LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
JAMES C. WOOD
STANLEY C. DALTON
RICHARD S. PHILLIPS
LLOYD W. MASON
TED E. KILLINGSWORTH
CHARLES L. ROWE
W. E. RECKTENWALD
DILLIS V. ALLEN
WM. A. VAN SANTEN
RONALD L. WANKE

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD
20 NORTH WACKER DRIVE
CHICAGO 60606

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AREA CODE 312

JOHN REX ALLEN
1945-1969

May 16, 1972

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MAY 18 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Donald J. Simpson
Hill, Sherman, Meroni, Gross & Simpson
53 West Jackson Boulevard
Chicago, Illinois 60604

Dear Don:

In accordance with your request to Bob Rines, * I enclose a copy of the Blonder-Tongue brief in the Court of Appeals. If you would be interested in any further information from our file, let me know.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. R. H. Rines

LAW OFFICES

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JOHN REX ALLEN
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July 26, 1972

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JUL 31 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. John F. Pearne
McNenny, Farrington, Pearne & Gordon
450 Tower East
Cleveland, Ohio 44122

Dear John:

* I enclose a copy of the decision in the Blonder-Tongue case.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. R. H. Rines
Mr. W. E. Wyss (*)

LAW OFFICES

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

20 NORTH WACKER DRIVE

CHICAGO 60606

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RONALD L. WANKE

July 27, 1972

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JUL 31 1972

RINES AND RINES

60, TEN POST OFFICE SQUARE, BOSTON

Mr. Nelson H. Shapiro
Shapiro and Shapiro
The Watergate
600 New Hampshire Avenue, N. W.
Washington, D. C. 20037

Dear Nels:

* I enclose a copy of the decision of the Court of Appeals affirming Judge Hoffman's finding of estoppel in the Blonder-Tongue case.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. R. H. Rines

LAW OFFICES

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

60 NORTH WACKER DRIVE

CHICAGO 60606

July 27, 1972

RECEIVED

JUL 31 1972

RINES AND RINES

Mr. Paul J. Foley
Bolan and Foley
840 Pennsylvania Building
425 Thirteenth Street, N. W.
Washington, D. C. 20004

Dear Mr. Foley:

I enclose a copy of the decision of the Court of Appeals affirming Judge Hoffman's finding of estoppel in the Blender-Tongue case.

Very truly yours,

Richard S. Phillips

RSP:lag

Enclosure

cc: Mr. R. H. Rines

LAW OFFICES

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

20 NORTH WACKER DRIVE

CHICAGO 60606

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RONALD L. WANKE

July 27, 1972

RECEIVED

JUL 31 1972

RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Keith Kulie
P. O. Box 88
Chicago, Illinois 60635

Dear Keith:

* I enclose a copy of the Court of Appeals decision in the Blonder-Tongue case.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. R. H. Rines

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
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JOHN REX ALLEN
1945-1969

July 26, 1972

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JUL 31 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Dear Mr. Rines:

* I enclose a copy of the decision of the 7th Circuit Court of Appeals in the Blonder-Tongue case. I have sent a copy also to Mr. Blonder. I understand he will see Bob in Scotland next week.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

In the
United States Court of Appeals
For the Seventh Circuit

SEPTEMBER TERM, 1971 — APRIL SESSION, 1972

No. 71-1879

UNIVERSITY OF ILLINOIS FOUNDATION,
Plaintiff-Appellant,

v.

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

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

66 C 567

JULIUS J. HOFFMAN, *Judge.*

ARGUED MAY 16, 1972 — DECIDED JULY 25, 1972

Before DUFFY and CASTLE, *Senior Circuit Judges,* and FAIRCHILD, *Circuit Judge.*

PER CURIAM. This is an appeal from a judgment, on remand from the Supreme Court, that plaintiff patent owner is estopped, by a prior adjudication of invalidity, from asserting the validity of its patent in this action. The decision of the district court is reported,[1] and sets forth the history of this litigation and the reasons, consistent with the decision of the Supreme Court,[2] for sustaining the defense of collateral estoppel.

[1] *University of Ill. Found.* v. *Blonder-Tongue Lab., Inc.,* 334 FSupp. 47 (N.D.Ill., 1971).

[2] *Blonder-Tongue* v. *University of Illinois Foundation,* 402 U.S. 313 (1971).

We adopt the opinion of the district court, adding the following comments:

On oral argument on appeal, plaintiff stressed its claim that although the courts which decided *Winegard* purported to employ *Graham* standards in deciding the subject matter was obvious, they did so defectively. The defect was said to be reliance upon the proposition that the results achieved by Isbell, though unpredictable, were achieved by logical exploration within known principles. Review by the court which considers the plea of collateral estoppel of the reasoning of the court which made the prior adjudication would be inconsistent with the doctrine of collateral estoppel. There can be no question but that the *Winegard* courts did "grasp the technical subject matter and issues in suit." Even if those courts erred in the reasoning challenged by plaintiff, we are confident that such error would not be a defect of the magnitude contemplated by the Supreme Court as a reason why the court in the second action should deny the effect of estoppel to the earlier judgment.

Recent decisions of other courts are consistent with the decision of the district court in this case.[3]

The judgment appealed from is affirmed.

A true Copy:

Teste:

.....

Clerk of the United States Court of Appeals for the Seventh Circuit.

[3] *Bourns, Inc. et al.* v. *Allen Bradley Co., et al.*, No. 70 C 1992, N.D.Ill. (Feb. 7, 1972); *Blumcraft of Pittsburgh* v. *Architectural Art Mfg., Inc.*, 337 F.Supp. 853 (D. Kansas, 1972).

USCA 3921—The Scheffer Press, Inc., Chicago, Illinois—7-25-72—200

Villanova Law Review
VILLANOVA UNIVERSITY
VILLANOVA, PENNA. 19085

February 11, 1972

Gen'l Corres.

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FEB 14 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Robert H. Rines, Esquire
Rines & Rines
10 P.O. Square - Room 1316
Boston, Mass. 02109

Dear Mr. Rines:

The Villanova Law Review is considering commenting on the case of Blonder-Tongue v. University Foundation.

To help us determine the feasibility of doing so we would appreciate your forwarding to us a copy of your brief and any supplementary material or information you feel is applicable.

Please be assured that all such material will be promptly returned upon completion of our research.

Respectfully yours,

James Shellenberger

FD:M

James Shellenberger
Research Editor

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
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JOHN B. McCORD
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CHICAGO 60606

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JOHN REX ALLEN
1945-1969

March 9, 1972

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MAR 13 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Dear Bob:

We have checked with the Clerk of the Court of Appeals to try to determine when the Blonder-Tongue case may be heard. We find that cases have presently been scheduled through the month of April. The Court will be in recess the first two weeks in May. The Blonder-Tongue case is one of some one hundred which are waiting to be set for hearing. It might be scheduled sometime in the period from the last week of May through the middle of June. If it should not be heard at that time, it is likely that it will be put over until the fall.

Very truly yours,

Richard S. Phillips

RSP:iag

cc: Mr. I. S. Blonder

file

March 5, 1971

Mr. Ben Tongue
Blonder-Tongue Laboratories, Inc.
One Jake Brown Road
Old Bridge, New Jersey 08857

Dear Ben:

We are sending, under separate cover, an extra copy of the Petitioner's brief and Appendices Volume I and II, and a Supplement to Volume II for your files in connection with the Supreme Court University of Illinois case.

You might be interested to know that, following the hearing additional parties have requested the permission of the Court to file briefs and just today, we have received a ruling of the Court that it was going to permit such filing (this matter bearing on the Triplett v. Lowell issue).

Very truly yours,

RINES AND RINES

By_____
Robert H. Rines

RHR/ch

April 12, 1972

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

Re: May 16 Hearing Court of Appeals -- University of Illinois v. Blonder-Tongue

Dear Dick:

Ike Blonder will be in Chicago at the time of the above hearing and he is reserving hotel accomodations for me at the Hilton, he thinks, the evening of the 15th.

Can you plan to meet with us to go over the strategy for the oral argument on the 16th.

Very truly yours,

RINES AND RINES

By
Robert H. Rines

RHR/ch
cc:Mr. Isaac Blonder

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
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JAMES C. WOOD
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20 NORTH WACKER DRIVE

CHICAGO 60606

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JOHN REX ALLEN
1945-1968

April 3, 1972

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RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Dear Bob:

I assume you have the notice setting the hearing before the Court of Appeals for Tuesday, May 16. Can we make a hotel reservation for you?

Very truly yours,

Dick

Richard S. Phillips

RSP:iag

United States Court of Appeals

FOR THE SEVENTH CIRCUIT

Chicago, Illinois 60604

RECEIVED RECEIVED Chicago, March 31, 1972

APR 3 APR 3

RINES AND RINES RINES AND RINES

NO. TEN POST OFFICE SQUARE, BOSTON NO. TEN POST OFFICE SQUARE, BOSTON

Gentlemen:

Cause No. 71-1879

UNIVERSITY OF ILLINOIS FOUNDATION,
Plaintiff and Counterclaim
Defendant-Appellant,

vs.

BLONDER-TONGUE LABORATORIES, INC.,
Defendant and Counterclaimant - Appellee,
and
JFD ELECTRONICS CORPORATION, Counterclaim Defendant-Appellee.

has been set for hearing on TUESDAY, May 16, 1972

at the Court Room of the United States Court of Appeals for the Seventh Circuit. 219 South Dearborn Street, Chicago.

Court convenes at 9:30 A. M.

Respectfully,

KENNETH J. CARRICK,
Clerk

NOTE: Oral argument is limited to 30 minutes for each side, pursuant to Rule 34(b) of the Federal Rules of Appellate Procedure effective July 1, 1968, and Circuit Rule 11(b), effective July 1, 1968.

to: Mr. Robert H. Rines, 10 Post Office Square, Boston, Mass. 02109
Mr. Richard S. Phillips, 20 N. Wacker, Chicago, Illinois 60606
Mr. Charles J. Merriam, Two First National Plaza, Chicago, Illinois 60670
Mr. Myron C. Cass, 105 West Adams, Chicago, Illinois
Mr. Jerome M. Berliner, 10 E. 40th Street, New York, N.Y.

LAW OFFICES

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

20 NORTH WACKER DRIVE

CHICAGO 60606

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JOHN REX ALLEN
1945-1969

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
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JAMES C. WOOD
STANLEY C. DALTON
RICHARD S. PHILLIPS
LLOYD W. MASON
TED E. KILLINGSWORTH
CHARLES L. ROWE
W. E. RECKTENWALD
DILLIS V. ALLEN
WM. A. VAN SANTEN
RONALD L. WANKE

December 4, 1972

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DEC 6 1972
RINES AND RINES
[illegible] POST OFFICE SQUARE, BOSTON

Mr. Isaac S. Blonder
Blonder-Tongue Laboratories Inc.
P/O Box 664
One Jake Brown Road
Old Bridge, New Jersey 08857

Dear Ike:

At long last we have finally pried a little money out of the University of Illinois Foundation.
* I am pleased to enclose a check to you for $3918.19.

Don't spend it all chasing the Loch Ness Monster.

Sincerely,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. R. H. Rines

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
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20 NORTH WACKER DRIVE
CHICAGO 60606

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JOHN REX ALLEN
1946-1969

Spoke to Phillips on phone - Feb 4 '72
He'll try to draft

January 28, 1972

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JAN 31 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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 brief which was served on us this afternoon. Our reply is due in 30 days. February 27, however, is a Sunday and the brief may be filed Monday, the 28th. We are limited by the Federal Rules of Appellate Procedure to 25 printed pages.

If you wish me to prepare the first draft, please let me know promptly.

I am sending copies to John Pearne and others who may be interested.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. I. S. Blonder (*)

OSTROLENK, FABER, GERB & SOFFEN
ATTORNEYS AT LAW
10 EAST 40TH STREET
NEW YORK, N.Y. 10016

SAMUEL OSTROLENK
1898-1968

SIDNEY G. FABER
BERNARD GERB
MARVIN C. SOFFEN
SAMUEL H. WEINER
JEROME M. BERLINER
LOUIS WEINSTEIN
MARC S. GROSS
ROBERT C. FABER

EDWARD A. MEILMAN
HOWARD SCHULDENFREI

PATENTS
TRADE MARKS
RELATED CAUSES

TELEPHONE
(212) 685-8470

CABLE:
OSTROFABER NEW YORK

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NO. TEN POST OFFICE SQUARE, BOSTON

April 5, 1972

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NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Kenneth J. Carrick, Clerk
United States Court of Appeals
For The Seventh Circuit
Chicago, Illinois 60604

Dear Mr. Carrick:

Re: Cause No. 71-1879
Our Ref. JFD3.223

Reference is made to the Notice of Hearing dated March 31, 1972, (copy annexed) for Cause No. 71-1879.

It is believed that the caption on this Notice refers improperly to our client, JFD Electronics Corporation, as "Counterclaim Defendant-Appellee." That is, the issue involved in this Cause on Appeal relates solely to the complaint, and down below JFD was merely a Counterclaim-Defendant. JFD is not a party to this Cause on Appeal.

Accordingly, it is respectfully requested that reference to JFD as Appellee or otherwise be removed from the caption of this Cause on Appeal.

Respectfully,

Jerome M. Berliner

JMB:jab
enclosure

cc: Robert H. Rines, Esq.
Richard S. Phillips, Esq.
Charles J. Merriam, Esq.
Myron C. Cass, Esq.

COPY

File

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
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JAMES C. WOOD
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JOHN REX ALLEN
1945-1969

March 17, 1972

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MAR 20 19[illegible]
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Dear Bob:

* I enclose a copy of a letter Merriam has written the Clerk of the Court of Appeals. I see no reason for us to write the Clerk and comment on it.

I have read the Foundation's brief several times without coming to any firm conclusion regarding what they are trying to say. Apparently a principal point they will argue is that the Winegard decision was not "final" at the time the Blonder-Tongue trial started. I think the force of this argument is significantly reduced by the Supreme Court's refusal of certiorari in Monsanto v. Dawson.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

CHARLES J. MERRIAM
WILLIAM A. MARSHALL
JEROME B. KLOSE
NORMAN M. SHAPIRO
BASIL P. MANN
CLYDE V. ERWIN, JR.
ALVIN D. SHULMAN
EDWARD M. O'TOOLE
ALLEN H. GERSTEIN

LAW OFFICES
MERRIAM, MARSHALL, SHAPIRO & KLOSE
TWO FIRST NATIONAL PLAZA
CHICAGO, ILLINOIS 60670
TELEPHONE
312 · 346 - 5750
TELEX 25 - 3856

OWEN J. MURRAY
DONALD E. EGAN
NATE F. SCARPELLI
CARL KUSTIN
MICHAEL P. BUCKLO
CARL E. MOORE, JR.
ROBERT D. WEIST
MICHAEL F. BORUN

March 16, 1972

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MAR 17 1972
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Mr. Kenneth J. Carrick
Clerk of the Court
U.S. Court of Appeals, 7th Circuit
219 South Dearborn Street
Chicago, Illinois 60604

Re: University of Illinois Foundation
vs. Blonder-Tongue Laboratories, Inc.
No. 71-1879

Dear Mr. Carrick:

When this case was originally heard, the panel was Judges Duffy, Castle and Fairchild, with Judge Fairchild writing the opinion. This is to suggest to the court the possibility that, if it is consistent with court policy, there would be a saving of judicial time if the same panel were available to hear it the second time.

This is particularly pertinent here since the background facts are complex and the issue now presented may require some consideration by the panel of the relevant content of its previous decision. The Supreme Court did not in any way contradict this court's reasoning but based its decision on an issue not presented to this court and which involved a repudiation of the Supreme Court's own prior rulings.

Very truly yours,

Charles J. Merriam

CJM/ms

cc: Richard S. Phillips, Esq.

LAW OFFICES

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March 9, 1972

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RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Kenneth J. Carrick
Clerk of the Court
U. S. Court of Appeals, 7th Circuit
219 South Dearborn Street
Chicago, Illinois 60604

RE: University of Illinois Foundation
v. Blonder-Tongue Laboratories, Inc.
No. 71-1879

Dear Sir:

In the Brief for Appellee, there is a reference in the last two lines of page 13 to a petition for certiorari filed by Monsanto Company in a suit against Dawson Chemical Company. This petition was denied by the Supreme Court on March 6. Accordingly, we wish to amend page 13 of the brief as follows:

In the next to the last line, strike "was";

In the last line, following "1971" insert -- , was denied March 6, 1972 --.

Very truly yours,

Richard S. Phillips

RSP:iag

cc: Mr. C. J. Merriam
Mr. R. H. Rines

March 9, 1972

Marvin H. Kleinberg, Esquire
Golove, Kleinberg & Morgenstern
6505 Wilshire Boulevard
Los Angeles, California 90048

Dear Marv:

RE: BLONDER-TONGUE ELECTRONICS v. HOWARD MERCER dba MACOM INUDSTRIES - United States District Court, Central District of California, CA 71-2459-HP

Replying to your notice of February 25, 1972 from the Court, we trust you will be able to attend the informal conference with the Judge on March 16.

