

**Inauguration  
of the  
Hon. William C. Conner  
Inn of Court  
and  
Dinner in Honor of Judge Conner**

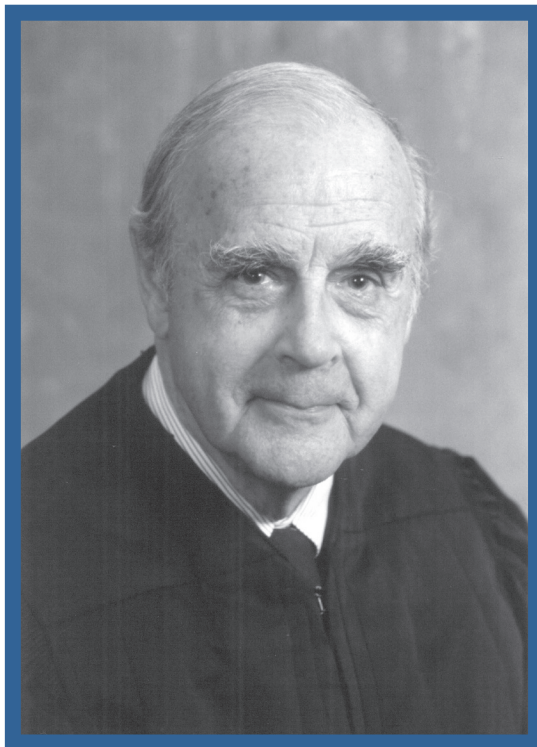


***January 15, 2009***  
***The Union League Club of New York***





# *Dinner in Honor of Judge William C. Conner*



January 15, 2009 The Union League Club, Manhattan

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## *Mission of the Hon. William C. Conner Inn of Court*

The mission of the Hon. William C. Conner Inn of Court is to promote excellence in professionalism, ethics, civility, and legal skills for judges, lawyers, academicians, and students of law and to advance the education of the members of the Inn, the members of the bench and bar, and the public in the fields of intellectual property law.



# *Program*

*Cocktail Reception* • 6:00 pm

*Dinner* • 7:00 pm

*Presentations*

*Welcome*

Anthony Giaccio

*Remarks*

Chief Judge Paul R. Michel, Federal Circuit

*Presentation of Charter*

Judge Richard Linn, Federal Circuit

*Tribute to Judge Conner*

Judge Barbara S. Jones and Judge Colleen McMahon,  
Southern District of New York



*Dinner Committee Chair*

Thomas Meloro

*Commemorative Journal Chair*

Dale Carlson



## Message from Conner Inn Executive Committee Chair

**I**t is a great pleasure for me to welcome everyone this evening to this Inauguration of the Hon. William C. Conner Inn of Court and Dinner in Honor of Judge Conner. It is both professionally and personally rewarding to see the overwhelming enthusiastic response within our IP community in New York to the formation of this intellectual property focused American Inn of Court.

The easiest task in setting up this new Inn of Court was finding the right name. Judge Conner has been a friend and mentor to the intellectual property community and has generously shared his talents and passion for Intellectual Property Law over the years as a practicing patent attorney, as a President of the New York Intellectual Property Law Association (1972-73), and as a United States District Court Judge (since Jan. 1974). We greatly appreciate his agreeing to allow us to use his name for our new Inn of Court.

We also greatly appreciate the efforts and support of several other members of the judiciary who helped make this Conner Inn a reality: Judge Richard Linn of the Federal Circuit for his vision, leadership and dedication to spreading the Inn of Court experience across the country; Judge Barbara Jones of the Southern District of New York for her dedication to the Inn of Court experience and her commitment to making the Conner Inn a success as its first President; Judges Richard Berman, Colleen McMahon, Stephen Robinson and retired Magistrate Judge Mark Fox of the Southern District of New York for their interest in participating in our Conner Inn; Chief Judge Paul Michel and Judges Timothy Dyk, Richard Linn, and Pauline Newman of the Federal Circuit for their interest in participating as visiting members of the judiciary; and each of the Judges from the Southern District of New York and the Second Circuit for joining us this evening to celebrate the formation of the Conner Inn and to honor Judge Conner.

I also want to thank the other members of the Executive Committee of the Conner Inn, Melvin Garner, John Lane, and Thomas Meloro, for their support and selfless dedication of time and energy in establishing this new Inn of Court in a few short months; Dale Carlson for putting together this commemorative journal; the leadership of the Linn Inn Alliance and of the six other intellectual property focused Inns of Court around the country for their encouragement and support; the NYIPLA for its co-sponsorship of this event; and the American Inns of Court Foundation, particularly Executive Director BG David Carey, USA (Ret.) (a.k.a. "the General") and Director of Chapter Relations for the Northeast Region, Lisa Chapin, for making the formation of a new American Inn of Court as painless as possible.

