December 31, 1968

VIA AIR MAIL

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: UIF v. BT

Dear Bob:

* I enclose a proof of the brief. When I talked with your secretary I had only looked at the page numbers on the proof. It appears that these are not the actual page numbers. We have estimated and made an allowance for headings and find that it runs about 52 pages. Approximate paging is indicated in the margin. Rule 28(g) provides for a maximum of 50 pages. Accordingly, a little bit must be cut out. I would appreciate your instructions on deletions promptly so that we can get this back to the printer. In the meantime, we are proof-reading, checking citations and beginning the preparation of an index and table of cases.

Best wishes for the New Year.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. J. F. Pearne (*)

December 23, 1968

VIA AIR MAIL

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Dear Bob:

We have completed double checking citations both of law and to the transcript. The printer is not working tomorrow, but will start on this Thursday morning.

Very truly yours,

Richard S. Phillips

RSP:iag

December 20, 1968

VIA AIR MAIL

Mr. Robert H. Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Dear Bob:

* I enclose a copy of a draft of the statement of facts I have written to be incorporated in the brief as called for by Appellate Rule 28(a)(3). I have not yet had an opportunity to add citations to the Appendix and appropriate exhibit numbers. We hope to deliver the draft to the printer Monday. Accordingly, if you have any changes, call me immediately.

I am afraid the brief is going to be too long. We are limited to 50 printed pages. As soon as the galley is ready, I will send you a copy.

Merry Christmas.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

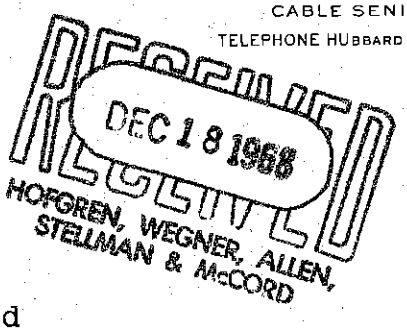
cc: Mr. J. F. Pearne (*)

RINES AND RINES
ATTORNEYS AT LAW
NO. TEN POST OFFICE SQUARE
BOSTON, MASSACHUSETTS 02109

DAVID RINES
ROBERT H. RINES

CABLE SENIR
TELEPHONE HUBBARD 2-3289

December 16, 1968



Richard S. Phillips, Esquire
Hofgren, Wegner, Allen, Stellman & McCord
20 North Wacker Drive
Chicago, Illinois 60606

Re: Brief for Defendant and Counterclaimant-Appellant; University of Illinois Foundation v. Blonder-Tongue Laboratories et al

Dear Dick:

Confirming our telephone conversation with Bill McNair today and in reply to your recent letter that we lacked a "Statement of the Case" and "Questions Presented" portions of the brief, we suggested that the "Introduction" in the draft that we sent to you be used as the "Statement of the Case", supplementing the same with a sentence reading somewhat as follows:

> "The District Court sustained the Foundation's patents and dismissed Blonder-Tongue's counterclaims."

As for the "Questions Presented" section, we believe that McNair has this material, since we dictated suggestions to him over the telephone on the basis of which he finalized the same for filing in the appeal.

We, therefore, believe that we now have everything necessary to submit the brief to the printer, except that we would mention that we received John Kern's comments that seemed very favorably disposed to our presentation.

Best wishes for the holiday season.

Very truly yours,

RINES AND RINES

By Bob
BD

RHR/BD
cc: William McNair, Esq.
Isaac S. Blonder

P.S. We note that the page in our draft of the brief No. 27A ("Conclusion as to Complaint") should be numbered 33A and should precede the section commencing with page 34 entitled "Blonder-Tongue's Unfair Competition Counterclaim I and Antitrust Counterclaim II".

December 16, 1968

M E M O R A N D U M

TO: R. S. Phillips

FROM: W. R. McNair

RE: University of Illinois v. Blonder-Tongue

I received a telephone call from Bob Rines on the afternoon of the 16th concerning your letter to him telling of the need for a "Statement of the Case" and "Questions Presented" section in the brief. Rines feels that the portion presently labeled "Introduction" could serve as the Statement of the Case and suggests that we change the heading "Introduction" to "Statement of the Case" and then add the following sentence at the end of that portion:

> "The District Court sustained the Foundation's patent and dismissed Blonder-Tongue's counterclaim."

He feels that since we formulated the questions presented for review in our designation of the Appendix, that we could prepare this portion for the brief as well.

WRM:ps

December 16, 1968

M E M O R A N D U M

TO: R. S. Phillips

FROM: W. R. McNair

RE: University of Illinois v. Blonder-Tongue

I received a telephone call from Bob Rines on the afternoon of the 16th concerning your letter to him telling of the need for a "Statement of the Case" and "Questions Presented" section in the brief. Rines feels that the portion presently labeled "Introduction" could serve as the Statement of the Case and suggests that we change the heading "Introduction" to "Statement of the Case" and then add the following sentence at the end of that portion:

> "The District Court sustained the Foundation's patent and dismissed Blonder-Tongue's counterclaim."

He feels that since we formulated the questions presented for review in our designation of the Appendix, that we could prepare this portion for the brief as well.

WRM:ps

RINES AND RINES
ATTORNEYS AT LAW
NO. TEN POST OFFICE SQUARE
BOSTON, MASSACHUSETTS 02109

DAVID RINES
ROBERT H. RINES

CABLE SENIR
TELEPHONE HUBBARD 2-3289

December 9, 1968

VIA AIR MAIL

Richard S. Phillips, Esquire
Hofgren, Wegner, Allen, Stellman & McCord
20 North Wacker Drive
Chicago, Illinois 60606

Re: University of Illinois-Blonder-Tongue-JFD
Appeal Brief

Dear Dick:

As stated to you over the telephone today, we at long last are enclosing the brief, parts of which have earlier been sent to you and John Pearne for critique.

As you will observe, we have embodied several of John's suggestions into this new draft and we trust that you, as you indicated over the telephone, will double-check us, prepare the Contents and Table of Cases and whatever revisions and supplementary citations and the like you deem appropriate.

In this connection, we are also enclosing a copy of this completed brief to John so that he may telephone any further suggestions directly to you before you send this to the printer.

This has certainly been a terrible chore; and I hope that we have presented it in a way that will attract the attention of the Court of Appeals to the very real injustice done in the premises and to the possibility that it could decide the case favorably to us without remand.

Cordially,

RINES AND RINES

By _____

RHR:H

cc: J. Pearne, Esq.
cc: Mr. I. Blonder
cc: Mr. B. Tongue

P.S. Perhaps John will feel that we should add some of his "predictability" versus "obviousness" cases; and we are hoping that you will be able to supply the 8th Circuit Court of Appeals citation in the Winegard case.

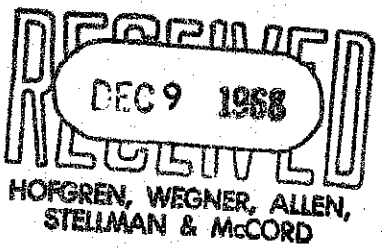
RHR:H

RINES AND RINES
ATTORNEYS AT LAW
NO. TEN POST OFFICE SQUARE
BOSTON, MASSACHUSETTS 02109

DAVID RINES
ROBERT H. RINES

CABLE SENIR
TELEPHONE HUbbard 2-3289

December 6, 1968



Richard S. Phillips, Esquire
Hofgren, Wegner, Allen, Stellman & McCord
20 North Wacker Drive
Chicago, Illinois 60606

and

John F. Pearne, Esquire
McNenny, Farrington, Pearne & Gordon
920 Midland Building
Cleveland, Ohio 44115

Re: Blonder-Tongue Brief in the
University of Illinois Appeal

Dear Mr. Phillips and Mr. Pearne:

Enclosed are several more sections of the above for your comments.

There is still a section on lack of due process and unfair competition-anti-trust which will be sent to you within a day or so.

The first of next week we will send to Dick Phillips the complete brief, including the draft sections that we have previously sent to you, duly corrected in final form; so, please do not hesitate to telephone any comments or suggestions.

Cordially,

RINES AND RINES

By Robert H. Rines
BD

RHR/BD
Encs.

Litigation

UIF v Winegard Company

December 30, 1968

Mr. Keith J. Kulie
Kulie and Southard
29 South LaSalle Street
Chicago, Illinois 60603

RE: UIF v. Winegard Company
Appeal No. 19000
Your File: 45-34

Dear Keith:

There has been no change in the times set for briefing in our appeal. Our main brief is due January 13, the reply briefs on February 12 and our reply on February 26. The appeal has not yet been placed on the calendar for argument.

Very truly yours,

Richard S. Phillips

RSP:ag

cc: Mr. R. H. Rines
Mr. J. F. Pearne

KULIE AND SOUTHARD

ATTORNEYS AT LAW

29 SOUTH LA SALLE STREET · CHICAGO, ILLINOIS 60603

KEITH J. KULIE
DONALD B. SOUTHARD

AREA CODE 312
CENTRAL 6-3351

December 26, 1968

Richard Phillips, Esq.
Hofgren, Wegner, Allen, Stellman & McCord
20 North Wacker Drive
Chicago, Illinois

Re: UIF -v- Winegard Company
Appeal No. 19000
Our File: 45-34

Dear Dick:

Enclosed is a copy of the order granting a further stay of mandate in the above appeal -- for 30 days to January 11, 1969.

The Court also indicates that another stay will be granted on request not to exceed a total of 90 days.

We discussed this with the clerk prior to opposing the request and he indicated to us at that time that they very likely would get the extension whether we opposed or not.

Any projection as yet on appeal times in the BT case?

Sincerely yours,

Keith J. Kulie

KJK:cvw
Enc.

RECEIVED
DEC 30 1968
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

No. 19000

University of Illinois Foundation, Appellant,

vs.

Winegard Company.

Appeal from the United States District Court for the Southern District of Iowa.

On consideration of the motion of appellant for a further stay of the mandate, and memorandum in opposition thereto, in this cause pending a petition to the Supreme Court of the United States for a writ of certiorari, it is now here ordered by this Court that the issuance of the mandate herein be, and the same is hereby, further stayed for a period of thirty days from and after December 12, 1968, without prejudice to the right of counsel for appellant to make further request for extension of time not to exceed ninety days.

If within the period of thirty days from and after December 12, 1968, there is filed with the Clerk of this Court a certificate of the Clerk of the Supreme Court of the United States that a petition for writ of certiorari and record have been filed, the further stay hereby granted shall continue until the final disposition of the case by the Supreme Court.

December 16, 1968

December 16, 1968

Mr. Isaac S. Blonder
Blonder-Tongue Laboratories, Inc.
9 Alling Street
Newark, New Jersey 07102

RE: University of Illinois Foundation v.
Blonder-Tongue Laboratories, Inc.

Dear Mr. Blonder:

At Mr. Rines' request, I am forwarding to you a copy of the Appendix which has been prepared and filed in the above case. The brief is due to be filed in about another month.

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

William R. McNair

WRM:ps

Enclosure

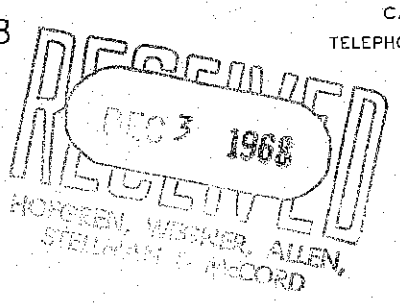
cc: Mr. R. H. Rines

RINES AND RINES
ATTORNEYS AT LAW
NO. TEN POST OFFICE SQUARE
BOSTON, MASSACHUSETTS 02109

DAVID RINES
ROBERT H. RINES

CABLE SENIR
TELEPHONE HUBBARD 2-3289

December 2, 1968



Richard S. Phillips, Esquire
Hofgren, Wegner, Allen, Stellman & McCord
20 North Wacker Drive
Chicago, Illinois 60606

Re: University of Illinois v. Blonder-Tongue

Dear Mr. Phillips:

We enclose a rough draft (not yet for printing) which represents three sections of the brief only. The rest will follow in the next day or so.

Very truly yours,

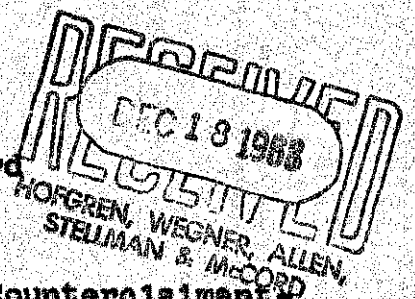
RINES AND RINES

By Robert H. Rines
RHR

RHR/BD
Enc.

RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

December 16, 1968



Richard S. Phillips, Esquire
Hofgren, Wegner, Allen, Stellman & McCord
20 North Wacker Drive
Chicago, Illinois 60606

Re: Brief for Defendant and Counterclaimant Appellant; University of Illinois Foundation v. Blonder-Tongue Laboratories et al

Dear Dick:

Confirming our telephone conversation with Bill McNair today and in reply to your recent letter that we lacked a "Statement of the Case" and "Questions Presented" portions of the brief, we suggested that the "Introduction" in the draft that we sent to you be used as the "Statement of the Case", supplementing the same with a sentence reading somewhat as follows:

> "The District Court sustained the Foundation's patents and dismissed Blonder-Tongue's counterclaims."

As for the "Questions Presented" section, we believe that McNair has this material, since we dictated suggestions to him over the telephone on the basis of which he finalized the same for filing in the appeal.

We, therefore, believe that we now have everything necessary to submit the brief to the printer, except that we would mention that we received John Kern's comments that seemed very favorably disposed to our presentation.

Best wishes for the holiday season.

Very truly yours,

RINES AND RINES

By _____

RHR/BD
cc: William McNair, Esq.
Isaac S. Blonder

P.S. We note that the page in our draft of the brief No. 27A ("Conclusion as to Complaint") should be numbered 33A and should precede the section commencing with page 34 entitled "Blonder-Tongue's Unfair Competition Counterclaim I and Antitrust Counterclaim II".

