

In the
United States Court of Appeals

For the Seventh Circuit

No. 71-1879

UNIVERSITY OF ILLINOIS FOUNDATION,
Plaintiff-Appellant,

vs.

**BLONDER-TONGUE LABORATORIES,
INC.,**
Defendant-Appellee.

Appeal from the United
States District Court for
the Northern District of
Illinois, Eastern Divi-
sion.

Honorable
Julius J. Hoffman,
Judge Presiding.

APPELLANT'S BRIEF.

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STATEMENT OF THE CASE.

On March 29, 1966, the University of Illinois Foundation (Foundation) filed suit against Blonder-Tongue Laboratories, Inc. (Blonder-Tongue) charging infringement of U. S. Patent No. 3,210,767 (the Isbell patent).¹ (App. 9). Trial commenced December 28, 1967, and on June 27, 1968, the district court entered judgment holding the patent valid and infringed.² On February 13, 1970, this Court affirmed. (422 F. 2d 769; Supp. App. 58).

Blonder-Tongue sought certiorari and its petition was granted October 19, 1970. (400 U. S. 864). Apart from the questions presented by Blonder-Tongue, the Supreme Court, *sua sponte*, requested that the parties brief the question whether the holding in *Triplett v. Lowell*, 297 U. S. 638 (1936) should be adhered to.

On May 3, 1971, the Supreme Court handed down its decision. (402 U. S. 313; Supp. App. 20). It modified (but did not reverse) the holding in *Triplett*; vacated (but did not reverse) the judgment of this Court; remanded the case to the district court to permit Blonder-Tongue to assert (and Foundation to contest) the defense of estoppel; and expressed "no views on the other issues presented." (Supp. App. 57).

Blonder-Tongue subsequently amended its answer (Supp. App. 7-9) to assert the affirmative defense of collateral estoppel. This defense was founded on the decision of the Southern District of Iowa (271 F. Supp. 412; Supp.

App. 84), affirmed by the Eighth Circuit (402 F. 2d 125; Supp. App. 76), in *University of Illinois Foundation v. Winegard Co. (Winegard)*, which had held certain claims of the Isbell patent invalid.

Both parties moved for judgment without taking additional testimony, Foundation having supplemented the record with respect to the pleadings and judgment in *Winegard* (Supp. App. 98-102) and the pleadings in co-pending suits on the Isbell patent in the Northern District of Illinois. On September 27, 1971, the district court entered judgment holding Foundation estopped from enforcing the Isbell patent. (171 U. S. P. Q. 468; Supp. App. 12, 17). This appeal followed in due course.

1. Another patent and other issues also were involved eventually, but they are not involved in this appeal.

2. This decision is not reported. It is reproduced at App. 820.

STATEMENT OF FACTS.

The Isbell patent discloses and claims a basic antenna component which is widely used commercially. The antenna has the familiar design comprising a number of parallel dipoles whose length and spacing increase from one end of the antenna to the other according to a given mathematical relationship. While such antennas have application wherever a unidirectional, frequency independent³ performance is desired, they have particular use in television reception, especially color reception which demands higher performance than black and white.

The facts necessary to this Court's consideration of the substantive patent issues have been aptly stated in its previous opinion. (422 F. 2d 769; Supp. App. 58). *Blonder-Tongue* has not contested the accuracy of those facts, and they need not be repeated here.

The facts necessary to the Court's consideration whether an estoppel should be imposed are also basically simple and undisputed.

The validity of the Isbell patent in suit has been raised in six actions, five in this Circuit and one in the Eighth Circuit.⁴ The chronology of filing dates is:⁵

October 15, 1965—*Foundation v. Finney et al.* (Supplemental Complaint), 65 C 220; Northern District of Illinois

3. This characteristic permits a single antenna to be used over a wide range of frequencies.

4. *Winegard* could not be sued in this Circuit.

5. The undecided cases have been dismissed without prejudice for the convenience of the Court, with leave to reinstate pending the outcome of *Blonder-Tongue*.

