

# Supreme Court of the United States

October  
██████████ TERM 1969

In the Matter of:

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 ANDERSON'S-BLACK ROCK, INC., :  
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 : Petitioner :  
 :  
 vs. :  
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 PAVEMENT SALVAGE CO., INC., :  
 :  
 : Respondent. :  
 :  
 -----X

Docket No. 45

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Place Washington, D. C.

Date November 10, 1969

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ORAL ARGUMENT OF:

P A G E

Walter J. Blenko, Esq. on behalf  
of Counsel for Respondent . . . . . 16

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IN THE SUPREME COURT OF THE UNITED STATES

October

TERM 1969

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 ) Petitioner )  
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 vs ) No. 45  
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 PAVEMENT SALVAGE CO., INC., )  
 )  
 ) Respondent )  
 ) Monday, November 10, 1969  
 ) Washington, D. C.  
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The above-entitled matter came on for hearing at  
11:00 o'clock a.m.

BEFORE:

- WARREN E. BURGER, Chief Justice
- HUGO L. BLACK, Associate Justice
- WILLIAM O. DOUGLAS, Associate Justice
- JOHN M. HARLAN, Associate Justice
- WILLIAM J. BRENNAN, JR., Associate Justice
- POTTER STEWART, Associate Justice
- BYRON R. WHITE, Associate Justice
- THURGOOD MARSHALL, Associate Justice

APPEARANCES:

- ALAN W. BORST, ESQ.  
10 East 40th Street  
New York, N. Y. 10016  
Counsel for Petitioner
  
- WALTER J. BLENKO, JR., ESQ.  
1020 North American Rockwell Building  
Pittsburgh, Pennsylvania 15222  
Counsel for Respondent

P R O C E E D I N G S

1  
2 MR. CHIEF JUSTICE BURGER: Number 35. Anderson's-  
3 Black Rock against Pavement Salvage Company.

4 Mr. Borst, you may proceed whenever you are ready.

5 MR. BORST: Thank you, sir.

6 If the Court please, this is a civil action; a case  
7 on patent infringement which was tried before the District  
8 Court in the Southern District of West Virginia. The trial was  
9 had and an opinion was rendered in written form declaring that  
10 the patent in the suit, namely: Neville Patent No. 30005280,  
11 was invalid; not reaching the issue by the defendant on  
12 account of that adjudication.

13 The appeal was then made to the Circuit Court of  
14 Appeals for the Fourth Circuit in Richmond, in which -- before  
15 which we had oral argument, and after that the decision was  
16 rendered reversing the District Court and remanding it to the  
17 District Court for consideration of the infringement issue.

18 Stay of that mandate was then granted on Petitioner's  
19 request, pending, of course, the determination of the whole  
20 matter by this Court.

21 The Neville Patent in the suit basically discloses  
22 a street paver. And suspended from the street paver is a  
23 heat generator. The street paver basically comprises a hopper  
24 which receives bituminous material from a truck which has  
25 obtained the material from an asphalt plant. A distributor

1 which deposits the material on a roadbed and a tamper which is  
2 vibrating fashion compacts material on the bed and very often  
3 a screed which irons or planes the material so as to smooth it  
4 and finally shape the pavement.

5 The heater which is suspended from the paver in the  
6 Neville patent is not used to -- in the operation of the paver  
7 to form the first strip of pavement. It is used solely when  
8 paving the second strip, which is to be laid in abutting re-  
9 lation to the first strip. Its functions -- the heater functions  
10 to preheat the longitudinal marginal edge of the first strip  
11 that had been laid but which had been allowed to grow cool;  
12 and then the paver itself deposits the asphalt on the roadbed  
13 and against the new -- the preheated edge so as to form a bond  
14 therewith -- a union therewith; and to make the so-called cold  
15 joint.

16 The claims in the suit and we have considered Claim  
17 IV representative, call broadly for a means for laying the  
18 asphalt and means for shaping the pavement. And that, broadly,  
19 therefore, covers the paver itself.

20 The claim goes on to recite a radiant generating  
21 means and further, in connection with the radiant energy  
22 generating means, that comprises a combustion chamber below a  
23 plate of which is perforated. And through the holes of the  
24 perforation, or adjacent thereto, propane gases or butane gases  
25 are fired and the plate thereby becomes incandescently hot and

1 becomes a source of radiant energy, or infra-red heat.

2 The radiant energy generator in another patent;  
3 is disclosed as far as it is claimed in Schwank Patent, No.  
4 2,775,294, and the Neville specification so states that the  
5 radiant energy generator that is disclosed in the Schwank pro-  
6 cess is entirely suitable for the patentee's purposes.