COPY

December 13, 1968

Mr. Robert H. Rines
Rines & Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: University of Illinois Foundation v.
Blonder-Tongue Laboratories, Inc.

Dear Mr. Rines:

Enclosed herewith are two copies of the Appendix which has been served and filed. We have the usual surplusage of extra copies of this Appendix and are retaining them here subject to your directions with respect to dissemination thereof.

Two copies were served on Merriam-Marshall, et al, Silverman and Cass, and one copy was sent to Mr. Berliner. Dick Phillips, Jack Allen and Myself have retained one copy.

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

William R. McNair

WRM:ps
Enclosures

December 9, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Mass. 02109

Re: University of Illinois Foundation
v. Blonder-Tongue and J F D Electronics

Dear Mr. Rines:

As shown by the attached copy of Order in the above case, the plaintiff-appellee's motion to place the appeal on the January 1969 calendar has been denied.

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

John Rex Allen

JRA:DB
Enc.

December 11, 1968

Mr. Jerome M. Berliner
Ostorlenk, Taber, Gerb
and Soffen
10 East 40th Street
New York, New York 10016

RE: University of Illinois Foundation v.
Blonder-Tongue Laboratories, Inc.

Dear Mr. Berliner:

Enclosed herewith, at the request of your local counsel, is a copy of the "Appendix to Brief for Defendant and Counterclaimant-Appellant".

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

William R. McNair

WRM:ps
Enclosure

cc: Mr. Herbert J. Singer

Litigation

December 5, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Re: University of Illinois v.
Blonder-Tongue Laboratories, Inc.

Dear Bob:

I enclose copies of the Motion and Affidavit served on us Tuesday by the Foundation and of the Affidavit and Reply we filed on Wednesday. Your Affidavit has not yet come in. When it does we will file it together with any supplemental statement which may be desirable.

I learned from Keith Kulie that the Foundation has a stay of the order of the Eighth Circuit Court of Appeals until December 12. Presumably, they will file a Petition for Certiorari before then.

I will let you know if anything further develops.

Very truly yours,

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Richard S. Phillips

RSP/dm
Enclosures

cc: (with enclosures)
Messrs: Keith J. Kulie
John F. Pearne

UIF v. Blonder Tongue

L. Figotin

KULIE AND SOUTHARD
ATTORNEYS AT LAW

29 SOUTH LA SALLE STREET · CHICAGO, ILLINOIS 60603

KEITH J. KULIE
DONALD B. SOUTHARD

AREA CODE 312
CENTRAL 6-3351

December 4, 1968

RECEIVED
DEC 5 1968
PATENT DEPT.

Richard Phillips, Esq.
Hofgren, Wegner, Allen, Stellman & McCord
20 N. Wacker Drive
Chicago, Illinois

RE: UIF -v- Winegard Company
Our File: 45-34

Dear Dick:

Enclosed are copies of materials relating to the above case.

The petition for rehearing was denied on November 5, 1968. The mandate normally would be entered within 7 days of the denial of such a petition, unless a stay is granted.

Counsel for the Foundation filed a petition for stay of mandate on November 8, 1968 asking for an extension of 30 days to permit them time to prepare and file a petition for writ of certiorari.

The mandate normally would have been entered on November 12. The 30 day extension was granted thereby extending the time for filing a petition to December 12.

We have received no further communication from counsel for the Foundation and assume that they will file their petition by December 12.

Sincerely yours,

Keith J. Kulie

k

enc.

ROBERT C. TUCKER, CLERK

United States Court of Appeals
FOR THE EIGHTH CIRCUIT
ST. LOUIS, MO. 63101

November 5, 1968

Hon. Roy L. Stephenson, Chief Judge
United States District Court
212 U.S.Courthouse
Des Moines, Iowa

Mr. Edward Dailey
Dailey,Dailey,Ruther&Bauer
National Bank Building
Burlington, Iowa

Messrs. Charles J. Merriam,Basil P. Mann and William A. Marshall
Merriam,Marshall,Shapiro & Klose
30 West Monroe Street
Chicago, Illinois 60603

West Publishing Co.
50 West Kellogg Blvd.
St. Paul, Minnesota 55102

Messrs. Keith J. Kulie and Donald B. Southard
Burmeister, Kulie, Southard & Godula
135 South LaSalle Street
Chicago, Illinois 60603

Re: No. 19000. University of Illinois Foundation
v. Winegard Company.

Dear Sirs:

The Court's slip opinion was filed in this case on September 30, 1968. I have today been directed by the Court to delete the sentence contained in the last three lines at the bottom of page six of the slip opinion. That sentence reads:

> Nor is it claimed that the subject patent "embrace(s) elements having an interdependent functional relationship." United States v. Adams, 383 U.S. at 50.

I would appreciate it very much if you would delete that sentence from the copy of the slip opinion previously forwarded to you.

Very truly yours,

Robert C. Tucker,
Clerk

RCT:p

UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

No. 19000

University of Illinois Foundation, Appellant,

vs.

Winegard Company.

Appeal from the United States District Court for the Southern District of Iowa.

There is before the Court appellant's petition for rehearing en banc and on consideration of such petition, it is the order of the Court that the petition for rehearing en banc be, and it is hereby, denied.

November 5, 1968.

ROBERT C. TUCKER, CLERK

United States Court of Appeals
FOR THE EIGHTH CIRCUIT

ST. LOUIS, MO. 63101

November 5, 1968

Messrs.Charles J. Merriam,
William A. Marshall and
Basil P. Mann
Merriam,Marshall,Shapiro & Klose
30 West Monroe Street
Chicago, Illinois, 60603

Mr. David J. Sohr
Cook,Blair,Balluff & Nagle
409 Putnam Building
Davenport, Iowa, 52801

Re: No. 19000. University of Illinois Foundation
v. Winegard Company.

Dear Sirs:

Enclosed to each of you is copy of an order in the above case, entered by us today at direction of the Court.

Very truly yours,

Robert C. Tucker,
Clerk

K
encl.

Copy to:Messrs. Keith J. Kulie and Donald B. Southard
Burmeister & Kulie
135 S. LaSalle Street
Chicago, Illinois, 60603

Mr. Edward W. Dailey
Fourth Floor National Bank Building
Burlington, Iowa, 52601

CERTIFICATE OF SERVICE

It is hereby acknowledged that one copy of the foregoing "Petition for Stay of Mandate" has been forwarded by mail, postage prepaid, to the offices of Kulie & Southard, 29 South LaSalle Street, Chicago, Illinois 60603 and to Dailey, Dailey, Ruther & Bauer, National Bank Building, Burlington, Iowa 52601 this 6th day of November, 1968.

Basil P. Mann

Basil P. Mann
Attorney for Plaintiff-
Appellant

IN THE UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

UNIVERSITY OF ILLINOIS FOUNDATION,	)	
Plaintiff,	)	Civil Action No.
v.	)	19000
WINEGARD COMPANY,	)	
Defendant.	)	

PETITION FOR STAY OF MANDATE

Pursuant to Rule 41 of the Federal Rules of Appellate Procedure, Appellant, University of Illinois Foundation, petitions for a stay of the mandate in this appeal, for thirty (30) days, in order to permit application to the Supreme Court of the United States for a writ of certiorari.

Respectfully submitted,

By Basil P. Mann

Basil P. Mann
One of the Attorneys for
Plaintiff-Appellant
MERRIAM, MARSHALL, SHAPIRO & KLOSE
30 West Monroe Street
Chicago, Illinois 60603
Area Code 312 - 346-5750

KULIE AND SOUTHARD
ATTORNEYS AT LAW
29 SOUTH LA SALLE STREET · CHICAGO, ILLINOIS 60603

KEITH J. KULIE
DONALD B. SOUTHARD

AREA CODE 312
CENTRAL 6-3651

November 9, 1968

Richard Phillips, Esq.
20 N. Wacker Drive
Chicago, Illinois

RE: UIF -v- Winegard Company
Our File: 45-34

Dear Dick:

You may be interested to know that the Foundation has filed a petition for stay of mandate of the court of appeals for 30 days. This means that the petition for writ of cert. must be filed on or before December 12.

Sincerely yours,

Keith J. Kulie

k

McNENNY, FARRINGTON, PEARNE & GORDON

ATTORNEYS AT LAW

920 MIDLAND BUILDING

CLEVELAND, OHIO 44115

F. O. RICHEY (1878-1964)

HAROLD F. McNENNY
DONALD W. FARRINGTON
JOHN F. PEARNE
CHARLES B. GORDON
ROBERT A. STURGES
WILLIAM A. GAIL
RICHARD H. DICKINSON JR.
THOMAS P. SCHILLER
LYNN L. AUGSPURGER

TELEPHONE
(216) 623-1040
CABLE ADDRESS
RICHEY

PATENT AND
TRADEMARK LAW

LLOYD L. EVANS
OF COUNSEL

December 3, 1968

RECEIVED
DEC 4 1968
ROBERT H. RINES, ALEN, HERTZOG & HASLAM

Robert H. Rines, Esq.
Rines and Rines
10 Post Office Square
Boston, Massachusetts 02109

Re: University of Illinois v. Blonder-Tongue

Dear Bob:

Thanks for your letter of December 2nd and the enclosed draft sections of the Blonder-Tongue appeal brief. I read through them immediately and will comment briefly on each section.

THE MAYES AND CARREL PATENT

Mayes and Carrel Were Not the "Inventors"

I like this section, but what is missing and seems urgently needed is a discussion of the applicable law at the bottom of page 2. Having researched the applicable law as thoroughly as I could during the preparation of our unsuccessful motion for summary judgment, I am attaching hereto Xerox copies of the section of that brief covering the law applicable to this issue. Your case is even stronger in view of the admission that Turner disclosed the V-angle of 30°.

Some of the cases and quotations in the attached material are believed to be too impressive to be omitted. Space may require you to be selective, but I would think you would want to at least cite practically all of the cases which I cited.

The Fraud in the Patent Office

Again, I like this section but believe added citations and discussions of authorities are needed.

Although not precisely in point as regards the obligations of one filing an affidavit under Rule 131, a recent Sixth Circuit decision is certainly in point regarding the obligations of attorneys to provide the Patent Office with the whole truth. That case is Chas. Pfizer & Co., Inc. v. Federal Trade Commission, 159 USPQ 193, 194-199. See also the applicable law cited in the enclosed section from my brief on my motion for summary judgment, which is considerably more complete than the legal discussion in the Pfizer case. I hope you will cite and discuss at least the Pfizer case and the most pertinent of the cases from my brief with a few of the more impressive quotations which those cases provide.

Non-Infringement

This is, no doubt, the toughest part of your case. I might be persuaded by your position if you had drawn a clearer, substantive comparison between the spacing of the parallel feeders in Fig. 2 of both Isbell and Mayes et al. with the spacing in the Blonder-Tongue antennas, in terms of wavelengths. On page 2 of this section, paragraph 5, you mention "1/18" of a wavelength spacing in the Blonder-Tongue antennas, indicating that it is "a substantial portion of a wavelength," but you give no comparative value for the Isbell and Mayes et al. antennas. Without that, and evidence that the difference is substantial in terms of operation, I am afraid you won't win on this issue.

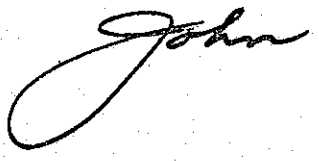
Counterclaim III

I think your position on validity is sound. On the question of infringement, however, there seems to be a need for demonstrating that the magnitude of the feeder spacing in the JFD antennas departs from the scope of the Isbell and Mayes et al. patents and comes within the scope of the Blonder-Tongue patent. This, again, involves the substantive comparison of such spacing in Isbell and Mayes et al. with that of the Blonder-Tongue patent. This is really an "off-the-cuff" reaction to an aspect of your case which I have not attempted to follow as thoroughly as the parts with which I am also concerned in the Finney Company suit.

I hope the above will be of some help and I shall be looking forward to receiving the additional sections of your brief as promised.

Good luck.

Sincerely,



JFP:jh
Enclosures

cc: Richard S. Phillips, Esq.

Thus, the particular antenna structures that are claimed in the Mayes et al. reissue patent in suit are only what were suggested by Turner; the design parameters employed were only those earlier taught by Isbell plus what was common practice in the prior art when using V-dipoles; and the mode of operation was only what was expected from the then well known operation of the Isbell antennas and of the prior art V-dipoles. Accordingly, there remains only the legal question of whether Mayes and Carrel themselves made an invention, if any is disclosed in their patent in suit, or merely derived the idea from another and added nothing patentable to it, so as to be barred from the right to a patent by 35 U.S.C. 102(f).*

The Law on Derivation of the Patented Invention from "Another"

An application of the law on patentability of inventions to the particular fact situation existing in this case may best be taken in two steps. It is first necessary to recognize what should be an obvious principle of law, i.e., what Turner admittedly suggested to Mayes et al. could not have been the invention of Mayes et al. That principle of law may have been first stated by the courts in the historic case of Stearns v. Davis, 22 Fed. Cases 1182, Fed. Case No. 13,338 (C.C., Dist. of Col., 1859). The

* Quoted in first footnote, p. 5, supra.

principle has never been better stated than in the headnote of the report of that case (fully supported by the opinion), which reads:

> "One who receives a 'suggestion' of a machine from another, and promptly reduces it to practical use, is not an inventor, and will acquire no right by reason of any laches of the original inventor in perfecting his invention. If the latter forfeits his rights, the forfeiture will be to the public."

The foregoing was, perhaps, the first authoritative statement of the law of "originality" or "derivation" that necessarily follows from the Constitutional provision for granting patents only to "Inventors," not to those who derived their ideas from others. Some 16 years later, the same thing was stated, in substance, by the Supreme Court in the noted case of Smith v. Nichols, 88 U.S. 112, 22 L.Ed. 566 (1875). In the words of the Supreme Court (22 L.Ed. at p. 567)--

> "A patentable invention is a mental result. It must be new and shown to be of practical utility. Everything within the domain of the conception belongs to him who conceived it. The machine, process or product is but its material reflex and embodiment."

