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Having regard to the above circumstances, I have come to the conclusion that confusion within the meaning of s. 6 of the *Trade Marks Act*, R.S.C. 1970, c. T-10 is not likely. I find that the grounds of opposition are not well founded and the opposition is rejected pursuant to the authority of s. 37(8) of the *Trade Marks Act*.

IMPORTATION OF CANADIAN INVENTIONS TO THE UNITED STATES*

*Karl F. Jorda, J.D.***

Introduction

The effective date of invention to be attributed under United States' law to a foreign invention imported or introduced into the United States deals with an apparently not too well-known area of U.S. patent practice: No article has been written on it; Rivise & Ceasar's four volume classic on Interference Practice treats it rather cursorily and there are relatively few decisions in this area. However, this subject is a very practical one and presents interesting possibilities not only in interference practice but also in patent prosecution, that is, Rule 131 practice and in validity studies.

Retrospectively perhaps reliance on importation of foreign inventions has been a rather rare occurrence, but prospectively it will surely be more important and more frequent. There has been a tremendous growth of multinational and international businesses — and the trend continues. Foreign companies have subsidiaries in the United States and American Companies have subsidiaries in other countries. Research is carried out outside of the United States, foreign technology is acquired and research and license agreements are concluded and business men and inventors travel back and forth carrying knowledge of inventions made in other countries with them.

Indeed, a high percentage of the applications pending in the U.S. Patent Office is of foreign origin and of course a high percentage (slightly more than 25% in 1970 and 1971) of the issued patents is of foreign origin. Importation opportunities

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*This paper represents the revised text of a presentation made by Mr. Jorda to the Patent and Trade Mark Institute of Canada at its annual meeting in Toronto held on September 28, 1972.

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or problems may arise with respect to these applications and patents.

Interestingly enough, Canadians were in *fifth* place among foreign patentees in the United States in both 1970 and 1971 right after the West Germans, British, Japanese and French with over 1,000 patents and almost 1,500 patents respectively. For this reason and the reason that quite a number of the case decisions in this area deal with imported Canadian inventions[1], this topic is bound to be of more than academic interest to a Canadian audience.

In many of the interferences involving applications of Swiss origin with which I had experience importation has been relied on. Where this has been done reference has been made to reports and samples having been sent over, Swiss inventors having come over or U.S. residents having come back with knowledge and embodiments of the inventions made in Switzerland.

As I already intimated, when I speak of importation of foreign inventions into the United States I refer to situations where knowledge of an invention made outside the United States is sent or brought here by foreigners and divulged to somebody in America or is communicated to a U.S. citizen abroad who then brings it back with him to America. This is *tantamount to conception in the United States* on the day it is read and understood there by someone or taken in by someone capable of understanding it. Additionally, I refer to situations where also the physical object or embodiment of such an invention is sent there or brought in and is in somebody's possession there who fully understands its nature, its production and its use which should be *tantamount to reduction to practice in the United States.*

Section 104

Why importation? Why are we concerned with importation in the first place? Very simply because of the existence of Section 104 of Title 35 of the U.S. Code and because the law on this point is so radically different from the law in Canada. Section 104 which is entitled "Invention made abroad", stipulates that

> In proceedings in the Patent Office and in the courts, an applicant for a patent or a patentee, may not establish a date of invention by

[1]At least one other U.S. interference involving an invention made in Canada and imported into the United States is now in the Final Hearing stage.

reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country . . .

One very important exception is made in Section 104 and that is the one provided for in Section 119 of Title 35 of the U.S. Code, namely, the right of Convention priority. In a sense, as I will explain a little later, importation of foreign inventions can be used as a sort of another exception.