We suggest that the complete impertinence of the cited art and the identical copying of the product should be made plain.

It was our understanding that at least previous counsel indicated the item would be redesigned.

Very truly yours,

RINES AND RINES

Robert H. Rines

RHR:la
cc: Ike Blonder

UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
UNITED STATES COURT HOUSE
LOS ANGELES, CALIFORNIA 90012

HARRY PREGERSON
JUDGE

RECEIVED
FEB 28 1972

February 25, 1972

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MAR 3 1972
RINES AND RINES
TEN POST OFFICE SQUARE, BOSTON

Mr. Marvin H. Kleinberg
Golove, Kleinberg &
Morgenstern (Suite 415)
6505 Wilshire Blvd.
Los Angeles, Calif. 90048

Mr. Martin R. Horn
Spensley, Horn, Jubas & Lubitz
Suite 500
1880 Century Park, East
Los Angeles, Calif. 90067

Case No. 71-2459-HP
BLONDER-TONGUE ELECTRONICS
v. HOWARD MERCER dba MACOM Ind.

Gentlemen:

I am engaged in reviewing certain pending cases on my calendar. I want to learn more of the factual background and legal aspects of the above-entitled case and its present status. You are therefore requested to come to my Chambers for an informal conference concerning the above-entitled action.

The conference will be held on March 16, 1972 at 9:30 A. M.

It is important that the attorney appearing be fully acquainted with the facts and the problems of law involved in the case.

Among other things, I will want to discuss the possibility of settlement. Even if settlement negotiations are underway at this time, I will still expect you on the above date for a report. However, if the case is effectively settled as to all parties, please inform my secretary of that fact and your presence will not be required.

If any new attorneys enter this case after the date of this letter by substitution or by the addition of new parties, it is the joint responsibility of addressee counsel to notify such new counsel in writing of the above hearing date and time.

Yours very truly,

Harry Pregerson

HARRY PREGERSON

HP:js

McNENNY, FARRINGTON, PEARNE & GORDON
450 TOWER EAST
CLEVELAND, OHIO 44122

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MAR 10 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

March 8, 1972

COPY

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

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

Dear Dick:

I have been slow in acknowledging receipt of the printed copy of Blonder-Tongue's appeal brief in the pending appeal in the above case. I have read it carefully and believe that a splendid job was done in focusing attention on the issues that should be controlling and in developing those issues to support the position of Blonder-Tongue.

I shall look forward to hearing further from you as the appeal proceeds and, of course, wish you and Bob the best of luck in bringing this matter to a successful, final conclusion.

Sincerely,

McNENNY, FARRINGTON, PEARNE & GORDON

John

J. F. Pearne

JFP:jh

cc: Mr. L. H. Finneburgh, Jr.
Robert H. Rines, Esq.

LAW OFFICES

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JOHN REX ALLEN
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March 2, 1972

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MAR 6
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Mr. Kenneth J. Carrick
Clerk of the Court
U. S. Court of Appeals, 7th Circuit
219 South Dearborn Street
Chicago, Illinois 60604

RE: University of Illinois Foundation
v. Blonder-Tongue Laboratories, Inc.
No. 71-1879

Dear Sir:

There is a typographic error on page 14 of appellee's brief. In the last line, "estopped" should be -- estoppel --.

Very truly yours,

Richard S. Phillips

RSP:iag

cc: Mr. C. J. Merriam
Mr. R. H. Rines

Sent from Fla. Nov 8/71

BRUMBAUGH, GRAVES, DONOHUE & RAYMOND

90 BROAD STREET

NEW YORK, N.Y. 10004

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EBEN M. GRAVES
MARK N. DONOHUE
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JOHN F. NEARY, JR.
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RICHARD G. FULLER, JR.
JAMES N. BUCKNER
FRANK W. FORD, JR.
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GEORGE W. WHITNEY

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ROBERT NEUNER

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NO. TEN POST OFFICE SQUARE, BOSTON

November 3, 1971

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

Re: Blonder-Tongue Panel
APLA - October 22, 1971

Dear Bob:

Charlotte has sent you, I understand, the transcript of your opening statement.

I am enclosing some comments which you made during the question period which you may like to take a look at. Let me know if you have any editing to suggest.

Charlotte would like to have this material by the end of this week or early next week, if possible.

Best regards.

Sincerely,

Enc p. 99-103
108-109
113-114

LAW OFFICES

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RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Kenneth J. Carrick
Clerk of the Court
U. S. Court of Appeals, 7th Circuit
219 South Dearborn Street
Chicago, Illinois 60604

RE: University of Illinois Foundation
v. Blonder-Tongue Laboratories, Inc.
No. 71-1879

Dear Sir:

We occasionally receive mail from the Court in connection with the above case directed to John Rex Allen. Mr. Allen died a couple of years ago and his name should be removed from the records of this case. If my name is not already of record, please enter it and direct correspondence to me.

Very truly yours,

Richard S. Phillips

RSP:iag

cc: Mr. Charles J. Merriam
Mr. Robert H. Rines

LAW OFFICES

AXEL A. HOFGREN
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MAR 3 [illegible]

RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Myron C. Cass
Silverman & Cass
105 West Adams Street
Chicago, Illinois 60603

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

Dear Mike:

I enclose a couple of copies of Blonder-Tongue's brief in the Court of Appeals. I thought you and Jerry Berliner might be interested.

Very truly yours,

Richard S. Phillips

RSP:iag

Enclosure

cc: Mr. R. H. Rines

LAW OFFICES

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February 29, 1972

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MAR 3 [illegible]
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NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Paul J. Foley
Belen and Foley
840 Pennsylvania Building
425 - 13th Street, N. W.
Washington, D. C. 20004

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

Dear Mr. Foley:

We have the Blonder-Tongue case back to the Seventh Circuit Court of Appeals. I enclose a copy * of the Blonder-Tongue brief.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. R. H. Rines

LAW OFFICES

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RONALD L. WANKE

February 18, 1972

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RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

RE: UIF v. B-T

Dear Bob:

* I enclose a copy of appellee's brief in the form I am delivering to the printer this afternoon. I hope to have page proof next Tuesday ~~or Wednesday~~. If you have any suggestions, call me. I will be out of town Monday but should be in the office Tuesday.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. I. S. Blonder (*)
Mr. J. F. Pearne (*)

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
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RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Jerome M. Berliner
Ostrolenk, Faber, Gerb & Soffen
10 East 40th Street
New York, New York 10016

RE: Blonder-Tongue v. University of
Illinois Foundation et al
Supreme Court, October Term 1970
No. 338

Dear Jerry:

Mr. Gullickson, assistant clerk of the Supreme Court, called me a few days ago and requested that arrangements be made to pick up the exhibits which were sent there. I have arranged for ours to be picked up. I suggest you do likewise or advise Mr. Gullickson that they may be thrown out.

Very truly yours,

Richard S. Phillips

RSP:iag

LAW OFFICES

AXEL A. HOFGREN
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February 16, 1972

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FEB 18
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. John F. Pearne
McNenny, Farrington, Pearne & Gordon
450 Tower East
Cleveland, Ohio 44122

Dear John:

* I enclose a copy of a draft of the brief for Blonder-Tongue. I would be pleased to have your comments and suggestions.

Good luck in your effort to secure an appointment to the CCPA. I think you could make a real contribution to the patent system.

Sincerely yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. R. H. Rines

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
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1945-1969

September 16, 1972

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FEB 18 '72

RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Nelson H. Shapiro
Shapiro and Shapiro
640 Washington Building
15th and New York Avenue, N. W.
Washington, D. C. 20005

RE: Blonder-Tongue v. University of
Illinois Foundation et al
Supreme Court, October Term 1970
No. 338

Dear Nels:

I had a call from Mr. Gullickson, Assistant Clerk, regarding disposition of the exhibits which were sent to the Supreme Court. Only a couple of them were ours. They are defendant's exhibits 24, a small model of an antenna made out of heavy wire, and 29, a piece of transmission line which was connected with plaintiff's exhibit 10, a Blonder-Tongue Golden Dart UHF antenna. I would like you to arrange for someone to pick up these three exhibits and send them back to me. There are several other antennas which were sent to the Supreme Court at the request of either the Foundation or JFD. We have no need for them and I am writing respective counsel suggesting that they make their own arrangements.

Very truly yours,

Richard S. Phillips

RSP:iag

cc: Mr. R. H. Rines

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
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February 16, 1972

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RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Office of the Clerk
Supreme Court of the United States
Washington, D. C. 20543

ATTENTION: Mr. Gullickson
Assistant Clerk

RE: Blonder-Tongue v. University of
Illinois Foundation et al
Supreme Court, October Term 1970
No. 338

Dear Mr. Gullickson:

I have asked Nelson H. Shapiro, Esq. of Washington to pick up the exhibits which were sent to the Court on behalf of Blonder-Tongue. I have also written counsel for the University of Illinois Foundation and JFD Electronics to take care of their exhibits.

Very truly yours,

Richard S. Phillips

RSP:iag

LAW OFFICES

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February 16, 1972

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RINES AND RINES

NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Basil P. Mann
Merriam, Marshall, Shapiro & Klose
Two First National Plaza, Suite 2100
Chicago, Illinois 60670

RE: Blonder-Tongue v. University of
Illinois Foundation et al
Supreme Court, October Term 1970
No. 338

Dear Pete:

Mr. Gullickson, assistant clerk of the Supreme Court, called me a few days ago and requested that arrangements be made to pick up the exhibits which were sent there. I have arranged for ours to be picked up. I suggest you do likewise or advise Mr. Gullickson that they may be thrown out.

Very truly yours,

Richard S. Phillips

RSP:iag

February 18, 1972

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

Dear Dick:

RE: BLONDER-TONGUE REPLY BRIEF

Replying to your letter of February 14, and the further draft of the brief, this apparently crossed our letter in the mail.

We share your feeling that too much dignity to some of the points is not warranted and feel that perhaps too much explanation may be presented in connection with Blumcraft.

The point that is determinitive, we feel, is that knowing all about equities and two decisions, the Supreme Court specifically ordered this remand as applicable in this case.

Cordially,

RINES AND RINES

Robert H. Rines

RHR:la

Bcc: Messrs. Blonder Tongue

LAW OFFICES

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February 14, 1972

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RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Dear Bob:

* I enclose a revision of the rather rough draft I sent you last Friday. I am still not completely satisfied with the latter portion of the argument, but I don't want to dignify some of the points raised by the Foundation by making too much of them. The brief is due entered February 28. If you can get me your comments by the end of the week, we should be able to have it completed without the need for an extension of time.

Very truly yours,

Dick

Richard S. Phillips

RSP:iag

* Enclosure

REPLY BRIEF

STATEMENT OF THE CASE

The statement of the case in Foundation's brief contains two errors:

(1) The decisions of the District Court for the Southern District of Iowa and the Court of Appeals for the Eighth Circuit holding the Isbell patent invalid were not limited to certain claims, but treated the patent as a whole. (Supp. App. 97 and 77).

(2) The District Court here held Foundation estopped to assert validity of the Isbell patent, rather than estopped from enforcing the patent.

The decision of the Supreme Court in this case modified the 1936 decision in Triplett v. Lowell and provided a presumptive estoppel in favor of an accused infringer where a patent has been held invalid. Section IIIA of the Supreme Court decision outlines the procedure to be followed. First, the defendant in support of a plea of estoppel should identify the issue in suit as the identical question finally decided against the patentee in previous litigation. Then patentee must have an opportunity to rebut the presumptive estoppel by demonstrating that it did not have "'a fair opportunity procedurally, substantively and evidentially to pursue his claim the first time.'" The Court suggests certain inquiries appropriate in

determining whether patentee had a full and fair chance to litigate validity in the earlier case where the issue is one of nonobviousness, as it is here.

(a) Whether the first validity determination purported to employ the standards announced in Graham v. John Deere Co.

(b) Whether the opinions indicate that the prior case was one of the relatively rare instances where the courts wholly failed to grasp the technical subject matter and issues.

(c) Whether, without fault, patentee was deprived of crucial evidence or witnesses in the first litigation.

The Court's concluding admonition is that the decision (whether patentee had a full and fair chance to litigate in the earlier case) will necessarily rest on the trial court's sense of justice and equity. (Supp. App. 39-40)

The Supreme Court in Section IV of its opinion remanded this case with instructions that Blonder-Tongue be allowed to amend its pleadings to assert estoppel, that Foundation be permitted to amend its pleadings and to supplement the record with any evidence showing why estoppel should not be imposed.

These instructions have been followed. Blonder-Tongue filed an amended answer (Supp. App. 6) setting up an affirmative defense of collateral estoppel based on the decisions of the Iowa District Court and the Court of Appeals for the Eighth Circuit, finding the Isbell patent invalid for obviousness. ~~(Supp. App. 10, 11)~~ Motions for judgment were filed by both

parties. (Supp. App. 10, 11) The District Court (Supp. App. 12) fissued a memorandum making findings that:

(1) Procedurally Foundation had a fair opportunity to pursue its claim in Iowa and the Eighth Circuit, specifically commenting on the convenience of the forum, incentive to litigate, identity of issues raised and decided, and opportunity to present all crucial evidence and witnesses. (Supp. App. 14)

(2) The decisions of the Iowa District Court and the Eighth Circuit Court of Appeals reveal "a conscientious effort to apply the standards laid down in Graham v. John Deere Co., supra, and a careful evaluation of the issues.", and the difference in conclusions reached regarding obviousness "does not demonstrate that either court 'wholly failed to grasp the technical subject matter.'" (Supp. App. 15)

(3) Foundation arguments that the cost of a retrial had already been incurred; the Winegard decision was not final when the Blonder-Tongue trial was held; and defendant did not plead estoppel earlier, were all based on facts before the Supreme Court and could not be asserted to defeat the estoppel. (Supp. App. 16)

(4) The whole Isbell patent was in issue in the Iowa case and there held to be invalid. (Supp. App. 16)

The District Court concluded that Foundation had not shown any reason why estoppel was improper and entered judgment for Blonder-Tongue. (Supp. App. 17)

Foundation's statement of facts makes reference to facts in the record here relating to substantive patent issues. These are not involved in the questions to be considered under the Supreme Court mandate.

SUMMARY OF ARGUMENT

(1) The decisions of the Iowa District Court and the Eighth Circuit Court of Appeals finally decided the question of validity of the Isbell patent.

(2) Foundation has not demonstrated that it was deprived of a full and fair chance to litigate the validity of Isbell in Iowa and the Eighth Circuit.

ARGUMENT

The inquiries prescribed by the mandate of the Supreme Court will be considered in order.

The issue here in question, validity of Isbell over a defense of obviousness, is the identical question decided in Winegard. In the District Court, Judge Stephenson found

> ". . . the disclosure of Isbell'e patent No. 3,210,767 is lacking in the prerequisite non-obviousness and, therefore, invalid." (Supp. App. 97)

The Court of Appeals agreed,

> "We have examined the record and find that all claims must be denied, lacking nonobviousness as a matter of law . . ." (Supp. App. 77)

Foundation objects that claims 6, 7 and 8 were not in issue, but the objection is not supported by the record. The complaint alleged infringement of the patent (Supp. App. 98) and the answer asserted that the patent was null and void

for failure to satisfy the requirements of 35 U.S.C. sections 102 and 103*. (Supp. App. 100) The only reference in the record to claims 6, 7 and 8 is Judge Stephenson's comment that

> "All of the claims except numbers 6, 7 and 8 are claimed to be infringed . . ." (Supp. App. 89)

Neither Winegard decision is limited with respect to specific claims, but both concedes validity of the patent as a single question. In fact, the District Court included claims 6, 7 and 8 with the other claims in Appendix A to its decision, 271 F. Supp. 423. It does not appear that Foundation objected to the scope of the judgments although it did raise other questions which resulted in an amendment of the District Court decision and a correction by the Court of Appeals of a finding by the District Court. (Supp. App. 77, 78) This Court should not presume to limit the judgment of the Eighth Circuit.

The answer in Winegard affirmatively alleged invalidity of Isbell. (Supp. App. 100) It seems Foundation would not question applicability of the decision to claims 6, 7 and 8 had

---

* 35 U.S.C. 103, first sentence, provides:
"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains."

the answer included a counterclaim making the same allegation. To hold that claims 6, 7 and 8 were not at issue in Winegard would put form before substance.

The situation hwere is analogous to that where a court first finds that there is no infringement and then goes on to determine validity. This is a common practice endorsed and urged by the Supreme Court.

> "There has been a tendency among the lower Federal courts in infringement suits to dispose of them where possible on the ground of non-infringement without going into the question of validity of the patent. [citing cases] It has come to be recognized, however, that of the two questions, validity has the greater public importance [citing cases], and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent." Sinclair &. Carroll Co. v. Interchemical Corp., 325 US 327, 89 L.Ed. 1644.