The Court then explained that one may improve on the prior invention or idea of another and patent the improvement. However, it also pointed out that the improvement must itself amount to an invention in order to be patentable over the prior idea. Here Mayes et al. patented the precise structure conceived and suggested to them by Turner and which was necessarily "within the domain of" and "belongs to" Turner "who conceived it."

The same principle was applied a few years later by the Supreme Court in the equally well known case of Atlantic Works v. Brady, 107 U.S. 192, 27 L.Ed. 438 (1882). In that case, the Court first sought in vain for any inventive difference of Brady's claimed invention from the prior art. Then (at 27 L.Ed. 442) it detailed how, in any event, "Brady derived his whole idea from the suggestions of General McAlester" and concluded, for that additional reason, "that the patent sued on cannot be sustained."

Such "derivation" or "originality" questions most frequently arise in patent interferences between rival inventors in the Patent Office. Thus, in the case of Barba v. Brizzolara, 104 F.2d 198, 202-203, 41 USPQ 749, 752-753 (C.C.P.A., 1939), the Court found that the basic idea was derived by the appellant from the appellee and that the particular detail of construction employed by the appellant could have been worked out by one skilled in the art (for example, the included angle of the V-dipole arms, which is not even mentioned in most of the claims here in suit). Accordingly, the Court held the appellee to be the inventor, not the appellant who had merely used the skill of the art in producing an operable structure. See, also, Finch v. Dillenback, Jr., 121 F.2d 459, 466, 49 USPQ 731, 738 (C.C.P.A., 1941).

As the Court of Customs and Patent Appeals explained more fully in Applegate et al. v. Scherer et al., 332 F.2d 571, 141 USPQ 796, 798-799 (1964)--

> "An originality or derivation case, which this is, is quite unlike a case involving independent inventors, between whom true 'priority' must be decided.

> "Appellants seem to propose that there cannot be a conception of an invention of the type here involved in the absence of knowledge that the invention will work. Such knowledge, necessarily, can rest only on an actual reduction to practice. To adopt this proposition would mean, as a practical matter, that one could never communicate an invention thought up by him to another who is to try it out, for, when the tester succeeds, the one who does no more than exercise ordinary skill would be rewarded and the innovator would not be. Such cannot be the law. A contrary intent is implicit in the statutes and in a multitude of precedents."

Clearly, on the authority and reasoning of the above cases, Mayes et al. did not themselves invent the structure claimed in their patent, which was suggested to them by Turner. In that connection, the facts of those cases and of the present case must be distinguished from the many cases reaching the opposite result because the one making the suggestion did not suggest enough for one having ordinary skill in the art to make a complete and operative device. In the present case, Turner suggested precisely what Mayes et al. disclosed, namely, the prior Isbell antenna modified only by substituting V-dipoles for straight dipoles. What V-angle to use for any higher harmonic mode operation above the half-wave mode for which the Isbell antennas had been designed, being handbook information at least since 1943, was clearly implicit in the mere suggestion of the use of the well known V-dipoles.

The next step is to deal with what Turner did not suggest to Mayes et al., namely the use of the proposed V-dipole forms of the Isbell antennas on the 3/2 wavelengths and higher harmonic modes, which produced higher gain and sharper directivity (something which Turner may not have appreciated). The authorities are uniform in holding that when one merely makes a new or extended use of an old device, he is not entitled to a patent on the device itself, which he did not invent.

The last cited principle may have had its first clear statement in Roberts v. Ryer, 91 U.S. 150, 157, 23 L.Ed. 267, 270 (1875), in which the Supreme Court more specifically stated--

> "It is no new invention to use an old machine for a new purpose. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not." (Emphasis added)

In that case, comparing the claimed machine of the Sanford patent in suit with the prior Lyman machine, the court continued--

> "There was no change in the machine: It was only put to a new use. If there was any change of construction suggested, it was only to increase its capacity for usefulness***Clearly, we think, therefore, the invention of Sanford was anticipated by Lyman and his patent is, on that account, void."

The logic of the decision in Roberts v. Ryer is clear and has constituted the cornerstone of a host of subsequent decisions involving countless variations of the particular facts involved in that case. However, a comment seems warranted on a related principle of patent law codified in the 1953 Patent Act,

namely, that "a new use of a known***machine" is embraced by the term "process" [35 U.S.C. 100(b)], and that "Whoever invents or discovers any new and useful process***may obtain a patent therefore, subject to the conditions and requirements of this title." [35 U.S.C. 101]. The distinction between the principle of Roberts v. Ryer and the quoted portions of 35 U.S.C. 100(b) and 101 is simply this: One who merely puts an old machine to a new use, or uses it in a different way, or for a new purpose, if his conception is inventive in character ("unobvious"), is entitled to patent his conception as a "new and useful process" by the terms of 35 U.S.C. 100(b) and 101. However, where there is no change in the construction of the machine, or any change made in the machine is not inventive, neither the machine nor its inherent functions is new and one who conceives only the new use for the machine is not entitled to claim the machine itself, as his invention, or to patent it, though he may be entitled to patent, in terms of a "process," the particular new steps or operations involved in the new use.

Thus, here, the claims of the Mayes et al. patent in suit improperly cover precisely the device that Turner suggested to Mayes et al., namely, the dipole antennas of Isbell modified only by substituting for Isbell's straight dipoles the well known V-dipoles of the prior art (even including the same V-angles for particular

higher modes of operation that were handbook standards in the prior art use of such V-dipoles).

The principle that discovering a new use for an old device does not entitle one to a patent on the old device, whether or not the new use was previously known, was re-emphasized again in 1892 in another historic case, Ansonia Brass & Copper Co. v. Electrical Supply Co., 144 U.S. 11, 36 L.Ed. 327, 329, citing and repeating the above-quoted language from Roberts v. Ryer.

This has been the law ever since. Thus, in General Electric Co. v. Jewel Incandescent Lamp Co., 326 U.S. 242 (1945), the Supreme Court said (at p. 249)--

> "Where there has been use of an article or the method of its manufacture has been known, more than a new advantage of the product must be discovered in order to claim invention. See DeForest Radio Co. v. General Electric Co., 283 US 664, 682, 75 L ed 1339, 1347, 51 S Ct 563. It is not invention to perceive that the product which others had discovered had qualities they failed to detect. See Corona Cord Tire Co. v. Dovan Chemical Corp. 276 US 358, 369, 72 L ed 610, 614, 48 S Ct 380."

Still more recently, this Court restated the principle and repeated the first part of the above quotation from General Electric v. Jewell. Armour Research Foundation of Illinois Institute of Technology et al. v. C. K. Williams & Co., Inc., 170 F. Supp. 871, 884, 121 USPQ 3, 13, (D.C., N.D. Ill., 1959); affirmed, 280 F. 2d 499.

The same principle has been applied by the Court of Appeals of the Seventh Circuit in the type of situations involved in the Ansonia case, supra. B.&M. Corp. v. Koolvent Aluminum Awning Corp. of Indiana, 257 F.2d 264, 267, 118 USPQ 191, 194 (1958). Armour & Co. v. Wilson & Co., 274 F.2d 143, 150, 124 USPQ 115, 120-121 (1960), citing 35 U.S.C. 102(f) on which this part of this motion is based.

Summary

In claiming only the V-dipole form of Isbell's log periodic antennas and the inherent functions or properties thereof when operating at higher harmonic frequencies, the Mayes et al. patent covers the precise antenna structure suggested to them by Turner. By the first principle of law discussed above, it is clear that such structure, per se could not be the invention of Mayes et al.; and by the second principle of law discussed above, it is equally clear that such structure was not rendered patentable to Mayes et al. by their concept of using it at higher frequencies, whether or not Turner knew that it could be so used or appreciated the advantages of doing so.

The factual premises upon which these legal conclusions are based, being admitted by Mayes in his testimony and by Mayes and Carrel in their Invention Record (PX-15), their patent is necessarily invalid as a matter of law, and no other facts which defendants might conceivably allege could alter this final legal conclusion.

The Patent Office, having thus been misled by the Mayes affidavit, expressly accepted it for the purpose for which it was offered, withdrew the rejection of the Mayes et al. claims on the cited IRE publication, and concurrently allowed the first seven claims of the application, which became the first seven claims of the Mayes et al. original and reissue patents (file history PX-29, pp. 44-45). In due course, the remaining claims thereof and the additional claims of the Mayes et al. reissue patent were allowed by the Patent Office without ever again citing the prior Isbell work as pertinent prior art. (File history, PX-29, page 46 to the end; reissue file history, PX-30, in its entirety).

The Applicable Law

In Hazel-Atlas Glass Company v. Hartford-Empire Company, 322 U.S. 238 (1944), the Supreme Court clearly established the principle of law that "fraud" in obtaining a patent for an invention requires a complete denial of relief to the patentee against a claimed infringement. As the court stated (at p. 246)--

> "This matter does not concern only private parties. There are issues of great moment to the public in a patent suit. [citing prior decisions]. Furthermore, tampering with the administration of justice in the manner indisputably shown here involves far more than an injury to a single litigant. It is a wrong against the institutions set up to protect and safeguard the public, institutions in which fraud cannot complacently be tolerated consistently with the good order of society."

As regards the extent, if any, to which the wrongful acts committed in procuring the patent actually influenced the granting thereof, the court stated (at p. 247)--

> "Doubtless it is wholly impossible accurately to appraise the influence that the article exerted on the judges. But we do not think the circumstances call for such an attempted appraisal. Hartford's officials and lawyers thought the article material. They conceived it in an effort to persuade a hostile Patent Office to grant their patent application***. They are in no position now to dispute its effectiveness."

As to the particular relief to which a defendant is entitled when sued on a patent so procured, the court had this to say (at p. 250)--

> "Had the District Court learned of the fraud on the Patent Office at the original infringement trial, it would have been warranted in dismissing Hartford's case. In a patent case where the fraud certainly was not more flagrant than here, this court said: 'Had the corruption of Clutter been disclosed at the trial***, the court undoubtedly would have been warranted in holding it sufficient to require dismissal of the cause of action there alleged for the infringement of the Downie patent.' [citing cases] The total effect of all this fraud, practiced both on the Patent Office and the courts, calls for nothing less than a complete denial of relief to Hartford for the claimed infringement of the patent thereby procured and enforced."

Shortly after its decision in the Hazel-Atlas case, in Precision Instrument Manufacturing Co. v. Automotive Maintenance Machinery Co., 324 U.S. 806 (1945), the Supreme Court clarified the kinds of misconduct that fall within the rule of Hazel-Atlas. In the later case, the court explained that it is the "unclean hands" maxim of equity that constitutes the guiding doctrine, and

that anyone "tainted with inequitableness or bad faith relative to the matter in which he seeks relief" must be denied that relief. More specifically, in that regard, the court stated (at p. 815)--

> "Accordingly one's misconduct need not necessarily have been of such a nature as to be punishable as a crime or as to justify legal proceedings of any character. Any willful act concerning the cause of action which rightfully can be said to transgress equitable standards of conduct is sufficient cause for the invocation of the maxim by the chancellor."

What is required "to transgress equitable standards of conduct" and call for the denial of relief was further explained by the court (at p. 818) as follows:

> "We need not speculate as to whether there was sufficient proof to present the matter to the District Attorney. But it is clear that Automotive knew and suppressed facts that, at the very least, should have been brought in some way to the attention of the Patent Office***. Those who have applications pending with the Patent Office or who are parties to Patent Office proceedings have an uncompromising duty to report to it all facts concerning possible fraud or inequitableness underlying the applications in issue. [Case citation] This duty is not excused by reasonable doubts as to the sufficiency of the proof of the inequitable conduct nor by resort to independent legal advice. Public interest demands that all facts relevant to such matters be submitted formally or informally to the Patent Office, which can then pass upon the sufficiency of the evidence. Only in this way can that agency act to safeguard the public in the first instance against fraudulent patent monopolies. Only in that way can the Patent Office and the public escape from being classed among the 'mute and helpless victims of deception and fraud.'"

In the most recent Supreme Court decision on this subject, on writ of certiorari to the Court of Appeals of the Seventh Circuit in Walker Process Equipment Inc. v. Food Machinery and Chemical Corp., 322 U.S. 172 (1965), the court cited its prior decisions in the Hazel-Atlas and Precision Instrument cases for the proposition that a person sued for infringement may challenge the validity of the patent on various grounds, including fraudulent procurement. Clarifying the breadth of that rule, the court further stated (at p. 176)--

> "In fact, one need not await the filing of a threatened suit by the patentee; the validity of the patent may be tested under the Declaratory Judgment Act, 28 U.S.C. §2201 (1964 Ed.)."

Thus, the defense asserted here against the Mayes et al. reissue patent in suit applies equally well to plaintiff's declaratory judgment suit and to the earlier suit by the Foundation with which the declaratory judgment suit has been consolidated.

Summary

Summarizing and applying the principles of the three Supreme Court cases reviewed above to the facts of the present case, there can be no doubt that--

1. The Mayes affidavit was filed in the application for the original Mayes et al. patent at a time when all parties concerned knew or should have known that the prior work of Isbell preceded the work of Mayes et al. and was known to Mayes et al. before they conceived the subject matter of their own patent application.

2. Mayes and Carrel both knew of the prior report PX-17, which most fully described the Isbell work, and to which they referred in their invention record, PX-15.

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September 9, 1968

RECEIVED
SEP 10 1968
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Mr. John Rex Allen
Attorney at Law
20 North Wacker Drive
Chicago, Illinois

Re: University of Ill. Foundation vs.
Blonder-Tongue Laboratories, vs.
J. F. D. Electronics Corporation

Dear Mr. Allen:

According to the docket of the United States Court of Appeals, Seventh Circuit, you will soon be required to file and serve printed copies of an Appendix and/or Brief in the above case.

For over 60 years we have specialized exclusively in legal printing, much of it for our many Illinois customers for this Court. We can always provide any service you may desire and require at any time, which is not the case with commercial printers and duplicators.