Section 104 may have been decried by you — as it has been by foreigners generally — as unfair and discriminatory. In a certain sense and in comparison to Canada's Conflict Practice, this is true. However, the statute does not distinguish between citizens of the United States and foreign countries but between *inventions* made in the United States and in other countries.[2] U.S. citizens residing abroad are also subject to Section 104 and foreigners living in the United States are not.[3]

Importation in General

Be that as it may,[4] there are ways and means to neutralize Section 104 in a perfectly legitimate manner, namely, by importation or introduction of foreign inventions. In a manner of speaking, as already indicated earlier, this is another exception to Section 104. The best known exception and the one expressly covered in Section 104 is, of course, reliance on a foreign Convention application under Section 119. This needs no discussion. Under this Section the foreign applicant, however, can go back only up to one year. Thus, reliance on Section 119 is in a sense a limited tool. With importation one can go further back in time much like a domestic inventor can.

There are a number of situations and circumstances where

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[2]This was pointed out in the very first importation case, *Thomas v. Reese*, 1880 C.D. 12, as well as in the fairly recent decision, *Monaco v. Hoffman*, 127 USPQ 516 (D.C.D.C., 1960), *aff'd* 130 USPQ 97 (C.A.D.C., 1961).

[3]For this reason, Prof. Irving Kayton of the George Washington University has suggested that reference to "extraterritorial" inventors would be more appropriate than reference to foreign inventors, which is a point well-taken.

[4]P. J. Federico has shown that this rule of law has also a favorable impact on foreigners since public knowledge and use of their inventions cannot defeat their rights to U.S. patents and that, according to a survey of the outcome of interferences involving foreign and domestic inventions which he made over a recent three-year period, there was no material difference: the party who made the invention in a foreign country won the interference about as often as the party making the invention in the U.S. P. J. Federico, "Patent Interferences in the United States", GRUR 1/1971, pp. 21-56.

importation is indeed advisable and can be of concrete value. These are as follows:

(1) When there is delay in filing a foreign priority application. Canadians perhaps need race to the Patent Office even less than U.S. inventors and certainly less than European inventors and may delay filing a Canadian priority application.

Sometimes, a good deal of testing has to be undertaken first or testing has to be carried out in certain geographical areas or under special conditions, and this may occasion delay.

(2) When the priority application is abandoned and refiled and a new priority year is started. This practice is fairly wide spread abroad. Here, there is obvious delay and, by the same token, obvious need for importation.

(3) When a U.S. application is not filed under the Convention but a non-Convention application is filed later on.

(4) When Convention filing is missed which happened, for example, in the case of *Schmierer v. Newton.*[5] There the application was delayed in customs and was filed a few days too late. Incidentally, in this case the foreign applicant tried to argue — to no avail — that Section 104 did not apply because the application was executed before a U.S. Consul in Paris. (Query: How about execution in a U.S. embassy which enjoys extraterritoriality?)

(5) When the foreign application has generally insufficient disclosure, e.g. of utility, or does not contain sufficient support for the subject matter of the count and its benefit cannot be obtained.

(6) When the required certified foreign priority application is not timely filed in the U.S. Patent Office because for instance, there are undue delays in obtaining it from abroad.[6]

(7) When, e.g., post-dating in Great Britain takes place and Section 119 precludes the right of priority as can be seen from the case *In re Clamp.*[7]

All of these delays and problems can arise and have arisen. Under such circumstances, it is advantageous to fall back on importation if there was any.

But even if it is possible to rely on a foreign priority date, and the priority application is good, it can still be helpful or

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[5]158 USPQ 203 (CCPA, 1968).

[6]Another remedy here is reissue according to *Brenner v. State of Israel*, 158 USPQ 584 (C.A.D.C., 1968).

[7]151 USPQ 423 (Com. 1966).

essential to resort to earlier importation on top of it. In an interference between two foreign applicants, the one with the later priority date will not get far unless he can allege earlier importation in his Preliminary Statement. The same is true in an interference between foreign and domestic applicants, where the foreign applicant's priority date is still not early enough to enable him to prevail over the domestic party.

It is, of course, rather clear, in spite of contrary arguments often made by opponents, that one can depend at the same time on the foreign priority application and on acts of importation. There is no need to make an election between one or the other.[8] Thus, as in an interference involving domestic parties, both courses of action are open: filing of foreign applications and importing of the foreign inventions and should be resorted to where opportune and feasible.