7 The components of the paver and the components of the  
8 generator are all old elements which is readily conceded by  
9 Respondent. In reversing the District Court --

10 Q There is no process patent involved here?

11 A There is no process claims; just apparatus  
12 claims.

13 In reversing the District Court the Circuit Court of  
14 Appeals commented the steps which occupy the attention of the  
15 District Court were narrow ones and went on to make its decision  
16 largely based on the satisfaction of the long-felt need and  
17 eventual acceptance of Neville's concepts by Respondents'  
18 experts who are initially skeptical.

19 The Court then went on to find that the method of  
20 forming the so-called cold joint between two asphalt layers of  
21 concrete -- of highway previous to Neville, involved the pro-  
22 cess of cutting back the vertical marginal edge and painting  
23 it with asphalt.

24 We feel that both this finding of the Circuit Court  
25 of Appeals and the significance to be attached to the experts'

1 original skeptability and incredulity, must be weighed in  
2 terms of the prior art which is extant at that time. Included  
3 in that art is British Patent No. 756911. According to that  
4 patent it is entirely feasible to cut back to feed the vertical  
5 edge of the first lane of concrete.

6 There is no mention in this prior art patent of  
7 cutting back that edge and painting it with hot asphalt. We  
8 feel that knowledge of this patent, as well as other patents of  
9 the prior art which we feel are particularly apposite, and  
10 their disclosures, should be imputed constructively to the  
11 -- to Respondent's experts, as well as to the patentee himself.

12 Q How much of a prior art constitutes a reliable  
13 claim -- all of it?

14 A All of it but the so-called Morcom Patent which  
15 I am about to come to.

16 The British patent was cited during the prosecution  
17 of the Neville application.

18 This matter of the previous method of forming an edge,  
19 we feel should be imputed to the patentee himself, who was  
20 supposed to have filled a long-felt need and thereby having made  
21 an unobvious discovery as required for patentability under  
22 35 US Code 103.

23 Aside from this, Petitioner believes it would be  
24 moot to consider here this question of long-felt need or com-  
25 mercial success in its function in patent laws with regard to

1 the determination of the validity or invalidity of patents.  
2 Under the decisions there is no question but that this is a  
3 marginal or peripheral question. This conclusion was explicitly  
4 expanded by this Court in <sup>the</sup> A&P versus Supermarket case decided  
5 in 1950 and in which it said, and I quote: "Commercial success  
6 without invention will not make patentability."

7 The decisions over the years have said that commer-  
8 cial success may be used to resolve doubt as to inventions, but  
9 not to inject such doubt. So, therefore, recognizing that such  
10 a ground as long-felt need is relevant solely on condition that  
11 after the usual test of patentability had been conducted, there  
12 is genuine doubt as to how to decide the issue invention, we  
13 have the really significant question here as to how much  
14 importance may be attached to commercial success, when the only  
15 evidence of that success that has been adduced by Plaintiff,  
16 relates to but one element of the patented combination; that  
17 being the radiant energy generator, as claimed, of the Schwank  
18 type."

19 The two engineers who testified for Respondent, des-  
20 cribed the benefits and virtues and glories of using a radiant  
21 energy generator of the Schwank type to heat up an asphalted  
22 edge which was to receive new asphalt in abutting relation.

23 They did not testify as to the success of or the un-  
24 expected benefits flowing from the combination paver and heater  
25 which is the subject of the claim. It is the combination which



1 is the supposed invention, not the heater, per se.

2 The original claims as filed in the Patent Office  
3 attempted to claim the heater per se in connection with its  
4 use in highway construction. But those claims they never  
5 failed to get. We also attempted to get claims to a process  
6 for using such a generator, and those claims he failed to get.

7 So, he is now in a position where he can only assert  
8 the scope of his invention -- the entire combination of con-  
9 ventional roadpavers and specific types of radiant energy  
10 generators.

11 Q It is your position that this is not a com-  
12 bination, rather simply an aggregation?

13 A Yes. I am using the term up until now in a  
14 rather nontechnical sense. When I say combination I mean rather  
15 a connotation or --

16 Q A collection of known ingredients?

17 A Right.

18 Q But, technically, it's your claim that this is  
19 an aggregation and I understand your submission is that the law  
20 is that a mere aggregation is never patentable; a combination  
21 may be patentable if it combines old elements to reach a new  
22 and unanticipated result; is that it?