Foundation does not question that the decision in Winegard is final. The immateriality of the relative timing of the Winegard and Blonder-Tongue decisions will be discussed below.

Foundation does not suggest that the courts in Winegard did not purport to employ the investigation and standards of Graham v. John Deere Co.; not does it allege that it was deprived of crucial evidence or witnesses*.

---

* Dr. DuHamel testified at the Blonder-Tongue trial, but did not at the Winegard trial. Presumably his testimony could have been presented at Winegard if Foundation had deemed it desirable.

Foundation asserts only that:

(a) The Iowa and Eighth Circuit Courts failed to grasp the technical subject matter,

(b) The Iowa and Eighth Circuit courts failed to apply the correct standard of invention

in support of the contention that it did not have a full and fair chance to litigate the validity of Isbell. The Supreme Court suggested that imposition of the estoppel would be unfair where

> ". . . the (prior) opinions . . . indicate that the prior case was one of those relatively rare instances where the courts wholly failed to grasp the technical subject matter and issues in suit." (Supp. App. 40)

This is clearly a reference to cases of the character identified in footnote 22 (Supp. App. 38), where the courts frankly admitted uncertainty:

> "The court below in recognition of its avowed limitations rested its decision basically on its evaluation of the relative credibility of opposing expert witnesses." Nyyssonen v. Bendix Corporation, 342 F.2d 531 at 532 (CA 1, 1965).

> "It is an issue which we are altogether incompetent to decide upon the merits; even the terminology is beyond our acquaintance, and what actually takes place in the tubes is inaccessible except by its gross manifestations -- indeed the very elements themselves are in dispute among those who have made them their life study, as the merest smattering of modern physics quickly discloses to a lay reader. While Congress sees fit to set before us tasks which are so much beyond our powers, suitors must be content that we shall resort to the

> testimony of experts, though they are concededly advocates with the inevitable bias that advocacy engenders." Harries v. Air King Products Co., 183 F.2d 158 at 164 (CA 2, 1950).
>
> "I cannot stop without calling attention to the extraordinary condition of the law which makes it possible for a man without any knowledge of even the rudiments of chemistry to pass upon such questions as these. The inordinate expense of time is the least of the resulting evils, for only a trained chemist is really capable of passing upon such facts, . . ." Parke-Davis & Co. v. H. K. Mulford Co., 189 F. 95 at 115 (CC SD NY, 1911).

The decisions in Winegard show no such failure to grasp either the technical subject matter or the issues in suit. Rather, both opinions (as with the District and Appellate Court opinions here) illustrate a remarkable understanding of a difficult subject matter. Judge Stephenson analyzed the Isbell patent, the prior art and the differences between them, and found the differences to be obvious to one skilled in the art. Judge Lay for the Court of Appeals did not perfunctorily affirm, but repeated the inquiries of Graham v. Deere and reached the same conclusion.

This Court is not authorized by the Supreme Court mandate to look into the record of the Blonder-Tongue trial (devoi as it is of testimony on behalf of Blonder-Tongue, regarding obviousness of Isbell) in determining whether the courts in Winegard grasped the subject matter and issues. The opinions there demonstrate clearly a thorough understanding of the subject matter and issues. This satisfies the inquiry suggested

by the Supreme Court.

The issue is neither a resolution of a "disagreement" between the decisions of the Eighth and Seventh Circuits or for this court to speculate whether the Eighth Circuit analysis correctly applied Graham v. Deere. The question asked by the Supreme Court is whether the prior decision "purported" to employ the standards of Graham v. Deere. The Foundation does not suggest that they did not, a reading of the decisions makes it clear that they did and, in fact, the Supreme Court so found (Supp. App. 21).

The Supreme Court did not mandate a comparison of the legal standards of the Eighth and Seventh Circuits and the District Court correctly ignored Foundation's invitation to make a comparison.

The Foundation complains that estoppel here is inequitable, injust or improper as (using Foundation's numbering)

> (2) The Winegard decision was not final, but on appeal to the Eighth Circuit when the Blonder-Tongue trial commenced;
>
> (4) The cost of the second trial has already been incurred;
>
> (5) The parties proceeded in good faith under seemingly settled law and it would be inequitable to impose an estoppel;
>
> (6) Blonder-Tongue did not raise the estoppel issue prior to the Supreme Court decision.

The facts with respect to each of these points were before the Supreme Court and were not considered by it to be

material. The remand and mandate of the Supreme Court established the law of the case with respect to these facts and the District Court correctly held that it could not evade the mandate by holding that they defeat the estoppel plea.

> "The power of a lower tribunal under a mandate of reversal is not unlimited. Where such mandate directs the entry of a specific judgment, the court below has no power to enter a different one, and where the reversing mandate specifies the further proceedings which shall be taken below, or where it definitely limits such proceedings, the power of the lower court is restricted accordingly." Cyclopedia of Federal Procedure, Third Edition, 1965, Revised Volume 14A, Section 69.39.

In Criscuolo v. United States, 250 F.2d 388 (1957), the Court of Appeals for the Seventh Circuit considered a similar situation. Contesting an action on an insurance policy by the named beneficiary, the deceased's widow introduced evidence of an attempt on the part of the insured to change the beneficiary and the performance of an affirmative act supporting such intent. The trial court held the evidence insufficient and found for the named beneficiary. The court of Appeals reversed and remanded to allow the named beneficiary to present evidence to overcome that presented by the widow. No additional evidence was offered, but the trial court held that it did not believe the witnesses which had been presented by the widow, finding again for the named beneficiary. The court of appeals reversed again, Judge Lindley saying:

> "As we have observed, we remanded the cause for the sole purpose of allowing plaintiff an

> opportunity to present evidence to overcome that of the widow. Thus the court below, in merely re-entering the order we had reversed, misconstrued the mandate of this court. In addition, by merely amending its findings to justify its original decision, the district court deviated from the law of the case as established by this court on the previous appeal; [citing cases]" 250 F.2d at 389.

Similarly, the Ninth Circuit held in Hermann v. Brownell, 274 F.2d 842, 843 (1960):

> "When a case is appealed from this Court to the Supreme Court, this Court completely loses jurisdiction of the cause. Thereafter, our jurisdiction can be revived only upon the mandate of the Supreme Court itself, and even upon such restoration, the jurisdiction of this Court is rigidly limited to those points, and those points only, specifically consigned to our consideration by the Supreme Court.
>
> "In the instant case, this Court is functioning under such a remand. Consequently, our jurisdiction is strictly limited to the Supreme Court's mandate. That mandate is our compass and our guide."

We need not speculate what effect may be given in the future to a prior decision which is on appeal at the time a subsequent trial is about to begin. This and related questions of docket load and trial scheduling will have to be worked out on a case-by-case basis. The Winegard decision is final and provides an appropriate basis for an estoppel plea.

An overlap in the timing of trials and decisions was disregarded by the Fifth Circuit in remanding a case for consideration of an estoppel plea. Monsanto Company brought two suits for infringement of a patent, one against Rohm & Haas Co. in Pennsylvania and the other against Dawson Chemical Company

Inc., et al in Texas. The Pennsylvania case was tried first and resulted in a holding that the patent was invalid. The trial in the Texas case was completed before the decision in Pennsylvania, but the decision was rendered later, finding the patent valid. The Texas court commented that the Pennsylvania decision was not res judicata and did not create an estoppel. Both decisions were appealed and neither appeal has yet been decided. The Blonder-Tongue decision was announced by the Supreme Court following the filing of briefs and the hearing of oral arguments in the Dawson case. The Fifth Circuit remanded the case to the District Court to allow the defendant to deliver an estoppel plea and to afford plaintiff an opportunity to show reasons why estoppel should not be allowed, in accordance with the procedure directed by the Supreme Court in Blonder-Tongue, 443 F.2d 1035. A petition for certiorari was filed December 14, 1971.

The facts in the Blumcraft decision (Supp. App. 103) distinguish that case from this. There, the patent was first held valid in the Court of Claims and later held invalid in the Third Circuit Court of Appeals. The District Court of Georgia merely said that it could not place more weight on one decision than the other in ruling on the estoppel plea. A rehearing has been requested in this case. Compare the decision of the Kansas District Court in Blumcraft of Pittsburgh v. Architectural Art Mfg. Inc., et al dated January 7,

1972, addendum page _____, where estoppel was found in another action on the same patent.

Foundation argues in effect, in support of point (5), that the Supreme Court decision should apply only prospectively and that Blonder-Tongue should not be entitled to assert an estoppel since the second trial had already been held. Such a contention is directly contrary to the Supreme Court mandate which directed that Blonder-Tongue be permitted to assert the estoppel. Furthermore, if the Supreme Court had intended such a result, it would have specifically provided that the modification of Triplett should have only a prospective effect. The Court has followed this procedure in other situations where the retroactive application of a change in the law might cause hardship. See, for example, England v. Louisiana State Board of Medical Examiners, 375 U.S. 411, 1964.

Other courts, moreover, have had no hesitancy in applying the changed law retroactively. See Monsanto v. Dawson, supra, and Bourns Inc. et al v. Allen Bradley Company, et al, DC NC Ill., Feb. 7, 1972, Add. _____.

CONCLUSION

The decision of the District Court finding that Foundation is estopped to assert validity of the Isbell patent is correct and should be affirmed.

February 15, 1972

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

Dear Dick:

RE: BLONDER-TONGUE Reply Brief on University of Illinois Appeal

We like the concept of annexing the Bourns vs. Allen-Bradley Company et al decision to the Blonder-Tongue reply brief.

The only point that occurs to us as perhaps needing the final nail in the coffin bears upon the actual finding by the Supreme Court itself that the Iowa Court in the Winegard case had followed the requirements of Graham vs. Deere:

> "Trial was to the court, and after pursuing the inquiry mandated by Graham v. John Deere Co., 383 U. S. 1, 17-18 (1966), Chief Judge Stephenson held the patent invalid since "it would have been obvious to one ordinarily skilled in the art and wishing to design a frequency independent unidirectional antenna to combine these three old elements, all suggested by the prior art references previously discussed."

As discussed with you, in view of our swamped litigative and other schedule these next few weeks, we shall rely on your further finalizing.

Many thanks for your able assistance.

Cordially,

RINES AND RINES

Robert H. RInes

RHR:la
cc: Messrs. Blonder & Tongue

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from Hofgren, Wegner, Allen, Stellman & McCord

REPLY BRIEF

~~CORRECTION OF~~ THE STATEMENT OF THE CASE

The statement of the case in the Foundation's brief contains two errors.

The decisions of the District Court for the Southern District of Iowa and the Court of Appeals for the Eighth Circuit holding the Isbell patent invlaid were not limited to certain claims, but treated the patent as a whole. (Supp. App. ___ and ___).

The District Court here held the Foundation estopped to assert validity of the Isbell patent, rather than estopped from enforcing it.

The statement of facts makes reference to facts relating to substantive patent issues. These are not involved in the questions to be considered under the Supreme Court mandate.

~~INTRODUCTION~~

The decision of the Supreme Court modifies the 1936 decision in Triplett v. Lowell and provides a presumptive estoppel in favor of an accused infringer where a patent has already been held invalid. Section IIIA of the Supreme Court decision requires first that a defendant in support of a plea

of estoppel should identify the issue in suit as the identical question finally decided against the patentee in previous litigation. Then patentee must have an opportunity to rebut the presumptive estoppel by demonstrating that it did not have "'a fair opportunity procedurally, substantively and evidentially to presue his claim the first time.'" The court suggests certain inquiries appropriate in determining whether patentee had a full and fair chance to litigate validity in the earlier case, where the issue is one of non-obviousness, as it is here.

(a) Whether the first validity determination purported to employ the standards announced in Graham v. John Deere Co.

(b) Whether the opinions indicate that the prior case was one of the relatively rare instances where the courts wholly failed to grasp the technical subject matter and issues.

(c) Whether, without fault, patentee was deprived of crucial evidence or witnesses in the first litigation.

The court's concluding admonition that the decision (whether patentee had a full and fair chance to litigate in the earlier case) will necessarily rest on the trial court's sense of justice and equity. (Supp. App. 39-49)

The Supreme Court in Section IV of its opinion remanded this case with instructions that Blonder-Tongue be allowed to amend its pleadings to assert estoppel, that the Foundation be permitted to amend its pleadings and supplement the record with any evidence showing why estoppel should not be imposed.

This procedure has been followed. Blonder-Tongue filed an amended answer setting up an affirmative defense of collateral estoppel based on the decisions of the Iowa District Court and the Court of Appeals for the Eighth Circuit, finding the Isbell patent invalid for obviousness. (Supp. App. 6) Motions for judgment were filed by both parties. The District Court (Suppl. App. 12) issued a memorandum making findings that

(1) procedurally Foundation had a fair opportunity to pursue its claim in Iowa and the Eighth Circuit, specifically commenting on the convenience of the forum incentive to litigate, identity of issues raised and decided, and opportunity to present all crucial evidence and witnesses.

(2) The decisions of the Iowa Districrt Court and the Eighth Circuit Court of Appeals reveal "a conscientious effort to apply the standards laid down in Graham v. John Deere Co. supra, and a careful evaluation of the issues.",

and the difference in conclusions reached regarding obviousness (does not demonstrate that either court 'wholly failed to grasp the technical subject matter.'" (Supp. App. 15)

(3) The arguments that the cost of a retrial had already been incurred; the Winegard decisions were not final when the Blonder-Tongue trial was held; and defendant did not plead estoppel earlier were all based on facts before the Supreme Court and could not be asserted to defeat the estoppel.

(4) The whole Isbell patent was in issue in the Iowa case and there held to be invalid.

SUMMARY OF ARGUMENT

(1) The decisions of the Iowa District Court and the Eighth Circuit Court of Appeals finally decided the question of validity of the Isbell patent.

(2) Foundation has not demonstrated that it was deprived of a full and fair chance to litigate the validity of Isbell in Iowa and the Eighth Circuit.

ARGUMENT

The inquiries prescribed by the mandate of the Supreme Court will be considered in order.

The issue here in question, validity of Isbell over a defense of obviousness, is the identical question decided in Winegard. In the District Court, Judge Stephenson found ". . . the disclosure of Isbell's patent No. 3,210,767 is lacking in the prerequisite non-obviousness and, therefore, invalid." (Supp. App. 97) The Court of Appeals agreed,

> "We have examined the record and find that all claims must be denied, lacking nonobviousness as a matter of law . . ."

Foundation objects that claims 6. 7 and 8 were not in issue, but the objection is not supported by the record. The complaint alleged infringement of the patent (Supp. App. 98) and the answer asserted that the patent was null and void for failure to satisfy the requirements of 35 U.S.C. 102 and 103, the latter

of which is concerned with obviousness. The only reference of record regarding claims 6, 7 and 8 is Judge Stephenson's comment that all claims "except 6, 7 and 8 are claimed to be infringed. (Supp. App. 89) Neither decision is limited with respect to the claims but rather both treat validity of the patent as a single question. It does not appear that the Foundation objected to the scope of the judgments although it did raise other questions which resulted in an amendment of the District Court decision and a correction by the Court of Appeals of a finding by the District Court to use more precise language in distinguishing between the log periodic formula for antenna design and a method for designing antennas. (Supp. App. 77, 78) This court should not presume to limit the decision in the Eighth Circuit.

The answer in Winegard alleged invalidity. It seems there would be no question here had the answer _____ _____ declaratory judgment counterclaim making the same allegation. To hold the claims 6, 7 and 8 were in Winegard would put form before substance. The situation here is analogous to that where a court first finds that there is no infringement and then goes on to determine validity. This is a common practice endorsed and urged by the Supreme Court.

> "There has been a tendency among the lower Federal courts in infringement suits to dispose of them where possible on the ground of non-infringement without going into the question of validity of the patent. [citing cases] It has come to be

recognized, however, that of the two questions, validity has the greater public importance, [citing cases] and the District Court in this case followed what will usually be the better practice by inquiring fully into the validity of this patent." Sinclair & Carroll Co. v. Interchemical Corp., 325 US 327, 89 L.Ed. 1644

Foundation does not question that the decision in Winegard is final. The immateriality in the present case of the relative timing of the Winegard and Blonder-Tongue decisions will be discussed below.

Foundation does not suggest that the court's in Winegard did not purport to employ the investigation and standards of Graham v. John Deere Co.; not does it suggest that it was deprived of crucial evidence or witnesses although the testimony of Dr. DuHamel was presented in Blonder-Tongue and not in Winegard. Presumably this testimony could have been presented in the earlier trial if the Foundation had deemed it desirable.