As you turn the pages of this commemorative journal, I hope that you will enjoy the tributes to Judge Conner and will take note of the sense of community, both locally and nationally, that he has fostered over his career. We look forward to advancing the values of civility, ethics, and professionalism, which Judge Conner exemplifies, in the IP community for many years to come.

By Anthony Giaccio,  
*Executive Committee Chair*



# *The Conner Inn Leadership*

## **Officers and Executive Committee**

### **Officers**

President	Hon. Barbara S. Jones <i>Southern District of New York</i>
Counselor	Hon. Colleen McMahon <i>Southern District of New York</i>
Secretary/Treasurer	Anthony Giaccio

### **Executive Committee**

Chair	Anthony Giaccio
Members	Melvin Garner John Lane Thomas Meloro

## **Distinguished Judicial Members of the Inn**

Hon. William C. Conner, *Southern District of New York*

### **Judicial Members of the Inn**

Hon. Richard M. Berman, *Southern District of New York*  
Hon. Barbara S. Jones, *Southern District of New York*  
Hon. Colleen McMahon, *Southern District of New York*  
Hon. Stephen C. Robinson, *Southern District of New York*  
Hon. Mark Fox, Magistrate Judge (Ret.), *Southern District of New York*

### **Visiting Judicial Members of the Inn**

Hon. Paul R. Michel, Chief, *Court of Appeals for the Federal Circuit*  
Hon. Timothy B. Dyk, *Court of Appeals for the Federal Circuit*  
Hon. Richard Linn, *Court of Appeals for the Federal Circuit*  
Hon. Pauline Newman, *Court of Appeals for the Federal Circuit*



## *Message from Chief Judge Paul R. Michel, United States Court of Appeals for the Federal Circuit*

Your Honoree tonight, Judge William C. Conner, gives your new Inn its distinctive name. He is himself an attorney and judge of great distinction. In at least one respect this distinction is unique. As far as I can determine, Judge Conner is the only District Judge of the 650 in the United States who previously worked as a patent litigator. Before his appointment in December 1973, he practiced patent litigation for 27 years here in New York City.

In addition to nearly three decades of distinguished service to clients of the firm of Curtis, Morris & Safford, Judge Conner led the patent bar here, serving immediately before his judicial appointment as the President of the New York Patent Law Association. His tenure on the United States District Court for the Southern District of New York exceeds even that of his private practice and will soon reach 36 years. When combined with his World War II naval service in the South Pacific, he has served the country for nearly 40 years – a record of distinguished achievement, generosity, leadership, and steadfastness.

Although he was duly recognized in 1973 with the Jefferson Medal and in 2003 with the first Outstanding Public Service Award by the New York Intellectual Property Association, I doubt anything else tops having an Inn of the Court named in your honor.

His career as litigator and judge has spanned the technology revolution in America. In 1941, he completed his degree in electrical engineering, followed by a law degree in 1942, both at the University of Texas. He immediately put the first discipline to use as an electronics officer aboard the aircraft carriers USS Enterprise and USS Lexington, and the second, starting in 1946, in private patent practice. Such cross-training in technology and law recently has become common, but in the 1940's, it was virtually unknown. Judge Conner was a pioneer.

One wonders if any classmate in his public school in Arlington, Texas in the 1930's could have imagined Bill Conner would relocate to New York City and become a famous lawyer and then a revered judge. They certainly could not have guessed he would have an association of distinguished intellectual property lawyers' named in his honor.



Like all true leaders, he quietly goes about doing his work with high standards and high skill as if that were nothing special. Tellingly, he never talks about himself, but often about the law. He has influenced countless lawyers and judges in his modest, but powerful fashion including Yours Truly. In an age of shallow celebrities and fake leaders, he is the true item, the real McCoy. He leads not with words, but actions, talking not with bravado, but care, frankness and humor. He shares what he knows, which is plenty, and inspires others to go and do likewise. I can think of few law professors who can teach as Judge Conner does, in his unassuming way, about how law works and justice is administered.

What better personification of the ideals behind every American Inn of Court. How fortunate the Conner Inn is to have his example, and how fitting for him to receive this well-deserved recognition.

Congratulations to Judge Conner and to your new Inn!

*Paul R. Michel*

Paul R. Michel  
Chief Judge  
United States Court of Appeals for the Federal Circuit  
January 15, 2009.