23 A That is our position perfectly stated.

24 The question, naturally, therefore presents itself as  
25 to whether the Respondents' testimony as to commercial

1 successes is even relevant since it goes only to the benefits  
2 of one element of an assembly of elements as patented, which  
3 is better than any invention in this assembly of old elements.

4 So, let us look at the so-called "narrow issues" and  
5 steps which occupy the attention of the District Court. In  
6 fact, these issues involve the scope and relevancy of the prior  
7 art to this development. It involved the question as to whether  
8 the patentee had solved a problem which had hitherto, essen-  
9 tially defied solution.

10 And it went into this question of aggregation which  
11 we feel was treated rather cavalierly by the Court below.

12 The prior right in this case which the Petitioner  
13 considers most pertinent, is the British patent which I pre-  
14 viously alluded to: the Morcum Patent, No. 709,014 was issued  
15 in 1905 and, of course, the Schwank Patent which was the  
16 radiant energy generator used on the Neville Paver.

17 Morcum refers to the basic problem of causing new  
18 asphalt to unite with old asphalt in place in road patching.  
19 And what is Morcum's solution? It is exactly and precisely the  
20 same as Neville's; namely: the use of radiant energy. Respon-  
21 dent has never tried to contend throughout the trial or the  
22 appeals that road patching in this regard presents any problem  
23 which differs essentially from road construction; there being  
24 in each case a question of how to get new asphalt, which is hot  
25 asphalt, to unite with old asphalt which has been allowed to

1 grow cold.

2 As Morcum in 1905 and Neville in 1959 -- some 50 or  
3 more years later, state that radiant energy prepares the cold  
4 surface edge and is less likely to scorch it, than say, an  
5 open flame. The British patent shares everything that Neville  
6 claims except that the British street paver meets the marginal  
7 asphalt edge with a different type radiant energy heater. It  
8 is not so denominated in the British patent of the radiant  
9 energy heater, but as Judge Haynesworth in the Fourth Circuit  
10 Court stated it is a radiant energy heater since it comprises a  
11 combustion chamber which permits and which provides for the  
12 firing of gaseous materials within and an escape or discharge  
13 opening, causing the bottom of the heater to raise its tempera-  
14 ture and therefore, of necessity, become a source of radiant  
15 heat. From a scientific point of view, any body, in fact, which  
16 has a temperature in excess of absolute zero degrees, is a  
17 source of radiant heat.

18 The same way it would seem that if radiant heat was  
19 desirable as suggested by Morcum, such a heater of any type  
20 could be obviously substituted for the radiation heater in the  
21 British claim, without making invention.

22 Schwank, as explained, shows the heater as that com-  
23 ponent as claimed in Neville, and that patent, is in fact,  
24 mentioned in the Neville Patent as disclosing a heater which is  
25 suitable for the patentee's purposes.

1           The District Court went on to discuss this question  
2 of aggregation. There is no question here and Respondent's  
3 experts and certainly Petitioner's expert have agreed that the  
4 paver operates entirely independently of the heater and the  
5 heater operates independently of the paver; therefore, the  
6 heater functions in precisely the same manner whether the tamper  
7 tamper is being -- for example, is being operated, or whether  
8 the distributor is actually laying the material; or whether the  
9 screed is there to smooth the material.

10           This is an unquestioned fact, as well, that the  
11 heater is, in constructing the adjoining roadblocks of a single  
12 lane, is removed from the paver and is placed on a separate  
13 mobile support and used to make the transverse edge of the two  
14 adjoining highway blocks in a single lane of highway.

15           In dispensing this whole question this Court, in  
16 deciding the Lincoln Engineering case, which is heavily relied  
17 upon in its briefs and petitions, found that at least one  
18 definition of aggregation was that the total must, somehow  
19 -- total of the old elements, must somehow exceed the sum of  
20 the parts. And in finding that the system there disclosed,  
21 which was a system for injecting grease into the bearings of an  
22 automobile which included a piston pump and a conduit connecting  
23 -- communicating therewith and a coupling consisting of jaws,  
24 were aggregated.

25           The Court makes at that time an observation which

1 we think is peculiarly applicable to the situation here. The  
2 Court in perhaps an overture, suggested that if the patentee  
3 had addressed his claims to the jaws per se, he might have  
4 found himself with a valid patent, but in fact, he did not and  
5 then by the time this patent got before this Court, it was, of  
6 course, too late to do that.