March 8, 1966—*Foundation v. Winegard*; Southern District of Iowa.

March 29, 1966—*Foundation v. Blonder-Tongue et al.*, 66 C 567; Northern District of Illinois.

March 29, 1966—*Foundation v. Channel Master et al.*, 66 C 568; Northern District of Illinois.

April 8, 1966—*Foundation v. Jerrold*, 66 C 636; Northern District of Illinois.

May 2, 1967—*Foundation v. Gavin*, 67 C 730; Northern District of Illinois.

The first case to be tried was *Winegard*, in the Southern District of Iowa, commencing February 13, 1967. The district court's decision in *Winegard*, holding the claims of the Isbell patent there in issue invalid for obviousness, was rendered June 23, 1967. (271 F. Supp. 412; Supp. App. 84). *Foundation* filed a timely Notice of Appeal on July 27, 1967.

On December 28, 1967, trial of *Blonder-Tongue* began in the Northern District of Illinois, and on June 27, 1968, Judge Hoffman handed down his decision holding the patent valid and infringed.

On September 30, 1968, the Eighth Circuit affirmed the decision of the district court in *Winegard*. (402 F. 2d 125; Supp. App. 76). *Foundation's* petition for writ of certiorari was denied March 24, 1969. (394 U. S. 917).

On February 13, 1970, the Seventh Circuit affirmed Judge Hoffman's decision holding the Isbell patent valid and infringed. Rehearing was denied April 2, 1970. (422 F. 2d 769).

In July, 1970, in view of the Seventh Circuit's decision, *Foundation* moved for leave to file a petition for rehearing on the Supreme Court's denial of certiorari in *Winegard*.

On October 19, 1970, the Supreme Court granted *Blonder-Tongue's* petition for writ of certiorari to review the deci-

sion of the Seventh Circuit. (400 U. S. 864). On May 3, 1971, the Supreme Court handed down its decision in that case, and on May 17, 1971, the Supreme Court denied Foundation's motion for leave to file a petition for rehearing on the denial of certiorari in *Winegard*.

A chronological chart summarizing these events is set out below:

- June 23, 1967—Decision, District Court, Iowa.
- July 27, 1967—Notice of Appeal.
- June 27, 1968—Decision, District Court, Illinois.
- September 30, 1968—Decision, Eighth Circuit.
- March 24, 1969—Decision, Supreme Court, denying certiorari to Eighth Circuit.
- February 13, 1970—Decision, Seventh Circuit.
- July, 1970—Motion for leave to file petition for rehearing on denial of certiorari to Eighth Circuit.
- October 19, 1970—Decision, Supreme Court, granting certiorari to Seventh Circuit.
- May 3, 1971—Decision, Supreme Court.
- May 17, 1971—Decision, Supreme Court, denying motion for leave to file petition for rehearing on denial of certiorari to Eighth Circuit.

SUMMARY OF ARGUMENT.

In the district court, Foundation argued that estoppel should not be imposed for the following reasons:

1. The Iowa district court and the Eighth Circuit failed to grasp the technical subject matter and nature of the Isbell patent and failed to apply the correct standard of invention.

2. There was no prior, *final* adverse adjudication to which estoppel could attach.

3. The issues in the adverse adjudication were *not* the same. Claims 6, 7, and 8 of the Isbell patent, held valid in the Seventh Circuit, were not in issue in the Eighth Circuit. Therefore, estoppel should not apply in any event to claims 6, 7, and 8 of the Isbell patent.

4. This case already having been "relitigated," the savings in expense and judicial effort which formed the basis for the Supreme Court's decision in *Blonder-Tongue* do not apply.

5. All parties, and the Courts, proceeded in good faith, under settled law, to the judgment of validity and infringement. Foundation diligently prosecuted this case, as it did *Winegard*. It should not be denied the benefit of this Court's judgment because of the happenstance of which case was tried first; a happenstance which became legally significant only after Judge Hoffman's judgment was entered and affirmed.