# *Honored Guests*

## SPECIAL GUESTS OF HONOR

Hon. William C. Conner

Mrs. Janice F. Conner

## UNITED STATES COURTS OF APPEAL

### *Federal Circuit*

Hon. Paul R. Michel, Chief Judge

Hon. Timothy B. Dyk, Circuit Judge

Hon. Richard Linn, Circuit Judge

Hon. Pauline Newman, Circuit Judge

### *Second Circuit*

Hon. Dennis Jacobs, Chief Judge

Hon. Wilfred Feinberg, Senior Circuit Judge

## UNITED STATES DISTRICT COURTS

### *Southern District of New York*

Hon. Kimba M. Wood, Chief Judge

Hon. Harold Baer, Jr., Senior District Judge

Hon. Miriam Goldman Cedarbaum, Senior District Judge

Hon. Denny Chin, District Judge, Southern District

Hon. William C. Conner, Senior District Judge

Hon. Thomas P. Griesa, Senior District Judge

Hon. John F. Keenan, Senior District Judge

Hon. Peter K. Leisure, Senior District Judge

Hon. Richard M. Berman, District Judge

Hon. Denny Chin, District Judge

Hon. Paul A. Crotty, District Judge

Hon. Barbara S. Jones, District Judge

Hon. Lewis A. Kaplan, District Judge

Hon. Kevin M. Karas, District Judge

Hon. John G. Koeltl, District Judge

Hon. Colleen McMahon, District Judge

Hon. William H. Pauley, III, District Judge

Hon. Loretta A. Preska, District Judge

Hon. Steven C. Robinson, District Judge

Hon. Mark D. Fox, Magistrate Judge (Ret.)



## UNITED STATES COURT EXECUTIVES

*Court of Appeals, Second Circuit*

Karen Greve Milton, Circuit Executive

*Southern District of New York*

Clifford Kirsch, District Court Executive

## JUDGE CONNER'S CHAMBERS

Gina Sicora, Deputy Clerk

Susan L. Greene, Law Clerk

Elizabeth F. Johnson, Law Clerk

## THE AMERICAN INNS OF COURT

BG David P. Carey, USA (Ret.), Executive Director

Lisa Chapin, Director of Chapter Relations, Northeast Region

## LINN INN ALLIANCE INNS OF COURT

Giles S. Rich American Inn of Court, *Washington DC*

Bruce T. Wieder, Esq., President

John C. Lifland American Inn of Court, *New Brunswick, NJ*

Robert G. Shepherd, Esq., President

San Francisco Bay Area IP American Inn of Court, *San Francisco, CA*

Joshua M. Masur, Esq., President

Benjamin Franklin American Inn of Court, *Philadelphia, PA*

Jacques L. Etkowicz, Esq., President

Richard Linn American Inn of Court, *Chicago, IL*

Meredith Martin Addy, Esq., President

Los Angeles IP American Inn of Court, *Los Angeles, CA*

Vern D. Schooley, Esq., President

## NYC AMERICAN INNS OF COURT

Federal Bar Council American Inn of Court

Hon. Denny Chin, President

Dennis McInerney NYCLA American Inn of Court

Michael Miller, President

## CONNER INN PARTICIPATING LAW SCHOOLS

Prof. Rochelle C. Dreyfuss, NYU School of Law

Prof. Hugh Hansen, Fordham Law School



*Message from Circuit Judge Richard Linn,  
United States Court of Appeals  
For the Federal Circuit*

**T**he United States Inns of Court movement began in 1977 when Chief Justice Warren Burger returned from a visit to England with the idea of creating in the United States an organization much like the English Inns of Court that would instill in younger members of the bar the traditions of civility, excellence and professionalism that serve as the hallmarks of the legal profession. Under the auspices of the Judicial Conference of the United States, which is the governing body of the federal judiciary, the Chief Justice formed an Ad Hoc Committee to explore this idea. One of the members of that committee was Howard T. Markey, who, for many years was a practicing patent attorney before being appointed to the bench and later becoming the first Chief Judge of the United States Court of Appeals for the Federal Circuit.

It is altogether fitting that this new Inn, which is focused on intellectual property and is located in New York City, the historic center of so much of the development of our intellectual property laws, should be named after another former patent attorney, William C. Conner, who has served this country so well and for so long as a United States District Judge.

Forty-four members participated in the first American Inn of Court in Utah in 1980. Today, there are more than 400 active American Inns. It is reassuring to know that so many lawyers in the United States embrace the goals of civility, ethics, and excellence of the Inns of Court movement.