7 It might be of interest to this Court to note that  
8 there are several cases in Great Britain which deal with the  
9 subject of aggregation which have not been brought to its  
10 attention in the brief and I thought I might do it now, if the  
11 Court would indulge me.

12 CHIEF JUSTICE BURGER: Could you supply them to us  
13 by memorandum at the close of your argument, as well? You may  
14 discuss the cases now but supply the citations.

15 MR. BORST: Yes, sir.

16 One case is the famous and classic Sausage Machine  
17 case which was decided by the Chancery Division of the High  
18 Court of Appeals in the 1890's -- in 1890. In that case the  
19 meat grinder ground the sausage meat and then the filling  
20 machine was placed somehow in communication with the grinder  
21 so that that machine filled the sausage skin with the ground  
22 meat. The High Court of Appeals, Chancery Division, stated that  
23 while it must be recognized that something new and useful was  
24 done here, the fact is that the two components operate so in-  
25 dependently of one another, from the standpoint of function and

1 are, in fact, separate from one another from the standpoint of  
2 structure, that the claims to the two elements are aggregated  
3 and therefore, invalid.

4 Q I am not enough of a patent lawyer to know how  
5 similar or how different it is, the British law of patents from  
6 our law; or the British law of 1890 from our law of 1969. It  
7 would help me in your discussion of these British cases if you  
8 could indicate at least in your submission, as to whether the  
9 laws are identical or different or what --

10 A It may be, if I could generalize, because much  
11 of our law has undergone transformation or modification through  
12 statutes.

13 The question of aggregation is not a statutory matter  
14 but has come through the law of patents in this country, and I  
15 believe, in Great Britain in a parallel way by decision-making.  
16 I think that the courts have felt that it was applicable and  
17 relevant to the question of invention -- state of invention  
18 and obviousness and therefore, have continued to retain it as  
19 an operating rule; test.

20 Q In Great Britain is patent law all common law,  
21 so to speak, or are there a series of statutes as we have here?

22 A There are patent statutes.

23 Q Patent.

24 A Yes, sir; but which have been construed and  
25 evolved -- the law has evolved through construction as our law

1 has; as it has involved our amendment to statutes.

2 Q Of course, we, unlike them, have Constitutional  
3 provisions that we sometimes adhere to, as well.

4 A That is true.

5 The House of Lords, itself, in 1935, in the case of  
6 Celanese Limited versus Plutos(?) with Lord Tomlin speaking for  
7 the Court, made this definition of aggregation, which I think  
8 can be accepted by American Courts today. And he said, and I  
9 quote: "It is accepted as sound law that a mere placing side  
10 by side, of old integers so that each performs its own proper  
11 function independently of any of the others, is not a patentable  
12 combination; but that where the old integers when placed to-  
13 gether have some working interrelation, produces a new and  
14 improved result, then there is patentable subject matter in the  
15 idea of the working interrelation brought about by the collo-  
16 cation of the integers.

17 The first case that I cited can be found -- that is  
18 Williams versus Nye in 7rpc 62; rpc being an acronym for report  
19 on patent cases.

20 Q Were there any findings by the Court here that  
21 the way in which these integers, to use that British phrase,  
22 were placed together; the generator or the heater on top, was  
23 an essential element of the patent?

24 In other words, what I'm getting at is there anything  
25 to exclude the use of the heater on a different machine running

1 it back of the -- or in front of --

2 A We have contended that the only reason that  
3 Neville has done this is entirely one for convenience. You  
4 could get the same results and perhaps it would be exactly a  
5 little more practical or expensive to provide a separate little  
6 cart running ahead of the street paver.

7 Q Then there is no finding that dealt with that  
8 problem?

9 A Pardon?

10 Q No finding of the District Court that dealt  
11 with that problem?

12 A When it discussed this whole question of  
13 aggregation it was discussing that problem because there is  
14 -- the two elements, the paver and the generator function in  
15 exactly and precisely the same way, whether they are put to-  
16 gether or whether they were on the same chassis or whether they  
17 were on different mobile supports.

18 Q In other words, the District Court found --  
19 this invalid and on the basis that there was no new function  
20 performed by any of these elements when in combination?

21 A No new function performed by a patentable  
22 combination. It would be somewhat unfair to say that there was  
23 no new function in its entirety, because it is true that no one  
24 else has used before the Schwank type heater to transmit radiant  
25 energy to an --



1 Q Yes, but the District Court held that each of the  
2 elements here performed its usual function when in combination;  
3 upon putting them together they still function as they always  
4 have.