6. *Blonder-Tongue* did not raise the issue of estoppel either before the district court or the Court of Appeals. In its briefs before the Supreme Court, it argued *against* the imposition of an estoppel. Even under questioning by the Supreme Court on oral argument, it equivocated as to

whether it sought relief on the theory of estoppel. In these circumstances, estoppel should not be imposed.

The district court did not independently consider these points. Point 1 was disposed of, without analysis, on the ground that what was involved was a "mere disagreement" between the circuits, and that such was not sufficient to bar an estoppel. (Supp. App. 15). In this brief, we shall demonstrate that far more than "mere disagreement" was involved.

Point 2 was not considered by the district court at all.

Point 3 was disposed of on the ground that the defendant in *Winegard* had, in the *prayer* to its Answer, asked that the patent be adjudged "null and void." (Supp. App. 16). No counterclaim for patent invalidity was filed in *Winegard*. In this brief, we shall demonstrate that this ground was not sound in law.

Points 4, 5 and 6 were disposed of summarily on the ground that:

All these circumstances were before the Supreme Court, and with this record before it that Court directed that defendant be given an opportunity in this Court to raise the defense. This Court cannot evade the mandate by holding that such factors defeat the plea. (Supp. App. 16).

In this brief, we shall demonstrate that the Supreme Court did not intend to impose any binding mandate on the district court, but rather left *all* issues open for its consideration in determining what would be just and equitable in the circumstances of this case.

ARGUMENT.

THE DISTRICT COURT MISCONSTRUED THE SUPREME COURT'S DECISION AND MANDATE.

The district court interpreted the Supreme Court's decision as a *mandate* to accept, without further consideration, the decision of the Eighth Circuit in *Winegard*. Accordingly, it did not fully and independently consider the factors presented by Foundation to determine what would be just and equitable in *all* of the circumstances of this case. It is submitted that the district court read into the Supreme Court's decision a mandate which does not exist and that this misconstruction was error as a matter of law.

The Supreme Court directed its attention to the legal question whether the rule of *Triplett v. Lowell* should be modified or overruled. After briefly stating the background facts, the Supreme Court confined its attention to that legal question without any reference to the particular facts of the present case, and concluded (Supp. App. 56):

... Triplett should be overruled to the extent it forecloses a plea of estoppel by one facing a charge of infringement of a patent that has once been declared invalid.

The Supreme Court set up the following factors as being relevant to the determination whether imposition of an estoppel would be just and equitable:

1. Whether the previous adverse judgment was final.
2. Whether the previous adverse judgment related to the same issues.
3. Whether the correctness of the prior adverse decision is open to doubt because of a defect in that Court's under-

standing of the technical issues, the application of the law, or the completeness of the evidence before it.

4. *Any* other factor which would make it inequitable and unjust to apply the estoppel.

Having thus changed the law, the Supreme Court had discharged its proper function within our judicial system. At the same time, it recognized that because of the rule in *Triplett* neither party had had an opportunity to address itself to the merits of imposing an estoppel during the litigation. Because the determination of the merits of this defense properly is the role of the trial court in the first instance, the Supreme Court vacated the decision and remanded the case to the district court. At no point, however, does the decision of the Supreme Court deal with the specific facts of the present case, nor indicate what effect it thought these facts should have on the outcome of the remand. Having stated the law, the Supreme Court left its application in the particular circumstances of the present case solely to the district court.

It did not, for example, treat the issue whether the decision of invalidity in *Winegard*, which did not become final until after *Blonder-Tongue* had been tried and decided, was nevertheless to be considered a final decision for purposes of imposing an estoppel. It did not even discuss, much less decide, the question whether the issues before the court in *Winegard* and those before the Court in *Blonder-Tongue* were identical and, if not, to what extent the discrepancy would prevent the application of an estoppel. The Supreme Court considered *none* of the specific factual questions presented by the case before it. As it said (Supp. App. 57):

In taking this action [of remanding the case to the district court] we intimate *no views* on the other issues presented in this case. (Emphasis added).