Foundation asserts only that:

(a) The Iowa and Eighth Circuit Courts failed to grasp the technical subject matter;

(b) The Iowa and Eighth Circuit courts failed to apply the

in support of the contention that it did not have a full and fair chance to litigate the validity of Isbell. The Supreme Court suggested

that imposition of the estoppel would be unfair where ". . . the (prior) opinions . . . indicate that the prior case was one of those relatively rare instances where the courts wholly failed to grasp the technical subject matter and _____ in suit." This is clearly a reference to cases of the character identified in footnote 22 (Supp. App. 38), where the courts frankly admitted uncertainty:

> "The court below in recognition of its avowed limitations rested its decision basically on its evaluation of the relative credibility of opposing expert witnesses." Nyyssonen v. Bendix Corporation, 342 F.2d 531 at 532 (CA 1, 1965).
>
> "It is an issue which we are altogether incompetent to decide upon the merits; even the terminology is beyond our acquaintance, and what actually takes place in the tubes is inaccessible except by its gross manifestations -- indeed the very elements themselves are in dispute among those who have made them their life study, as the merest smattering of modern physics quickly discloses to a lay reader. While Congress sees fit to set before us tasks which are so much beyond our powers, suitors must be content that we shall resort to the testimony of experts, though they are concededly advocates with the inevitable bias that advocacy engenders." Harries v. Air King Products Co., 183 F.2d 158 at 164 (CA 2, 1950).
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The decisions in Winegard show no such failure to grasp either the technical subject matter or the issues in suit. Rather, both opinions (as with the District Court and Appeal Court opinions here) illustrate a remarkable understanding of a difficult subject matter. Judge Stephenson analysed the Isbell patent, the prior art, the differences and found the differences to be obvious to one skilled in the art. Judge Lay for the Court of Appeals did not perfunctorily affirm, but repeated the inquiries of Graham v. Deere and reached the same conclusions.

This Court is not authorized by the Supreme Court mandate to look into the record in the second trial (devoid as it is of testimony regarding obviousness of Isbell on behalf of Blonder-Tongue) in determining whether the courts in Winegard grasped the subject matter and issues. The opinions ~~and~~ there demonstrate clearly a thorough understanding of the subject matter and issues. This satisfies the inquiry suggested by the Supreme Court.

The issue is neither a resumption of a "disagreement" twin circuits decisions or ~~k~~ for this court to speculate whether the Eighth Circuit analysis correctly applied Graham v. Deere. The question asked by the Supreme Court is whether the prior decision "purported" to employ the standards of Graham v. Deere. The Foundation does not suggest that they did not, a reading of the decisions mades it clear that they did and, in fact, the Supreme Court so commended (Supp. App. 21).

The Supreme Court did not mandate a comparison of the legal standards of the Eighth and Seventh Circuits and the District Court here correctly ignored questions of this character raised by Foundation.

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(2) The Winegard decision was not final, but on appeal to the Eighth Circuit when the Blonder-Tongue tirla commenced;

(4) The cost of the second trial has already been incurred;

(5) The parties proceeded in good faith under seemingly settled law and the Supreme Court modification of Triplett should not be applied retroactively;

(6) Blonder-Tongue did not raise the estoppel issue prior to the Supreme Court decision.

The facts with respect to each of these points were before the Supreme Court and were not considered by it to be material. The remand and mandate of the Supreme Court established the law of the case with respect to these facts and the District Court correctly held that it could not evade the mandate by holding that the factors defeat the estoppel plea.

> "The power of a lower tribunal under a mandate of reversal is not unlimited. Where such mandate directs the entry of a specific judgment, the court below has no power to enter a different one, and where the reversing mandate specifies the further proceedings which shall be taken below, or where it definitely limits such proceedings, the power of the lower court is restricted accordingly." Cyclopedia of Federal Procedure, Third Edision, 1965, Revised Volume 14A, Section 69.39.

In Criscuolo v. United States, 250 F.2d 388 (1957), the court of appeals for the Seventh Circuit considered a similar situation. Contesting an action on an insurance policy by the named beneficiary, the deceased's widow introduced evidence of an attempt on the part of the insured to change the beneficiary and the performance of an affirmative act supporting

such intent. The trial court held the evidence insufficient and found for the named beneficiary. The court of appeals reversed and remanded to allow the named beneficiary to present evidence to overcome that presented by the widow. No additional evidence was offered, but the trial court held that it did not believe the witnesses which had been presented by the widow, finding again for the named beneficiary. The court of appeals reversed again, Judge Lindley saying:

> "As we have observed, we remanded the cause for the sole purpose of allowing plaintiff an opportunity to present evidence to overcome that of the widow. Thus the court below, in merely re-entering the order we had reversed, misconstrued the mandate of this court. In addition, by merely amending its findings to justify its original decision, the district court deviated from the law of the case as established by this court on the previous appeal; [citing cases]" 250 F.2d at 389.

Similarly, the Ninth Circuit held in Hermann v. Brownell, 274 F.2d 842, 843 (1960):

> "When a case is appealed from this Court to the Supreme Court, this Court completely loses jurisdiction of the cause. Thereafter, our jurisdiction can be revived only upon the mandate of the Supreme Court itself, and even upon such restoration, the jurisdiction of this Court is rigidly limited to those points, and those points only, specifically consigned to our consideration by the Supreme Court.
>
> "In the instant case, this Court is functioning under such a remand. Consequently, our jurisdiction is strictly limited to the Supreme Court's mandate. That mandate is our compass and our guide."

We need not speculate what effect may be given in the future to a prior decision which is on appeal at the time a subsequent trial is about to begin. This and related questions of docket load and trial scheduling will have to be worked out on a case-by-case basis. The Winegard decision is final and provides an appropriate basis for an estoppel plea. In Monsanto Chemical Co. et al v. Dawson Chemical Co., CA 5, June 8, 1971, 1970 USPQ 199, the Fifth Circuit remanded a case which had been briefed and argued to the District Court for consideration of an estoppel plea. Based on a holdinf of invalidity by the District Court for the Eastern District of Pennsylvania, an appeal to the Court of Appeals for the Third Circuit is still pending and a petition for certiorari has been filed from the Fifth Circuit decision.

The facts in the Blumcraft decision cited by Foundation distinguish that case from this. There, the patent was first held valid in the Court of Claims and later held invalid in the Third Circuit Court of Appeals. The District Court of Georgia merely said that he could not place more weight on one decision than the other in ruling on the estoppel plea. A rehearing has been requested in this case. Compare the decision of the Kansas Cistrict Court in Blumcraft v. Architectural Art Mfg. Inc. dated January 7, 1972, addendum page _____, where estoppel was held proper in another action on the same patent.

More to Come

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CURRIER
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JIRAUCH
WESLEY
ROCKFORD

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION

BOURNS, INC., and MARLAN E. BOURNS,
Plaintiffs,

vs.

ALLEN-BRADLEY COMPANY, BECKMAN INSTRUMENTS, INC., THE BUNKER-RAMO CORPORATION, FAIRCHILD CAMERA & INSTRUMENT CORP., TRW INC., and WESTON INSTRUMENTS, INC., on behalf of themselves and as representatives of others similarly situated,
Defendants.

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DECISION and ORDER

This cause comes on to be heard on motion of the defendants for summary judgment on the ground of collateral estoppel under Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, 402 U.S. 313, 91 S.Ct. 1434 (May 3, 1971). The court concludes that the defendants' Motion should be granted, with the result that a final judgment will be entered in their favor. The earlier motions filed by the defendants are thereby rendered obsolete.

The Complaint in the case at bar was filed on August 11, 1970 by the owner and assignee of United States Patent No. 2,777,926 issued on January 19, 1957. Plaintiffs allege that six corporate defendants, as representatives of a class, had been infringing their patent for six years and would continue to

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do so unless enjoined. Defendants answered separately and alleged that the patent was invalid for obviousness and for other reasons. They also alleged that plaintiffs were estopped and barred from the instant action by virtue of a final judgment entered against them by the United States District Court for Nebraska in Bourns, Inc. and Marlan E. Bourns v. Dale Electronics Inc., 308 F.Supp. 501 (D.Neb. 1969).

After the decision in Blonder-Tongue, supra, defendants filed amended answers in which they alleged further that plaintiffs had acquiesced in the Nebraska judgment by voluntarily dismissing their appeal to the United States Court of Appeals for the Eighth Circuit on May 4, 1970. Defendants thereupon filed the instant motions for summary judgment which in substance are motions for judgment on the pleadings under F.R.C.P. 12(c).

The only question on such a motion is whether a genuine issue of material fact remains to be decided and, if not, whether the moving parties are entitled to judgment as a matter of law. Since plaintiffs did not move to strike or to file a reply to defendants' affirmative defenses of estoppel and res judicata, the pleadings do not spell out plaintiffs' position with respect to these defenses. The court has considered the contentions made in plaintiffs' brief, however, in light of the defenses

suggested by the Supreme Court's decision in its unanimous Blonder-Tongue decision.

Despite possible harshness on occasion, there can be no doubt that Blonder-Tongue applies retrospectively. Monsanto Co. v. Dawson Chemical Co., 443 F.2d 1035 (5th Cir. 1971), petition for cert. filed, No.71-787, 40 U.S.L.W. 3356 (Dec. 14, 1971). It is true that plaintiffs were not apprised of this particular decision when they abandoned their appeal to the Eighth Circuit, but there were rumblings of it (cf. 402 U.S. 313, 91 S.Ct. at p.1453). The same unfortunate turn of events occurred in Blonder-Tongue when the University of Illinois Foundation unexpectedly became bound by an adverse decision of the Eighth Circuit in University of Illinois Foundation v. Winegard Co., 402 F.2d 125 (1968), cert.den. 394 U.S. 917 (1969). The Supreme Court could have softened the blow by ruling only prospectively in Blonder-Tongue, as it has done on several occasions. Cf. England v. Louisiana State Bd. of Med. Exam., 375 U.S. 411, 84 S.Ct. 461 (1964). But the court no doubt felt that the public policy which it was enunciating in Blonder-Tongue was sufficient to justify an all-embracing decision.

Plaintiffs argue that the adverse decision by the federal court in Nebraska did not affect the entire patent but

only certain of its claims. This argument is based primarily on that court's judgment order, entered after the decision reported at 308 F.Supp. 501, which reads in part: "Claims 1, 2,11,14,15,16 and 20 of United States Patent No. 2,777,926 are invalid." The court then dismissed the Amended Complaint "with prejudice" and sustained the Amended Counterclaim "to the extent indicated." The record in that case does not reveal whether the parties thereafter treated the patent as invalid, but the court's published opinion makes clear that it found the entire patent invalid. Among other things, the court's decision says with respect to Patent No. 2,777,926: "... the '926 patent is held to be invalid." 308 F.Supp. at 507.

The pleadings in the Nebraska suit demonstrate that both the plaintiffs and the defendant were litigating the validity of the patent, not merely part of it. The Amended Complaint alleged that the patent was "duly and regularly issued" to the plaintiffs and that the defendant had been infringing it for six years. Plaintiffs sought an injunction, damages and attorneys fees "pursuant to the patent laws of the United States." Defendant in its Amended Answer denied knowledge of whether the patent was duly and regularly issued and stated "Plaintiffs are left to their proofs." Defendant also pleaded affirmative defenses and filed a counterclaim for declaratory judgment in which it alleged that the patent was invalid by reason of anticipation, obviousness,

and other grounds going to the entire patent. Nowhere in the pleadings are specific claims or partial invalidity alleged.

In the case at bar the Complaint and Answers likewise go to the validity of the entire patent, and no mention is made of specific claims. Plaintiffs now contend that they are relying herein on Claims Nos. 3,4,6,7,12,19,21 and 22, as well as the ones itemized by the Nebraska judgment order. Plaintiffs' specification in the case at bar arises from their answers to interrogatories when the defendants inquired as to specific claims which their particular devices were allegedly infringing. Plaintiffs answered by listing most, if not all, of the 22 claims in their patent (Supplemental Answer filed July 20, 1971), but they have never amended their complaint to allege that they were relying on the validity of those claims not specified by the Nebraska court. We conclude that the Nebraska judgment order is explained by the same procedures as explains this particular defense raised by the plaintiffs: the court was referring to the claims alleged to be infringed by a defendant's product but had no intention of changing its decision of invalidity. Blonder-Tongue precludes us from relitigating this decision.

Even if Blonder-Tongue is potentially a bar to the entire complaint (as this court holds), plaintiffs seek to avail themselves of the exceptions left open to them by the Supreme Court's decision. Plaintiffs argue that the Nebraska court failed to

grasp the issues of the controversy and in particular misapplied Graham v. John Deere & Co., 383 U.S. 1 (1966). The Supreme Court cited this case as one example where a trial court might have completely failed to meet and decide the issues before it, therefore aborting estoppel. From an examination of the Nebraska court's decision, however, it not only appears that the court cited and purported to follow Graham v. John Deere & Co. (which is all the Supreme Court suggested it do), but also that the trial court did grasp the issues and render a full and fair opinion on the merits. Any revision of that decision lay there or in the Court of Appeals, not here.

Plaintiffs next argue that they lacked the requisite incentive to litigate to a finish in the Nebraska suit. They blame this partly on the allegedly myopic view of patents taken by the Eighth Circuit Court of Appeals as compared with the enlightened view of the Seventh Circuit. This court need not enter that debate because the Supreme Court itself discounts the argument: choice of forum militates against the plaintiffs who made the choice, albeit without realization that they would be universally bound by the result. As to plaintiffs' alleged reliance on pre-Blonder-Tongue decisions when abandoning their appeal, that argument is contrary to the holding of that con-

trolling decision which abrogated the prior law.

The subsequent proceedings in the Blonder-Tongue litigation are instructive, as reported in University of Illinois Foundation v. Blonder-Tongue Laboratories, Inc., 334 F.Supp. 47 (N.D.Ill. 1971), (pending in the Seventh Circuit Court of Appeals, No. 71-1829, Dec. 6, 1971). Although Judge Hoffman in that case had initally upheld a patent which had been previously invalidated by an Iowa federal court, and although the Seventh Circuit had affirmed Judge Hoffman's decision, upon remand he applied the Supreme Court's decision and entered summary judgment for the defendant on the basis of the Iowa court's prior judgment of invalidity. In doing so he rejected the argument that the second case involved different claims than the first one, considered the exceptions left open by the Supreme Court, and found them unsatisfied, as this court does in the case at bar. This result, incidentally, conformed to that reached by the Eighth Circuit Court of Appeals which had in the meantime affirmed the Iowa court.

Plaintiffs attach a number of affidavits to their brief to demonstrate a lack of crucial evidence and witnesses in the Nebraska litigation allegedly not due to the fault of the plaintiffs. What plaintiffs really argue is that the attorneys (and plaintiffs) in the Nebraska law suit did not uncover all of the existing evidence during the seven years that the suit was

pending. Much of the information allegedly newly discovered from the defendants in this cause was a matter of public record or was otherwise known to plaintiffs, and most if not all of it was in existence and discoverable during the Nebraska litigation. If plaintiffs could demonstrate that the pending litigation was made possible by new facts or change of circumstances which did not exist at the time of the trial in 1969, their argument under this point might have merit. But as it is, the argument merely says that plaintiffs' attorneys in the present suit believe they could do better by a second effort. To litigate this issue here would be a step backward toward trial by combat and is not what the Supreme Court intended.

In the last analysis, the Supreme Court has told the federal judges to decide questions of collateral estoppel in patent cases on the basis of the trial court's sense of justice and equity (402 U.S. 313, 91 S.Ct. at p.1445). The justice in this matter is pre-empted by the Blonder-Tongue decision itself, together with the exceptions mentioned therein and this court's determination that the decision is to be applied retrospectively. The equities in this matter militate heavily against the plaintiffs. They have had the benefit of their patent since 1957. They have filed several suits to enforce it, all of which were settled beneficially to the plaintiffs. They elected to file yet another suit in the Nebraska federal court. They left that suit

pending for seven years in a jurisdiction which had no back-log. They had ample time for nationwide discovery and taking deposition testimony. They went to trial and lost on the merits after a full and fair hearing. They abandoned their appeal shortly before filing the case at bar in which they hoped, by a class action, to recover damages far in excess of the million dollars or so sought in Nebraska. They had enjoyed the benefits of a patent for almost thirteen years before their come-uppance. In the opinion of this court they had not been treated unfairly by the law.

IT IS THEREFORE ORDERED, ADJUDGED AND DECREED that defendant's Motion for Summary Judgment is granted and judgment is entered on the Complaint in favor of the defendants.

Enter:

Thomas C. Wheelock
Judge, U.S.District Court

FEB 7 1972

GOLOVE, KLEINBERG & MORGANSTERN
ATTORNEYS AT LAW
6505 WILSHIRE BOULEVARD
LOS ANGELES, CALIFORNIA 90048
OLIVE 3-5380

LEONARD GOLOVE
MARVIN H. KLEINBERG
RICHARD MORGANSTERN

PATENT, COPYRIGHT
TRADEMARK CAUSES

January 25, 1972

Spensley, Horn, Jubas & Lubitz
Attorneys at Law
Suite 500 1880 Century Park East
Los Angeles, California 90067

RECEIVED
JAN 27 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Attention: Martin R. Horn, Esq.