We would sincerely appreciate this opportunity to be of service to you and we look forward to hearing from you in the near future.

Yours very truly,

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November 20, 1968

VIA AIR MAIL

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Dear Bob:

* I enclose a copy of a recent decision of the Seventh Circuit Court of Appeals in a patent case. I don't believe there is any new law which is particularly applicable to the Blonder-Tongue appeal. However, this decision again points up the attitude of our court that it will not disturb findings of fact of the District Court which are supported by some evidence.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

November 13, 1968

John F. Pearne, Esquire
McNenny, Farrington, Pearne & Gordon
920 Midland Building
Cleveland, Ohio 44115

Re: University of Illinois Foundation
v. Blonder-Tongue Laboratories Inc.

Dear John:

Belated thanks for your recent information relating to obviousness versus predictability.

We are putting the finishing touches on the last draft of the appeal brief and hope to have copies sent to you and Dick Phillips early next week for criticism before finalizing and sending to the printer.

One of our problems, of course, has been a matter of explaining multiple points and complicated concepts in a few words, since we are taking the tack that although we have been deprived of a proper trial so that the Court of Appeals cannot sustain the decision of the District Court, there are enough findings in certain phases of the case and enough evidence clearly and erroneously overlooked by the District Court to warrant reversal on certain phases, and there is sufficient error of law even on facts found by Judge Hoffman to warrant reversal on other phases.

More later.

Cordially,

RINES AND RINES

By _____

RHR:H

cc: R.S. Phillips, Esq.
W.R. McNair, Esq.

COPY

RECEIVED
NOV 14 1968

November 11, 1968

VIA AIR MAIL

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: UIF v. BT v. JFD

Dear Mr. Rines:

* Enclosed herewith is the remainder of the galley proofs of the Appendix which we have just received from the printer. I have reviewed the remaining proofs to see that they include the matters set forth in our designation filed September 13 and, according to my review, all the designated matters are included in the Appendix.

Since you are undertaking the preparation of the brief, I assume that you will see to preparing the index for the Appendix.

As I believe I mentioned before, you have our copy of the transcript so that we have not attempted to make a comparison of the galley proof for purposes of accuracy. I have noticed an occasional typographical error which I am sure you have come across also. One matter which will surely require your further study is the obvious missing copy on page 720 of the Appendix.

Your only exhibit to be printed, the Blonder patent, was forwarded with the first portion of galley proofs.

I remind you that the Appendix is due to be filed on December 13 and our printer will need the authority to proceed with the printing on Tuesday, November 26. Accordingly, I will look forward to receiving the index and your comments concerning any corrections or the like in the near future.

Very truly yours,

WRM:iag
* Enclosure

William R. McNair

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PATENT AND
TRADEMARK LAW

LLOYD L. EVANS
OF COUNSEL

October 29, 1968

RECEIVED
OCT 30 1968
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Robert H. Rines, Esq.
Rines and Rines
10 Post Office Square
Boston, Massachusetts 02109

Re: Log-Periodic Patent Litigation

Dear Bob:

Enclosed herewith is a letter I wrote to Dick Phillips on September 20. I was in Chicago and talked briefly to Jack Allen about the contents of the enclosed letter and learned that Dick had been out of town on an extended lawsuit and had not had an opportunity to look for the materials missing from my files. While we are waiting for Dick to return and check his own files, I would appreciate your checking yours on the chance that the missing materials may be in your possession.

Jack advised me that the time for filing defendant's appendix has been reset for December 13th and the time for filing defendant's brief has been reset for January 13th. I shall, of course, be most interested in seeing a brief draft while there is time for me to make any constructive suggestions that might occur to me.

In the latter connection, while I was still on vacation in August, my secretary sent you Xerox copies of portions of decisions bearing on the issue of obviousness as affected by unpredictability. The same issue has been raised in the Winegard suit by a petition for a rehearing filed by the Foundation following the recent affirmance by the Eighth Circuit Court of Appeals of the District Court decision holding the Isbell patent invalid in that suit. For the benefit of Winegard's attorneys, who seemed to be having trouble finding helpful law on that issue, I reviewed the results of our earlier law search and prepared the enclosed memorandum, which I sent to them yesterday. It may possibly also be helpful to you.

Sincerely,

John

JFP:jh
Enclosure
cc: Richard S. Phillips, Esq.

RELATIONSHIP BETWEEN "PREDICTABILITY"
AND "OBVIOUSNESS" UNDER 35 U.S.C. 103

> "Experimentation may well have been necessary to determine this. But from the facts that prevision [prediction] is not certain in chemistry,***it does not follow that every new and useful result accomplished by experiment is patentable. [Citation of long list of decisions including two in the 8th Circuit*]***But the use of the solution in those patents would at least suggest experimentation with that particular bleaching agent so far as the outside of potatoes is concerned."

Following the above quotation, the Court discussed the appellant's arguments, including the argument that the art warned against use of the invention sought to be patented, but concluded on the facts that the art did not contain such a warning. Naamlooze Venootschafs, Etc. v. Coe, 132 F.2d 573, 575-576 (C.A., DC, 1942).

In another chemical case involving essentially the same fact situation as above, the Supreme Court stated:

> "But we think that the state of the art was plainly sufficient to demonstrate to any skilled chemist searching for an anti-corrosive agent that he should make the simple experiment that was made here.***It is not surprising therefore that after experimenting with various standard alkalies in an effort to find a corrosion inhibitor that would not greatly reduce acidic astringency, the patentees promptly turned to urea.
>
> "As the United States Court of Appeals for the Second Circuit pointed out when this patent was before it: '***skillful experiments in a laboratory, in cases where the principles of the investigations are well known, and the achievements of the desired end requires routine work rather than imagination, do not involve invention.'"

Mandel Bros. v. Wallace, 335 U.S. 293, 295-296 (1948).

---

* We have not checked any of these decisions, and all of them should certainly be checked.

The CCPA, without citing any prior authority, reached the result of the above two cases in 1961 and explained its reasoning as follows:

> "What this amounts to is an argument that if one slavishly following the prior art, albeit with a little educated imagination, will sometimes succeed and sometimes fail, then he is always entitled to a patent in case of success. This is not the intention behind 35 U.S.C. Sec. 103. Obviousness does not require absolute predictability. Where, as here, the knowledge of the art clearly suggests a certain class of compounds, materials actually known by the term 'viscosity improving agents,' as useful to improve the viscosity index of a certain group of hydraulic fluid lubricants, the mere possibility of failure does not render their successful use 'unobvious.'
>
> "Appellant has not shown the production of anything unexpected here."

Application of Moreton, 288 F.2d 940, 943-944 (CCPA, 1961). This decision has been cited in most of the subsequent decisions noted below herein and has become a landmark case.

In 1965, the CCPA again considered the same question of law and decided the case in the same way, citing its prior decision of In re Moreton, supra, and adding--

> "In other words, an invention can be said to be obvious if one ordinarily skilled in the art would consider that it was logical to anticipate with a high degree of probability that a trial of it would be successful."

Application of Pantzer, 341 F.2d 121, 126.

The District Court for the District of Columbia, without reference to the prior decisions of the CCPA, considered the same question of law and reached the same result. After noting the numerous efforts by experts in prior cases to convince the court that there is no predictability in chemistry (none of the prior cases being cited, however), the court stated its conviction based on known examples that many results in chemistry are reasonably predictable. The court then continued--

> "With further regard to this alleged lack of predictability, little sophistication is required to distinguish between the undeniably true statement that there is no absolute predictability in chemistry on the one hand, and the erroneous statement that there is absolutely no predictability in chemistry on the other hand. An unequivocal holding to the effect that there is no predictability whatsoever in the science of chemistry would completely eliminate the obviousness test of 35 U.S.C. Sec. 103 from consideration in determining the patentability of claimed chemical inventions. If there is no predictability in chemistry, then no new chemical invention would ever have been obvious at the time it was made to an ordinarily skilled chemist, and it would logically follow that any new and useful chemical invention would be patentable. Such elimination of the obviousness test of 35 U.S.C. Sec. 103 in determining the patentability of chemical inventions would be quite contrary to statute law and to the clear intent of Congress in enacting Section 103 that the test should be applied in determining patentability of every 'invention,' whether chemical, mechanical, or electrical."

Hedman v. Commissioner of Patents, 148 USPQ 582 (DC, DC, 1966).

In rapid succession following the preceding case, the District Court for the District of Columbia reached the same result in two apparently related cases bearing the same titles. In the first of those apparently related decisions, the court cited its decision in the Hedman et al. v. Commissioner of Patents case, supra, and the In re Moreton decision of the CCPA, supra, restating its position as follows:

> "Plaintiff's position in this case is based on a familiar argument, the alleged lack of predictability of claimed chemical subject matter in view of prior art disclosures. This Court recently expressed certain unequivocal views with respect to this argument in Hedman et al. v. Commissioner of Patents, 253 F. Supp. 515 (1966), wherein the rule of 'reasonably based predictions' is stressed and reference is made to 'the scientific fact that there is indeed a considerable amount of predictability in chemistry,'

> meaning, of course, an amount which is worthy of consideration, as distinguished from an insignificant amount. The Court of Customs and Patent Appeals has held that 'obviousness does not require absolute predictability,' in a case involving claimed chemical subject matter. In re Moreton, 288 F.2d 940, 943, 48 C.C.P.A. 928 (1961). See also Walker, "Patent Protection Available on New Uses for Old Chemicals,' in 'Patents for Chemical Invention,' American Chemical Society, Washington, 1964, p. 82 to the effect that 'our understanding of the laws of chemistry may change, but the laws of chemistry themselves do not change.'"

In continuing following the above quotation, the court referred to "the paramount rule of 'reasonably based predictions.'" In the second of those apparently related decisions, the court merely stated that "obviousness does not require absolute predictability," citing In re Moreton by the CCPA. Clinical Products, Ltd. v. Brenner, 255 F. Supp. 151, 152 and 255 F. Supp., 131, 136 (DC, DC, 1966).

Shortly after the three decisions of the District Court of the District of Columbia, supra, the CCPA again cited and followed its decision, In re Moreton, supra, in a case in which it acknowledged "that a skilled chemist could not predict with absolute certainty" that the claimed invention would produce the results claimed for it. The possibly significant final contribution of this decision is its apparent reliance upon the fact that the superiority of the results obtained by the claimed invention were "not unexpected." Application of Wilson, 368 F.2d 269, 271 (CCPA, 1966).

In what appears to be the next decision by the CCPA on this question, the court noted the conclusion by the Board of Appeals that a chemist of ordinary skill "would be led***to try" the process of the claimed invention and stated--

> "The mere fact that the results to be obtained are not absolutely predictable does not make its successful use unobvious."

Application of Chi K. Dien, 371 F.2d 886, 887 (CCPA, 1967). In that decision, the last quotation was followed by a citation of a much earlier decision by the CCPA that had apparently been overlooked by that court in its prior decisions discussed above, namely, In re Wietzel et al., 400 O.G. 463, 39 F.2d, 669, 672. In that early case, the CCPA quoted, with approval, the following language by the Board of Appeals in the decision below:

> "We consider these disclosures sufficient to raise a presumption at least that the reactions disclosed would apply to formamid and to hydrocyanic acid as the nitrile of formic acid. And, where there is no real reason to suppose that the result would not be produced there is no invention in trying it and finding out that the process is successful."

Care should be taken in applying the "obvious to try" test, however, in view of another 1966 decision by the CCPA in which the Examiner had held that "it would have been obvious for a skilled chemist to try to stabilize polypropylene with a known stabilizer for polyethylene," and that it would be "routine experimentation for a skilled chemist to attempt to stabilize polypropylene***by first trying the known stabilizers for polyethylene***." The CCPA countered the Examiner's position with the observation 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." In this connection, the court suggested--

> "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 'research.'"

Perhaps the distinction which the court sought to draw was between the obviousness of a specific step suggested by the prior art and the unobviousness of a step taken in the face of only a general suggestion by the prior art of a "direction to be taken." Application of Tomlinson, 363 F.2d 928 (1966).

Another exception to the rule of In re Moreton, supra, is involved in a 1963 decision of the CCPA in which the court was persuaded to reach the opposite result in view of its conclusion that "the record as a whole here teaches away from the employment of" the claimed chemical invention for achieving the result sought thereby. The claims on appeal were for a soil fumigating composition, and the prior art indicated that the claimed compositions

would be toxic to plants and, therefore, entirely unsuitable for the purpose of the invention, although likely to be operative in other respects. It may be concluded from this case, therefore, that a claimed invention would not be considered obvious under 35 U.S.C. 103 if the art as a whole affirmatively teaches that the invention would be unsatisfactory for its intended purpose and that it would be harmful to employ it for such a purpose. Application of Pieroh, 319 F.2d 248, 251 (CCPA, 1963).

The U. S. District Court for the Northern District of Illinois cited and followed the Supreme Court decision in Mandel Bros. v. Wallace, supra, the Court of Appeals for the District of Columbia decision in Naamlooze Venootschafs, Etc. v. Coe, and the CCPA decision in Application of Moreton, supra, stating--

> "The alleged 'compatability discovery' that PVP is miscible in an anhydrous alcohol-Freon system does not convert the patentee's obvious composition to an unobvious one merely because a single and obvious experiment may have been necessary to establish that the composition was compatible or miscible."

265 F. Supp. 961 (DC, ND Ill., E.D., 1965), Aff'd. 152 USPQ 163 (CA 7, 1966).

Since the law search reported above was directed primarily to finding support in the Seventh Circuit for the doctrine of "reasonably based predictions" followed by the CCPA and District Court for the District of Columbia, the only Federal Court decisions noted were the one by the Supreme Court and the one in the Seventh Circuit affirmed by the Court of Appeals of that Circuit. Thus, the above cited decisions may well lead to similar decisions in other circuits.