In this context it is interesting to note that in multi-national or international companies, especially those that are "technology-intensive", to use an economist's term, importation is taking place frequently though unwittingly. Research reports, models, samples or what-have-you are sent in by foreign subsidiaries, foreign parent companies or foreign research partners or licensors, and there are visits back and forth. However, unless the patent implications are appreciated, it is unlikely that importation can be proven as a legal or procedural matter and the consequences are ironic: there is importation as a substantive matter but not provable as an adjective matter. In other words, there is importation *de facto* but not *de jure*.

Now, before I talk about certain procedures that must be established and followed it will be helpful to review some of the few extant importation cases to get a clearer understanding of importation within the framework of U.S. priority-of-invention concepts, namely, conception, reduction to practice and diligence.

Importation of Descriptions of Foreign Inventions

If it has always been the law that foreign activities cannot be relied on it seems that it has also been the law that importation can be depended on at least insofar as the conception aspect of an invention is concerned. The first case to come down, in 1880, was *Thomas v. Reese, supra*, in which the Commissioner of Patents, in commenting on the position of a foreign inventor stated:

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[8] *Wilson et al. v. Sherts et al.*, 28 USPQ 378 (CCPA, 1936); *Lassman v. Brossi et al.*, 159 USPQ 182 (Board of Interferences 1967).

> . . . If, having conceived it and reduced it to practice abroad, he communicates it to an agent in a foreign country and sends his agent to the United States to obtain letters patent or to introduce it to public use, he may, in an interference, fix the date of his invention on the day of his agent's arrival in the United States . . .

In *Gueniffett v. Wictorsohn*,[9] the evidence indicated that one Jaros had been shown a machine for making mouthpieces for cigarettes in operation in France and its mechanism was fully explained to him. He then went to New York bringing with him a number of cigarettes made with the machine. However, he did not disclose the invention to anyone in America until after Wictorsohn's filing date. The Commissioner held that mere knowledge by Jaros, uncommunicated to anyone in America, was insufficient.

Winter et al. v. Latour[10] involved an interference proceeding between two foreign inventors, one German and one French. The German inventor claimed a conception date of 1902 and a reduction to practice in Berlin in December, 1902. He filed his German patent application on January 14, 1903, at a time when Germany had not yet adopted the International Convention on patents. The German inventor disclosed his invention to an employee of the General Electric Company in Berlin in January, 1903, and this employee sent a description of the invention to a member of the General Electric staff in New York, where the description was read and understood on January 24, 1903. The German inventor applied for his United States patent on March 7, 1903.

The French inventor filed his French patent application on January 21, 1903, at a time when France had already adhered to the International Convention on patents. The French inventor also transmitted a description of his invention to the General Electric offices in New York, and this description was read and understood by a member of the General Electric staff on February 5, 1903. The French inventor instructed General Electric to file a U.S. patent application, and such application was filed on January 19, 1904, within the one year priority period provided by the Convention and the U.S. patent laws.

The court agreed that the German inventor was properly awarded January 24, 1903, the date on which the description of his invention was read and understood in New York, as his invention date in the United States. However, the court

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[9] 1907 C.D. 379, *aff'd.* 1908 C.D. 367.

[10] 1910 C.D. 408.

held that the French inventor was entitled to his priority date of January 21, 1903, under the terms of the Convention.

The court did not question the finding of the Patent Office that both the German and the French inventors were entitled to claim as their invention dates in the United States the respective dates on which the descriptions of their inventions were read and understood by members of the General Electric staff. It does not appear that either inventor ever went to the United States.