Reference: BLONDER-TONGUE ELECTRONICS
v.
MACOM INDUSTRIES
Your File No. P-2144

Dear Marty:

I think the enclosed will be satisfactory for our purposes. If the Judge does not go along, I will file an immediate reply and stipulation to your amendment of the pleadings to add additional references.

Please file the copy with my attached envelope so that the Clerk can return a conformed copy.

Best personal regards,

GOLOVE, KLEINBERG & MORGANSTERN

MHK

Marvin H. Kleinberg

MHK:nch

Enclosures

cc: Rines & Rines

GOLOVE, KLEINBERG & MORGANSTERN
Attorneys at Law
6505 Wilshire Boulevard, Suite 415
Los Angeles, California 90048

653-5380

Attorneys for Plaintiff

RECEIVED
JAN 27 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

IN THE UNITED STATES DISTRICT COURT

FOR THE CENTRAL DISTRICT OF CALIFORNIA

BLONDER-TONGUE ELECTRONICS, Plaintiff, vs. HOWARD MERCER, Doing Business as MACOM INDUSTRIES, Defendant.	Civil Action No. 71-2459-HP STIPULATION

IT IS HEREBY STIPULATED by and between the parties that DEFENDANT, CROSS COMPLAINANT has learned of additional prior art and that the parties are agreeable that the CROSS COMPLAINT may be amended to include such prior art.

THE PARTIES FURTHER AGREE that PLAINTIFF shall for 30 days from the filing of such amended CROSS COMPLAINT, have the right to file a responsive pleading and that PLAINTIFF need not file a reply at this time in anticipation of such an amended pleading.

Date: .....

.....
Marvin H. Kleinberg
Attorney for Plaintiff

Date: .....

.....
Martin R. Horn
Attorney for Defendant

APPROVED:

Date: .....

.....
U. S. District Court Judge

LAW OFFICES

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

20 NORTH WACKER DRIVE

CHICAGO 60606

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AREA CODE 312

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1945-1969

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WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
JAMES C. WOOD
STANLEY C. DALTON
RICHARD S. PHILLIPS
LLOYD W. MASON
TED E. KILLINGSWORTH
CHARLES L. ROWE
W. E. RECKTENWALD
DILLIS V. ALLEN
WM. A. VAN SANTEN
RONALD L. WANKE

January 17, 1972

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JAN 19 '72

RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Touche, Ross & Co.
24 Washington Street
Morristown, New Jersey

RE: Blonder-Tongue Laboratories Inc.

Gentlemen:

We are assisting Robert H. Rines in connection with the lawsuit between the University of Illinois Foundation, Blonder-Tongue Laboratories, and JFD Electronics. This matter was remanded by the United States Supreme Court to the Federal District Court for the Northern District of Illinois. Following the remand, we filed a motion for judgment in favor of Blonder-Tongue Laboratories which motion was granted by the District Court. The University of Illinois Foundation has initiated an appeal to the Court of Appeals for the Seventh Circuit. Their brief is presently due February 1.

If you need further information concerning this, I suggest you check directly with Mr. Rines.

I have no knowledge of any other matters of the character described in the letter from Mr. Smith.

Very truly yours,

Richard S. Phillips

RSP:iag

cc: Mr. F. E. Smith
Mr. R. H. Rines

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November 22, 1971

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NOV 24 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

RE: UIF v. BT v. JFD

Dear Bob:

The record on appeal was to have been transmitted from the District Court to the Court of Appeals today. However, the clerk has been unable to find some of the documents and asked that the Foundation obtain a two week extension of time.

Apparently the Clerk of the Supreme Court has not yet acted on the disagreement between the Foundation and JFD regarding allocation of the Supreme Court costs. As soon as this is settled, we will push again for payment of the cost awards to Blonder-Tongue.

Very truly yours,

Richard S. Phillips

RSP:iag

cc: Mr. I. S. Blonder

LAW OFFICES

AXEL A. HOFGREN
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JOHN REX ALLEN
1845-1969

December 3, 1971

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DEC 6 1971

RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Dear Bob:

In case news of doings in Chicago doesn't make the Boston Globe, I thought you might be interested to know that the Hon. Judge Hoffman has requested that he be placed on senior status; and that Richard McClaren is leaving the Justice Department to take his place. The first story on the McClaren appointment in the Chicago Tribune suggested that many businessmen had been concerned with Mr. McClaren's antitrust activities and had been urging Senator Percy to appoint him to the bench in order to get him out of the Justice Department.

I received some material from Mike Nacey, but have not yet had a chance to digest it.

The Beverly Bank is on the far southwest side of Chicago. I have some friends out that way who may be able to help check on it. In the meantime, I'll see what I can run down regarding the big banks in the Loop.

Best wishes.

Very truly yours,

Dick

Richard S. Phillips

RSP:iag

LAW OFFICES

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JOHN REX ALLEN
1945-1969

January 18, 1972

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JAN 20 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Dear Bob:

* I enclose a copy of the supplemental appendix which has been prepared and filed by the Foundation. Both the complaint and answer in the Winegard case are included.

They have also printed the Georgia District Court decision in Blumcraft v. Kawneer. I do not believe this decision has yet been officially reported.

I have started a collection of the estoppel decisions from other courts. Any to which we wish to refer can be printed as an appendix to our brief.

The Foundation's brief is presently due February 1.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
JAMES C. WOOD
STANLEY C. DALTON
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JOHN REX ALLEN
1945-1969

January 10, 1972

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JAN 13 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Dear Bob:

* I enclose a copy of a decision which Walt Wyss gave me. A District Court in Kansas agreed with the decision of Judge Hoffman in enforcing an estoppel even though all of the claims had not been asserted in the earlier litigation.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

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

IN THE UNITED STATES DISTRICT COURT

FOR THE DISTRICT OF KANSAS

BLUMCRAFT OF PITTSBURGH, Plaintiff,	)	
vs.	)	Civil Action No. W-4037
ARCHITECTURAL ART MFG., INC., and WENZEL W. THOM, Defendants.	)	

OPINION AND ORDER OF THE COURT SUSTAINING DEFENDANTS' MOTION FOR SUMMARY JUDGMENT

This case is presently before the Court on defendants' motion for summary judgment, based originally on a claim of res judicata and estoppel as a result of a decision of the Fourth Circuit Court of Appeals holding plaintiff's patents invalid, and subsequent action of the United States Supreme Court denying certiorari. See *Blumcraft of Pittsburgh v. Citizens and Southern National Bank of South Carolina*, 407 F.2d 557 (1969), cert. den. 395 U.S. 961 (1969). During the pendency of this action, the United States Supreme Court came down with a very cogent opinion by Mr. Justice White and a much-needed bulwark in the patent law of this country in the case of *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, et al*, 402 U.S. 313, 2 L.Ed. 2d 788, 91 S.Ct. 1434 (1971). Defendants now place total reliance on this case and plaintiff disputes such a position.

During the Court's reading and listening to the extended arguments in this case, he has become familiar with an apparent anomaly in patent law cases or a fixation of viewpoint by counsel in such cases regardless of which side of the controversy is represented, i.e., a tendency to resist any ruling

of finality on either side as to definitive decision upon the validity of the patent. The learned patent counsel on both sides exhibited this eccentricity, but the position of plaintiff has been marked by an illusiveness, versatility, or metamorphosis hard to describe, but differing analogously in minute degree from a fishery biologist's attempt to grasp a live eel in algaed waters.

FACTS OF THE CASE

This case arises from the complaint filed in this Court on August 7, 1968 by the plaintiff Blumcraft, charging Architectural Art and Wenzel W. Thom, its president and principal stockholder, with infringing plaintiff's patents and seeking both injunctive relief and damages.

Plaintiff, a legal entity as a partnership, is the legal owner and patentee of two patents designated as United States Letters Patent No. D-171,963, a design patent dated April 20, 1954, and No. 2,905,445, a mechanical patent dated September 22, 1959, for an invention in ornamental rail structures for use in building construction. It has its place of business in Pittsburgh, Pennsylvania. Defendant is a Wichita, Kansas, based corporation. This appears to be at least the third legal encounter between these parties -- actual or covert. While both parties have most competent local counsel in this suit, the principal adversaries have been Mr. James C. McConnon, of a prominent Philadelphia patent firm, for the plaintiff, and Mr. Warren N. Williams, of a prominent Kansas City, Missouri patent firm. These lawyers have been long engaged in touché and counter-touché over the validity of the patents in issue.

In a case entitled *Blumcraft of Pittsburgh v. The United States*, 372 F.2d 1014 (1967), originating before the Court

of Claims in 1965, the Court of Claims held that the design patent No. D-171,963 was valid and infringed by the United States by its use of railing structures in certain public buildings constructed by the United States, and for which Blumcraft had not licensed their use. Plaintiff claims that defendant, through its attorney Warren Williams, secretly advised, counselled and assisted the Department of Justice in defending the Court of Claims suit, and hence, defendant should be bound here by the decision in that case.

In the case of *Blumcraft of Pittsburgh v. Citizens and Southern National Bank of South Carolina*, 286 F.Supp. 488 (D.So.Car. May 23, 1968), it was held that plaintiff's design patent No. D-171,963 was valid and infringed, and that its mechanical patent No. 2,905,445 was also valid and infringed. These rulings of the trial court were reversed by the Fourth Circuit Court of Appeals in February, 1969, and certiorari was denied by the Supreme Court in June, 1969, as referred to, supra, in the Court's introduction to this opinion. The essence of the Circuit's opinion was that both of plaintiff's patents were invalid.

The initial position taken by both of the present parties to this suit was that on the basis alone of a prior adjudication of a patent's invalidity in one judicial circuit of the United States did not preclude its continued and new litigation in the other circuits under the teaching of *Triplett v. Lowell*, 297 U.S. 638 (1936), and the fallout from that opinion that unless the party sought to be bound by the certain patent suit judgment was a party defendant in the suit or in position to control the course of the litigation, though not a party, he could not be bound by it on the basis of res judicata or estoppel. As a result of this decision, this Court was persuaded to allow

extensive discovery into the machinations and maneuverings of these parties and their counsel in the South Carolina case. While these proceedings were taking place, *Blonder-Tongue* burst upon the legal scene, apparently taking all patent counsel by surprise, and certainly in that case, eliciting equivocal positions by patent counsel for all adversaries.

RULING OF THE COURT

Blumcraft is here doomed and the decision must be against it for two very valid reasons, viz., (1) it is bound by its original claims and assertions as to the nature, character and participation of the parties here in the South Carolina litigation, which assertions, for plaintiff's own good, the Court presumes to be true; (2) and most importantly, it is bound by the holding of *Blonder-Tongue* and its progeny.

THE ADMISSIONS AND/OR CONTENTIONS OF THE PARTIES AS TO THE PARTICIPATION IN OR EFFECTIVENESS OF THE SOUTH CAROLINA SUIT

The complaint of plaintiff Blumcraft contained, inter alia, these allegations:

> "14. Defendant ARCHITECTURAL ART MFG., INC. participated in and controlled the defense of the recent case of Blumcraft of Pittsburgh v. Citizens & Southern National Bank of South Carolina, et al, Civil Action No. 4168, in the District Court for the Western District of South Carolina. A copy of the decision of the Court is attached hereto as Exhibit A.
>
> 15. Defendant ARCHITECTURAL ART MFG., INC. participated in the control of the defense of the case of Blumcraft of Pittsburgh vs. The United States, 153 U.S.P.Q. 298 (Ct.Cl. 1967). A copy of the decision of the Court is attached hereto as Exhibit B.

16. Judgment in the aforesaid action in the District Court for the Western District of South Carolina is binding on the defendant ARCHITECTURAL ART MFG., INC.

17. Judgment in the aforesaid action in the Court of Claims is binding on the defendant ARCHITECTURAL ART MFG., INC."

In their answer herein, the defendants made, inter alia, the following allegations:

"21. The suit referred to in the complaint as Blumcraft of Pittsburgh v. Citizens & Southern National Bank of South Carolina, et al, Civil Action No. 4168, U.S. District Court for the Western District of South Carolina, now pending Appeal No. 17219 before the U.S. Court of Appeals for the Fourth Circuit, once the issue of liability presented therein has been finally adjudicated, will be res adjudicata as between and binding upon both plaintiff and defendant Architectural Art Mfg., Inc. as to the question of validity of the patents involved in this action and the question of infringement of said patents by certain structure at one time made and sold by defendant Architectural Art Mfg., Inc. as its 'Clean-Line' model railings; but such final adjudication has not yet occurred, wherefore this action will be controlled and completely barred by res adjudicata if and when said patents are finally adjudicated to be invalid in the aforesaid suit now pending on appeal before the U.S. Court of Appeals for the Fourth Circuit and will be controlled and barred as to the 'Clean-Line' model railings of defendant Architectural Art Mfg., Inc. if and when said structures are finally adjudicated not to infringe said patents in the aforesaid suit now pending on appeal before the U.S. Court of Appeals for the Fourth Circuit.

22. Although final adjudication of the aforesaid suit will be binding upon both plaintiff and defendant Architectural Art Mfg., Inc. on certain important and possibly herein dispositive issues, as set forth in Paragraph 21 of this Answer, and although defendant Architectural Art Mfg., Inc. has and is controlling the defense of said suit and the appeal now pending therein, neither of the defendants in this action was a party to said suit nor subject to any liability therein to plaintiff for any damages that might be awarded therein."

It thus plainly appears from the lips of the parties how each construed and understood the participation of each and the effect thereof in the South Carolina litigation. The Court construes the admissions of both parties in their pleadings to be identical in language, scope and purport, and accepts them as binding stipulations of fact, except, of course, as to plaintiff's construction of the participation of defendants and the effect of the Court of Claims suit in Paragraphs 15 and 17 of its complaint, which is placed in its proper perspective by Justice White in his lucid and long-needed opinion in *Blonder-Tongue*. This finding of the Court is further buttressed by the finding of District Judge Simons, of the federal court in South Carolina, who states in his opinion at page 450:

> "Architectural Art has controlled and conducted the defense of this suit but is not a party to this action for the reasons stated in this Court's previous order."

FINALITY OF *BLONDER-TONGUE*

On May 3, 1971, the Supreme Court came down with a hallmark case in the patent field in *Blonder-Tongue Laboratories, Inc. v. University of Illinois Foundation, et al*, supra. A careful reading of that opinion reveals a crystal clear holding that a court determination of patent invalidity will operate as an estoppel in a subsequent suit by the same patentee against a different defendant so long as the patentee has had one full and fair opportunity to litigate the merits of his patent.

Judge Doyle, in the recent Tenth Circuit case of *Boutell v. Volk*, No. 624-70, decided October 22, 1971, further clarifies some misapprehensions, of counsel in other cases and plaintiff's counsel in this case, of the import of *Blonder-Tongue* when he states:

"The *Blonder-Tongue* opinion reviewed with great care the mutuality requirement as it had existed under the 1936 decision in *Triplett v. Lowell*, 297 U.S. 638, 642, 56 S.Ct. 645, 80 L.Ed. 949, 29 USPQ 1, 3 (1936). *Triplett* had conditioned the plea of res judicata on there being total mutuality as to the parties. Thus, all parties involved had to have been actual parties or privy to actual parties in order for estoppel by judgment to come into play. The result was that a patentee whose patent had been held invalid in one court was free to pursue infringement suits in other districts in a quest for a judgment of validity. *Blonder-Tongue* in some degree stopped this multiplicity of actions in various districts and circuits by simply holding that adjudication of *invalidity* of a patent following a full and fair hearing in which the defender of the patent had an adequate opportunity to present his case in support of validity would be final. The patentee against whom the judgment has been entered is barred from asserting in another action that the patent is valid."

Justice White pinpoints the type of suits in which estoppel is a defense against a patentee when he says:

"Even conceding the extreme intricacy of some patent cases, we should keep firmly in mind that we are considering the situation where the patentee was plaintiff in the prior suit and chose to litigate at that time and place. Presumably he was prepared to litigate and to litigate to the finish against the defendant there involved. Patent litigation characteristically proceeds with some deliberation and with the avenues for discovery available under the present rules of procedure, there is no reason to suppose that plaintiff patentees would face either surprise or unusual difficulties in getting all relevant and probative evidence before the court in the first litigation.

"Moreover, we do not suggest, without legislative guidance, that a plea of estoppel by an infringement or royalty suit defendant must automatically be accepted once the defendant in support of his plea identifies the issue in suit as the identical question finally decided against the patentee or one of his privies in previous litigation. Rather, the patentee-plaintiff must be permitted to demonstrate, if he can, that he did not have 'a fair opportunity procedurally, substantively and evidentially to pursue his claim the first time.'"