JUSTICE AND EQUITY REQUIRE THAT COLLATERAL ESTOPPEL NOT BE IMPOSED.

A. The Eighth Circuit Did Not Apply the Proper Legal Standards in *Winegard*.

In *Blonder-Tongue*, the Supreme Court said one of the factors to be considered in deciding the propriety of an estoppel is whether the first validity determination properly applied the standards of invention set out in *Graham v. John Deere Co.*, 383 U. S. 1 (1966). This is a substantive question, to be decided as a matter of law by this Court.

In *Graham* and its companion, *U. S. v. Adams*, 383 U. S. 39 (1966), the Supreme Court set out the guidelines for determining non-obviousness under 35 U. S. C. § 103. The federal courts were directed by these guidelines to determine the scope and content of the prior art, the differences between the prior art and the claimed invention, and the level of ordinary skill in the art. Having made these inquiries, the courts were then to decide the legal question of patentability with due consideration of such pertinent factors as commercial success, long-felt but unresolved needs, and prior attempts and failures. (383 U. S. 1, 36 and 39, 52).

The Supreme Court *did not* pass on the validity of the Isbell patent. The Eighth Circuit held that the invention covered by the claims of the Isbell patent there in suit was obvious. Conversely, and in the face of that decision, this Court held the invention covered by all claims of the Isbell patent to be nonobvious. It is submitted that this Court and its district court correctly applied the *Graham* guidelines, whereas the Eighth Circuit and its district court did not.

This Court does not have to review in depth the technical aspects of the invention. It did so in deciding that the

Isbell patent was valid. The issue now is whether in so doing it "merely disagreed" with the Eighth Circuit or whether, in its view, the standard of patentability applied by the Eighth Circuit in *Winegard* departed from *Graham*.

It is evident that it did. For some time, the Eighth Circuit notoriously has been out of step with this and the other circuits on the issue of patentability. Since *Graham*, and until June, 1971, the Eighth Circuit had occasion to pass on the validity of 18 patents and found every one of them invalid, reversing in several instances a district court which had held a patent valid.

In *Woodstream Corp. v. Herter's, Inc.*, 446 F. 2d 1143 (8th Cir. 1971) the Court, for the first time since *Graham*, found a patent valid. It referred to *Blonder-Tongue* and Mr. Justice White's emphasis therein of the importance of the presumption of validity in patent law, and held the patent valid "primarily, because the defendants have failed to rebut the § 282 presumption." (446 F. 2d 1143, 1149, 1156).

The sudden emphasis by the Eighth Circuit on the presumption of validity in *Woodstream* must be contrasted with its previous disregard for this presumption since *Graham*. Also, an analysis of the Eighth Circuit's decisions since *Graham* and prior to *Woodstream* indicates that the Court had routinely rejected all evidence of commercial success, long-felt want, and prior attempts and failures in considering the question of obviousness.

That the *Woodstream* decision does indeed represent a change in the standards of invention applied by the Eighth Circuit is clear from the concluding remarks of the Court (446 F. 2d 1143, 1157):

In *Blonder-Tongue, supra*, the Supreme Court observed that a defendant in a patent infringement suit must not only introduce proof to overcome the presumption of patent validity, but must also rebut whatever proof the patentee offers to bolster his claims.

The Eighth Circuit may now have come belatedly to apply properly the *Graham* standards of patentability, but too late to be of any benefit to Foundation in *Winegard*. In *Winegard*, the Court ignored the presumption of validity as well as to the showings of commercial success, long-felt need, prior failure, and, indeed, the expressed statements of those skilled in the art that the results achieved by Isbell were in fact unpredictable.

In *Woodstream*, the court quoted with approval two of the decisions of Judge Learned Hand. (446 F. 2d 1143, 1156-57). The first, from *B. G. Corporation v. Walter Kidde & Co.*, 79 F. 2d 20, 22 (2nd Cir. 1935), is as follows:

All machines are made up of the same elements; rods, pawls, pitmans, journals, toggles, gears, cams, and the like, all acting their parts as they always do and always must. * * * But the elements are capable of an infinity of permutations, and the selection of that group which proves serviceable to a given need may require a high degree of originality. It is that act of selection which is the invention; and it must be beyond the capacity of common-place imagination.

