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Book Review: Court Review of Patent Office Decisions: Court of Customs and Patent Appeals, Volumes 4 & 4a of Patent Law and Practice Series

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BOOK REVIEW

COURT REVIEW OF PATENT OFFICE DECISIONS: COURT OF CUSTOMS AND PATENT APPEALS, VOLUMES 4 & 4A OF PATENT LAW AND PRACTICE SERIES BY DONALD R. DUNNER

New York: Matthew Bender Co., 1973. Volume 4: Pp. xxxiv, 481; \$50.00; Volume 4A: Pp. x, 645; \$50.00.

Volumes 4 and 4A, *Court Review of Patent Office Decisions*, were first conceived in a limited-enrollment, intensive seminar sponsored by the National Law Center of the George Washington University, and were designed to provide the patent practitioner with a comprehensive and practical view of the formalized procedures involved in patent office decisions from the decision of the Board to the final decision in the Court of Customs and Patent Appeals. The author has provided the specialized practitioner in patents and trademarks law with one of the most detailed and explicit collections of substantive and adjectival presentations it has been the pleasure of this writer to read and review.

Layout of the Volumes 4 and 4A exemplify the concern and sympathetic dedication of the author to the pressing needs of that select group of practitioners before the Court of Customs and Patent Appeals. The author exhaustively surveyed and sorted the most varied and effective documents and pleadings with the assistance and cooperation of practicing attorneys, judges, and other officials of the Court of Customs and Patent Appeals; the distillation of what amounts to a formidable total of manhours and assiduous research and effort has been sorted, capsulized, and reproduced in a narrative and positive way.

For example, the lead pages of Volume 4 provide the practitioner with a correlation table between CCPA rules revised as of May 18, 1972 and the new rules effective January 1, 1974. In and of itself, such a table is rather plodding and mechanical. The table, though, is followed by a commentary on the new rules, which is valuable in updating those practitioners accustomed to the 1972 rules by pointing out at each step of the way the expansion effected by the 1974 rules and the detailed effects of such expansion. The commentary is exceptionally clear and complete, and is indeed a model of the kind of legal literature that lawyers could and should expect when substantial changes in substantive law or procedure come into being, and are superimposed upon the basic purview of knowledge that a professional of average skill in the field is supposed to have mastered.

The works restrict themselves to practices and procedures on appeals from patent office decisions in (1) *Ex parte* patent decisions of the Board of Appeals of the Patent Office, 35 U.S.C. § 141-145; 28 U.S.C. § 1542; P.O. Rules 301-304; (2) *Inter partes* Patent Decisions of the Board of Patent Interferences, 35 U.S.C. § 141-144, 146; 28 U.S.C. § 1542; P.O. Rules 301-304, 42 U.S.C. § 2182, 2457; and (3) *Ex parte* and *inter partes* trademark decisions of the Commissioner and Trademark Trial and Appeal Board, 15 U.S.C. § 1071; T.M. Rules 2.145, 2.119; 28 U.S.C. § 1361, 1542.

Volumes 4 and 4A are obviously designed for those members of the profession who are presently engaged in, or by necessity compelled to, practice before the Court of Customs and Patent Appeals. The volumes' orientation towards and value to the pressed and harried practitioner can perhaps be best exemplified by the arrangement of the volumes: Substantive comment is followed immediately in each chapter by a complete collection of exceptionally well drafted forms for the execution and implementation of the substantive points discussed. In Volume 4 for example, the table of forms itself occupies 17 pages. If one pursues this table to a particular form one finds a complete and impressively concise legal document for almost any situation one can imagine that might arise in a CCPA appeals situation.

Volume 4 initially discusses *ex parte* patent appeals, and discusses in detail the procedures of the patent office, including step by step chronologies, pleadings, documents, and fees. The next chapter reviews *ex parte* patent appeals and preliminary procedures in the Court of Customs and Patent Appeals and covers, once again, the kinds of details, such as forms, fees, printing, and the like, that many attorneys have, hat in hand, sought *ad hoc* from the ministerial functionaries of the multitudinous courts of record throughout the land.

Chapter 4 commences with a rather concise substantive discussion of motions practice, followed by some extensive motions documents illustrating the substantive introduction. Chapter 5 deals with the hearing and decision elements of *ex parte* patents appeals.