Closely following the above language, Justice White clearly elucidates the criteria for judicial examination in subsequent suits by or against a patentee who had sustained a prior adjudication of the patent's invalidity:

> "Determining whether a patentee has had a full and fair chance to litigate the validity of his patent in an earlier case is of necessity not a simple matter. In addition to the considerations of choice of forum and incentive to litigate mentioned above, certain other factors immediately emerge. For example, if the issue is non-obviousness, appropriate inquiries would be whether the first validity determination purported to employ the standards announced in *Graham v. John Deere Co.*, supra; whether the opinions filed by the District Court and the reviewing court, if any, indicate that the prior case was one of those relatively rare instances where the courts wholly failed to grasp the technical subject matter and issues in suit; and whether without fault of his own the patentee was deprived of crucial evidence or witnesses in the first litigation. But as so often is the case, no one set of facts, no one collection of words or phrases, will provide an automatic formula for proper rulings on estoppel pleas. In the end, decision will necessarily rest on the trial courts' sense of justice and equity.
>
> "We are not persuaded, therefore, that the *Triplett* rule, as it was formulated, is essential to effectuate the purposes of the patent system or is an indispensable or even an effective safeguard against faulty trials and judgments."

One fact indisputably emerges which plaintiff's counsel misconstrues in their strong reliance on the Court of Claims case, and their contention that it is to be weighted heavier for plaintiff since it was the first decision, or at least be balanced off against the use of the South Carolina case against it. This is the fact that *Blonder-Tongue*, as expounded by its own author and other judicial commentators on its efficacy, including Judge Doyle in *Boutell v. Volk*, and Judge Hoffman in applying *Blonder-Tongue* on remand, applies only to judgments of invalidity -- not to judgments of validity. Such an application of

Blonder-Tongue here eliminates the Court of Claims case and emphasizes the estoppel factors of the Fourth Circuit case unless it can be said that the Court of Claims case was res judicata. Obviously, it was not -- since the claim of plaintiff is only that defendants' counsel Williams advised, consorted with, and gave aid and comfort to the Government attorneys -- and, it should be noted that the United States was the sole defendant.

All the pertinent facts are before this Court relative to the scope and issues of the South Carolina case. There, this plaintiff was the aggressor, the attacker, "choosing his own forum and with the incentive to litigate." One of the principal issues urged by defendants in that suit was non-obviousness. Perusal of the opinions of both District Judge Simons and Circuit Judge Butzner, indicate a familiarity with and application of the standards announced in *Graham v. Deere*, 383 U.S. 1, to the evidence in the case. The available records nowhere indicate that the patentee Blumcraft was deprived either of crucial evidence or witnesses in the District Court, nor was there a claim by plaintiff that such a detriment occurred. This Court's whole impression from examining the exhibits and record in the South Carolina case is one of full proof and effort on both sides, and a studied and considered conclusion by three learned circuit judges, without division, of the patents' invalidity. This is a far cry from the necessary finding by this Court that either court in the South Carolina case "wholly failed to grasp the technical subject matter."

Plaintiff claims a significant difference exists between the issues and scope of the South Carolina case and the issues and scope of the one at bar, in that the mechanical patent No. 2,905,445, in this case, has all six claims contested, whereas only claims one and three were at issue in South Carolina

in addition to the design patent. This sort of claim was put at rest by Judge Hoffman on the remand of *Blonder-Tongue*, where it was pointed out the judgment in the first court held the whole patents invalid, even though all of the claims were not controverted in the lawsuit. In the case at bar, when one examines the opinions in the South Carolina case, both in the trial and appellate courts, the final judgments referred to the validity or invalidity of the whole patents. Moreover, the discussion by the appellate court of the obviousness of plaintiff's mechanical patent indicates their reference and contemplation of it as a whole as to rails, posts, and the clamp, bolts and notches for holding them in place. No separability or savings clause as to any claims is indicated by the Fourth Circuit. The judgment of obviousness must be deemed to relate to the entire mechanical patent.

In sum, Blumcraft must lose here on the basis of res judicata, i.e., that the issues decided in the previous litigation (the South Carolina case) were identical with the ones extant here, there was a final judgment against it on the merits in the Fourth Circuit, plaintiff is the party against whom the defense of res judicata is asserted by the defendants here, and defendants were in privity with the ultimate prevailing parties in the South Carolina litigation.

Also, plaintiff must lose on strength of the holding in *Blonder-Tongue* that it is estopped in this case to assert the validity of its patents which were previously adjudged invalid in a case in which it had a fair and full opportunity to try out the issue of validity. It is hornbook law that an invalid patent cannot be infringed.

In accordance with the expressions, findings and legal conclusions of the foregoing opinion, it follows that summary

judgment be, and the same is hereby, entered for defendants Architectural Art Mfg., Inc., and Wenzel W. Thom, against plaintiff Blumcraft of Pittsburgh, a partnership; and that the costs of this action be, and the same are hereby, assessed against the plaintiff. No separate additional journal entry of judgment shall be required or is necessary herein.

IT IS SO ORDERED.

At Wichita, Kansas, this 7th day of January, 1972.

/S/ Frank G. Theis
United States District Judge

GOLOVE, KLEINBERG & MORGANSTERN
ATTORNEYS AT LAW
6505 WILSHIRE BOULEVARD
LOS ANGELES, CALIFORNIA 90048
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LEONARD GOLOVE
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RICHARD MORGANSTERN

PATENT, COPYRIGHT
TRADEMARK CAUSES

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JAN 6 1972
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

January 4, 1972

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

Dear Bob:

I am enclosing herewith a draft of a reply to the Counter Claim which I will sign and file prior to January 17th, unless I receive instructions to the contrary.

Best wishes for the new year.

GOLOVE, KLEINBERG AND MORGANSTERN

Marvin H. Kleinberg

MHK:nch

Enclosure

GOLOVE, KLEINBERG & MORGANSTERN
Attorneys at Law
6505 Wilshire Boulevard
Los Angeles, California 90048

653-5380

Attorneys for Plaintiff

IN THE UNITED STATES DISTRICT COURT

FOR THE CENTRAL DISTRICT OF CALIFORNIA

BLONDER-TONGUE ELECTRONICS, Plaintiff, vs. HOWARD MERCER, Doing Business As MACOM INDUSTRIES, Defendant.	Civil Action No. 71-2459-HP REPLY TO COUNTERCLAIM

PLAINTIFF, BLONDER TONGUE ELECTRONICS, by its attorneys, GOLOVE, KLEINBERG & MORGANSTERN, as and for a reply to the counterclaim filed by defendant, HOWARD MERCER, alleges as follows:

1. PLAINTIFF admits the allegations set forth in Paragraphs 1 through 4, inclusive, of the counterclaim.

2. PLAINTIFF denies the allegations set forth in Paragraphs 5 through 9, inclusive, of the counterclaim.

WHEREFORE, PLAINTIFF demands the relief sought in the complaint herein, and that defendant be denied any relief whatsoever upon his counterclaim.

GOLOVE, KLEINBERG & MORGANSTERN

by: _____
Marvin H. Kleinberg

Of Counsel:

ROBERT H. RINES
DAVID RINES
RINES AND RINES
10 Post Office Square
Boston, Massachusetts 02109
(617) HU. 2-3289

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JAN 6 19[illegible]
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NO. TEN POST OFFICE SQUARE, BOSTON

United States Court of Appeals

For the Seventh Circuit
Chicago, Illinois 60604

RECEIVED
JAN 4 1972
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

JANUARY 3, 19 72

Before

Hon. WILBUR F. PELL, JR, Circuit Judge

Hon. _____

Hon. _____

UNIVERSITY OF ILLINOIS FOUNDATION,
Plaintiff and Counterclaim
Defendant-Appellant
No. 71-1879 vs.

BLONDER-TONGUE LABORATORIES, INC.,
Defendant- and Counterclaimant-
Appellee,

and

JFD ELECTRONICS CORPORATION,
Counterclaim Defendant-Appellee

} Appeal from the United States District Court for The Northern District of Illinois, Eastern Division

On consideration of the motion of counsel for Plaintiff-Appellant,

IT IS ORDERED that leave be granted to consider the appendix previously filed in this Court in Appeal No. 17153 (Appendix to brief for Defendant and Counterclaimant-Appellant) as an Appendix in this appeal.

IT IS FURTHER ORDERED that leave be granted to Plaintiff-Appellant to file an additional supplemental appendix on or before the date when Plaintiff-Appellant's brief is filed with this Court.

Xerox copy to
R. N. Rines
1/4/72

FPI MI—9-10-69-ICM-5945

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
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20 NORTH WACKER DRIVE
CHICAGO 60606

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1945-1969

January 5, 1972

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JAN 6 '72
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Jerome M. Berliner
Ostrolenk, Faber, Gerb & Soffen
10 East 40th Street
New York, New York 10016

RE: Blonder Tongue v. University of Illinois Foundation et al

Dear Jerry:

I assume that the letter from Mr. Seaver of December 22, 1971, should end the disagreement between the Foundation and JFD regarding payment of costs awarded by the Supreme Court.

I would appreciate receiving from you promptly a check payable to Blonder-Tongue in the amount of $2130.73, one-half the costs awarded by the Supreme Court. If JFD plans to continue its objection to payment of these costs, let me know.

Very truly yours,

Richard S. Phillips

RSP:iag

cc: Mr. B. P. Mann
Mr. R. H. Rines
Mr. I. S. Blonder

To Haun

PS: I assume the Foundation will continue its refusal to pay the costs awarded by the Court of Appeals and the Supreme Court. Accordingly, you may expect that we will shortly seek an order that these costs be paid.

United States Court of Appeals

For the Seventh Circuit
Chicago, Illinois 60604

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DEC 31
RINES AND RINES
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DECEMBER 28, 19 71

Before

Hon. ROBERT A. SPRECHER, Circuit Judge

Hon. _____

Hon. _____

UNIVERSITY OF ILLINOIS FOUNDATION,
Plaintiff and Counterclaim
Defendant-Appellant,

No. 71-1879 vs.

BLONDER-TONGUE LABORATORIES, INC.,
Defendant and Counterclaimant-
Appellee,

and

JFD ELECTRONICS CORPORATION,
Counterclaim Defendant-Appellee.

} Appeal from the United States District Court for the Northern District of Illinois, Eastern Division

On consideration of the motion and affidavit of counsel for plaintiff-appellant, University of Illinois Foundation, counsel for defendant-appellee having no objections thereto,

IT IS ORDERED that the time for filing plaintiff-appellant's brief be extended to and including February 1, 1972.

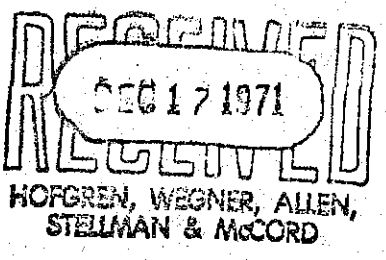
FPI MI—9-10-69-10M-3945

CHARLES J. MERRIAM
WILLIAM A. MARSHALL
JEROME B. KLOSE
NORMAN M. SHAPIRO
BASIL P. MANN
CLYDE V. ERWIN, JR.
ALVIN D. SHULMAN
EDWARD M. O'TOOLE
ALLEN H. GERSTEIN

LAW OFFICES
MERRIAM, MARSHALL, SHAPIRO & KLOSE
TWO FIRST NATIONAL PLAZA
CHICAGO, ILLINOIS 60670
TELEPHONE
312·346·5750
TELEX 25·3856

OWEN J. MURRAY
DONALD E. EGAN
NATE F. SCARPELLI
CARL KUSTIN
MICHAEL P. BUCKLO
CARL E. MOORE, JR.
ROBERT D. WEIST
MICHAEL F. BORUN

December 16, 1971



Mr. E. Robert Seaver, Clerk
Supreme Court of the United States
Washington, D. C. 20543

Re: Blonder-Tongue Laboratories, Inc. v.
University of Illinois Foundation et al
No. 338, October Term, 1970

Dear Mr. Seaver:

After receiving a copy of your letter of December 14 to Mr. Phillips, I checked my previous correspondence with you and determined that through an inadvertent error a certain confusion has been injected into the matter of costs in this case.

My letter of October 18, 1971 was occasioned by Mr. Berliner's letter of October 13, in which he suggested that his client JFD should not pay any portion of the costs. My letter of October 18 was intended to set out our opposition to Mr. Berliner's proposal. Unfortunately, however, my letter confused the parties in the case. I intended to say:

> "We also believe this [apportionment of costs] to be proper, but do not agree that JFD should not bear its share. The costs awarded to Blonder-Tongue were no more intimately associated with the issues involving the Foundation than they were to the issues directly concerning JFD. Accordingly, it is suggested that an equal division of the costs between the Foundation and JFD should be ordered."

My letter was not an offer on behalf of the Foundation to pay all of the award of costs, but rather a suggestion that the payment should be in accordance with the order of the court, i.e., jointly. You apparently agree that joint payment of costs was ordered. As I understand the situation as it now exists, each of the Foundation and JFD must pay one-half of the award of costs. Any other apportionment would require that the Court's order be revised.

Very truly yours,

Basil P. Mann

BPM/kd

cc: Richard S. Phillips, Esq.
Jerome M. Berliner, Esq.

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
JAMES C. WOOD
STANLEY C. DALTON
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20 NORTH WACKER DRIVE

CHICAGO 60606

TELEPHONE
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JOHN REX ALLEN
1945-1969

December 17, 1971

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DEC 20 19[illegible]
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Re: B-T v. UIF

Dear Bob:

I enclose a copy of an Order from the Court of Appeals directing that we answer the Foundation's Motion regarding the appendix on or before Monday, December 27.

Call me if you have any objections to the procedure requested by the Foundation.

Very truly yours,

Richard S. Phillips

RSP:cm
Encls.

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
JAMES C. WOOD
STANLEY C. DALTON
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CHICAGO 60606

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JOHN REX ALLEN
1945-1968

December 28, 1971

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DEC 30 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Re: UIF v. BTL

Dear Bob:

Pete Mann called me to ask if we would object to an additional fifteen days for them to file their brief. The court would undoubtedly grant the time even if we objected and, accordingly, I saw no reason to object. I enclose a copy of the motion, affidavit and order.

Yours very truly,

Richard S. Phillips

RSP:vm
Encl.

SUPREME COURT OF THE UNITED STATES
OFFICE OF THE CLERK
WASHINGTON, D. C. 20543

E. ROBERT SEAVER
CLERK OF THE COURT

December 22, 1971

Richard S. Phillips, Esq.
20 North Wacker Drive
Chicago, Illinois 60606

Basil P. Mann, Esq.
Two First National Plaza
Chicago, Illinois 60670

Re: Blonder-Tongue Laboratories, Inc. v.
University of Illinois Foundation, et al.
No. 338, October Term, 1970

Gentlemen:

There is no ambiguity in the Court's judgment in this case. It assesses one half of the total costs against the Foundation and JFD jointly. This means that each of them must pay to Blonder-Tongue one quarter of its costs.

Ordinarily the Court awards full costs to the successful party, but in this case Blonder-Tongue was awarded only half and this was done advisedly. In the circumstances, the respondents having been given the benefit of this action, it would seem that rather than questioning the Court's judgment they would each pay their share and close the matter.

Yours very truly,

E. Robert Seaver

E. Robert Seaver

cc: Jerome M. Berliner, Esq.

Bob — We may finally get some action.

RECEIVED
DEC 27 1971
HOPGOOD, WEGNER, ALLEN, STELLMAN & McCORD

Send Xerox if we have it not keep for RHR's return

file

THE UNIVERSITY OF CHICAGO
CHICAGO 37 · ILLINOIS
THE LAW SCHOOL LIBRARY

September 27, 1971

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SEP 29 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Robert H. Rines
Mr. David Rines
Mr. Richard S. Phillips
Rines and Rines
No. Ten Post Office Square
Boston, Mass. 02109

Dear Sirs:

Our collection of United States Supreme Court Briefs and Records is missing the following items in **Blonder Tongue v. Univ. Foundation, 402 U.S. 313: Petition for Certiorari**

If you have extra copies of any or all of these items and feel that you could make a gift of them to the University Law Library we shall be most grateful.

If this is not possible, can you suggest another source where we might be able to obtain them?

We will appreciate any kindness you might extend to us in this matter.

Sincerely,

Eric S Petersen

Eric S. Petersen
Briefs and Records Clerk

December 17, 1971

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

Dear Dick:

RE: BLONDER-TONGUE v. UNIVERSITY OF ILLINOIS

We enclose the entry of appearance form in the appeal filed by the University of Illinois 71-1879.

We note the reference of the order that Blonder-Tongue is to recover sums from the University of Illinois Foundation in connection with the Supreme Court decision and the certificate of costs in the Court of Appeals, as well. What is the status of our recovering these sums and your gestimate of time table.

Very truly yours,

RINES AND RINES

Robert H. Rines

RHR:la
Enclosure
cc: Ike Blonder
Ben Tongue

DOCKETED

DEC 6 - 1971

UNITED STATES COURT OF APPEALS
FOR THE SEVENTH CIRCUIT
CHICAGO, ILLINOIS 60604

Cause No. 71-1879

UNIVERSITY OF ILLINOIS FOUNDATION,

Plaintiff and Counterclaim Defendant-Appellant

vs.