In the second, from *Reiner v. I. Leon Co.*, 285 F. 2d 501, 503-04 (2nd Cir. 1960) Judge Hand said, concerning the role of a court in patent litigation:

The test laid down [for obviousness] is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person "having ordinary skill" in an "art" with which we are totally unfamiliar; and we do not see how such a standard can be applied at all except by recourse to the earlier work in the art, and to the general history of the means available at the time. To judge on our own that this or that new assemblage of old factors was, or was not, "obvious" is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it. There are indeed some signposts: e.g. how long did the need exist; how many tried to find the way; how long did the

surrounding and accessory arts disclose the means; how immediately was the invention recognized as an answer by those who used the new variant?

The rule which the court quotes with approval in *Woodstream* is precisely that which was rejected by it in *Winegard*.

In holding the Isbell patent invalid, the Iowa district court said:

It is thus apparent that the Isbell antenna is a combination of elements, all known in the prior art and also that these known elements were combined in the Isbell antenna in a manner dictated by a theory also known in the prior art.

The theory referred to by Court as being "known" was stated to be "the log periodic method of designing frequency independent antennas." (271 F. Supp. 412, 418; Supp. App. 95).

If the Iowa district court's premise concerning the manner in which the known elements of the prior art had been combined by Isbell had been correct, we would have no quarrel with the court's determination that the results must have been obvious to one skilled in the art. Knowing that a desired effect can be achieved merely by combining certain elements in a known manner, one would have no difficulty in assembling Isbell's invention. The "act of selection" referred to by Judge Hand in *B. G. Corporation, supra*, would have been within "the capacity of commonplace imagination."

The fact is, however, that *there was and is no* "log periodic method of designing frequency independent antennas," but rather only a method of designing log periodic structures, which may potentially be antennas having frequency independent properties, but which in the vast and unpredictable majority of cases are *not*.

On appeal the Eighth Circuit *agreed* that the premise of the trial Court had indeed been erroneous and that the art did *not* know how to design a frequency-independent log periodic antenna with any assurance of success. (402 F. 2d 125, 126; Supp. App. 77-78). The Court accepted as true the statements of the prior art that:

Unfortunately no theory has been established which even predicts the types of structures which will give frequency independent operation.

and,

It is not possible to determine *a priori* the frequency independent type of log-periodic antennas.

Having thus established the level of skill in the art, the Eighth Circuit ignored it and substituted its *own* judgment of what one skilled in the art would find obvious. Without citing any support the Court stated (402 F. 2d 125, 128; Supp. App. 82):

The problem here was one of trial and error with a combination of commonly used elements operating within known principles of electronics and mechanics to achieve a desired result.

The Court, in essence, held that in view of the availability of the elements of which Isbell's antenna is formed it was obvious to combine them to produce Isbell's invention, on a hit-or-miss, trial-and-error basis. This is precisely the argument that was rejected by Judge Hand in *Reiner, supra*.

The argument that an invention is obvious because it requires only "routine experimentation" was also rejected in *Application of Tomlinson*, 363 F. 2d 928, 931 (C. C. P. A. 1966):

Our reply to this view is simply that it begs the question, which is obviousness under section 103 of *compositions and methods*, not of the direction to be taken in

making *efforts or attempts*. Slight reflection suggests, we think, that there is usually an element of "obviousness to try" in any research endeavor, that it is not undertaken with complete blindness but rather with some semblance of a chance of success, and that patentability determinations based on that as the test would not only be contrary to statute but result in a marked deterioration of the entire patent system as an incentive to invest in those efforts and attempts which go by the name of "research."