Other illustrative cases are *DeKando v. Armstrong*,[11] where an American engineer saw the invention in operation in Hungary in 1904 and obtained a full description of it and returned to the United States where he disclosed it in full to other engineers in 1905; *Minorsky v. Thilo*,[12] where a German inventor was accorded a conception date when a description of the invention arrived in the United States in the hands of a person who was apparently an assignee of the inventor; *Wilson et al. v. Sherts, supra*, where an English invention was disclosed by a collaborator in the United States in October, 1928, which was held to be the conception date; *General Talking Pictures Corp. v. American Tri-Ergon Corporation et al.*[13] where the prevailing party first conceived his invention on shipboard with his patent attorney present and was held to be entitled to the date of his re-entry into the United States as his date of conception; *Langevin v. Nicolson*,[14] where an invention relating to piezophony was made in France and allegedly disclosed in Washington, D.C. in June, 1917, by a Franco-Britannic mission at scientific conferences but where the affidavits relied upon by Langevin to establish the introduction of the invention into the United States were held inadequate for him to be awarded conception since they were made sixteen years after the alleged disclosure.

A more recent case is *Mortsell v. Laurila*,[15] a contest between a German inventor, Laurila, and a Swedish inventor, Mortsell. Mortsell was senior party on the basis of a Swedish application filed April 15, 1954. Laurila's German agent sent a text of a specification in German to U.S. attorneys who received it on March 12, 1954. The text was translated and a U.S. application was sent back to Germany on April 1, 1954.

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[11] 1911 C.D. 413 (Appeals D.C. 1911).
[12] 16 USPQ 401 (CCPA, 1933)
[13] 36 USPQ 428 (3d Cir. 1938)
[14] 45 USPQ 92 (CCPA, 1940)
[15] 133 USPQ 380 (CCPA, 1962)

Laurila executed it on May 3-5, 1954. It was mailed to the U.S. attorney by the German agent on May 11th, received in the United States on May 18th and filed on May 20th. The Patent Office, in a decision not reported, held Laurila to have been diligent. The Court of Customs & Patent Appeals affirmed. Since the period in which diligence was required to have been shown was from just prior to April 15, 1954, when Mortsell filed, until May 20th, and since the major part of that time involved only activity in Germany, it is clear that such activity must have been considered in weighing diligence.

The last case to be mentioned in this group of cases is *Lassman v. Brossi et al., supra.* In the two-count interference behind this case the British and Swiss applicants had filed their foreign applications on the same day. Lassman proved, however, that a letter and memorandum disclosing a process meeting the terms of count 2 had been sent to his attorney Pike in the United States several months prior to his British filing date and that Pike had read and understood his memorandum, endorsed this fact on the face of the memorandum and acknowledged receipt of it. Lassman was therefore awarded priority as to count 2. But as to count 1 which covered a derivative of the product made by the process of count 2 neither party was entitled to judgment of priority because neither party had established prior importation.

The rules that can be deduced from this line of cases is that the foreign inventor (and in fact a U.S. inventor making an invention abroad as well) may establish an early date in the United States by reference to activities there by persons acting on his behalf. Such inventor is awarded conception as of the date when the invention is first disclosed to and understood or possessed by his representatives in the United States or brought in by a U.S. resident to whom the invention was disclosed abroad. The inventor himself does not have to go to the United States. Introduction of the knowledge or description of the invention is thus conception or is tantamount, that is, equivalent in effect to conception in the United States when it is read and understood by someone there capable of doing so. The disclosure must of course, be adequate and full.

The need for knowledge of a foreign invention to be possessed by someone in the United States is of course bottomed on the basic principle of American patent law, reiterated in the case of *Monaco v. Hoffman, supra,* that there must be as-

surance that an invention will be rendered available to the American people.

The proposition that importation of a disclosure of a foreign invention is tantamount to conception in the United States is countenanced by the Patent Office. Rule 217, titled "Contents of preliminary statement, invention made abroad" officially sanctions Preliminary Statements alleging importation of disclosures of foreign inventions and Form 45 provides a suggested text.

At this point and in this context mention should be made of the Disclosure Document Program of the Patent Office. In so far as foreigners are concerned this could be construed as providing for importation of disclosures of foreign inventions Filing of a Disclosure Document establishes at best only a conception date. (Query: is it even that much since it is not read and understood by someone who could corroborate this and is kept only for two years and then thrown away unless a patent application has been filed and reference to the disclosure document has been made?)