BLONDER-TONGUE LABORATORIES, INC., Defendant and Counterclaimant-Appellee

and JFD ELECTRONICS CORPORATION, Counterclaim Defendant-Appellee

The Clerk will enter our appearance as counsel for ~~Blonder-Tongue Laboratories, Inc.~~
(Please specify party whom you represent)

Robert H. Rines
(Signature)

Robert H. Rines
(Typed Name)

No. Ten Post Office Square
Boston, Massachusetts 02109
(Address)

(Signature)

(Typed Name)

(Address)

Richard S. Phillips
(Signature)

Richard S. Phillips
(Typed Name)

20 North Wacker Drive
Chicago, Illinois 60606
(Address)

(Signature)

(Typed Name)

(Address)

NOTE: An attorney entering his appearance in a case before being admitted to the Bar of this Court must be admitted thereafter, and not later than the morning on which said case is set for hearing.

Individual and not firm names must be signed and *typed.*

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
JAMES C. WOOD
STANLEY C. DALTON
RICHARD S. PHILLIPS
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WM. A. VAN SANTEN
RONALD L. WANKE

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CHICAGO 60606

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JOHN REX ALLEN
1945-1969

December 7, 1971

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DEC 9 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Dear Bob:

* I enclose a copy of the certificate of the Clerk of the District Court regarding the record on appeal, together with certified copies of the docket entries.

* I also enclose an appearance form which you should sign and return.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosures

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF ILLINOIS
UNITED STATES COURT HOUSE
CHICAGO 60604

H. STUART CUNNINGHAM
CLERK

OFFICE OF THE CLERK

December 6, 1971

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DEC 7 1971
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Hon. Kenneth J. Carrick, Clerk
U.S. Court of Appeals, 7th Circuit
219 S. Dearborn St., 27th Flr.
Chicago, Illinois 60604

Re: The University of Illinois Foundation vs Blonder-Tongue Laboratories, Inc. No 66 C. 567

Dear Mr. Carrick,

Certified and transmitted to you herewith is the record on appeal, prepared pursuant to stipulation of the parties with the original papers incorporated therein together with certified copy of the docket entries, in compliance with the rules of your Court.

The record consist of all entries from June 17, 1971 to this date.

Very truly yours,

H. STUART CUNNINGHAM, CLERK

BY: Clyde Louis Brown
Deputy Clerk

Copy of letter, list of documents and certificate(s) to:

UNITED STATES OF AMERICA)
) SS
NORTHERN DISTRICT OF ILLINOIS)

I, H. STUART CUNNINGHAM, Clerk of the United States District Court for the Northern District of Illinois, do hereby certify to the United States Court of Appeals, for the Seventh Circuit, that the documents submitted herewith and annexed hereto are the original papers filed and entered of record in my office, on the dates designated in the List of Documents, and together with a true copy of docket entries as they appear in the official dockets in this office. from June 17, 1971 to this date constitutes the stipulated record on appeal in cause entitled; The University of Illinois Foundation vs Blounder-Tongue Laboratories, Inc. No 66 C 567

IN TESTIMONY WHEREOF, I have hereunto subscribed my name and affixed the seal of the aforesaid Court at Chicago, Illinois, this 6th day of December, 1971

H. STUART CUNNINGHAM, CLERK

BY: Clyde Louis Brown
Deputy Clerk

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
JAMES C. WOOD
STANLEY C. DALTON
RICHARD S. PHILLIPS
LLOYD W. MASON
TED E. KILLINGSWORTH
CHARLES L. ROWE
W. E. RECKTENWALD
DILLIS V. ALLEN
WM. A. VAN SANTEN
RONALD L. WANKE

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CHICAGO 60606

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December 9, 1971

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RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. E. Robert Seaver, Clerk
Supreme Court of the United States
Washington, D. C. 20543

RE: Blonder-Tongue Laboratories, Inc. v.
University of Illinois Foundation et al
No. 338, October Term, 1970
Opinion dated May 3, 1971; 91 S.Ct. 1434

Dear Mr. Seaver:

We would appreciate a decision from you with regard to the disagreement between JFD and the University of Illinois Foundation concerning the allocation of the costs assessed in the above.

Very truly yours,

Richard S. Phillips

RSP:iag

cc: MR. B. P. Mann
Mr. J. M. Berliner
Mr. R. H. Rines
Mr. I. S. Blonder

Call Phillips

United States Court of Appeals

For the Seventh Circuit

Chicago, Illinois 60604

RECEIVED
DEC 20 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

December 15, 1971

Before

Hon. WILBUR F. PELL, JR., Circuit Judge

Hon. _____

Hon. _____

UNIVERSITY OF ILLINOIS FOUNDATION,
Plaintiff and Counterclaim
Defendant-Appellant,

No. 71-1879 vs.

BLONDER-TONGUE LABORATORIES, INC.,
Defendant and Counterclaimant-Appellee,

and

JFD ELECTRONICS CORPORATION,
Counterclaim Defendant-Appellee.

} Appeal from the United States District Court for the Northern District of Illinois, Eastern Division

This matter comes before the Court on the motion and affidavit of counsel for plaintiff-appellant for an order allowing the appendix previously filed in this Court in appeal number 17153 to be considered as an appendix in this appeal and for other relief. On consideration whereof,

IT IS ORDERED that counsel for defendant-appellee file answer to said motion on or before Monday, December 27, 1971.

FPI MI—9-10-69-10M-3945

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
JAMES C. WOOD
STANLEY C. DALTON
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JOHN REX ALLEN
1945-1969

December 16, 1971

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RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Re: UIF v. Blonder-Tongue

Dear Bob:

I enclose a copy of Motion on behalf of the Foundation seeking to proceed on the Appeal with fewer than the normal number of printed appendices of the trial record, to avoid the expense of re-printing unnecessary material. This seems like a reasonable request, and unless you disagree, I do not plan to oppose the Motion.

Very truly yours,

Richard S. Phillips

RSP:cm
Encl.

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
JAMES C. WOOD
STANLEY C. DALTON
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CHICAGO 60606

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AREA CODE 312

JOHN REX ALLEN
1945-1969

December 16, 1971

Mr. E. Robert Seaver
Clerk of the Court
Supreme Court of the United States
Washington, D. C. 20543

Re: Blonder-Tongue Laboratories, Inc. v
University of Illinois Foundation, et al
No. 338, October Term, 1970

Dear Mr. Seaver:

I should have been more specific in my letter of December 9th.

The Court awarded Blonder-Tongue one-half its costs. As I pointed out in my letter of October 8th, the University of Illinois Foundation and JFD Electronics were unable to agree on the apportionment of this payment between them. Mr. Berliner in his letter of October 13th explained the position of JFD that no costs should be taxed against them. Mr. Mann's letter of October 18th answering Mr. Berliner contains what appears to be three typographical errors on page 2, referring to Blonder-Tongue in lines 3, 5 and 7, where the reference should be to JFD. The Foundation has not offered to pay the entire cost award.

I would appreciate your confirming that the effect of the Order is to assess one-half the cost award against the Foundation and the other half against JFD.

Very truly yours,

Richard S. Phillips

RSP:cm

CC: Basil P. Mann, Esq.
Jerome M. Berliner, Esq.
Robert H. Rines, Esq.

SUPREME COURT OF THE UNITED STATES
OFFICE OF THE CLERK
WASHINGTON, D. C. 20543

E. ROBERT SEAVER
CLERK OF THE COURT

December 14, 1971

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DEC 16 1971
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Richard S. Phillips, Esq.
20 North Wacker Drive
Chicago, Illinois 60606

Re: Blonder-Tongue Laboratories, Inc.
University of Illinois Foundation, et al.
No. 338, October Term, 1970

Dear Mr. Phillips:

Your letter dated December 9, 1971, has been received. I have perceived no disagreement as between JFD and the Foundation as to the apportionment of the costs assessed against respondents and for this reason I was not under the impression that any decision on my part was required. Mr. Mann, attorney for the Foundation, agreed, in his letter of October 18, that there should be "an equal division of the costs between the Foundation and Blonder-Tongue ---."

All that remains, then, is for the Foundation to reimburse Blonder-Tongue $4,261.45, representing half of the costs, and this will constitute compliance with the Court's order of May 3, 1971. While it is true that the order assesses one-half of the costs ($4,261.45) against respondents jointly, if one of the respondents pays this sum to petitioner, there is no need to revise the order. Only the Court could revise the order, of course.

Very truly yours,

E. Robert Seaver

E. Robert Seaver

cc: Basil P. Mann, Esq.
Jerome M. Berliner, Esq.

December 8, 1971

Mr. J. Anthony Patterson, Jr.
Southwestern Law Journal
Dallas, Texas 75222

Dear Mr. Patterson:

RE: Blonder-Tongue v. University of Illinois

In belated response to your letter of October 27, we declined to support the abandonment of the doctrine of Triplett v. Lowell in our Petitioner's Brief because we felt, in the present climate where the courts have run rough short over patents, we did not wish the whittling away of any further changes of patentees of ultimately getting a fair hearing. We enclose Xerox copies of pages 12-16 of our Petitioner's Brief on this.

What happened in oral argument you will gleen from the Court's decision; since I am quoted presumably to give the Supreme Court some basis for deciding this case on the doctrine of mutuality of estoppel.

I hope this can be of some help even though we did not really address ourselves to this issue.

As you willuundoubtedly gather from the decision, this was not one of the questions we raised in our petition; but one which the Supreme Court later raised on its on and asked us to address ourselves to; it being rather evident that they were waiting for an opportunity to over-rule this doctrine, much as they have been stripping away the prerogative and the protective rights of patentees over the past decades (see, for example, the Lear decided a couple of years before Blonder-Tongue).

Very truly yours,

RINES AND RINES

Robert H. Rines

RHR:la
Enclosure

SOUTHWESTERN LAW JOURNAL

a publication of

SOUTHERN METHODIST UNIVERSITY SCHOOL OF LAW

DALLAS, TEXAS 75222

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NOV 1 1971

RINES AND RINES

NO. TEN POST OFFICE SQUARE, BOSTON

October 27, 1971

Mr. Robert Rines, Esq.
Rines & Rines
10 P.O. Square
Boston, Massachusetts

RE: Blonder-Tongue Lab., Inc. v.
Univ. of Illinois Foundation

Dear Sir:

I am undertaking to write a case note for the Southwestern Law Journal concerning Blonder-Tongue Lab., Inc. v. Univ. of Illinois Foundation. The point which I will primarily address myself to is that of the abandonment of Triplett v. Lowell and the doctrine of mutuality of estoppel. It would greatly aid in my treatment of these matters if you would send me that portion of your brief that dealt with them. I will make a copy of the brief and return it immediately. If you would prefer, I would certainly be willing to receive a copy and reimburse you for the expense.

I will be pleased to send you a complementary copy of the Southwestern Law Journal with the case note when it is published. Thank you for your consideration.

Sincerely yours,

J. Anthony Patterson Jr.

J. Anthony Patterson, Jr.

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
WILLIAM J. STELLMAN
JOHN B. McCORD
BRADFORD WILES
JAMES C. WOOD
STANLEY C. DALTON
RICHARD S. PHILLIPS
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DILLIS V. ALLEN
WM. A. VAN SANTEN
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JOHN REX ALLEN
1945-1969

October 27, 1971

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RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Dear Bob:

* I enclose a stipulation regarding the record for appeal to the Court of Appeals.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

LAW OFFICES
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TWO FIRST NATIONAL PLAZA
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TELEPHONE
312-346-5750
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October 18, 1971

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OCT 20 1971
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Mr. E. Robert Seaver, Clerk
Supreme Court of the United States
Washington, D.C. 20543

Re: Blonder-Tongue Laboratories, Inc. v.
University of Illinois Foundation et al.
No. 338, October Term, 1970
Opinion Dated May 3, 1971, 91 S.Ct. 1434

Dear Mr. Seaver:

This is in response to the letter of October 13, 1971 by Jerome M. Berliner, Esq. concerning the apportionment of costs in this case.

In his letter, Mr. Berliner suggests that no costs should be taxed against his client, JFD Electronics Corp., because the Supreme Court did not rule on the counterclaims against JFD, although the judgment appealed by petitioner Blonder-Tongue was vacated by the Court.

It should be pointed out, however, that practically none of the costs expended by and awarded to Blonder-Tongue related to the only issue considered and decided by the Court, i.e., the Triplett rule. Not only was this issue not presented for review by Blonder-Tongue in its Petition for Certiorari, it even argued against the conclusion reached by the Court. Virtually none of the Appendix, which represented substantially all of Blonder-Tongue's costs, was necessary for the Court's decision. Nevertheless, Blonder-Tongue was awarded a portion of all of its costs, including those related to the counterclaims involving JFD.

In awarding only a portion of its costs to Blonder-Tongue, the Court apparently decided that, in view of the circumstances, it would be equitable that the parties share

Xerox copy to R.D. Rines D.S. Blonder 10/20/71

the cost. We also believe this to be proper, but do not agree that Blonder-Tongue should not bear its share. The costs awarded to Blonder-Tongue were no more intimately associated with the issues involving the Foundation than they were to the issues directly concerning Blonder-Tongue. Accordingly, it is suggested that an equal division of the costs between the Foundation and Blonder-Tongue should be ordered.

Very truly yours,

Basil P. Mann
Attorney for University of
Illinois Foundation

BPM/kd

cc: Mr. Jerome M. Berliner
Mr. Richard S. Phillips

LAW OFFICES

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October 18, 1971

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OCT 20 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. E. Robert Seaver
Clerk of the Court
Supreme Court of the United States
Washington, D. C. 20543

RE: Blonder-Tongue Laboratories, Inc. v.
University of Illinois Foundation et al,
No. 338, October Term, 1970

Dear Mr. Seaver:

Thank you for your letter of October 13 regarding the assessment of costs in the above. Your letter crossed in the mail with a letter to you from the attorneys for JFD explaining why they feel no costs should be assessed against their client. If the University of Illinois Foundation proposes to answer the JFD argument, I assume they will do so promptly.

We appreciate your prompt consideration of this question.

Very truly yours,

Richard S. Phillips

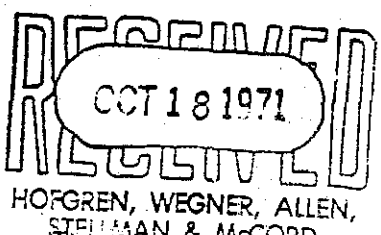
RSP:iag

cc: Mr. B. P. Mann
Mr. J. M. Berliner
Mr. R. H. Rines
Mr. I. S. Blonder

SUPREME COURT OF THE UNITED STATES
OFFICE OF THE CLERK
WASHINGTON, D. C. 20543

E. ROBERT SEAVER
CLERK OF THE COURT

October 13, 1971



Richard S. Phillips, Esq.
20 North Wacker Drive
Chicago, Illinois 60606

Re: Blonder-Tongue Laboratories, Inc. v.
University of Illinois Foundation, et al.,
No. 338, October Term, 1970

Dear Mr. Phillips:

This will acknowledge receipt of your letter of October 8, 1971.

Normally, when an order is entered such as that in this case the respondents share equally the costs that are assessed against them. If respondents herein present some valid reason why their liability for costs should be apportioned among them in some other way, please let me know.

Very truly yours,

E. Robert Seaver

E. Robert Seaver

OSTROLENK, FABER, GERB & SOFFEN
ATTORNEYS AT LAW
10 EAST 40TH STREET
NEW YORK, N. Y. 10016

SAMUEL OSTROLENK
1898-1968

SIDNEY G. FABER
BERNARD GERB
MARVIN C. SOFFEN
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JEROME M. BERLINER
LOUIS WEINSTEIN
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ROBERT C. FABER

EDWARD A. MEILMAN
HOWARD SCHULDENFREI

PATENTS
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TELEPHONE
(212) 685-8470

CABLE:
OSTROFABER NEW YORK

October 13, 1971

RECEIVED
OCT 15 1971
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Mr. E. Robert Seaver, Clerk
Supreme Court of the United States
Washington, D. C. 20543

Re: Blonder-Tongue Laboratories Inc. v
University of Illinois Foundation et al
No. 338, October Term, 1970
(OFGS File No. JFD-3.223)
Opinion Dated May 3, 1971, 91 S.Ct. 1434

Dear Mr. Seaver:

Reference is made to the letter of October 8, 1971 (copy annexed) from Richard S. Phillips, Esq. requesting "clarification of the cost award order".

It appears that taxing costs against our client, JFD Electronics Corp., would be unjust in light of the Opinion of the Supreme Court.

At the District Court level, Plaintiff University of Illinois Foundation charged Defendant Blonder-Tongue Laboratories Inc., inter alia, with infringement of U. S. Patent No. 3,210,797. JFD was in no way involved in the Complaint. JFD was first brought into the suit at the District Court level when Blonder-Tongue counterclaimed against JFD for unfair competition, anti-trust law violation and infringement of one of Blonder-Tongue's own patents. All of the counterclaims against JFD were unrelated to infringement or validity of the Foundation's patent in suit.