The standard of patentability applied by the Eighth Circuit in *Winegard* effectively denied the patentability of *all* combinations of known elements. A result can be desired without any knowledge of how to achieve the result and a trial-and-error procedure can always be employed using known elements. Applying the *Winegard* rationale, one would hold that a novel chemical compound having the unpredictable property of curing cancer or of growing hair on bald heads would nevertheless be obvious since the result is desired and all chemical elements are known, the result in that sense being achieved in an "obvious" way merely by trial-and-error experimentation with all possible combinations of chemical elements.

Contrast this attitude with the proper application of the law by this Circuit. In coming to their original decisions that the Isbell patent was valid, both Judge Hoffman and this Court rejected the "obvious-to-try" standard of obviousness. The decisions of the Courts in this Circuit, opposed to those in the Eighth Circuit and with full knowledge thereof, are persuasive evidence that the legal standards applied by the Eighth Circuit in *Winegard* were erroneous. The Eighth Circuit's own holding in *Woodstream*, decided after the Supreme Court's decision in *Blonder-Tongue*, appears to recognize this fact.

In so ruling, this Court would not be evidencing judicial "arrogance," as the district court thought, nor would it be sitting in "review" of a sister Circuit Court. It merely would be determining whether its own legal standards and prior decisions should be enforced or whether they should bow to the decisions of another circuit. The district court did not analyze or even consider these factors.

B. At the Least, the Eighth Circuit's Holding in *Winegard* Is in Doubt and Should Not Give Rise to an Estoppel.

Even if this Court does not find that the Eighth Circuit failed to grasp the technical subject matter of the invention, nor that it applied an incorrect standard of invention, justice and equity require that an estoppel not be imposed.

In *Blonder-Tongue*, the Supreme Court did not direct its attention to a situation in which a patent has been held invalid by one court and valid by another, equal court as of the time that estoppel is first asserted as a defense. Such a situation is present here and it was also recently faced in *Blumcraft of Pittsburgh v. Kawneer Co. Inc.*, F. Supp., 172 U. S. P. Q. 43 (N. D. Ga., 1971); Supp. App. 103.

The court in *Blumcraft* acknowledged that none of the specific factors set out by the Supreme Court as negating a defense of estoppel was there present. The *Blumcraft* court recognized, however, that it would be unjust and inequitable to apply an estoppel *merely* because the patent had been previously held invalid. It recognized that substantial doubt as to the propriety of the finding of invalidity was created merely by the previous finding of

validity. Accordingly, it refused to impose an estoppel, saying (Supp. App. 107-08):

At present, there are two conflicting decisions construing the validity of the patent in question. In the interest of justice, this court cannot place more weight on the decision of the Court of Appeals than on the decision of the Court of Claims in ruling on the defendants' plea for estoppel.

The situation faced by Judge Hoffman on remand, in effect, is identical to *Blumcraft*. Even assuming *arguendo* that none of the specific factors considered by the Supreme Court to justify denial of estoppel were present here, the fact remains that, after a full consideration of the issues, the Isbell patent was declared valid by this Court with knowledge of the previous finding of invalidity by the Eighth Circuit. The inescapable conclusion is that there exists substantial doubt as to the correctness of the decision of the Eighth Circuit, irrespective of its application of legal standards. *Blonder-Tongue* in this case, to just as great an extent as the Foundation in the *Winegard* case, has had its day in court. To apply the estoppel here would be to put more weight on the decision of invalidity of the Eighth Circuit than on the finding of validity rendered by this Court, without *any* justification. Because of this fact alone, an estoppel should not be imposed.⁶

C. The Judgment in *Winegard* Was Not Final for Purposes of Estoppel.

The Supreme Court recognized that the prior adverse decision to which an estoppel is alleged to attach must be a *final* decision. As the Court said (Supp. App. 39):

6. The Supreme Court had a clear opportunity to choose the Eighth Circuit's decision over that of this Court, but it did not do so.

Moreover, we do not suggest, without legislative guidance, that a plea of estoppel by an infringement or royalty suit defendant must automatically be accepted once the defendant in support of his plea identifies the issue in suit as the identical question *finally decided* against the patentee or one of his privies in previous litigation. (Emphasis added.)