5 A As they always have.

6 Q And that's what the District Court held?

7 A That's what the District Court did hold.

8 Q Did that Court of Appeals attempt to set aside  
9 that finding?

10 A It made no direct reference, sir, except to say  
11 that the District Court dealt with narrow issues.

12 Q With what?

13 A Narrow steps or issues.

14 I was about to give the citation the Chief Justice  
15 asked for for the case in the House of Lords in 1935, namely:  
16 Celanese verus Pluto's. That may be found in 52 rpc 171,  
17 particularly noting Page 193.

18 We have always contended -- not always, but later-  
19 ally contended in this case that this suit could also be de-  
20 cided on the question of exhaustive combinations; a combination  
21 which has been -- old elements which have been previously  
22 patented may not be repatented merely because one has improved  
23 one of the elements of that combination. And that may be  
24 exemplified by saying that if one improves a spark plug or a  
25 carbueretor he's not entitled to reclaim the engine block and

1 steering apparatus and the windshield wipers and the safety  
2 belts that go together to make up the combination which we know  
3 in an automobile.

4 The position that we take on this matter: we believe  
5 is amply supported by the decision in this Court entitled:  
6 Bassick Manufacturing Co. vs R. M. Hollingshead, which is cited  
7 as 298 U.S. 415.

8 MR. CHIEF JUSTICE BURGER: Mr. Blenko.

9 ORAL ARGUMENT BY WALTER J. BLENKO, ESQ.

10 COUNSEL FOR RESPONDENT

XXXXX  
11 MR. BLENKO: Mr. Chief Justice, and may it please the  
12 Court. I should like at once to answer a few of the questions  
13 that were just put from the Court.

14 Mr. Justice Harlan raised the question of whether the  
15 District Court has made findings. There were no separate  
16 findings made by the District Court. The only findings are such  
17 as appear in that Court's opinion.

18 Mr. Justice White, you asked a question at the very  
19 end, regarding findings by the District Court on the coaction of  
20 the several elements. As I said, there were no formal findings  
21 as such.

22 I think that the ~~language~~ which should be noted in  
23 responseto your question is that conclusion of the Opinion of  
24 the Trial Court. That's at Page 26-A of the Appendix. The  
25 last paragraph on that page contains, I think, the summarizing

1 statement. "It is my opinion that Plaintiff's combination in  
2 no way exceeds the sum of its parts."

3 Q Did you say 22-A?

4 A 26-A, Mr. Justice Black. I am sorry.

5 The last paragraph commencing about eight lines from  
6 the bottom of the page. The point that I want to make is that  
7 it is avowedly stated as an Opinion of the Trial Judge. I want  
8 to carry it a little bit further, if I may because the evidence  
9 which we pointed to in the Court of Appeals, and which we point  
10 to here, is, in our submission, undisputed and is the other way  
11 and that the Opinion expressed by the Trial Judge, we think,  
12 simply does not find any support in the evidence which was  
13 before you. And I want to develop that a little bit further,  
14 I think, if I can deal with the facts and then come back --

15 Q Well, do you think this is a finding -- is this  
16 a factual matter or not?

17 A I think it is a matter which is fact; I think  
18 necessarily it must be based upon the evidence; I don't think  
19 that --

20 Q This is subject to the clearly erroneous  
21 standard in the Court of Appeals?

22 A I think it is, Your Honor.

23 Q Did the Court of Appeals find this Smith state-  
24 ment clearly erroneous?

25 A Not referring to this language as such. I

1 think it's implicit and tacit and straightforward within the  
2 Opinion of the Court of Appeals. Judges Haynesworth and  
3 Sobeloff dealt with this in an Opinion by Judge Haynesworth and  
4 it made perfectly clear what the evidence shows. I would like  
5 to develop that evidence with you a little bit further as I go  
6 forward.

7 Q Pardon me. It seems to me that that last  
8 paragraph is not a finding but a conclusion of law.

9 A We're into this area, Your Honor, where it has  
10 been debated back and forth whether these are findings or  
11 conclusions. I think with all respect it probably is properly  
12 a finding of fact. In this case I do not think --

13 Q But finding it's invalid, that's not a finding  
14 of any facts, though, that would underlie the conclusion that  
15 it is invalid?

16 A No, Your Honor. Invalidity is plainly a legal  
17 conclusion; obviousness is a factual matter to be determined  
18 upon the evidence in the record.

19 Q Well, in the sentences that follow at Page 25,  
20 Mr. Blenko, the sentence that "it is my opinion that each  
21 element of the combination forms in the same manner," et  
22 cetera, "all the plaintiff has done is to construct four ele-  
23 ments known in the prior art on one chassis." Are they not  
24 findings of fact?