The Honorable William C. Conner American Inn of Court is now the seventh Inn focused on Intellectual Property law. The other six Inns are the Giles S. Rich Inn, which meets in Washington, D.C.; the Ben Franklin Inn, which meets in Philadelphia; the John C. Lifland Inn, which meets in Morristown, New Jersey; the San Francisco Bay Area Intellectual Property Law Inn; the Richard Linn Inn, which meets in Chicago; and the Los Angeles Intellectual Property Inn. These Inns are a part of a newly formed coalition, named the Linn Inn Alliance, which serves to facilitate the exchange among IP Inns of program information and materials and to welcome the attendance at Inn meetings across the country of visiting members of other IP Inns. On behalf of the Alliance, I am pleased to welcome the new Conner Inn into the fold.

I commend the executive committee of the New York Intellectual Property Law Association, and in particular, its current president, Anthony Giaccio, for their untiring leadership in taking the idea of forming a new IP focused Inn of Court in New York City and making it a reality. Mel Garner told me over a year ago, "If you want to get anything like that done, the go-to guy is Anthony Giaccio." Mel was certainly right. Once Anthony understood the concept, satisfied himself that it was feasible, and presented it to the NYIPLA leadership, there was no holding them back. I am very pleased that this initiative has now come to fruition, that the new Inn



has been formed, that officers have been duly elected, and that the new Inn is positioned to take its place in the leadership ranks of the American Inn of Court movement.

It is now my distinct honor to present to the new president of the Inn, my colleague, District Judge Barbara Jones, the official charter of the William C. Conner American Inn of Court and to extend to her and to all of the members of the new Inn my congratulations, my best wishes, and my continuing support.

I am also privileged to present to Judge Jones a very special booklet entitled: In Celebration: Judge Giles S. Rich and the Giles S. Rich American Inn of Court. This booklet describes the formation seventeen years ago of the Giles S. Rich American Inn of Court – the first Inn specializing in intellectual property law. It includes a copy of Judge Rich’s talk at the inaugural meeting of the Inn on October 1, 1991, as well as articles, photographs, and program materials relating to the first two years of the Inn’s existence. On November 30, 1995, this booklet was given by the Giles Rich Inn to the president of the Ben Franklin Inn on the occasion of the formation of that Inn. It bears the handwritten note: “Best wishes to the new Philadelphia American Inn. Giles S. Rich.” On January 17, 2007, at the inaugural meeting of the Richard Linn Inn,

Paul Prestia, on behalf of the members of the Ben Franklin Inn, graciously presented the booklet to the then newest IP Inn as a token of their congratulations. The Ben Franklin members expressed the hope that their gesture would mark the start of a tradition to pass the booklet on to other new IP Inns in the future. That wish was honored on March 18, 2008, when I passed the booklet to Vern Schooley at the inaugural meeting of the Los Angeles Intellectual Property American Inn of Court. I am now very pleased, on behalf of the Los Angeles Intellectual Property American Inn of Court, to continue the tradition and pass the booklet on to you with their best wishes and congratulations. They wish you much success and hope that you, in turn, will honor the tradition and pass the booklet on to the next new IP Inn.



# A Snap-Shot of Judge Conner

*Prologue by Dale Carlson*

*I*t is only fitting that a new Inn of Court being established for the N.Y. metropolitan area bear the name of Judge Conner. For more than thirty years, he's been an avid teacher and role model for fellow federal judges & practitioners alike, particularly in regard to the niceties and intricacies of patent law.

*Judge Conner is the first practicing patent lawyer in the history of our nation to be elevated to the district court bench. However, his success at the task provides a clear pathway for other patent lawyers to follow suit.*

*We may wonder which of Judge Conner's admirable attributes led to his being nominated for the district court in the first instance. Perhaps it was the clarity of his vision, his razor-sharp wit, his kindly sense of humor, his polite and unassuming style, or the directness and soundness of his oral and written communications. Most likely it was a combination of all of these factors.*

*Although it may be easy to see the wisdom of Judge Conner's nomination when given the benefit of the kind of twenty-twenty hindsight vision that we enjoy while seated here this evening, it was doubtless not so easy for the sitting President to share that vision back in 1973. The reason is that, back then, there was no proper precedent for placing a specialist, much less one focusing upon patent law, in a position where he or she would be making rulings that would touch upon the full spectrum of general legal principles and issues.*

*Thankfully for all of us, and for our profession as a whole, the nomination did happen, and he rose to the bench.*

*In 1977, Judge Conner spoke at the NYIPLA's Waldorf dinner in honor of the federal judiciary on the topic "Can a Patent Attorney Find Happiness on the Federal Bench?". Although his short answer was a decided "Yes", his longer answer is much more fun to read, inasmuch as it offers insight into his lively wit and wisdom.*