The requirement that a prior adverse judgment must be final is in keeping with the classical requirements of *res judicata* and *collateral estoppel*, and with the concepts of justice and equity. A judgment not yet final can obviously be overturned and a judgment based on an estoppel created by a not-yet-final previous holding is not only unjust but inviting of judicial chaos. There is no indication that in permitting *Blonder-Tongue* belatedly to raise an estoppel defense the Supreme Court made any prejudgments or intended to waive any of the requirements for applying *res judicata* or *collateral estoppel*, including specifically the existence of a *final prior* judgment.

The trial before Judge Hoffman was held during the period of December 28, 1967 to January 11, 1968. The decision in *Winegard* did not become final until the Foundation's petition for writ of certiorari was denied on March 24, 1969, well over a year after the close of the trial before Judge Hoffman and almost 9 months after Judge Hoffman's decision holding the Isbell patent valid. Even if the modification of *Triplett* had been announced by the Supreme Court prior to the time of trial before Judge Hoffman, he would not have been able to act on a plea of estoppel because there was no finality.

The district court gave *no* consideration to this factor.

D. The Record in and Issues Decided by Winegard Were Not Identical to Those in This Case.

The Supreme Court recognized that a prior adverse decision to which estoppel is alleged to attach must not only be *final* but must have decided the *same* issues as are involved in the case at issue. Neither the record, nor the issues were identical in *Winegard* and *Blonder-Tongue*.

The most significant difference in the records was the testimony of Dr. DuHamel, the noted authority on log-periodic antenna designs. He testified in *Blonder-Tongue*, but not *Winegard*. His testimony corroborated Foundation's position on non-obviousness. This Court specifically commented on such testimony (Supp. App. 67, *et seq.*) in addition to the other evidence and concluded that:

From the record before us, we do not view the situation as one where it was obvious to antenna designers that a simple dipole and the segment of line between it and the next dipole in an array would describe a cell fitting the concept of logarithmically periodic antennas, nor that some arrangement of simple dipoles in geometric progression would be a frequency independent broadband antenna, making it simply a matter of logical experimentation to find one.

The issues in *Winegard* were also different from those in *Blonder-Tongue*. As the *Winegard* district court noted, claims 6, 7, and 8 were not there charged to have been infringed. (Supp. App. 89). No evidence was introduced and no arguments were made during the *Winegard* trial with respect to these claims. Although the defendant in *Winegard* asserted in its Answer that the Isbell patent was "null and void and of no force and effect," there was no counterclaim filed by the defendant in that case. The validity of claims 6, 7, and 8 was thus not in issue.

On the other hand, in *Blonder-Tongue*, all of the patent claims, including claims 6, 7, and 8 were in issue. Regard-

less of whether the estoppel is otherwise held to be applicable, therefore, there cannot be an estoppel as to claims 6, 7, and 8.

It is settled law that each claim of the patent "represents a separate cause of action." *Stumpf v. A. Schreiber Brewing Co.*, 252 Fed. 142, 143 (2nd Cir. 1918). In passing on the validity of the claims of a patent, they are not treated as a group but rather individually and the validity or invalidity of one does not affect the others. These principles are clearly stated in 35 U. S. C. 253:

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. * * *

and in 35 U. S. C. 288:

Whenever, without deceptive intention, a claim of a patent is invalid, an action may be maintained for the infringement of a claim of the patent which may be valid.

The provisions of these sections were passed by Congress "to remove the harsh and inexorable rule of the common law theretofore applied, that if one claim of a patent was invalid, the whole patent was void." *General Electric Co. v. Hygrade Sylvania Corp.*, 61 F. Supp. 539, 542 (S. D. N. Y. 1944).