J. F. Pearne

October 29, 1968

Mr. John F. Pearne
McNenny, Farrington, Pearne & Gordon
920 Midland Building
Cleveland, Ohio 44115

Dear John:

Sorry I missed you when you stopped in. I enclose
* your copy of the publication THE 20th NATIONAL ELECTRONICS CONFERENCE SEMINAR ON TOPICS IN MODERN ANTENNA THEORY and your file histories of Isbell 3,210,767, Mayes et al Re. 25,740, and Mayes et al 3,108,260.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

McNENNY, FARRINGTON, PEARNE & GORDON

ATTORNEYS AT LAW

920 MIDLAND BUILDING

CLEVELAND, OHIO 44115

TELEPHONE
(216) 623-1040
CABLE ADDRESS
RICHEY

PATENT AND
TRADEMARK LAW

F. O. RICHEY (1878-1964)

HAROLD F. McNENNY
DONALD W. FARRINGTON
JOHN F. PEARNE
CHARLES B. GORDON
ROBERT A. STURGES
WILLIAM A. GAIL
RICHARD H. DICKINSON, JR.
THOMAS P. SCHILLER
LYNN L. AUGSPURGER

LLOYD L. EVANS
OF COUNSEL

September 20, 1968

RECEIVED
SEP 23 1968
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Richard S. Phillips, Esq.
Hofgren, Wegner, Allen, Stellman & McCord
20 North Wacker Drive
Chicago, Illinois 60606

Dear Dick:

Since the trial of the Foundation v. Blonder-Tongue suit, I have been unable to find my copy of a publication entitled--

THE 20th NATIONAL ELECTRONICS CONFERENCE
SEMINAR ON
TOPICS IN MODERN ANTENNA THEORY.

Isabelle - See if you can find this on top of locked file

That publication began with an article by Rumsey on Frequency Independent Antennas, followed by an article by Mayes on the same subject, and then by several additional articles. The article by Mayes gave his definition of a frequency independent antenna in the first paragraph describing "EARLY WORK."

I have a foggy recollection that I supplied you and Bob Rhines with my copy of that publication for use during the trial of your case and may not have received it back. I would greatly appreciate your checking carefully to be sure that you do not have that publication still in your files. As I remember the copy that I had at that time, it was a pamphlet nearly a half inch thick with pages at least as large as 8-1/2" x 11".

I spent some time with Bob Rhines at his resort in the Maine woods late in July, at which time we discussed various approaches Blonder-Tongue might take in its appeal. Bob said he would be working on his appeal brief during the last few weeks of his time at the resort and would get a draft to me, as well

as to you for comment, after which we might get together again if there seemed to be a need for it. Knowing the delays inherent in the appeal procedure before the briefing time begins to run and Bob's tendency to let things go until the last minute, I assume that he has not yet sent you a draft of a brief. Whether or not any comments I might make will be helpful, I would certainly appreciate an opportunity to present my comments to both of you before your brief is finalized.

Sincerely,

John

JFP:jh

October 24, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: University of Illinois Foundation v.
Blonder-Tongue Laboratories, Inc.

Dear Mr. Rines:

Enclosed herewith you will find page proofs of the initial portion of the Appendix, apparently running through page 387. The printer has provided us with two copies of the page proofs and I am retaining one copy here for our examination.

The printer advises me that as further portions of the Appendix are printed in page proof, he will supply two copies of the proofs to me and I will pass them on to you from time to time.

Please let me know if there are any changes or corrections that you wish to have made and I will forward your instructions to the printer.

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & MC CORD

William R. McNair

WRM:ps
Enclosure

October 24, 1968

MEMORANDUM

TO: MR. RICHARD S. PHILLIPS

Re: Blonder-Tongue Litigation

The Winegard decision by CCA 8 is published at 159 USPQ 129.

J.R.A.

JRA:DB

October 17, 1968

VIA AIR MAIL

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: UIF v. BT v. JFD
Appeal No. 17153

Dear Mr. Rines:

We have just received an order of the Court of Appeals extending the time for filing our appendix to and including December 13, 1968, and extending the time for filing our brief to and including January 13, 1969.

* A copy of the order is enclosed.

Very truly yours,

Ronald L. Wanke
Docket Clerk

RLW:iag

* Enclosure

October 9, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: University of Illinois Foundation v.
Blonder-Tongue Laboratories, Inc.

Dear Mr. Rines:

Enclosed herewith for your files is a copy of the Motion and Affidavit submitted to the Court of Appeals to secure an extension of time for filing the Brief and Appendix in the above case. Also enclosed herewith is a copy of the Eighth Circuit decision in the Winegard case.

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

William R. McNair

WRM:ps

Enclosures

October 4, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: University of Illinois Foundation v.
Blonder-Tongue Laboratories, Inc.

Dear Mr. Rines:

Under separate cover I am forwarding today, in three parcels, the transcript of the above proceeding per the request in your October 1st letter.

I have been in touch with our local printer who advises me that it may take up to 60 days to have the Appendix printed. Therefore, I will move the Court of Appeals for an extension of time to file the Appendix and Brief, requesting 60 days for the Appendix and an additional 30 days for the Brief, so you will have an opportunity to put the appropriate page references in your brief. I have consulted with counsel for both of the other parties and they have advised me that they would not contest the motion, but they did not wish to stipulate to the extension. As you can appreciate, Mr. Mann indicated that he is most anxious to have this case argued and decided.

I have been advised that the Court of Appeals for the 8th Circuit has affirmed the decision of the District Court in the Winegard case. As soon as I obtain a copy of the decision, I will forward it to you.

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & MC CORD

William R. McNair

WRM:ps

September 27, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: University of Illinois Foundation v.
Blonder-Tongue Laboratories, Inc.

Dear Mr. Rines:

Dick Phillips will be engaged in trial in Seattle for at least two, and maybe three, weeks. According to our records, your Appendix and Brief is due on October 14. Would you please advise as to whether you would like to have the Brief printed here and, if so, we should have the draft of the Brief in the relatively near future so that we can forward it to the printer.

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & MC CORD

William R. McNair

WRM:ps

September 17, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Re: University of Illinois v.
Blonder-Tongue Laboratories

Dear Mr. Rines:

Enclosed herewith is a copy of the Designation of Appendix and Statement of Issues which was served and filed on Friday, September 13th.

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & MC CORD

William R. McNair

WRM:sls
Enclosures

September 9, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Re: U.Ill. Foundation v. Blonder Tongue

Dear Mr. Rines:

Enclosed is a copy of the local rules of the Seventh Circuit, which just recently became available.

Very truly yours,

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Ronald L. Wanke

RLW/dm
Enclosure

September 9, 1968

VIA AIR MAIL

Mr. Robert H. Rines
Rines & Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: UIF v. BT v. JFD

Dear Bob:

This is just a reminder that we have to designate the portions of the transcript for printing on the 13th. Please get this information to us as promptly as possible.

Very truly yours,

Richard S. Phillips

RSP:iag

September 3, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusettes 02109

Re: University of Illinois
v. Blonder-Tongue

Dear Mr. Rines:

As you know, I am assisting Dick Phillips in taking care of the procedural matters with respect to the appeal. Dick has asked that I write you and summarize our activities to date, as well as advising what lies ahead.

As of this date we have gone through the steps of filing the Notice of Appeal, obtaining a Supersedeas Bond which we have had approved by an order of the court, by means of which the issuance of an injunction and the initiating of the accounting proceeding have been stayed.

In addition, we have sent a statement to opposing counsel advising that the entire transcript is to be included in the record on appeal and that in addition, the hearing of December 27th is to be also included. Following this, we prepared and entered into a Stipulation with respect to the Docket entries to be included on the record on appeal and also prepared an exhibit list for all parties and obtained a Stipulation with respect to this list. Last week we conferred with the District Court Clerk and filed our exhibits with the clerk preparatory to docketing the appeal.

On September 3 the appeal was docketed with the clerk of the Court of Appeals for the 7th Circuit.

According to our reading of the Federal Rules of Appeals Procedure, we must transmit to opposing counsel our designation of the parts of record to be included in the

appendix no later than September 13th. On September 23, the other parties are to serve on us their designation of the record to be included in the appendix. I would suggest that you have this designation in our hands no later than September 12th. Following this, our appendix and brief will be due on October 14th.

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & MC CORD

William R. McNair

WRM:sls

August 9, 1968

Mr. Basil P. Mann
Merriam, Marshall,
Shapiro & Klose
30 West Monroe Street
Chicago, Illinois 60603

Mr. Myron C. Cass
Silverman & Cass
105 West Adams Street
Chicago, Illinois

RE: The University of Illinois Foundation
v. Blonder-Tongue Laboratories Inc.

Dear Mr. Mann and Mr. Cass:

Enclosed herewith is a copy of the docket entry in the above case with the entries deemed unnecessary for the record on appeal having been lined out. In accordance with our telephone conversation, I understand that you will review the same and I will get in touch with you early next week to determine what changes, if any, should be made prior to entering into a stipulation with respect to the portions of the docket entry to be included in the record on appeal.

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

William R. McNair

WRM/ps
Encl.

August 5, 1968

Miss Dorothy L. Brackenbury
219 South Dearborn Street
Chicago, Illinois 60604

RE: University of Illinois Foundation v.
Blonder-Tongue v. JFD

Dear Dorothy:

* I enclose a copy of our notice regarding the Record on appeal in the above. Please note that we wish to include in the Record the transcript of proceedings in connection with our motions for postponement on December 26 and December 27, 1967. The transcript of the proceedings on these two days is not a part of the trial transcript in Judge Hoffman's possession. At the time you made a transcript for us of the proceedings on the 26th, but not those of the 27th.

Please prepare the necessary transcripts and file them with the court. We would also like for our files a copy of the transcript for December 27.

Very truly yours,

Richard S. Phillips

RSP:iaq

* Enclosure

cc: Mr. B. P. Mann
Mr. M. C. Cass
Mr. R. H. Rines

August 5, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Re: U.Ill. Foundation v. Blonder Tongue

Dear Mr. Rines:

Enclosed is a copy of the Notice we filed pursuant to Rule 10(b) of the Federal Rules of Appellate Procedure. The reason we filed this Notice is that we are including in the record a transcript of the proceedings on December 26 and 27, 1967, not a part of the official transcript at trial, and which we have ordered from the court reporter. To insure that opposing counsel would not object that they had no notice of these additional proceedings, we served and filed the Notice.

Mr. Phillips talked with the attorneys for both Foundation and JFD, and it was agreed that each would file for the record on appeal all of their exhibits. We are preparing a descriptive list of all exhibits, to be filed with the record on appeal.

The Clerk of the District Court has sent us a letter requesting that the record, transcripts and exhibits be filed with them by August 14, 1968 in order to expedite preparation of the record on appeal, and we will attempt to accommodate this request.

Very truly yours,

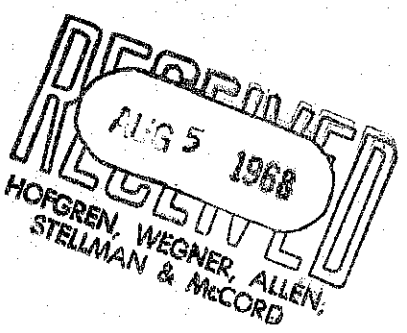
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Ronald L. Wanke

RLW/dm
Enclosure

BLONDER-TONGUE

Laboratories Inc. / 9 Alling St., Newark 2, N. J. / Area code 201 / MArket 2-8151



July 31, 1968

Mr. William R. McNair
Hofgren, Wegner, Allen, Stellman & McCord
20 North Wacker Drive
Chicago, Illinois 60606

Dear Mr. McNair:

We are returning herewith the bond application form which has been properly signed and notarized, in accordance with your letter of July 25th.

The net worth of the Blonder-Tongue Laboratories Inc. is in excess of One Million Dollars.

Sincerely,

BLONDER-TONGUE LABORATORIES INC.

Ben H. Tongue
President

BHT/jg
Enc.

THE GUNTHORP-WARREN PRINTING COMPANY
123 NORTH WACKER DRIVE · CHICAGO 60606
TELEPHONE FINANCIAL 6-1717

RECEIVED
JUL 31 1968
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

R. S. Phillips
% Hofgren, Wegner, Allen
Stellman & McCord
20 N. Wacker Dr. Rm. 2200
Chicago, Ill. 60606

University of Ill. Foundation
vs
Blonder-Tongue Laboratories
vs
J. F. D. Electronics Corp.

It comes to our attention that you will file a brief and appendix in the above matter and take this opportunity to solicit their printing. Gunthorp-Warren Printing Company is the official court printer for the United States Court of Appeals and prints all appendices printed under the Clerk's supervision. Also, our 70 years' experience as printers to lawyers merits your consideration.

Your notice of appeal was filed in the District Court 7/25. Your record is due to be filed in the United States Court of Appeals within forty (40) days, or 9/3, unless extended by motion. Promptly after filing notice of appeal, the appellant should prepare a stipulation pursuant to Rule 12(e) and the prefix pursuant to 12(c) of the rules of the United States Court of Appeals.

Should you decide to have the appendix printed through the Clerk of the United States Court of Appeals, you write a letter to the Clerk advising him that you elect to have him supervise the printing of your appendix and attach a designation of the parts of the record you wish to put into your appendix. He will then send you an estimate of the costs and as soon as that is paid he will release the record to us so we can send a page proof to you (for your page references in your brief) and another proof to the Court for insertion of running heads and making up of the index. By so doing you are taking advantage of a contract price which is passed on to you. Upon docketing the record in the United States Court of Appeals an appearance fee of $25.00 is required.

Brief and appendix are due to be filed within 30 days after the record has been filed in the United States Court of Appeals.