*Below are excerpts from those remarks, which are first being offered in print at our gathering this evening. Enjoy!*



## Judge Conner's 1977 Remarks After Being Elevated to the Bench

**I**n case you are wondering why any attorney would give up a lucrative and enjoyable private practice and take the vows of poverty and chastity, there were at least two reasons why I did so. In addition, of course, to the obvious appeal to vanity in being the first patent attorney appointed to the federal bench, there was the hope that I might be able to do something, however small, to help reverse the judicial tide which had been running against the patent system for at least a quarter century, with the percentage of patents invalidated by the courts steadily rising, and with even the licensees under a patent now being free to attack its validity.

Unfortunately, up to now, as you will see, the patent cases which have come before me have been notably poor vehicles for reaching that objective, involving such advances in the frontiers of science as a toy piano and a heated sock.

In those cases, there was no way I could have ruled the patent valid without utterly destroying my credibility.

However, as I had hoped, my fellow judges have frequently flattered me by soliciting my advice in connection with their patent cases, and I have sometimes been able to get in a little "soft sell" for the patent system....

During the short time I have been on the bench, I have tried six patent cases. I want to discuss three of them briefly tonight, because I think each involves a technique or a concept which either my fellow judges or my former fellow patent trial attorneys might wish to consider in the trial of their own patent cases.

The first case I would like to discuss is  
**CAPRI JEWELRY V. HATTIE CARNEGIE.**

It involved a patent on the "mood rings" that change color according to skin temperature.

Defendant Hattie Carnegie, the licensee under the patent, had charged infringement by plaintiffs' rings, had placed an ad in Women's Wear Daily, threatening suit, and had written a letter to Gimbels, a large customer of plaintiffs, repeating the threat in even more specific terms.

Plaintiffs claimed several large orders had been cancelled as a result of these threats. Since the market on such "fad" articles is very short-lived, plaintiffs were in danger of being shut out of the market altogether. They brought an action for a declaratory judgment of non-infringement and invalidity and simultaneously filed a motion for summary judgment and sought a temporary restraining order.

At the hearing on the TRO a few days after the suit was filed, plaintiffs submitted an affidavit describing the construction of their rings, copies of patent in suit, the file history and the principal prior patent, and defendant submitted photomicrographs of cross-sectioned rings and affidavits describing their construction. A quick reading of the patent claims made it clear that there was no literal infringement because all claims required a recess in back of the glass "stone" in which a microencapsulated liquid crystal material is deposited and plaintiffs' stones had a flat back with no recess. However, there remained a question of infringement of doctrine of equivalents - - a factual question which precludes summary judgment.

However, there was so much doubt as to infringement, that I suggested a separate trial





limited to that issue, the trial to take place as soon as parties could be ready.

Plaintiff said they would be ready on the following Monday; defendants' attorney had another commitment that week and I set trial for one week later.

The weekend before the trial, I took home and studied the patent, the file history, the prior art, plaintiffs' rings, defendant's photomicrographs and all the affidavits.

It was perfectly clear from this study that there was a classic case of prosecution history estoppel which would prevent any resort to the doctrine of equivalents. During prosecution of application for claims identical with the patent claims except for omitting the recitation of a recess in back of the stone were finally rejected as fully anticipated by a single prior patent. At the same time, the dependent claims containing this limitation were indicated to be allowable if amended to place them in independent form. They were so amended and were allowed.

If I had been more passively judicious, perhaps I should simply have said nothing and proceeded with a wholly unnecessary trial. But, I am constitutionally opposed to time wasting -- some might say to prudent restraint.

So, on Monday morning before the trial, I asked permission to talk to counsel separately -- plaintiff's counsel first. Of course, I did not tell plaintiff's counsel that I felt obliged to rule in his favor, because this would obviously have put him in no mood to compromise. He agreed to drop the claim for damages if defendant would accept a consent decree of non-infringement and pay \$8,000 -- cost of a single ad in Women's Wear Daily announcing the decree -- to counteract the effect of the ad placed by defendant.

When I talked to defendant's counsel, I told him that I had already studied all of the materials bearing on the issue, and that there was an

estoppel which would absolutely bar a finding of infringement; that if plaintiffs could prove the lost sales they claimed, the damages could be very substantial; that I had arranged for an inexpensive way out, which would involve defendant's payment of only cost of single ad in Women's Wear Daily. Defendant's counsel was furious that I had "prejudged" the case -- refusing to recognize that I had already considered the only evidence which could possibly affect the existence of a prosecution history estoppel, and that I was really trying to do him a favor by making it possible to "bail out" of an impossible case at minimum cost.