25 A I think that much constitutes finding of fact,

1 and I would say to Your Honor, that it is clearly erroneous;  
2 that there is absolutely no evidence in this record to sustain  
3 either.

4 Q Either?

5 A Either.

6 Q As you get into these discussions of the evidence  
7 in your own mind, Mr. Blenko, your statement in Judge Craven's  
8 Dissenting Opinion, which is a specific aspect of which you  
9 have just been discussing and which was the subject of Justice  
10 Harlan's question, right in the first paragraph. He says:  
11 "Nor is it demonstrated to my satisfaction that the combination  
12 on one chassis as a paving machine and heat generator is  
13 necessary to produce the desired result." That is a combination  
14 on one body and set of wheels. "yet the combination is held  
15 patentable, though for all we know, the same desired result may  
16 be achieved by two machines juxtaposed and separately propelled."  
17 That, as I say, is one specific aspect, rather dramatically, I  
18 would suppose, of presenting the issue as to whether or not this  
19 combination is simply the known and expectable result of a  
20 combination of old ingredients, or whether there is one in which  
21 the result exceeds the sum of its parts.

22 I would like to know what the evidence shows on that  
23 particular aspect of it, if you can let us know at your conven-  
24 ience.

25 MR. BLENKO: Yes; I think I'll say at once I don't

1 believe there is any explicit evidence upon that point. I  
2 believe that the proposition which Judge Craven brought forward  
3 here was one which was, in effect, how far can you nudge for-  
4 wards or away from the scope of the claim and still have an  
5 infringement. I think it's one of the imperfect infringements,  
6 if you will. It's not a question which fairly arises upon this  
7 record, because that's not the fact that is before the Courty,  
8 but I think it's the old story: when you define an invention in  
9 plain language, there is always the temptation -- particularly  
10 if one is discussing the scope of the claim as distinguished  
11 from the practical working world -- to say well, if you do this  
12 and slightly bend the edges, will you infringe? I feel that  
13 this is the sort of thing that that is. But there is no  
14 evidence which directed their --

15 Q One way or the other?

16 A One way or the other.

17 Q Mr. Blenko, you said here in response to a  
18 question of Mr. Justice Brennan that the second sentence in the  
19 final paragraph on Page 26-A is essentially a finding of fact,  
20 even though not cast in the formal language and then you said  
21 there is no evidence to support that.

22 A That's right.

23 Q Now, I take it that you mean that no one picked  
24 out each of the parts that resulted in that sentence and said  
25 -- gave testimony to the contrary; but may not a tryer of facts

1 look at the record as a whole and viewing the record as a whole  
2 and synthesizing all the testimony, make findings, even though  
3 no one has no particular witness that has addressed himself to  
4 each of the parts?

5 A I think that certainly they do that; I think  
6 that in doing so it's always open to review; we submit that  
7 upon the whole record that this statement simply is not support-  
8 table; that the contrary is affirmatively shown; the contrary  
9 is an agreed fact and is admitted by the Defendant's witnesses,  
10 and by the real defendant, who is not the named party, who pro-  
11 claimed that to the trade. Their position in the courtroom  
12 here is directly opposite to everything they say to --

13 Q When you say "they proclaimed it to the trade,  
14 do you mean in their advertising material and that sort of  
15 thing?

16 A Yes, Your Honor.

17 Q Do you think that the Court can rely on that  
18 as a -- as evidence of the facts, in this context?

19 A The material is in the record. I point  
20 primarily to the last page of the Defendant's volume where  
21 Aeroil, who is the real Defendant, stated in this context:  
22 "This remarkable new development is a dramatic breakthrough in  
23 asphalt highway and road maintenance. Infrared heat is not  
24 new but the application is revolutionary." We agree to that.

25 Let me just answer -- I'm sorry.

1           The Aeroil's Vice President appeared as a witness at  
2 the trial; he acknowledged that these were the publications of  
3 Aeroil. I asked him did he wish it to be understood that they  
4 were misrepresenting the facts to the public. He said,  
5 "certainly not."

6           I think that's good evidence.

7           Mr. Justice White, I am sorry I put you aside so long.

8           MR. JUSTICE WHITE: I was wondering if -- does the  
9 Court of Appeals in effect say, even if there is nothing new  
10 in these two elements, and even if in this combination they  
11 perform their same old function, nevertheless, their patent-  
12 ability here, because no one ever thought of putting these two  
13 together?