Trusting the above information is helpful and hoping you will not hesitate to call if there is anything further we might do, we remain

Yours very truly,

GUNTHORP-WARREN PRINTING COMPANY

L. R. Veit

L. R. Veit

The FUND
Insurance Companies

☐ FIREMAN'S FUND INSURANCE COMPANY

☐ NATIONAL SURETY CORPORATION

APPLICATION FOR JUDICIAL OR COURT BONDS

(NOT INCLUDING BONDS FOR FIDUCIARIES)
WITH OR WITHOUT COLLATERAL

The undersigned, hereinafter called Indemnitors, hereby make application to Fireman's Fund Insurance Company or National Surety Corporation, as the case may be, any one or both hereinafter referred to as SURETY, for the following bond or undertaking, hereinafter referred to as Bond:

1. Full name of Applicant _____

2. Residence address _____ 3. Occupation _____

4. Business address _____

5. Name and address of attorney _____

6. Kind of Bond _____ 7. Amount of Bond $ _____ 8. Premium $ _____

9. Title of the action _____

10. Court and County in which action is pending _____

11. If applicant is plaintiff state —

(a) Amount of Claim or value of property involved $ _____

(b) Grounds upon which the remedy is sought _____

12. If applicant is defendant state —

Amount of judgment, claim or value of property involved $ _____

13. Financial statement of _____ as of _____ 19____

ASSETS		LIABILITIES	
Cash on hand (not in bank)	$	Borrowed money from banks	$
Cash deposited in following banks:		When due?	
	$	How Secured?	
	$		
Stocks and bonds (market value) consisting of	$		
	$	Other notes payable	$
	$	When due?	
State which, if any, of the above hypothecated for loans.		How Secured?	
Real Estate, title to which is IN NAME OF			
	$	Accounts payable	$
consisting of		Mortgages on real estate	
a	$	a	$
b	$	b	$
Notes receivable	$	Other liabilities (in detail)	$
Accounts receivable	$		$
Other assets (in detail)		The undersigned declares that he has no liabilities or debts of any kind or nature excepting those shown above.	
	$		
Total Assets,	$	Total Liabilities,	$

If no liabilities—write "None"

BN 282 12/58

(OVER)

In consideration of the execution of said bond, and in compliance with the promise of the undersigned made prior to the execution thereof, the undersigned, hereinafter called Indemnitors, hereby jointly and severally agree, for themselves, their personal representatives, successors and assigns, as follows:

1. That they will pay to the Surety, upon the execution of the bond, the premium prescribed by the Surety's regular manual of rates in force at the date of execution of the bond, (stated or intended to be stated in answer to question 9 on reverse side), and the same amount annually thereafter in advance until the Surety shall be furnished with legally sufficient evidence of its discharge from liability under said bond.
2. That they will indemnify the Surety, its successors and assigns, against any and all liability, loss, costs, damages, fees of attorneys and other expenses which the Surety may sustain or incur in consequence of having executed, or procured upon its indemnity the execution of, said bond, including but not limited to (a) sums paid or liabilities incurred in settlement of, and expenses paid or incurred in connection with, claims, suits or judgments under said bond; and (b) expenses paid or incurred in making investigations or in taking any other action in connection with said bond, and in recovering or attempting to recover losses or expenses paid or incurred as aforesaid.
3. That if the Surety shall set up a reserve to cover any claim, suit or judgment under said bond, the Indemnitors will, immediately upon demand, deposit with the Surety a sum of money equal to such reserve, to be held by the Surety as collateral security on said bond.
4. That if the Surety shall, otherwise than upon its own indemnity, procure any other company or companies to execute or join with it in executing, or to reinsure, said bond, this instrument shall inure to the benefit of such other company or companies, its or their successors and assigns, so as to give to it or them a direct right of action against the Indemnitors to enforce this instrument, and in that event the word "Surety," wherever used herein, shall be deemed to include such other company or companies, as their respective interests may appear.
5. That an itemized statement of payments made by the Surety for any of the purposes above specified, sworn to by an officer of the Surety, or the voucher or vouchers for such payments, shall be prima facie evidence of the liability of the Indemnitors to reimburse the Surety for such payments, with interest; and if the Surety shall bring suit to enforce any obligation of the Indemnitors under this instrument, the Indemnitors shall be liable for the costs and expenses, including fees of attorneys, incurred in prosecuting such suit, and such costs and expenses shall be included in any judgment that may be rendered against the Indemnitors.
6. That the Surety is hereby authorized but not required (a) to recognize, as the authorized representative of the Applicant until the Surety shall have been fully discharged from liability under said bond, any attorney of record for the Applicant in said action at the date of the execution of said bond; and (b) to take such action as it may deem appropriate to prevent or minimize loss under said bond, including but not limited to steps to procure its discharge from liability under said bond or to appeal from any judgment that may be rendered in said action; and (c) to adjust, settle or compromise any claim or suit arising under said bond and, with respect to any such claim or suit, to take any action it may deem appropriate or refrain from taking any action it may deem inappropriate.
7. That any money or property which shall have been or shall hereafter be pledged by any of the Indemnitors as collateral security on said bond shall be held subject to the terms of the Surety's regular form of "Receipt for Collateral," which is hereby made a part of this instrument to the same extent as if set out at length herein, and any such money or property shall be available, in the discretion of the Surety, as collateral security on any other or all bonds heretofore or hereafter executed for or at the request of any of the Indemnitors.
8. That the liability of the Indemnitors hereunder shall not be affected by the failure of the Applicant to sign said bond nor by any claim that other indemnity or security was to have been obtained, nor by the release of any indemnity, or the return or exchange of any security, that may have been obtained; and if any Indemnitor signing this instrument is not bound for any reason, this obligation shall still be binding upon each and every other Indemnitor.
9. That separate suits may be brought hereunder as causes of action accrue, and suit may be brought against any or all of the Indemnitors; and suit or suits upon one or more causes of action, or against one or more of the Indemnitors, shall not prejudice or bar subsequent suits against any other or all of the Indemnitors on the same or any other cause or causes of action, whether theretofore or thereafter accruing; and this instrument, being based upon a valuable consideration, shall be construed in accordance with the rules applicable to the obligations of compensated sureties.
10. That the Surety may, at its option, decline to execute, participate in or procure the execution of said bond. If such bond be executed, the Surety shall not be held responsible in the event it is not accepted by or on behalf of the Obligee, or is not effective to accomplish the purpose for which it is required.
11. That wherever used in this instrument the plural term shall include the singular and the singular shall include the plural, as the circumstances require.
12. No change or modification of this agreement shall be effective unless made by writing executed by the applicant and an authorized officer of Surety.

Signed, sealed and dated the 31 day of July 1968

In the presence of

Jean M. Goldberg

X Blonder-Tongue Lab. (Seal)

Signature by Ben H. Tongue (Seal)

Tongue (Seal)

STATE OF) ss:
COUNTY OF)

On the day of 19 , before me personally came , to me known and known to me to be the individual who executed the foregoing instrument, and acknowledged that he executed the same.

STATE OF) ss:
COUNTY OF)

On the day of 19 , before me personally came , known to me, and stated that partner in the firm of , and acknowledged that he executed the foregoing instrument as the act of the said firm.

STATE OF NEW JERSEY) ss:
COUNTY OF ESSEX)

On the 31st day of July 1968, before me personally came Ben H. Tongue, to me known, who, being by me duly sworn, did depose and say that he resides in West Orange N.J.; that he is the President of the BLONDER-TONGUE LABORATORIES INC., the corporation which executed the foregoing instrument; that he knows the seal of the said corporation; that the seal affixed to the said instrument is such corporate seal; that it was so affixed by order of the Board of Directors of the said corporation, and that he signed his name to the said instrument by like order.

Jean M. Goldberg
JEAN M. GOLDBERG
NOTARY PUBLIC OF NEW JERSEY
My Commission Expires April 2, 1972

July 29, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: University of Illinois Foundation v.
Blonder-Tongue Laboratories, Inc.

Dear Mr. Rines:

Friday morning, July 26th, I appeared before Judge Perry, the emergency judge, and presented our motion to stay the enforcement of Judge Hoffman's decision of June 27th and to approve of supersedeas bond in the amount of $20,000.00. Judge Perry, being unfamiliar with the case, was reluctant to approve of the amount of the bond, but I advised him that the University of Illinois Foundation attorneys had indicated that they would not object. Mr. Cass, attorney for J.F.D. Electronics, requested an opportunity to consult with the principals.

As a result, Judge Perry entered an Order staying the enforcement of the judgment and approving our bond with the proviso that the motion could be vacated by appearing before Judge Perry no later than 2:00 P.M. on Tuesday, July 30th.

Yours very truly,

HOFGREN, WEGNER, ALLEN, STELLMAN & MC CORD

William R. McNair

WRM/ps

The Scheffer Press
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RECEIVED
JUL 29 1968
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

July 26, 1968

Richard S. Phillips, Esq.
20 North Wacker Drive
Chicago, Illinois

RE: University of Illinois Foundation
vs: Blonder-Tongue Lab. Inc.

Dear Mr. Phillips:

Referring to our conversation pertaining to the above mentioned appeal and with the thought you may find the following information helpful as a supplement to your present file, we have herewith set out due dates for documents to be filed (assuming Notice of Appeal was filed July 25, 1968.)

As you undoubtedly know, under the present practice, the District Court Clerk forwards the record to the United States Court of Appeals within the time provided (40 days in civil and admirality cases, or up to 90 days if extended by the trial judge—Federal Appellate Rule 11(a) and (b)). Also see Federal Appellate Rule 10(b) re Transcript of Proceedings.

Typewritten record to be filed by Appellant in the U.S.C.A. on or before September 3, 1968. Federal Appellate Rule 11(a).

The Clerk of that Court will promptly give notice to all parties at the time case is docketed in the U.S.C.A. Federal Appellate Rule 12(b).

Appellant's printed brief and appendix due forty (40) days after the date the typewritten record is filed in the U.S.C.A. Federal Appellate Rule 30(a) and 31(a).

If parties do not stipulate or agree as to contents of the appendix, the appellant shall within ten (10) days after filing of record in U.S.C.A. serve upon appellee a designation of the parts of the record he intends to include in the appendix and a statement of the issues he intends to present for review.

Appellee shall have ten (10) days after service to serve appellant as to additional contents of record he so desires in appendix. Federal Appellate Rule 30(b).

(continued)

The Scheffer Press

July 26, 1958

Richard S. Phillips, Esq.

RE: University of Illinois Foundation
vs: Blonder-Tongue Lab. Inc.

Appellee's brief due thirty (30) days after filing of Appellant's brief. Federal Appellate Rule 31(a).

Appellant's Reply Brief due fourteen (14) days after filing of Appellee's brief.

Further, after the filing of the typewritten record in the U.S.C.A. and after designations are filed in compliance with Federal Appellate Rule 30(b), and with your consent, we will supervise, at no additional charge, the complete printing of the appendix, including the preparation of running titles and index, and submit same to you upon its completion. In this manner, you will be relieved of this added detail and thereby allowing you more time to devote to the preparation of Appellant's brief.

Should there be any question pertaining to the above, please do not hesitate to call as it shall be our pleasure to serve you further.

Cordially yours,

THE SCHEFFER PRESS, INC.

R. Scheffer

Representative

RS:gfd

July 29, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Re: U. of Ill. Foundation v.
Blonder Tongue

Dear Mr. Rines:

At Dick Phillips' request, I enclose a Xerox copy of our firm's current litigation docket sheet, with the dates of matters handled by Dick Phillips circled thereon.

Very truly yours,

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Ronald L. Wanke

RLW/dm
Enclosure

RSP

LITIGATION DOCKET
July 26, 1968

7-18 Safe Flight v. UNITED CONTROL - P's Ans. to D's 1st Req. for Admissions WJS/RSP

7-26 GENERAL TELEPHONE v. National Video - Last day for production of documents JRS/RSP/WRM/JRH

7-26 GLEN v. Fulton - P's Brief & Proposed findings & conclusions WJS/JRS
(was 8-15)

7-27 KING-SEELEY v. Borg-Warner - D's Ans. to P's Req. for Admissions WJS/WRM

7-29 General Tire v. JEFFERSON - P's Obj. to D's 2nd Interr. JRA/JRS/JRH

7-30 LAIDIG SILO v. Nutri-Seal - Ans. due WJS/BW

7-30 MARVIN GLASS v. Mattel - Ans. of Sears JRS/JRH

7-31 Roper-Wright v. NOBLE - Last day to complete pre-trial conference JCW/JRH

8-5 General Tire v. JEFFERSON - P's Ans. to D's 2nd Interr JRA/JRS/JRH

8-5 - U.Ill. v. BLONDER TONGUE - D Order Transcript not on file (if any) and serve statement JRA/RSP/WRM

8-15 GENERAL TELEPHONE v. National Video - GT&E and Sylvania Ans. to D's Counterclaims JRS/RSP/WRM/JRH

8-15 - GLEN v. Fulton - D's Brief & Proposed Findings & Conclusions WJS/JRS

8-15 - MARVIN GLASS v. Gardel - Ans. due JRS/JRH

8-20 Versa Products v. FLICK-REEDY - Answer due JCW/JRH

8-15 INDIANA GENERAL v. Lockheed - Hearing before CA9 WJS/JCW/WER

8-31 Westinghouse v. MONTGOMERY ELEVATOR - Answers due BW/RSP/RLH

8-31 Bela Seating v. Poloron (TEXTRON) - D's Brief on Antitrust WJS/JRS/JRH

8-31 Bela Seating v. Poloron (TEXTRON) - P's Brief on Patent WJS/JRS/JRH

Sept. KING-SEELEY v. Jefferson Ice - Passed case calendar call WJS/WRM

Sept. - General Tire v. JEFFERSON - D's Ans. on Motion to Dismiss Counterclaim (Hearing 9-17) JRA/JRS/JRH

9-3 - U.Ill. v. BLONDER TONGUE - Estimated day Clerk of Court files record JRA/RSP/WRM

9-3 - U.Ill. v. BLONDER TONGUE - D to Docket Appeal, last day for transmission of record JRA/RSP/WRM

9-9 Schneider v. SENG - 10:00 Pre-trial conference BW/JRH

9-13 - U.Ill. v. BLONDER TONGUE - D's designation for appendix (estimate) JRA/RSP/WRM

9-13 - U.Ill. v. BLONDER TONGUE - Last day for D's election on deferred appendix (estimate) JRA/RSP/WRM

9-17 General Tire v. JEFFERSON - Hearing on Motion to Dismiss Counterclaim JRA/JRS/JRH

9-18 GENERAL TELEPHONE v. National Video - Pretrial JRS/RSP/WRM/JRH

9-18 - SIMONIZ v. Gulfport - Hearing on Motions Rules 34 and 37 JRA/JRS

9-21 - Delnatel v. BENTLEY - P's Opposition Brief on D's Motion to Dismiss or Transfer JRH/WRM

9-23 - U.Ill. v. BLONDER TONGUE - P's designation for appendix (estimate) JRA/RSP/WRM

9-27 UARCO v. Moore - Ruling on Motions JCW/WRM

9-30 Safe Flight v. UNITED CONTROL - Trial WJS/RSP

10-7 Particle Data v. COULTER - Pretrial 10:00 BJ

10-14 - U.Ill. v. BLONDER TONGUE - D to file joint appendix (estimate) JRA/RSP/WRM

10-14 - U.Ill. v. BLONDER TONGUE - D's Brief (estimate) JRA/RSP/WRM

10-15 Bela Seating v. Poloron (TEXTRON) - D's Ans. Brief on Patent WJS/JRS/JRH

10-15 Bela Seating v. Poloron (TEXTRON) - P's Ans. Brief on Antitrust WJS/JRS/JRH

10-18 FORMICA v. Rhode Island - Complete discovery to Ans. case ready on calendar call JRA

10-30 Bela Seating v. Poloron (TEXTRON) - P's Reply Brief on Patent WJS/JRS/JRH

10-21 - Deknatel v. BENTLEY - Hearing on Motion to Dismiss or Transfer LMM/WRM

10-30 Bela Seating v. Poloron (TEXTRON) - D's Reply Brief on Antitrust WJS/JRS/JRH

11-13 - U.Ill. v. BLONDER TONGUE - P's Brief (estimate) JRA/RSP/WRM

11-18 - Super Draulic v. COATS - Trial JCW/WRM

11-27 - U.Ill. v. BLONDER TONGUE - D's Reply Brief (estimate) JRA/RSP/WRM

ORAL EXTENSION TO INTERR. ANS.