So we went to trial. The trial lasted only two hours. Each of the two plaintiffs put on a witness to describe the construction of its ring.

Defendant put on a technical expert to explain what the photomicrographs showed.

Defendant then called a "patent expert," a patent attorney (incidentally, an old acquaintance of mine) to testify as to the prosecution history of the patent application and its legal effect on the construction of the claims.

I excluded that testimony because the file wrapper was already in evidence, and the patent expert, who had nothing to do with the prosecution, was in no better position than I, or any other judge, to read it; the balance of his proffered testimony was only a legal argument that could as well be made by counsel in their post-trial briefs.

Because the president of one of the plaintiffs had testified that, if plaintiffs were not to be totally shut out of the Christmas market, they had to have a ruling before the fall trade show at the end of October, I accordingly allowed only one week for the filing of post-trial memoranda, and wrote my 17-page opinion the same day the memoranda were received -- just 20 days after the action was filed!

To no one's surprise, I ruled that the patent



was not infringed by plaintiff's rings.

Defendant appealed, and its principal argument on appeal was that I had prejudged the case and rushed the parties to trial without proper opportunity to prepare. The Court of Appeals gave those contentions rather rough handling, stating that a trial court's doing its homework by studying the relevant materials before trial was not only proper but highly commendable, and that "where justice is both sure and swift, as it was here, it is at its best."

There are several possibly useful lessons buried in that narrative:

First, in a patent case, don't try any more issues than are necessary; if your preliminary study raises a substantial question of infringement, bifurcate the issues, and try the issue of infringement separately and first; you may eliminate weeks of trial on the much more complicated issue of validity. I am not insensible of the admonition of Supreme Court in *Sinclair & Carroll v. Interchemical*, that a trial court should not by-pass a ruling on validity and dispose of the case only on the ground of non-infringement, leaving possibly invalid patent as a "scarecrow" which holds the art in terrorem. But that was a case in which the issue of validity had been fully tried. The doctrine announced there would not prevent a separate trial of the issue of infringement, or force a trial court to proceed to hear evidence as to the validity of a patent which it had ruled not infringed.

Incidentally, I followed the same technique in another case, *Berkey Photo, Inc. v. Klimsch Repro, Inc.*, and again concluded that both patents in suit were not infringed, thereby saving myself about two weeks of trial.

I also attempted it in *Lerner v. Child Guidance*, an action for infringement of patent on a toy piano, even though the plaintiff had demanded

a jury trial. As it turned out, in that case, we saved no time, because the jury found the patent infringed, so we had to proceed to trial on the issue of validity.

Second suggestion is: There is no reason whatever for testimony of "patent expert" witnesses who are making essentially legal arguments which can as well be made by the attorneys in their post-trial briefs.

Possible additional lesson for attorneys: Where the same firm of attorneys who prosecuted the patent application represent the patent owner in the litigation, it takes great courage for them to tell the client for whom they have just obtained a patent at considerable expense that the first competitor who comes along does not infringe the patent.

So the moral for trial attorneys is: try to be objective; to be a good trial attorney you must first be a good judge.

For corporate patent counsel: before proceeding to an expensive trial, get an independent opinion of infringement and validity - - i.e., independent of the attorney who prosecuted the application.

The second case I would like to discuss is: **KAZ v. NOTHERN ELECTRIC CO.**

Action for infringement of three patents on electric vaporizers - - the kind used in bedrooms of children with croup.

At the trial, plaintiff's enter prima facie case consisted of offering the patents in evidence, with claim charts showing where various elements called for in the claims could be found in defendant's accused vaporizers.

This is the only case I have ever heard of where there was not one scintilla of what Supreme Court in *Graham v. John Deere* referred to as "secondary" evidence of patentability. Incredible as it may seem, plaintiff even stipulated that it would not rely on commercial success to establish validity.





All of what Judge Learned Hand referred to as the “signposts” of patentability pointed clearly of obviousness: particularly the evidence of generally contemporaneous invention by a number of others.

The moral of this story is equally obvious: Relying solely on presumption of validity of a patent is a slow and painful but absolutely foolproof method of suicide.

Patent suits can be won only by the so-called “secondary evidence” of patentability: long-felt need for invention; unsuccessful efforts of others; skepticism of experts as to operability of invention; widespread acclaim of invention, including sincerest praise of all copying by defendant and others; commercial success; and acceptance of royalty-bearing licenses.