All of the counterclaims against JFD were dismissed by the District Court. Blonder-Tongue appealed the dismissal to the Seventh Circuit Court of Appeals, and

COPY

the dismissal of the counterclaims against JFD was affirmed. JFD was, therefore, the "prevailing party" at both the District Court and Court of Appeals levels.

Blonder-Tongue again raised the counterclaims against JFD in the U. S. Supreme Court. But this Court refused to even consider these counterclaims. Justice White wrote a lengthy Opinion concerned only with the validity of the Foundation's patent in suit. It was only at the very end of the Opinion that the following appears, at 91 S. Ct., p. 1454:

> "In taking this action, we intimate no views on the other issues presented in this case. The judgment of the Court of Appeals is vacated and the cause is remanded to the District Court for further proceedings consistent with this opinion."

Because the Supreme Court refused to rule on the dismissal of the counterclaims against JFD, JFD became the "prevailing party" in the Supreme Court as well as in the two courts below.

It is submitted that no costs should be taxed against JFD at the Supreme Court level -- Title 28 U. S. Code, Sec. 1912. It is true, under Supreme Court Rule 57, sub-section 2, that in the event a Judgment is vacated, costs are to be allowed to the Petitioner, here Blonder-Tongue. We submit that such costs should not be taxed against JFD. Insofar as the counterclaims against JFD are concerned, JFD was the prevailing party. The Court of Appeals' Judgment in JFD's favor was, in effect, affirmed. JFD should be relieved of its obligation to pay costs on the Supreme Court level, pursuant to sub-section 1 of Supreme Court Rule 57.

COPY

Accordingly, we respectfully request that you correct the cost award order to relieve JFD of the obligation of paying costs at the Supreme Court level.

Very truly yours,

OSTROLENK FABER GERB & SOFFEN

Jerome M. Berliner

JMB - jab
Encl.
cc: Mr. Charles J. Merriam
Mr. Richard S. Phillips

COPY

UNITED STATES DISTRICT COURT
EVERETT McKINLEY DIRKSEN BUILDING
UNITED STATES COURT HOUSE
CHICAGO 60604

H. STUART CUNNINGHAM
CLERK

OFFICE OF THE CLERK

October 13, 1971

Mr. Basil P. Mann
Merriam, Marshall, Shapiro and Klose
2 First National Plaza
Chicago, Ill.

RE: UNIVERSITY OF ILL. FOUNDATION vs BLONDER-TONGUE LABORATORIES INC. No. 66 C 567

The enclosed copy of the docket entries is forwarded to you for the convenience of preparing a Stipulation for the Record on Appeal pursuant to Rule 11(f) of the Federal Rules of Appellate Procedure. If no stipulation is to be filed, the Appellant must file a request for the complete record.

Transcripts of Proceedings which are to be included in the Record on Appeal, but are not yet filed in our office, should be obtained pursuant to Rule 10(b) FRAP as amended. Exhibits to be included in Record on Appeal should be filed with a descriptive list and sufficient copies of the list.

The record on appeal is due to be filed in the Court of Appeals, on or before November 22, 1971.
It will be appreciated if the original stipulation and copy or request for the complete record, transcripts and exhibits are filed within 20 days of this date to expedite the preparation of the Record on Appeal.

Very truly yours,

H. STUART CUNNINGHAM, CLERK

BY: Clyde Louis Brown

Copy of letter only to: Attorneys for appellees

RECEIVED
OCT 14 1971
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
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JOHN REX ALLEN
1945-1969

October 13, 1971

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OCT 15 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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 notice of appeal we received this morning from the Foundation.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. I. S. Blonder (*)
Mr. J. F. Pearne (*)

HANNOCH, WEISMAN, STERN & BESSER
COUNSELLORS AT LAW
744 BROAD STREET
NEWARK, NEW JERSEY 07102

COPY

621-8800
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N. Y. TELEPHONE
267-4498
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REFER TO FILE NO.

760-7

October 12, 1971

Mr. Isaac S. Blonder
Blonder-Tongue Laboratories, Inc.
One Jake Brown Road
Old Bridge, New Jersey 08857

RECEIVED
OCT 14 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. Ben H. Tongue
Blonder-Tongue Laboratories, Inc.
One Jake Brown Road
Old Bridge, New Jersey 08857

Dear Ike and Ben:

By letter of January 26, 1971, I sent each of you a copy of a proposed Amended and Restated Partnership Agreement for B-T Investment Associates.

By letter of February 2, 1971, I sent each of you a copy of a newly revised "Buy-Sell" Agreement for Blonder-Tongue Laboratories, and a copy of a memorandum outlining some of the major questions raised by the existing agreement and the proposed revision.

It is now mid-October and still you have not reached agreement on the changes to the partnership agreement, and changes to the corporate buy-sell, with attendant increases in insurance.

I am very concerned at this state of affairs, because, as I have set forth to both of you in detail, the existing partnership agreement's requirement of a mandatory purchase by the surviving partner (at 50% of the net worth of the partnership) and the amount of uninsured valuation of the corporation's stock in the existing buy-sell agreement would both present very serious problems in case either of you passed away.

Once again, I urge both of you to compromise on the valuation-insurance questions posed by the corporate buy-sell agreement so that we can get a new revised buy-sell into effect, without any further delay.

With respect to the partnership agreement, I believe that it should be signed up at this time regardless of whether or not the corporate buy-sell is signed.

Please get in touch with me on this soon.

Sincerely,

Philip L. Chapman

PLC/tr

cc: Mr. Charles E. Bloom, Jr.
Touche, Ross & Co.
80 Pine Street
New York, New York

cc: Robert H. Rines, Esq.
10 Post Office Square
Boston, Massachusetts

LAW OFFICES

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October 8, 1971

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OCT 12 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Mr. E. Robert Seaver, Clerk
Supreme Court of the United States
Washington, D. C. 20543

RE: Blonder-Tongue Laboratories Inc. v.
University of Illinois Foundation et al
No. 338, October Term, 1970

Dear Mr. Seaver:

* Attached is a copy of the order taxing costs in the above. Petitioner was awarded one-half its costs, to be recovered from "University of Illinois Foundation et al". The University of Illinois Foundation and JFD Electronics have questioned the manner in which payment of the costs is to be apportioned between them. Accordingly, on behalf of Blonder-Tongue Laboratories, we request clarification of the cost award order.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosure

cc: Mr. Charles J. Merriam
Mr. Sidney G. Faber

bcc: Mr. R. H. Rines
Mr. I. S. Blonder
Mr. B. P. Mann
Mr. M. C. Cass

CHARLES J. MERRIAM
WILLIAM A. MARSHALL
JEROME B. KLOSE
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MICHAEL F. BORUN

October 7, 1971

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HOFGREN, WEGNER, ALLEN,
STELLMAN & McCORD

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

Re: UIF v. BT v. JFD

Dear Dick:

The uncertainty re the apportionment of costs arises in the order of the Supreme Court which states that Blonder-Tongue should recover from "the University of Illinois Foundation et al.", the "et al." obviously referring to JFD.

In any event, we are considering an appeal in this case and still believe that no costs should be paid until the judgment becomes final. Accordingly, if you feel that the costs should be paid before such time, I suggest you seek an order from the court.

Bob - this will be due 10/27 Dick

Sincerely yours,

Basil P. Mann

BPM/kd

Xerox copy to R.W. Kuhn D.S. Blanke 10/13/71

LAW OFFICES

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ERNEST A. WEGNER
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JOHN REX ALLEN
1945-1969

October 7, 1971

Mr. Stephen D. Kahn
Davis, Hoxie, Faithfull & Hapgood
30 Broad Street
New York, New York 10004

RECEIVED
OCT 12 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Dear Mr. Kahn:

I read with interest your article on the Blonder-Tongue decision in the September issue of the JPOS. The University of Illinois Foundation did raise the point you suggest in arguing that estoppel was not proper. For your * information, I enclose a copy of the memorandum which we filed on behalf of Blonder-Tongue opposing the Foundation's argument. Last week Judge Hoffman issued a memorandum decision adopting our argument and holding that the Foundation was barred by the earlier decision from re-litigating * validity. I enclose a copy of his decision.

Very truly yours,

Richard S. Phillips

RSP:iag

* Enclosures

cc: Mr. R. H. Rines

LAW OFFICES

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JOHN REX ALLEN
1945-1969

October 6, 1971

Mr. Basil P. Mann
Merriam, Marshall, Shapiro & Klose
Two First National Plaza, Suite 2100
Chicago, Illinois 60670

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RINES AND RINES
TEN POST OFFICE SQUARE, BOSTON

RE: UIF v. BT v. JFD

Dear Pete:

I have checked the orders of the Supreme Court and the Court of Appeals with regard to costs and fail to understand your question regarding apportionment between the Foundation and JFD. Attached are copies of * the orders of both courts that Blonder-Tongue should recover portions of its costs from the Foundation.

I expect this to be paid promptly.

Very truly yours,

Richard S. Phillips

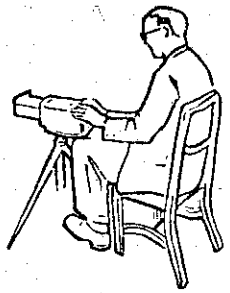
RSP:iag

* Enclosure

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

Alderson Reporting Company, Inc.

General Stenotype Reporting



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ASSISTANT GENERAL MANAGER
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MIKEL J. COPELAND
JOHN R. CORR

17 August, 1971

Mr. Richard S. Phillips
Hofgren, Wegner, Allen, Stellman and McCord
20 North Wacker Drive
Chicago, Ill. 60606

RECEIVED
AUG 25 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

Dear Sir;

Please be advised that the cost of the transcript in the matter of Blonder-Tongue Laboratories v. University of Illinios is $260.70, plus postage of approximately $1.00.

If you still wish us to send you a copy of this argument, we will do so upon receipt of your check.

Sincerely,

P. Wachzema

Duplicating Department,
Alderson Reporting Co.
300 7th St, SW
Washington, DC 20024

RECEIVED
AUG 19 1971
HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

Bob:

If you still want a copy of the argument, I suggest you order it directly.

R. S. Phillips

Verbatim Record of Official Proceedings

LAW OFFICES

AXEL A. HOFGREN
ERNEST A. WEGNER
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AUG 16 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

August 11, 1971

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

RE: UIF v. BT v. JFD

Dear Bob:

You received a copy of the notice from the Clerk of the Court of Appeals for the 7th Circuit regarding the withdrawal of physical and documentary exhibits.

We withdrew the collection of original documentary exhibits at the time of preparation of the appendix for the Supreme Court, and I believe we still have it in our office. Defendant's exhibits 24, the model of the DuHamel and Ore antenna, and 29, the piece of transmission line connected with plaintiff's exhibit 10, the Golden Dart antenna, were sent to the Supreme Court and as far as I know are still there.

I went through the file in the Court of Appeals, and the exhibits which they still have, and found nothing further which I think we need worry about. There are several antennas still there, but they belong either to the Foundation or to JFD.

Very truly yours,

Richard S. Phillips

RSP:iag

File —

LAW OFFICES

HOFGREN, WEGNER, ALLEN, STELLMAN & McCORD

20 NORTH WACKER DRIVE

CHICAGO 60606

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DILLIS V. ALLEN
WM. A. VAN SANTEN
RONALD L. WANKE
LOUIS A. HECHT

August 11, 1971

RECEIVED
AUG 16 1971
RINES AND RINES
NO. TEN POST OFFICE SQUARE, BOSTON

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

Dear Bob:

* I enclose a copy of an article about Paul Mayes from the Electrical Engineering Alumni publication of the University of Illinois. I thought this might be of interest to you.

I see from the BNA Patent, Trademark and Copyright Journal that petitions for certiorari have been filed in two cases seeking to extend the Blonder-Tongue reversal of Triplett v. Lowell. In one case the patent was held valid and infringed in the Court of Claims, following a full trial. In a subsequent case in California, it was held invalid on a motion for summary judgment and the 9th Circuit affirmed. The patentee argues that the estoppel should extend to defendants unless they can show that the prior defendant did not have a full, fair opportunity to litigate or that they have significantly different evidence to present. The other case involves an interference proceeding where the petitioner argues that the decision of the Board of Patent Interferences should stand unless the losing party can show lack of a full opportunity to present evidence.

The Blonder-Tongue name will certainly be well known in patent circles for many years. I don't know how much of the publicity will translate into sales dollars, but maybe it will compensate to some extent for the expenses they have had.

Very truly yours,

Dick

Richard S. Phillips

RSP:iag

* Enclosure

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

He vigorously participates in professional activities. He served as Chairman of the IEEE Information Theory Group of the Chicago Area in 1967, Editor for Coding for the 1970 IEEE International Symposium on Information Theory, and is presently a member of the Administrative Committee of the Information Theory Group.

The Chiens were naturalized last year and now live (with four children, Emily, Tony, Andrew and Steve) on top of the tallest hill in South-East Urbana.

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PAUL E. MAYES

B.S., 1950, University of Oklahoma
M.S., 1952, Northwestern University
Ph.D., 1955, Northwestern University

Professor Mayes was born in one small town, received his mail from another, and went to school in a third, all located in the southwestern part of Oklahoma. His early interest in electronics was no doubt partly due to his distaste for farming. Presented with an inoperative, second-hand radio during his war-time teen-age years (when new ones were not available and all the repair men were away), he initiated a lifelong display of incompetence in economics by taking a $ 200.00 correspondence course in radio repair. He escaped from the farm by enrolling at O.U.; the easy course to pursue was Electrical Engineering. Mayes and thousands of returning veterans matriculated together and, subsequently, graduated together in the recession year of 1950. Employment prospects being bleak, he was advised by one of his professors (who had come from a farm a mile across the field and consequently knew Mayes from birth) to go to graduate school. A classmate, "Jerry" Ernst, recommended the University of Illinois where his brother Ed (now on the U. of I. faculty) was then a graduate student. However, Northwestern came through with an earlier offer of a graduate assistantship so Mayes and his new bride Lola packed their belongings and moved to the "big city".

At Northwestern, Mayes was assigned to the Microwave Lab under the guidance of Professor Robert Beam. In those pre-computer days he spent many hours calculating dispersion data for dielectric waveguides before venturing into the lab to study the efficiency of various methods of exciting propagating modes on dielectric rods. He also was involved in measuring losses due to radiation from bends in dielectric-rod waveguides and in developing techniques for calculating and measuring the near-field of two-dimensional conducting scatterers.

After receiving his Ph.D., Mayes joined the staff of the Antenna Lab of the University of Illinois. He has worked, with the help of numerous students, on slot antennas, antenna synthesis, frequency-independent antennas, small antennas and active antennas . Several of these antennas have been patented by the University of Illinois Foundation, the most famous being the log-periodic vee (LPV) which was developed into a highly successful antenna for TV reception. His log-periodic zigzag is also widely used, in central Illinois particularly, for receiving UHF TV signals.

Mayes has served as a technical consultant to a number of firms. JFD Electronics Corporation, which located a research laboratory in Champaign in 1962, developed the first 83-channel TV antennas using the LPV concept. More recently, Mayes has been intrigued with the idea of combining new solid-state devices with antennas. For more than two years his car radio has been operating from signals supplied by a transistor on a small disc which is mounted underneath the car. "It out-performs the original whip antenna," he explains, "and isn't as easily broken off."

Professor Mayes is a Senior Member of the IEEE, a member of Commission VI of URSI, a member of Sigma Xi, Tau Beta Pi and Eta Kappa Nu. He has published a textbook on electromagnetics and numerous research papers, two of which have received certificates as outstanding contributions. But his greatest source of pride is his family-- Gwynne, 18, a violinist and vocalist who enters the University of Illinois School of Music this fall; Linda, 16, an accomplished seamstress who sews most of her own and many of her sisters' clothes; Stuart, 14, who enjoys playing basketball, beating drums and eating, in that order; Pat, 12, another musician who plays piano, bassoon and clarinet and who aspires to be an organist; Steven, 9, a budding artist who enjoys eating and playing baseball, in that order; and David, 3, who undoubtedly will surpass his brothers and sisters in all things.

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ANNUAL REVIEW OF ELECTRONICS

We are pleased to announce the 9th Annual Review of Electronics (ARE), to be held Monday, October 18, 1971, with Professor J. Verdeyen, Chairman. The program, covering topical areas of Biological Electronics, Materials and Atmospheric Sciences, promises to be most interesting.

In addition to the ARE meeting, you are invited to attend the annual meeting of the Coordinated Science Laboratory, Tuesday and Wednesday, October 19-20, 1971. For further information please contact Professor J. Verdeyen or Dr. M. E. Krasnow, Coordinator of University Industrial Relations.

So mark your calendar to spend one or more days on the U of I campus attending an informative series of meetings in Electronics.