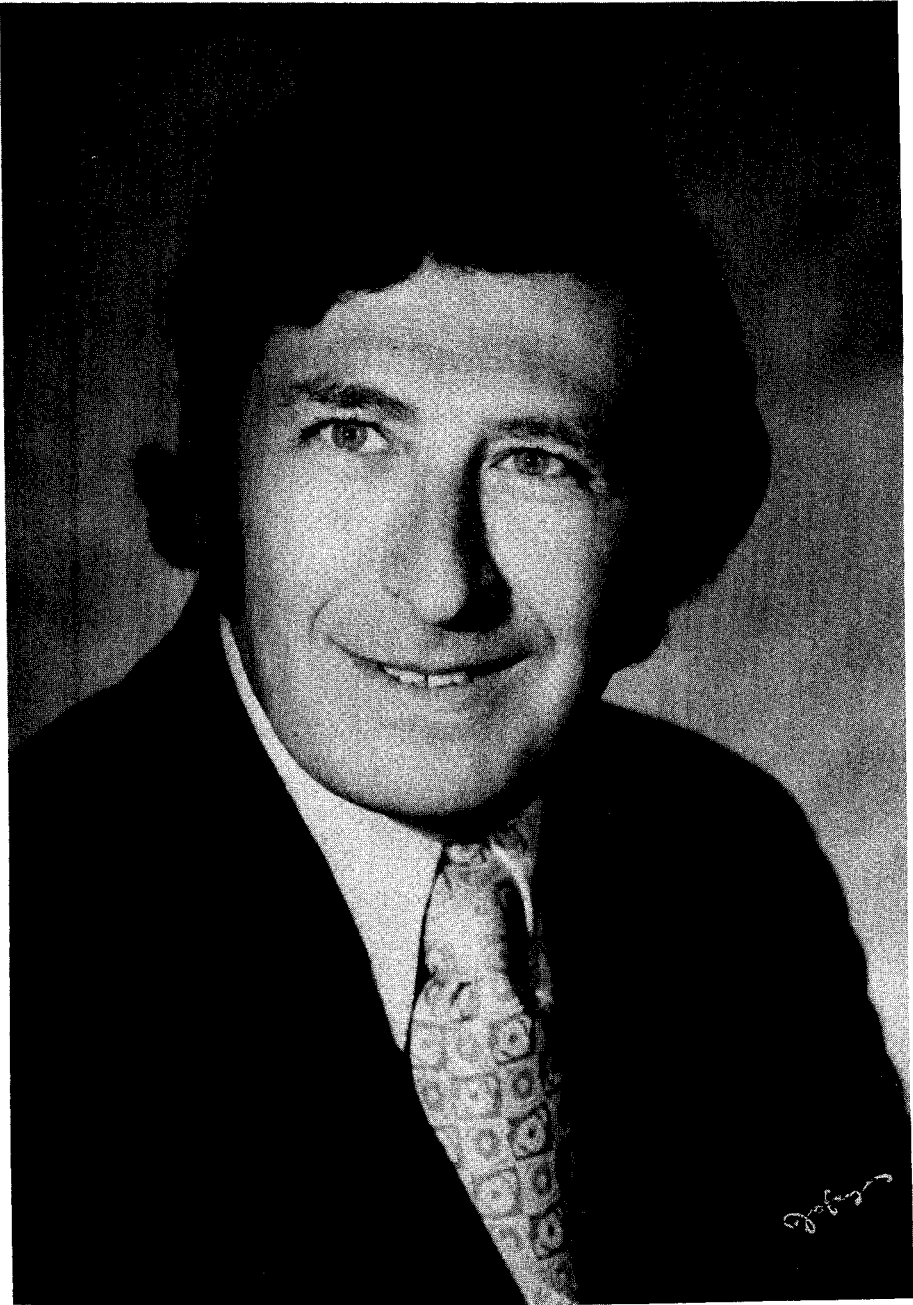
The denouement of this esoteric but delightful insight into a very sophisticated and unique area of practice continues in Volume 4A with chapter 6 where the *inter partes* appeals and the

Board of Patent Interferences is illustrated and described in an unusually thorough appraisal. Chapter 7, entitled "Appeals in Trademark Cases," may have an appeal to members of our profession who are not members of the Patent Bar, but who have developed or have been visited with a number of clients in the less scientific and more pragmatic field of unfair trade practices. In this chapter once again, the author has assembled a remarkable and admirable sequence of substantive narrative followed by crisp and detailed examples of practice documentation. Chapter 8 has the delightful title of "Miscellaneous Matters" and presents practical solutions for clients' problems and settlement negotiations, including comparative factors such as costs, time delays, ease of presentation, the effect of *res judicata*, and, not to be totally ignored, fees. The final chapter of Volume 4A sets forth the texts of statutory provisions and patent office and court rules relating to review of patent office decisions.

The sequence of matters presented in these two volumes is well arranged in a logical scheme, well indexed and explained, with a minimum of "fog count." The author has demonstrated unusual concern and scholarship in providing a reference work so complete and detailed that it would appear to constitute both an advanced primer for the infrequent petitioner before the Court of Customs and Patent Appeals, and a reliable refresher and reference source for the professional who appears before that body with regularity.

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DEDICATION

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