance stated that part of the problem was that the private bar does not invest enough time, and, in some cases, money, in preparing their stipulations, and that this lack of preparation is evidenced by the many errors contained in the stipulations. He reiterated the need for cooperation between the Government bar, the private bar, and the court.

The Chief Judge suggested that this might be an area in which oral hearings may be useful.

Judge Landis suggested that an increase in consolidations might alleviate this problem, in that the time interval which occurs after the disposition of a test case would be eliminated.

Mr. Doherty responded that this would aid in the expedition of some cases, but inasmuch as there are entries continually being made and liquidated, as well as protests continually being filed, it would be too lengthy a process to seek consolidation in all instances.

Mr. Paley suggested that the rules be amended to provide for designation of a test case prior to joinder of issue. This possibly would obviate the many requests for extensions of time.

Judge Watson questioned why, during the October, 1970 Reserve File, attorneys did not suspend or consolidate summonses

with one complaint, rather than going through the process of summons, complaint, and answer.

Mr. Doherty explained that this was due to the constant flow of protests and liquidations.

Judge Watson then asked whether there was any prohibition to including those with the first case, to which Mr. Doherty responded that although there was no prohibition, there was a limitation as to the time within which cases may be consolidated. Mr. Doherty predicted that the end result to such a procedure would be a multiplicity of consolidations.

#### Operation of the Clerk's Office

Mr. Joseph E. Lombardi, Clerk of the United States Customs Court, discussed the operation of the Clerk's Office.

Mr. Lombardi prefaced his remarks with the information that the Customs Court has adopted an amendment to its rules, to become effective June 1, 1974, which concerns access to papers. He explained that the rule provides, in essence, that all papers, with the exception of entries, invoices, and laboratory reports, will be available to any person. This amendment is similar to that recently adopted by the CCPA. Mr. Lombardi noted that there will be no notification to any party if there is a person desirous of looking at papers in a particular action.

Mr. Lombardi then explained the operation of the Clerk's Office under the old rules of the court, and the difference in the practices which prevailed then, and which are currently practiced now. Under the old rules, he said, the philosophy of the attorneys was to file a paper and forget about it until the Clerk's Office served a reminder. Such reminders were numerous, as every time the case appeared on a calendar, 21 of which were prepared in New York alone, and almost 100 of which were prepared for ports outside of New York, it was called. Since the calendars were called every month, an attorney was assured that the court was looking at his case several times.

Under the new rules, calendars have been eliminated, and therefore, the burden which these calendars had imposed on the Clerk's Office has now been shifted to the attorneys, who now have the responsibility of moving a case to its ultimate disposition. The Clerk's Office offers assistance by providing the attorneys with notification each step of the way of the automatic termination date which applies to the status of the case at that point.

Mr. Lombardi explained another important practice which came about because of the new rules. Under the old rules, the Clerk's Office had to accept any papers filed with it. Under the new rules, the Clerk has the authority and the responsibility to use his discretion in rejecting papers which are not in compliance with the rules of the court. This change was necessary to enable the Clerk's Office to perform one of its major functions, which is to act as an adjunct to chambers, and to provide judges with assistance in receiving papers which are in proper form. Mr. Lombardi pointed out that the Court of Customs and Patent Appeals has recently adopted a similar rule.

Mr. Lombardi then asked the cooperation of both the private and the Government bars in supplying the Clerk's Office with accurate information concerning cases, such as the title of the action, the court number, the name of the judge to whom the action has been assigned, and the particular calendar or file which the case is in at a given time, so that the Clerk's Office can maintain control of the cases, and serve notification at the proper time.

Mr. Lombardi applauded the efforts of the attorneys since October, 1970, and stated that it is the intention of the Clerk's Office to extend the same cooperation to the bar as has been received to date by the Clerk's Office. He asked that the attorneys alert the Clerk's Office if this cooperation is not received, and noted that the private bar, the Government bar, and the Clerk's Office must work together if the court is to be served in the best manner.

#### Conclusion

Chief Judge Boe expressed the appreciation of the participants of the Judicial Conference to Mr. Vance, Mr. Davidson, and Mr. Lombardi, who helped arrange the Customs Breakout Session, and added that it was his hope that this first judicial conference would be only the first of a continuing series. The Chief Judge then concluded the session by reiterating that with cooperation between the Bench and the Bar, solutions will be found to rectify not only those problems presented at the breakout session, but also any future problems which might arise.

#### Closing Remarks

CHIEF JUDGE MARKEY: Ladies and gentlemen, we're about to close the conference, but before we do, you should meet a great group of people, who were here at six o'clock this morning, who have been at it ever since, who have worked hard and be-

yond the call of duty not only in the extensive efforts of the court in the last year and a half to reduce its backlog but in making this conference a success. I said two years ago when I joined my colleagues, that this was the finest such group I had ever seen, and I double that statement now. Ladies and gentlemen, the *staff* of the United States Court of Customs and Patent Appeals!

In closing the conference let me thank you all again for coming. Let me thank you also for your patience. We request, we beg your suggestions. Wherever and whenever you think of them, pick up the phone or send a letter. Tell us your ideas for improving the administration of justice in our court.