7-2 General Tire v. JEFFERSON - D's Ans. to P's Interr. (orally ordered) 1-29 JRA/JRS/JRH

7-3 General Tire v. JEFFERSON - P's Ans. to D's 1st (orally ordered) Interr. JRA/JRS/JRH

7-10 AQUA CHEM v. Gulf - P's Ojb. or Ans. to D's Interr. (appropriately) Nos. 1-110 WJS/JCW/JRS

APPEAL

U.Ill. v. BLONDER TONGUE - D's Appeal to CA7 filed JRA/RSP/WRM

SUMMER RECESS EMERGENCY JUDGES

JUDGE PERRY 7-15 to 7-28

JUDGE WILL 7-29 - 8-11

RSP

U.Ill. v. BLONDER TONGUE

DOCKET DATES

8-5 - U.Ill. v. BLONDER TONGUE - D Order Transcript not on file (if any) and serve statement JRA/RSP/WRM

9-3 - U.Ill. v. BLONDER TONGUE - D to Docket Appeal, last day for transmission of record JRA/RSP/WRM

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9-13 - U.Ill. v. BLONDER TONGUE - D's designation for appendix (estimate) JRA/RSP/WRM

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11-13 - U.Ill. v. BLONDER TONGUE - P's Brief (estimate) JRA/RSP/WRM

11-27 - U.Ill. v. BLONDER TONGUE - D's Reply Brief (estimate) JRA/RSP/WRM

July 26, 1968

M E M O R A N D U M

TO: John Rex Allen
Richard S. Phillips ✓
William R. McNair

FROM: Ronald L. Wanke

Re: Procedure for Appeal to U.S. Court of Appeals (U. of Ill. v. Blonder Tongue)

General - as of July 1, 1968, appeals are governed by the new Federal Rules of Appellate Procedure (FRAP), which supersede Rules 72-76 of the Federal Rules of Civil Procedure (FRCP) and the local rules of the Seventh Circuit (gray colored pamphlet). Certain language is my interpretation of the rules, please read the actual rules if you believe there is a change from old practice. A check with the Clerk of the Court of Appeals determined that new local rules are being prepared, but are not yet available. The Clerk's office said the FRAP probably contains all procedures which we should follow, and the new local rules will mainly cover miscellaneous matters such as calendars. No comparison between the new FRAP and the old

local rules has been made by me, possibly someone acquainted with the old procedure should check with the Clerk's office as to matters in the old local rules which might supplement the FRAP. The following procedure is based on the FRAP.

Notice of Appeal - filed in District Court within 30 days from entry of Judgment; any other party may file a Notice of Appeal within 14 days after filing of the first Notice of Appeal (FRAP 4a); the Clerk of the District Court to send notice to opposing counsel (FRAP 3d). A $250 cost bond must be filed with the Notice of Appeal, unless Supersedeas bond is filed (FRAP 7). Filing fee for the Notice of Appeal is $5.00.

Stay Pending Appeal - by special exception, a Judgment directing a patent accounting is not automatically stayed by an appeal (FRCP 62). A stay of the Judgment, and approval of a Supersedeas bond, must first be sought in the District Court (FRAP 8a).

Record on Appeal - is composed of the original papers and exhibits filed in the District Court, the transcript of proceedings, and a certified copy of the docket entries prepared by District Court (FRAP 10a).

Transcript of Proceeding or Agreed Statement (FRAP 10b) - within 10 days after filing the Notice of Appeal, appellant shall order from the reporter a transcript of those parts of the proceedings not already on file which are to be included in the record. Unless the entire transcript is included in the record, appellant shall also, within said 10 days after filing the Notice of Appeal, file and serve on appellee a description of the transcript ordered and a statement of the issues. Within 10 days after service of appellant's statement, appellee shall file and serve on appellant any additional parts of the transcript to be included. See FRAP 10b, made mandatory by FRAP 11a. Alternatively, if an agreed statement is to be filed as the record, it shall be approved by the District Court and certified to the Court of Appeals within the time for transmission of the record (FRAP 10d).

Transmission of the Record on Appeal - within 40 days after filing Notice of Appeal (FRAP 11a). Duty on appellant after filing notice of appeal to take all action necessary to enable clerk to assemble and transmit the record. For procedure to retain record in District Court for parties use in preparing appellate papers, see FRAP 11c (appeal must

still be docketed). Parties may stipulate to part of record to be retained in District Court (FRAP 11f).

Docket the Appeal and File the Record - within time for transmission of the record, appellant shall pay docket fee to Clerk of Court of Appeals (FRAP 12a), the Clerk of the Court of Appeals to file record after receipt and give notice of date filed (FRAP 12b).

Joint Appendix to the Briefs - filed within 40 days after record filed. Appellant to prepare and file appendix for both parties. For contents of appendix see FRAP 30a and for form see FRAP 30d and 32a. In absence of agreement, appellant within 10 days after record filed shall serve on appellee the parts of record he will include in appendix and a statement of issues. Appellee within 10 days after receipt shall serve upon appellant those parts he wishes included (FRAP 30b). Unless agreed, cost of appendix is initially paid by appellant (FRAP 30b). Appellant may elect to file appendix 21 days after service of appellee's brief. Notice of election must be filed and served within 10 days after record filed (see FRAP 30c for all provisions on deferred appendix). 10 copies of appendix for the Court, 1 copy for opposing counsel (FRAP 30a).

Appellant's Brief - filed within 40 days after record filed (FRAP 31a). Not to exceed 50 pages of typographic printing or 70 pages of printing by other means (FRAP 28g). For contents, see FRAP 28a, and for form, see FRAP 32a. 25 copies for the Court, 2 copies for opposing counsel (FRAP 31b).

Appellee's Brief - filed within 30 days after service of appellant's brief. Not to exceed 50 pages of typographic printing or 70 pages of printing by other means (FRAP 28g). For contents, see FRAP 28b, and for form, see FRAP 32a. 25 copies for the Court, 2 copies for opposing counsel (FRAP 31b).

Appellant's Reply Brief - filed within 14 days after service of appellee's brief, but at least 3 days before argument (FRAP 31a). Not to exceed 25 pages of typographic printing or 35 pages of printing by other means (FRAP 28g). For form, see FRAP 32a (no provision for contents). 25 copies for the Court, 2 copies for opposing counsel (FRAP 31b).

After Entry of Judgment by Court of Appeals - Petition for rehearing filed within 14 days after entry (FRAP 40a); writ of certiorari within 90 days after entry (28 USC 2101c).

July 26, 1968

VIA AIR MAIL

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Dear Bob:

* I enclose a copy of a letter and of the docket entries which we received today from the court.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

Rines -

7/10/68

less than $250,000 on terms for last year -
Port bond

2nd week in August - Pierce & Maine -

Check re bond for Official -

Rines
Next week

Wed NY - BT -

the rest of the week on beat

207 - 534 - 2571

July 8, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Mass. 02109

Re: The University of Illinois v. Blonder-Tongue et al

Dear Bob:

In the event you want to talk to Dick Phillips * about the decision in the above case, you can reach him at Ransburg Electro-Coating Corp., Indianapolis, Indiana, 317-291-6330.

Sincerely,

JRA:DB

* this week

July 2, 1968

MEMORANDUM

TO: RICHARD S. PHILLIPS

Re: Blonder-Tongue

Keith Cooley representing the defendant in the Iowa case called to inquire as to whether or not a decision had been made to appeal the above case. I told him that we had not been in touch with Rines since he had received a copy of the decision but that we probably would be discussing it with him tomorrow. Cooley will probably call you tomorrow afternoon about it.

He also stated that they believed the decision of the Court of Appeals in his case would come down within the next month.

J.R.A.

JRA:DB

Keeley said that BT is no longer in the antenna business

7/5 - Jack - I heard nothing from Robert - I'll be at Ramberg at least through Thursday - Call and leave a message if I can do anything -

Deb

7/1

Jack -

I'll be here today and Wednesday - Then in Singapore next week -

Dick

June 28, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Mass. 02109

Re: University of Illinois Foundation
v. Blonder-Tongue et al

Dear Bob:

Attached please find copy of the Judgment Order and Memorandum of Decision in the above case about which I told you this morning. By the time that you receive this, Dick Phillips and I will both have had a chance to read the Memorandum of Decision so as to be able to discuss it with you with some degree of intelligence at your convenience.

Yours very truly,

JRA:DB
Enc.

July 26, 1968

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Re: U. of Ill. Foundation v.
Blonder Tongue

Dear Mr. Rines:

At Dick Phillips' request, I am enclosing herewith a memorandum prepared for purposes of docketing time concerning the appeal in the above. The Notice of Appeal to the Court of Appeals was filed with the District Court on July 25, 1968.

Very truly yours,

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Ronald L. Wanke

RLW/dm
Enclosure

July 26, 1968

M E M O R A N D U M

TO: John Rex Allen
Richard S. Phillips
William R. McNair

FROM: Ronald L. Wanke

Re: Procedure for Appeal to U.S. Court of Appeals (U. of Ill. v. Blonder Tongue)

General - as of July 1, 1968, appeals are governed by the new Federal Rules of Appellate Procedure (FRAP), which supersede Rules 72-76 of the Federal Rules of Civil Procedure (FRCP) and the local rules of the Seventh Circuit (gray colored pamphlet). Certain language is my interpretation of the rules, please read the actual rules if you believe there is a change from old practice. A check with the Clerk of the Court of Appeals determined that new local rules are being prepared, but are not yet available. The Clerk's office said the FRAP probably contains all procedures which we should follow, and the new local rules will mainly cover miscellaneous matters such as calendars. No comparison between the new FRAP and the old

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Appellee's Brief - filed within 30 days after service of appellant's brief. Not to exceed 50 pages of typographic printing or 70 pages of printing by other means (FRAP 28g). For contents, see FRAP 28b, and for form, see FRAP 32a. 25 copies for the Court, 2 copies for opposing counsel (FRAP 31b).

Appellant's Reply Brief - filed within 14 days after service of appellee's brief, but at least 3 days before argument (FRAP 31a). Not to exceed 25 pages of typographic printing or 35 pages of printing by other means (FRAP 28g). For form, see FRAP 32a (no provision for contents). 25 copies for the Court, 2 copies for opposing counsel (FRAP 31b).

After Entry of Judgment by Court of Appeals - Petition for rehearing filed within 14 days after entry (FRAP 40a); writ of certiorari within 90 days after entry (28 USC 2101c).

July 25, 1968

VIA AIR MAIL

Mr. Isaac S. Blonder
Blonder-Tongue Laboratories Inc.
9 Alling Street
Newark, New Jersey

Dear Ike:

* I enclose the bond application form in connection with your appeal. This should be signed by an officer of Blonder-Tongue Laboratories Inc., the signature notarized and the form returned to me.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. R. H. Rines

June 27, 1968
(Dictated June 26, 1968)

VIA AIR MAIL

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Dear Bob:

I just talked with Mike Cass. He tells me that he ran into Judge Hoffman's clerk on the street and learned that the decision is presently being typed and will be mailed to counsel before the end of the term, which is Friday. This means that we should get the decision this week or early next week. I will call you when it comes.

Very truly yours,

Richard S. Phillips

RSP:iag

May 22, 1968

VIA AIR MAIL

Mr. Theodore Abeles
Lum, Biunno & Tompkins
550 Broad Street
Newark, New Jersey 01702

RE: University of Illinois Foundation
v. Blonder Tongue v. JFD

Dear Mr. Abeles:

In accordance with our phone conversation, I * enclose copies of Blonder-Tongue's reply brief to the plaintiff's brief, JFD's brief in opposition to the counterclaim, and Blonder-Tongue's reply brief with regard to the counterclaim.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. R. H. Rines
Mr. I. S. Blonder

RINES AND RINES
ATTORNEYS AT LAW
NO. TEN POST OFFICE SQUARE
BOSTON, MASSACHUSETTS 02109

DAVID RINES
ROBERT H. RINES

CABLE SENIR
TELEPHONE HUBBARD 2-3289

April 24, 1968

VIA AIR MAIL

Richard S. Phillips, Esquire
Hofgren, Wegner, Allen, Stellman & McCord
20 North Wacker Drive
Chicago, Illinois 60606

Re: UIF v. BT v. JFD

Dear Dick:

Thank you for your letter of April 23, 1968.