If you will consider for a moment, you will recognize that all of those types of evidence are indeed “secondary” or indirect, except one: trial and failure of others.

After all, the test of patentability established by § 103 is whether, at the time it was made, the invention would have been obvious to those having ordinary skill in the art.

I can see no reason not to interpret those words as meaning exactly what they say. However, I believe that in many cases, the courts have clearly not done so.

If evidence shows that a number of persons skilled in the art, with substantial resources at their disposal, actually tried over a substantial period to solve a problem and failed to do so, I simply cannot see how a court can possibly conclude that the invention was “obvious” to such persons at that time. For that reason I was, quite frankly, angry when I read the decision of the Court of Appeals for the Second Circuit in *Vanity Fair Mills v. Olga*. In that case, the court ruled an invention in a panty girdle obvious notwithstanding an express finding that the invention solved a problem of riding up which

a number of experts in the field had unsuccessfully attempted to solve for 20 years.

The Court said it was “troubled” by that evidence. Small wonder! But the Court should not merely have been troubled - - it should have been persuaded.

The Court clearly was relying solely on its own hindsight evaluation of the invention rather than applying the statutory test.

It was because I felt so strongly about that decision that the first time I was offered an opportunity to sit on the Court of Appeals in a patent case, I accepted with almost unbecoming haste. I should have looked before I leaped, because that particular case involved turned out to be singularly inappropriate for undoing the mischief of *Vanity Fair Mills*.

The case was **TIMELY PRODUCTS CORP. V. ARRON**.

This was an action for infringement of a patent on, of all things socks in which the toes are electrically heated by a small battery contained in a pouch on the cuff.

The prior art was close: socks whose entire soles were heated by a larger battery contained in a pouch supported on the wearer’s belt.

There was no “secondary” evidence of patentability except for commercial acceptance.

To no one’s surprise, I was assigned to write the opinion.

From my discussions with the other two members of the panel, it was clear that if I were to conclude that the invention was patentable, I would be writing the minority opinion, so I decided by best course was to build a little character with the court, against a time when it might be useful.

However, I was still determined to do anything I could to prevent a repetition of the *Vanity Fair* disaster.

So, apropos of absolutely nothing in the case, I wrote, if you will pardon the quotation;



"We can conceive of no better way to determine whether an invention would have been obvious to persons of ordinary skill in the art at the time, than to see what such persons actually did or failed to do when they were confronted with the problem in the course of their work. If the evidence shows that a number of skilled technicians actually attempted, over a substantial period, to solve the specific problem which the invention overcame and failed to do so, notwithstanding the availability of all the necessary materials, it is difficult to see how a court could conclude that the invention was 'obvious' to such person at the time."

Then: I added this kicker:

"However, no such evidence exists in this case."

The respectful suggestion I would make to my fellow judges is: Congress has provided us with a precisely delineated test of obviousness: it is NOT how simple the invention appears in the always perfect vision of hindsight, but whether it was obvious at the time it was made to persons of ordinary skill in the art.

If there is direct evidence on that issue, I see no reason to look any further.

I don't mean to suggest that the only direct evidence of obviousness is the failure of others; it may be of their success. And, by the same token, if the evidence shows as it did in the vaporizer case, that a number of others, when presented with the same problem, promptly came up with the same solution at about the same time, this is very persuasive that the solution was obvious.

The moral for patent trial attorneys is: in proving patentability, nothing succeeds like failure - - the trial and failure of others.

And, if you are stuck for a citation to support an argument that such failure is proof positive of non-obviousness, take a look at my frankly irrelevant dictum in *Timely Products v. Arron*.

I myself found the citation quite useful in ruling valid a patent on a lightweight communications headset in *Plantronics v. Roanwell*.

I believe you will agree that when a district judge relies on an opinion which he wrote while sitting on the Court of Appeals in his own circuit, he adds new dimension to the term "bootstrap."

The last case I would like to discuss is **SPLENDOR FORM BRASSIERE CO. v. RAPID AMERICAN**.

This was an action for declaratory judgment of invalidity to the patents on the well-known Playtex "Cross Your Heart" brassiere - - an invention which may unexpectedly have contributed to Governor Carter's "looking with lust" at women.

After reading the Playboy article, I know why he smiles so much.

In *Splendor Form*, I could not take the easy way out and try the issue of infringement first, because there was no question that the principal patent was infringed; indeed, the plaintiff candidly admitted that it had copied the "Cross Your Heart" brassiere stitch-for-stitch.

This patent was entitled "Anti-creep brassiere," which does not mean that it wards off undesirable characters, but that it does not ride up on the wearer during normal bodily movements and cause uncomfortable pressure on the breasts or loss of support.