Importation of Embodiments of Foreign Inventions

While the law on importation of foreign inventions is quite clear on the issue of whether receipt of knowledge of a foreign invention is tantamount to conception in the United States, it is unfortunately not so clear on whether importation of an embodiment of a foreign invention is reduction to practice or tantamount to it especially with respect to chemical compounds and complex machinery and electronic gear. I submit it should be.

With respect to this issue the decisions are even sparser. *Swan v. Thompson*,[16] is the first case I could find. One Swan made an invention which related to safety razors and blades therefor in England. He brought samples to the United States which were later exhibits in court. With the intention to sell his invention he showed them in the United States to one Thompson of Gillette and others, some of whom shaved with them. Swan introduced testimony taken in England to show, among other things, that when he brought the razors and blades to America he was in complete possession of the invention. The court, overruling the Interference Examiner and the Board of Appeals, agreed with Swan and held (at p. 82):

> Swan having completed the structure embodying the issue of the counts and disclosed it to others and found it to be useful for any purpose should not be deprived of the benefits flowing therefrom because another entering the field later has found that additional beneficial results could be obtained from it.

[16] 28 USPQ 77 (CCPA 1936)

Although, at first blush, this case appears to be a derivation case involving the issue of originality inasmuch as Swan claimed that Thompson obtained the invention from him, it is not such a case. "The tribunals below found to the contrary and it is not necessary in view of our conclusion that Swan was the first inventor of the subject matter of the counts here involved, to pass upon this question..." said the court, at p. 82.

In *French v. Colby et al.*,[17] the opinion of the Court of Appeals is rather cryptic, and the opinions in the District Court and the Patent Office appear not to have been published. However, it does appear from the opinion that British inventors (French et al. sent to their U.S. "affiliate" a letter dated January 27, 1939, describing the invention and enclosing a sample of it. It was an integrally woven ladder web for venetian blinds. The letter was received in the New York office of their U.S. affiliate by one Harris in "early February 1939", who in turn took it "early in March 1939" to one Gibbons, the manager of their mill in Massachusetts who was capable of understanding the invention. The U.S. inventors' (Colby et al.) "date of disclosure" was March 6, 1939.

The court in reversing the District Court held:

> We agree with the Patent Office that French is entitled to a date early in February 1939, when his letter was received in New York . . . The letter specified the problem to be solved, described the solution, and enclosed a sample. The invention is sufficiently simple . . . to be understood even by a non-expert person. But in any event, it passes belief that Gibbons, an admitted specialist, who had been working toward a solution of the same problem should have had the slightest difficulty in understanding the invention when the sample was shown to him prior to March 6, 1939.

It is interesting to note that Colby had argued — to no avail — that it was necessary to examine the specimen under a magnifying glass in order to understand it.

A third case, one involving a Canadian invention, was *Kravig et al. v. Henderson*,[18] in which a machine for fabricating decorative bows was brought in from Canada by the Canadian Henderson and installed and operated at Plattsburgh New York, by others allegedly in 1955. The Board of Interferences had awarded all four counts to Henderson, even though he had to prove his case beyond a reasonable doubt. However, the CCPA on appeal awarded Henderson only two

[17] 64 USPQ 499 (D.C. Cir. 1945) *cert. denied* 326 U.S. 726 (1945)
[18] 150 USPQ 377 (CCPA, 1966)

counts because the other two counts did not read on the imported machine. Two years later the CCPA had this case again before it and it took away those two counts also because new evidence had shown that the machine had not been brought in as early as had been alleged.[19]

Lastly, as far as published decisions go where embodiments of inventions were imported, there are two recent Board of Interference cases: *Andre v. Daito*,[20] and *Weigand v. Hedgewick*.[21]