We concur that there does not appear to be anything gained by specially calling the 8th Circuit argument to Judge Hoffman's attention.

Very truly yours,

RINES AND RINES

RHR:H

By Robert H. Rines

RECEIVED
APR 26 1968
HOFGREN, WEGNER, ALLEN,
STELLMAN & McCORD

McNENNY, FARRINGTON, PEARNE & GORDON

ATTORNEYS AT LAW

920 MIDLAND BUILDING

CLEVELAND, OHIO 44115

TELEPHONE
(216) 623-1040
CABLE ADDRESS
RICHEY

PATENT AND
TRADEMARK LAW

F. O. RICHEY (1878-1964)

HAROLD F. McNENNY
DONALD W. FARRINGTON
JOHN F. PEARNE
CHARLES B. GORDON
ROBERT A. STURGES
WILLIAM A. GAIL
RICHARD H. DICKINSON, JR.
THOMAS P. SCHILLER
LYNN L. AUGSPURGER

JOSEPH L. BRZUSZEK

LLOYD L. EVANS
OF COUNSEL

April 23, 1968

Richard S. Phillips, Esq.
Hofgren, Wegner, Allen, Stellman & McCord
20 North Wacker Drive
Chicago, Illinois 60606

Dear Dick:

Thanks for the copy of Blonder-Tongue's answering brief.

I have read all of the briefs you have sent me and have concluded that the Court cannot lightly sustain the Foundation patents in view of the evidence of invalidity or ignore all of the evidence of unfair competition (despite the obvious weakness of much of it). I'll be awaiting the outcome with more than casual interest.

Sincerely,

JFP:jh

cc: R. H. Rines, Esq.

RECEIVED
APR 24 1968
HOFGREN, WEGNER, ALLEN,
STELLMAN & McCORD

April 23, 1968

VIA AIR MAIL

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: UIF v. BT v. JFD

Dear Bob:

* I enclose a copy of a letter from Keith Kulie regarding the above. I talked with Pete Mann and find that he has not advised Judge Hoffman that the Winegard appeal was argued on April 2.

It is my opinion that if Judge Hoffman has any concern about what the Eighth Circuit Court of Appeals is going to do, he will inquire whether the appeal has been argued. I think there is nothing to be gained by specially calling it to his attention.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

BURMEISTER, KULIE, SOUTHARD & GODULA

135 SOUTH LA SALLE STREET, CHICAGO, ILLINOIS 60603

MARSHALL A. BURMEISTER
KEITH J. KULIE
DONALD B. SOUTHARD
EDMUND A. GODULA

ATTORNEYS AT LAW-FRANKLIN 2-1344, CENTRAL 6-3351

April 22, 1968

RECEIVED
APR 23 1968
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Richard Phillips, Esq.
20 N. Wacker Drive
Chicago, Illinois 60606

Re: University Litigation

Dear Dick:

Thank you for forwarding a copy of the reply brief of Blonder-Tongue to us.

My recollection is that Judge Hoffman indicated he would decide this case within a relatively short period after all of the briefs were on file. Has anyone advised him that the arguments on appeal in the Eighth Circuit were heard on April 2? As I indicated to you earlier, the clerk indicated that we might expect a decision in this case within sixty days to four months after the argument. This is an extimate, of course, and contemplates a decision taken in the normal sequence of cases assigned to the Court of Appeals.

We will, of course, advise you promptly of the decision on appeal in the Eighth Circuit. However, if Judge Hoffman is aware that the Winegard case might be close to a decision on appeal he could defer his decision as to the Isbell patent until the Eighth Circuit decision comes down. This will not help him, of course, with the Mayes patent in issue in your suit.

Sincerely yours,

Keith J. Kulie

KJK:cvw

April 18, 1968

VIA AIR MAIL

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Dear Bob:

* I enclose copies of the reply brief, findings, conclusions and order submitted by the Foundation and of the findings, conclusions and order submitted by JFD. We did not receive a copy of a further brief from JFD and, upon checking with Herb Singer, I found that they did not submit a further brief.

Our proposed judgment order was omitted from the papers that were filed and I am sending it to Judge
* Hoffman today per the enclosed copy.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosures

April 18, 1968

VIA AIR MAIL

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

Dear Bob:

I talked with Keith Kulie about the appeal argument in the Winegard case. Merriam presented the argument and concentrated on three areas:

(1) General antenna background;

(2) Unpredictability;

(3) The K.O. antenna was before the Patent Office.

They anticipate that a decision will be made by the Court of Appeals in something between 60 days and four months.

Very truly yours,

Richard S. Phillips

RSP:iag

McNENNY, FARRINGTON, PEARNE & GORDON

ATTORNEYS AT LAW

920 MIDLAND BUILDING

CLEVELAND, OHIO 44115

TELEPHONE
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JOHN F. PEARNE
CHARLES B. GORDON
ROBERT A. STURGES
WILLIAM A. GAIL
RICHARD H. DICKINSON, JR
THOMAS P. SCHILLER
LYNN L. AUGSPURGER

JOSEPH L. BRZUSZEK

April 16, 1968

Richard S. Phillips, Esq.
Hofgren, Wegner, Allen, Stellman & McCord
20 North Wacker Drive
Chicago, Illinois 60606

Dear Dick:

Many thanks for sending me copies of the briefs in the Foundation-Blonder-Tongue-JFD suit. Those that you sent me are:

1. The Foundation's brief after trial.

2. Blonder-Tongue's brief in support of its counter-claim.

3. Blonder-Tongue's brief replying to the Foundation's brief.

4. JFD's brief replying to Blonder-Tongue on the counterclaim.

Am I correct in assuming that there has been no provision for the Foundation to answer brief number 2 or for Blonder-Tongue to answer brief number 4 in the above list?

Sincerely,

John

JFP:jh

cc: R. H. Rines, Esq.

RECEIVED
APR 17 1968
HOFGREN, WEGNER, ALLEN,
STELLMAN & McCORD

January 31, 1968

VIA AIR MAIL

Mr. Robert H. Rines
Rines and Rines
No. Ten Post Office Square
Boston, Massachusetts 02109

RE: UIF v. BT v. JFD

Dear Bob:

* I enclose a copy of the Foundation's reply brief in the Winegard suit.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

January 18, 1968

Mr. I. S. Blonder
Blonder-Tongue Laboratories Inc.
9 Alling Street
Newark, New Jersey 07102

Dear Ike:

* I enclose copies of the JFD test results for your antennas.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosures

January 8, 1968

Mr. Donald B. Southard
Burmeister, Kulie, Southard & Godula
135 South LaSalle Street
Chicago, Illinois 60603

Dear Don:

* I am returning herewith the Winegard exhibits which were picked up from your office on January 3.

Thanks for loaning them to us.

Sincerely,

Richard S. Phillips

RSP:iag

* Enclosures

BURMEISTER, KULIE, SOUTHARD & GODULA

135 SOUTH LA SALLE STREET, CHICAGO, ILLINOIS 60603

MARSHALL A. BURMEISTER
KEITH J. KULIE
DONALD B. SOUTHARD
EDMUND A. GODULA

ATTORNEYS AT LAW-FRANKLIN 2-1344, CENTRAL 6-3351

January 3, 1967

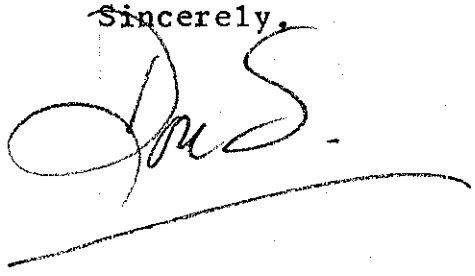
Dick:

Defendant Winegard Company's exhibits H-1 through H-11 are included along with Plaintiff Foundation's exhibits Nos. 58 and 59.

H-3 has been omitted per your instructions. Also, in case you are not aware of it, Exhibit H-2 was not offered in evidence by Winegard.

If there are any questions, please call at any time.

Sincerely,



Don Southard
135 South LaSalle

CE 6-3351

	1.	H-4	5338	Local list - master book of distribution lists
	2.	H-5	5339	Purchase order
	3.	H-6	5340	Notice of delivery from print shop
	4.	H-7	5341	Requisition
	5.	H-8		Purchase order - Q rep. #2 A1-6079
	6.	H-9		Delivery invoice voucher
	7.	H-10		Requisition
*	8.	A-3(a)		Q Rep. #1-6079 (D-7)
*	9.	A-3(b)		Q Rep. #2-6079 (D-8)
	10.	H-1		Transmittal letter - TR36 & Q Rep. #2 ~~T.R.-36~~
*	11.	H-3		T.R. 36 - (D-)
	12.	Pltf-58		Postal receipts
	13.	Pltf-59	5114	Invoice
	14.	H-11		Receiving Report

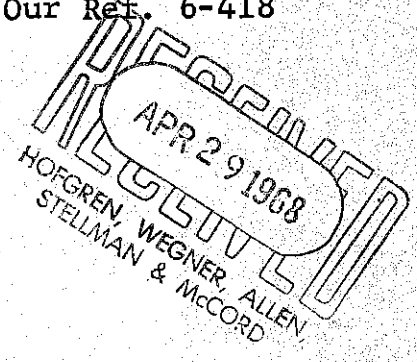
* Not to be picked up from Mr. Southard

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I. IRVING SILVERMAN
MYRON C. CASS
SIDNEY N. FOX
GERALD R. HIBNICK, IND. BAR
RICHARD A. GIANGIORGI
HERBERT J. SINGER
IRVING FABER

April 26, 1968

Our Ref. 6-418



The Honorable Julius J. Hoffman
Judge of the United States District Court
United States Courthouse - Room 2303
219 South Dearborn Street
Chicago, Illinois 60604

Re: University of Illinois Foundation
v.
Blonder-Tongue Laboratories, Inc.
v.
JFD Electronics Corporation
Civil Action No. 66 C 567

Dear Judge Hoffman:

Upon review of the transcript of the record in the above action, we have discovered a number of errors which have not previously been corrected. A list of the corrections which should be made is attached hereto.

Yours very truly,

SILVERMAN & CASS

Myron C. Cass

Myron C. Cass
Attorneys for JFD Electronics
Corporation - Counterclaim Defendant

MCC/gm
Encl.
cc: Merriam, Marshall, Shapiro & Klose
Hofgren, Wegner, Allen, Stellman & McCord

CORRECTIONS IN TRIAL TRANSCRIPT

(N.D. ILL. E.D. 66-C-567)

PAGE	LINE	CORRECTION
703	5&6	change "undersand" to --understand--
704	22	change "pleading" to --motion--
705	17	change "Criminal" to --Civil--
764	17, 18, 21	change "Balish" to --Balash--
765	1, 4	change "Balish" to --Balash--
766	24	change "Balish" to --Balash--
767	2, 7, 17	change "Balish" to --Balash--
768	10, 19	change "Balish" to --Balash--
769	4, 11, 24	change "Balish" to --Balash--
770	3, 16, 24	change "Balish" to --Balash--
771	11, 14, 20	change "Balish" to --Balash--
778	3	change "Helhoske" to --Helhoski--
	11	change "Balish" to --Balash--
780	15	change "Balish's" to --Balash's--
832	20, 21	change "Bohmack" to --Womack--
833	6, 24	change "Bohmack" to --Womack--
834	19	change "Allan" to --Allen--
836	22	change "Helhoski" to --Helhoski--
		change "Balish" to --Balash--
880	15	change "28-A" to --28-C--
905	12, 16	change "Balish" to --Balash--
906	16, 17	change "Helhoske" to --Helhoski--
926	16	change "LAZARS?" to --LASERS?--

PAGE	LINE	CORRECTION
1023	3	change "Duison" to --Dyson--
1050	10	change "Helhoske" to --Helhoski--
1074	14	change "M-1" to --H-1--
1088	4, 5	change "31" to --32--
1162	1	change "A" to --Q--
1189	2	change "instructions" to --constructions--
1191	24	change "back" to --boom--
1197	12	change "we" to --I--
1217	7	change "through" to --from--
1223	7	change "principal" to --parallel--
1243	1	change "RO" to --Ro--
	2	change "ZO" to --Zo--
1256	2	change "specification" to --construction--
1257	14	change "for" to --or--
	16	change "or" to --of--
1278	17	change "Valash" to --Valach--
1279	2	change "Valitch" to --Valach--

Did you want these put in the folders with the exhibits? All of these exhibits in the booklet are in the pocket. The stipulation isn't an exhibit and the other is Mann's (?) list of the BT exhibits.

LIST OF DEFENDANT (B-T) EXHIBITS ADMITTED IN EVIDENCE

EXHIBIT NO.	ADMITTED
DX-1	286
DX-2	286
DX-3	288
DX-4	288
DX-5	287
DX-6	290
DX-7	285
DX-8	285
DX-9	318
DX-10	345
DX-11	323
DX-12	323
DX-13	324
DX-14	372
DX-15	372
DX-16	372
DX-17	372
DX-18	372
DX-19	372
DX-21	366 (Conditionally)
DX-21	376 (Substitute)
DX-22	379
DX-23	377
DX-24	699
DX-26	706
DX-27	730
DX-27A	744 (Original)
DX-27A	856 (w/markings)
DX-27A	1086 (w/markings)
DX-29	721
DX-30	1029
DX-42	777
DX-43	795
DX-46	798
DX-48	843
DX-49	845
DX-50	844
DX-51	846
DX-52	847
DX-53	848
DX-54	851
DX-55	851
DX-56	851
DX-57	851

EXHIBIT NO.	ADMITTED
DX-61	1094
DX-63	1039
DX-65	1026
DX-66	1026
DX-67	1026