14           A        In our submission the Court of Appeals did not  
15 say that.

16           Q        What if it had?

17           A        I think then that it would plainly be wrong.  
18 But I don't think is the case which arises upon this record.  
19 Let me see if I can develop that a little bit.

20           First of all, there are several matters here which I  
21 think are beyond dispute if you look at the record, as distin-  
22 guished from arguments and contentions of counsel. First of  
23 all, Neville did create a new combination of elements. You can  
24 look through the entire record and you will not find Neville's  
25 combination anyplace in the prior art. I think that the most



1 telling comment upon that was again in the testimony of Mr.  
2 Quail, who was Aeroil's Vice President and at Page 40, 41 and  
3 42-A in the printed Appendix I asked him where he found the  
4 elements of the Neville patent, and he said: "You will have to  
5 look to all in order to find it." Those were some eight pieces  
6 of prior art in numbers, so he had to look to in order  
7 to find the Neville Patent.

8 So, we say on that basis and upon review of the  
9 elements of the prior art individually that this was a new  
10 combination.

11 Q What was that last page reference?

12 A 40, 40-A and through 42-A, Your Honor; the last  
13 question and answer at the top of 42-A.

14 Now, the second point that I want to develop is that  
15 this combination was not an obvious one. Nowhere in the record  
16 will you find any testimony by people skilled in this art,  
17 showing that it was obvious or stating that it was obvious to  
18 them. The evidence is just to the contrary. We brought in two  
19 witnesses. One of these men had been director of research of  
20 the Pennsylvania Department of Highways. The inventor came to  
21 him and in effect, he said, "He won't work" and eased him out of  
22 his office. The second was a civilian employee of the Air  
23 Force, a man greatly concerned with asphalt paving. He was  
24 interested in it and he spoke with very real embarrassment  
25 which I think will show up on the record, and said, "He showed

1 it to me and I didn't believe it would work. I had to have  
2 somebody else that I could rely on who had seen it work, tell  
3 me and then I got interested."

4 There is testimony here as to the result. There was  
5 a test job done at Andrews Air Force Base that is the subject  
6 of testimony. It showed a complete difference between the  
7 combination of the patent in the suit and what had been done  
8 before that time.

9 Now, this brings me to what is the essential point,  
10 and that is: the elimination of the cold joint. This arises  
11 when you lay two lanes of asphalt, bituminous, blacktop, what-  
12 ever you like to call it; the sort of thing we see on the  
13 ordinary highway. When you lay them side by side you almost  
14 invariably lay one lane and then bring another lane and lay it  
15 alongside later.

16 The inventor was an individual; he was one of these  
17 men that the patent system, I think, may be said to be designed  
18 to encourage and protect; he was not a part of any organization.  
19 He concedes that if you put on a radiant energy at the joint  
20 area as you lay the second abutting course that then you would  
21 eliminate this cold joint where you never had a really good  
22 matching or marriage, as they call it, between the two mats  
23 which had been laid down. And he went around the established  
24 people and he tried to make his point with them and got nowhere.  
25 He finally got backing from a layman who didn't know much about

1 it either, but who was sold; and they went to work; and they  
2 now managed to bring their system forward and show that this is  
3 a real and a workable scheme.

4 Q Do you have to apply the radiant energy at the  
5 time you put the pieces together?

6 A Yes, Your Honor.

7 Q That is what you call -- that you consider to  
8 be the new discovery?

9 A Yes. I want to go a little bit further than  
10 that. We have all spoken here in the courtroom in very  
11 generalized terms, of course. But I want to take that a little  
12 bit further if I may.

13 The claim, which is printed and I won't try to deal  
14 with it orally, is lengthy, specific and detailed. It is, in  
15 reality, a narrow claim. And if you go through it you will  
16 find many, many limitations and requirements, each of which must  
17 must be met in order to infringe. It isn't a broad claim at  
18 all.

19 Now, the point I make from that is this: If this  
20 plan is so elaborate it certainly is an easy thing to avoid  
21 infringement by changing a few of these details and you can  
22 make some much more radical changes in trying to mount these on  
23 two separate chassis. You can still stay on one chassis, but  
24 you can certainly avoid infringement very easily; they don't  
25 do it. And the reason is, of course, that there is no

1 alternate; this is the essential scheme, which we think demon-  
2 strates invention.

3 Now, speaking again very broadly, without going into  
4 the details of the claim language, there are three elements  
5 which we have talked about for convenience, and these are the  
6 asphalt or bituminous spreader and then the street element which  
7 shapes it and you also have the radiant energy generator which  
8 bears on the previously laid lane and which makes it receptive  
9 for the asphalt which is being laid alongside.