The patent specification propounds what seemed to me a wholly implausible theory of how this anti-creep result is achieved.

But I was willing to admit that there are more things in heaven and earth - - and particularly ladies' undergarments - - that are not compassed by my philosophy.

At the trial, the defendant patent owner attempted to demonstrate the superiority of its patented brassiere over the prior art by having a professional model, selected for several



obvious reasons, wearing nothing else above the waist but a “Cross Your Heart” bra, go through a standardized set of bending and stretching exercises and then announce, “It is still comfortable, and has not ridden up on my breasts.” I was forced to accept her word for it, even though it was clearly not the best evidence.

Then the model went back into my robing room, alone of course, and changed into a competitive brassiere that the plaintiff had selected as typical of the prior art.

She then emerged and went through the same set of exercises and announced that the brassiere had ridden up on her breasts and was uncomfortable.

At that point, I, paying more attention than is customary, noticed that there was a red line on the model’s skin, spaced about 1/2 inch below the lower edge of the brassiere, apparently marking the position of the lower edge of the brassiere before the exercises.

The defendants’ expert was quick to confirm that this was evidence that the brassiere had crept up on the model during the exercises.

In their rebuttal case, plaintiffs took a daring gamble which paid off handsomely. They hired the same model, sent her out to a department store to purchase a dozen “Cross Your Heart” bras and bring them to court in the still unopened boxes.

She then selected one of the boxes at random, went back into the robbing room and put it on. When she emerged, plaintiff’s attorney drew a red line on her skin around the lower edge of the brassiere with a felt marking pen, which may be the ultimate test of courtroom cool. She then went through the standard exercises, and behold, the red line was 5/8” below the lower edge! By the patent owner’s own test, the patented brassiere was not better, but slightly worse, than the prior art.

At the request of defendant’s counsel, the test was repeated, with identical results.

Defendant’s counsel, suspecting foul play, then asked me to impound the two “Cross Your Heart” brassieres that had been used in the demonstrations so that he could have them examined to see whether they conformed to dimensional tolerances, and I did so.

Several weeks later, apparently convinced that he had uncovered evidence that would nullify plaintiff’s rebuttal demonstrations, he asked leave of the Court to reopen, and I granted it.

At the reopening, he produced a different model who repeated the demonstration with a “Cross Your Heart” brassiere especially selected for conformity to dimensional tolerances, but the repetition only confirmed the previous results.

Since the invention thus failed to accomplish the only object stated in the patent, I was forced to conclude that the invention lacked the utility which is requisite to patentability.

Apparently alerted by some form of ESP, reporters from the AP and the New York Daily News, with commendable journalistic zeal, attended the entire trial, and their news stories were printed in papers as far away as Texas and California.

Shortly afterward, I received a telephone call from a young lady reporter for the Trenton, New Jersey Times, who asked whether she could interview me over the telephone. I agreed and she proceeded to question me for about 15 minutes by long distance.

She finally asked, I’m sure without any sense of double meaning:

“When the model entered the courtroom wearing nothing above the waist but a brassiere, were there any titters in the audience?” I answered, “I suppose, and probably leg men too.”

I guess the only moral in that last story is that patent cases don’t have to be dull.

And, as we have already seen, they don’t have to be long, and they don’t have to result in a ruling of invalidity.

I think that’s almost too much wisdom for one evening. It has been a pleasure to be with you.



## *Epilogue by Dale Carlson*

*Twenty years later, Judge Conner again spoke at the NYIPLA's Waldorf dinner in honor of the federal judiciary on the occasion of the NYIPLA's 75th Anniversary in 1997. Thankfully, that speech is re-produced in its entirety in the Volume 6, Number 4 issue of the Federal Circuit Bar Journal (Winter 1996).*

*As reflected in Judge Conner's 1997 remarks, much had changed for the betterment of the patent system, and the lot of patent practitioners, in two decades time. Judge Conner attributed the development of a "golden age of patent law" epitomizing that era to the creation of the Court of Appeals for the Federal Circuit and the wisdom of that Court's decisions emanating from the likes of Judges Howard Markey, Helen Nies, Giles Rich and Pauline Newman.*

*Some would say that the "golden age of patent law" has now passed us by, marked by Opinions from the Supreme Court, such as Ebay and KSR, that can be construed as working against the incentivizing force provided by the patent system. If so, in order to help set things right, we'll need to consider how to best mentor patent lawyers to follow in the foot-steps of Judge Conner up the stairs to the federal bench.*

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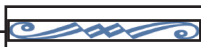
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