Andre v. Daito, manifestly was an importation case even though this is apparent not so much from the decision as from the file history. Andre, a U.S. business man, conceived a design of a desk lamp in the United States and went to Japan where he reduced it to practice. He brought back a model and the day when he arrived in San Francisco with the model was the day of his reduction to practice. This was on September 4, 1966. Daito filed in Japan on September 12, 1966; he was senior party inasmuch as Andre had only filed on December 27, 1966. The holding was as follows: (at p. 93):

> In support of his case for priority Andre has presented well-documented evidence in the form of his own testimony, the testimony of two corroborating witnesses (in addition to statements on record by his attorney relating to the preparation of his involved application) and including some forty documentary exhibits and three physical exhibits.
>
> The above-noted evidence establishes conception of the invention in issue by Andre as early as June 16, 1966 and the presence of a model . . . in the United States in his custody in early September of 1966 prior to September 12, 1966 the date to which Daito is restricted.
>
> Such model . . . . embodies the invention in issue and sustains a holding that Andre had both conceived and reduced the invention to practice prior to Daito.

Weigand v. Hedgewick, is of special interest since both applicants were Canadians. The invention related to safety caps or closures for containers of drugs or medicines and was independently made by two Canadians whose applications were respectively filed on April 5, 1966 and June 27, 1966. The senior party Hedgewick took no testimony but Weigand introduced "a mass of testimony and exhibits" the bulk of which related to "activities occurring wholly in Canada leading up to

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[19] 157 USPQ 564 (CCPA 1968)

[20] 166 USPQ 92 (Board of Interferences 1969)

[21] 168 USPQ 535 (Board of Interferences 1970)

the asserted introduction of the invention into the United States". However, the only evidence relating to the actual receipt in the United States of a sample and a pamphlet was by one Simmons, the Executive Secretary of the National Association of Retail Druggists, to whom Weigand wrote in an attempt to promote his invention in the United States. Unfortunately, Simmons could only recall that he saw the sample and that there was some information that accompanied the sample. He remembered no details and the sample was lost. In holding against Weigand under these circumstances, the Board distinguished the *Swan, supra*, and *Wilson, supra*, decisions wherein it had been proven that the inventions supporting the counts were disclosed in the United States prior to the opposing parties' record dates.

Apparently, no other published decisions exist. But it is submitted that it is clear even from the few cases which are on the books and even though in some cases there was actual use or operation in the United States, that in proper cases, properly proven, importation of the physical object or embodiment of an invention made abroad, accompanied by full and clear disclosure of its nature and its mode of production and use, is tantamount to reduction to practice in the United States. No separate and independent actual reduction to practice in the United States by re-construction and retesting should be necessary. (Query: Is the situation different when the invention relates to a method of making or using a product which is imported? It would seem so. Practice of the method would appear to be necessary.)

Importation of Embodiments of Complex Inventions

Of course in the case of a simple invention like a lamp design, a safety cap and a ladder web for venetian blinds and perhaps even a razor and a machine for making bows, mere visual inspection may reveal the nature of the invention and its mode of construction and use. However, complex electronic apparatus and chemical compounds defy visual identification, but that does not mean that therefore they cannot be imported as a legal matter without being reduced to practice in the United States all over again. It merely means that the burden of proof is different and more onerous. It is then indispensable, in order to establish the nature or identity of the invention, to submit evidence based on actual or stipulated testimony taken abroad or in the United States in case the inventor and his representatives go there for the purpose. A whole chain of evidence may then have to be forged to demon-

strate, for example in the case of a chemical compound, that the compound made was the compound analyzed, that the compound analyzed was the compound tested, that the compound tested was the compound shipped and that the compound shipped was the compound received.