The patent statutes also provide that the existence of one or more invalid claims in a patent shall not effect the presumption of validity of the other claims. 35 U. S. C. § 282 provides:

A patent shall be presumed valid. Each claim of a patent (whether in independent or dependent form) shall be presumed valid independently of the validity of other claims; * * *

In *Felburn v. New York Central R. R. Co.*, 350 F. 2d 416, 420 (6th Cir. 1965), only some of the claims of two

patents in suit were in issue, although the Complaint as filed alleged infringement broadly and the defendant's Answer alleged the invalidity of the patents broadly. The Court of Appeals reversed judgment of the trial court which held the *patents* invalid saying (at 420):

As a preliminary matter, we note that the District Court, in its conclusions of law numbered 8 and 9, held both patents "invalid and void for lack of novelty and patentable invention," without restricting that holding to the particular claims on which the issues were tried. We think it was error for the District Court, even impliedly, to pass upon the validity of claims which were not properly put in issue. . . . While a different result might well obtain where there is a claim or counterclaim seeking a declaratory judgment of invalidity of the entire patent, . . . we do not have that situation in the present case.

This principle was also stated in *Bain v. M. A. Hanna Co.*, 331 F. 2d 974, 980 (6th Cir. 1964).

E. This Case Already Having Been Litigated in Good Faith, Under Settled Law, Equity and Justice Require That No Estoppel Be Imposed.

Plaintiff has diligently and in good faith attempted to enforce the patent in suit against infringers. This enforcement, because of the requirements of venue, led to the filing of five suits in the Northern District of Illinois and one in the Southern District of Iowa. These suits were prosecuted concurrently, with diligence, and, as it happened, the Iowa suit was the first to reach trial. The Illinois suits were diligently prosecuted throughout, however, and this case, the first to be readied for trial, was tried when reached on the district court's calendar.⁷

7. The first-filed Illinois suit was unavoidably delayed by its transfer from Judge Marovitz to Judge Lynch,

As a result of this dual prosecution, recognized by *both* parties and the courts to be in accordance with and required by the law as expressed in *Triplett* there now exists a situation in which two district courts, and their respective Courts of Appeal, disagree as to the validity of the patent in suit.

The question, therefore, is not whether Foundation should be permitted to relitigate the issue of validity. The issue *has* been relitigated in fact. The question is whether it would be equitable to impose an estoppel barring Foundation from the fruits of this Court's judgment. It is as much a matter of public concern that a valid patent be enforceable as that an invalid one be stricken. Both are requisites to the healthy patent system judged desirable by Congress and the Constitution.

No reason for an estoppel appears in this case. The basis for the Supreme Court's modification of *Triplett* was the desirability of reducing the cost of multiple litigation to the parties and the burden imposed on the federal courts by such litigation. Neither of these grounds is applicable here, where the relitigation has already taken place, in good faith and in full accord with existing law.

The district court considered itself barred by the Supreme Court's decision from considering this factor. (Supp. App. 16). Yet there is *no* such indication in the Supreme Court's decision. It left *all* factors open for the district court's consideration.

Judge Lynch's illness, and an unsuccessful motion for summary judgment filed by the defendant in that case: factors obviously beyond the control of either Foundation or the courts. Foundation sought, unsuccessfully, to consolidate the Illinois cases.

F. Blonder-Tongue Did Not Seek the Benefits of the Supreme Court's Remand and Opposed Changing the Rule in Triplett.

In its brief before the Supreme Court, Blonder-Tongue answered in the *affirmative* the question whether *Triplett* should be adhered to. On oral argument, it never squarely answered the Court's questions of whether it sought relief on the basis of a modification of *Triplett*.⁸ (Supp. App. 25-26). While the Supreme Court found the question properly to be before it, Blonder-Tongue's position in that Court is a valid consideration in determining the justice and equity in imposing an estoppel to the enforcement of this Court's judgment. See *Grantham v. McGraw Edison Company*, F. 2d (7th Cir. 1971).

8. Defendant never attempted to argue for an estoppel either before this Court or the Court of Appeals, nor in its briefs before the Supreme Court.

CONCLUSION.

For the foregoing reasons, the district court's decision on remand that Foundation is estopped to enforce the validity of the Ishell patent should be reversed.

Respectfully submitted,

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