It is perfectly clear that Section 104 does not ban, and never has banned, testimony relating to acts outside the United States where the testimony is used to show merely the identity of an invention introduced into the United States and is not designed to establish dates of invention abroad. Some of the cases mentioned above bring this out. Another case which confirms this specifically is *Rebuffat v. Crawford.*[22] Rebuffat took testimony in Italy, dealing with conversations he had with his agent, one Pomilio, about work he had done in Europe. Pomilio went to the United States and discussed the invention with Crawford. The Court held that Rebuffat had not proved introduction into the United States "beyond reasonable doubt". On the question of activity abroad the Court remarked that Rebuffat could not obtain any benefit for the work he did abroad but then added (at p. 324):

> The nature of his work abroad might be important in determining the identity of the invention or whether he had any concept of it or not, but it is incumbent upon him to prove, in this case, that the invention was introduced into the United States prior to the filing date of the senior party . . .

In Interference No. 93,802 of record in the file of the U.S. Patent No. 3,454,554, numerous affidavits were filed to establish the identity of the compound received in the United States from Switzerland. The opponents moved that all of these affidavits be stricken from the record as violative of Section 104 but the Board of Interferences held that the evidence would not be stricken particularly since the events abroad may be necessary for a complete understanding of what occurred in the United States.[23]

Alternatively, and as a desirable backstop, an independent analysis in the case of chemical compounds could be carried out in the United States so that one or more persons know of

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[22] 20 USPQ 321 (CCPA 1934).

[23] In interferences involving an originality contest (*who* made the invention) rather than a priority contest (who made the invention *first*) it is well-established that foreign activities can be relied on, *Nielsen v. Cahill,* 133 USPQ 563 (Board of Interference, 1961) and cases cited therein. Also, on the issue of diligence, it may be possible to bring testimony regarding foreign activities to bear, as will be shown below.

their own knowledge the identity of an imported compound. In most cases, however, it would be a tall order to make a complete analysis. Perhaps one reliable test, a so-called fingerprint test, as for example, an X-ray determination, to at least corroborate the structure, is all that is needed. Even this is a tall order if hundreds of compounds are being imported from abroad.[24]

Diligence

In addition to conception and reduction to practice or something tantamount to it, diligence may also be an issue. On the one hand, perhaps, diligence is the most serious problem if there is an importation of knowledge of an invention and nothing further. On the other hand, no diligence problem need arise if a completed invention is imported including a model, sample or prototype or if a patent disclosure is sent to a U.S. attorney who works diligently with it towards filing in the United States or a machine or compound is shipped in for testing or use which is diligently carried out.

An interesting legal point here is whether on the diligence issue activities abroad can be relied on if coupled with activities here. Section 104 would seem to preclude it. Rivise & Caesar, Interference Law & Practice, Vol. 1, Sec. 187, p. 585 (1940) indicate that it can be done and cite *Wilson et al. v. Sherts et al., supra,* for this proposition. There the court stated that "activities abroad . . . unaccompanied by any activities in the United States may not be considered in establishing diligence . . ." citing *Hall v. O'Connor,* Interference No. 51,743, an unpublished decision, where there were activities in the United States and in Canada and the

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[24](1) In these cases, it might perhaps be sufficient to keep a sample or sub-sample of every compound and do analytical work at a later date for those few compounds only which are tagged as commercial candidates. There should be no problem of nunc-pro-tunc reduction to practice which is frowned upon by the courts [*Heard v. Burton et al.,* 142 USPQ 97 (CCPA, 1964)]; perhaps such practice can be brought under the rule of *General Motors v. Bendix,* 102 USPQ 58 (D.C. Ind., 1954) to the effect that subsequent tests are admissible to corroborate and supplement evidence relating to prior reduction to practice.

(2) In discharging the burden of proof regarding the identity of the invention whether it be by forging a chain of evidence from preparation abroad to receipt in this country or by establishing independent analysis in this country or both, one must keep in mind of course that corroboration should not "be based on facts the truth of which depends upon information received from the inventor." *Thurston v. Wulff,* 76 USPQ 121, 126 (CCPA 1947).

Board held that the Canadian activities could be relied on although the work done in the United States would have been sufficient.

In *Lorimer v. Erickson*,[25] evidence of diligence abroad was admissible. Lorimer conceived the invention in the United States in 1904. He then went to France, where he built and operated a successful embodiment. He returned in November 1905 and on November 18, wrote to a patent attorney to begin preparation of an application. The application was filed in April 1906. Erickson's date was December 9-15, 1905, so that Lorimer's diligence was the crucial question. The Court found that he had been diligent, and in so holding clearly considered Lorimer's activity in France, for it said (at p. 203) :

> Diligence in the particular case depends upon the special facts and circumstances attending it. It is quite clear that Lorimer never gave up the invention. He carried it to France with him where he was engaged in filling a contract of his employers with the French Government, and there constructed it and tested it completely. with the automatic telephone system then installed.
>
> Appreciating the importance of the invention, he immediately upon his return to the United States disclosed it to the patent attorney . . . . He was not concealing the invention, nor did he show any intention to abandon it . . .

There are no recent CCPA or other Court decisions which expressly permit such coupling by way of an exception to Section 104. But in a recent and unusual case, *Rosen et al. v. NASA*,[26] involving a satellite communication system, the Patent Office countenanced coupling (citing *Wilson v. Sherts, supra*), since the system necessarily extended outside the United States. Admittedly this is a special situation and while neither the *Wilson* nor the *Hall* cases can be considered as sound precedents, coupling as a practical matter may be possible as is illustrated in *Mortsell v. Laurila, supra*. If the ball bounces back and forth, so to speak, as was the case there with respect to the preparation, review and execution of a patent application, perhaps it can be said that while the ball is abroad there is at least a reasonable explanation for the inactivity in the United States at the moment.

Conclusion

Although the foregoing discussion deals predominantly with interference practice it should be kept in mind that the subject of importation also has relevance in Rule 131 prac-

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[25] 1916 CD 200 (App. D.C. 1916).

[26] 152 USPQ 757 (Board of Interferences 1966).

tice and validity studies as was mentioned at the outset. This is illustrated, for instance, in *Ex parte Pavilanis et al.*, 166 USPQ 413 (Board of Appeals 1969) where a reference was sworn back of by virtue of importation from *Canada* of a patent application draft for the purpose of filing in the United States. A Rule 131 affidavit based on importation is also found in the file history of U.S. Patent No. 3,448,200. As far as validity studies are concerned, it can of course not be taken for granted in view of the above discussion that a foreign priority date relied on in a U.S. patent is the very earliest date beyond which the patentee cannot go to overcome a reference or establish an invention date.

From the cases discussed above and the principles enunciated in them, an outline of a procedure for legally and procedurally adequate and effective importation can be put forth. Such a procedure would consist essentially of three steps:

(1) It would involve as early as possible a full disclosure of the foreign invention in the United States, preferably in writing, including detailed information on the mode of preparation, the nature and constitution of the invention and its utility and accompanied, where feasible, by a model or sample or other embodiment of the invention.

(2) These materials would be promptly and carefully studied and inspected upon receipt, preferably by two persons who are capable of understanding the invention and who master the language if a foreign language, e.g., French, is employed — otherwise a prompt translation would have to be obtained. Each person would date and sign and annotate each page as having been read and understood by him. Incidentally, also foreign priority applications can be handled in the same manner just in case something goes wrong with the Convention filing or claim of priority.

(3) These materials, including any sample or sub-sample or other embodiment, would be carefully kept or preserved and good records would also have to exist abroad pertaining to the production and testing and importation of the invention. Independent exploration of the nature of any embodiment of the invention, e.g. analytical structure corroboration in case of a chemical substance, would be a desirable backstop. Immediate testing or use would further strengthen the case for importation.

While foreign inventors more often have failed perhaps than prevailed in U.S. interference proceedings in the past either because they had not resorted to importation at all and

were restricted to their foreign priority dates or they had imported their inventions as a substantive matter but were unable to prove it as a procedural matter, I am confident that foreigners fully aware of the importation opportunities and beware of the pitfalls, would fare much better in priority contests in the future by heeding the above-outlined procedure.