10 So, as the machine goes down the highway, you have  
11 to one side, a previously laid lane of asphalt. The paver  
12 is running beside that; the radiant energy generator is direct-  
13 ing the radiant energy onto the existing lane of asphalt; and  
14 then a new lane of asphalt is laid alongside. And because you  
15 do have the radiant energy you get your marriage of the two  
16 lanes and you avoid this cold joint and everything that that  
17 entails.

18 The problems that arise from that are set forth in  
19 the testimony in the Appendix.

20 Q How long has radiant energy been used for this  
21 purpose?

22 A For this purpose, Mr. Justice Black, it was  
23 never used before this inventor's time. Other people had  
24 talked of radiant energy. They had had thoughts and they had  
25 had ideas. I'd be the last one to suggest that people haven't

1 tried to do all sorts of things. This inventor was not coming  
2 into a field that was wide open to him. This inventor was  
3 coming in to solve a problem which had existed in the field for  
4 many, many years. People had used all sorts of earlier schemes  
5 and they had been unsuccessful by and large.

6 Reference has been made here to the Morcum Patent,  
7 and I want to say at once that you will find very little about  
8 it in the record because Morcum was really not the thrust of  
9 the defense in the trial court; it just came along for the ride.  
10 The primary reference has simply been abandoned at this point,  
11 so you won't find very much testimony on Morcum.

12 The testimony that is there is that it won't work.  
13 And it won't work because it's different from what is claimed  
14 in the patent. You will find in the patent plans very specific  
15 requirements that this radiant energy generator has perfor-  
16 ations or interstices that a combustible gas be delivered  
17 through these; that it be combusted adjacent to service and  
18 a number of things. Morcum lacked all of these and Morcum  
19 won't work as a result. They could use Morcum if they wanted  
20 to, but they don't want to.

21 Q Was part of the problem, until this came along,  
22 the unavailability of the right kind of combustible gas?

23 A There is no evidence to that effect, Your  
24 Honor, and I think not. Certainly these bottled gases have  
25 been around for nearly 30 years to my own personal recollection.

1 Q What's the date of this patent?

2 A The application was 1952, if my memory is  
3 correct. I'm sorry; 1959. It is, of course, several years  
4 later.

5 Q I would like to be sure I understand your  
6 legal position, Mr. Blenko. As I understand it you told us  
7 that first of all that this was a combination; not an aggre-  
8 gation and you told us that it was a new combination.

9 A Yes.

10 Q The fact, as I understand it, does not mean  
11 that it is necessarily patentable so far. These are just the  
12 first two steps in the combination patent; right?

13 A That's part of it, yes; there's one more step.

14 Q There's one more step and you say that it was  
15 not obvious and for that statement you rely on the testimony of  
16 the people who said they didn't think it would work and were  
17 skeptical about it.

18 A And lack of any countervailing testimony.

19 Q And not any countervailing testimony. Now,  
20 is that enough, in your view to claim that it's patentable?

21 A Yes, Your Honor. I think that that does carry  
22 the burden for us. I would like, if I may, simply to restate  
23 that fact in my own terms. I think it is essentially what you  
24 said.

25 The three sections to the statute to which we look in

1 these matters, have been discussed most recently by this Court  
2 in Graham against John Deere and United States against Adams.  
3 Those are Sections 101 and 102 and 103. If I may be presumed  
4 to state my understanding of them, it would be this:

5 That Section 1 requires that there be an invention  
6 in fact. I think the defense of aggregation really is statu-  
7 tory and is a Section 101 defense. In short, you must show  
8 that you have some elements brought together which do co-act  
9 to be an invention in a patentable or legal sense. It is not  
10 enough to claim a table and a chair. The mere fact that you  
11 claim two things does not mean that you have any combination  
12 or legal invention. So, as I say, that is the Section 101  
13 defense.

14 Section 102 defense is the defense of lack of novelty.

15 Q Is what?

16 A Lack of novelty.

17 Q Lack of novelty?

18 A Yes. The problem is that no one has ever  
19 found an affirmative definition of invention. I think that  
20 comes from its nature because it's always pushing into the  
21 unknown. After we know the invention, it's very easy to have  
22 20/20 hindsight and see all about it, but at the time the in-  
23 vention is made and we are all reaching forward, it's a dif-  
24 ferent matter. So, we always end up putting this in the nega-  
25 tive sense: novelty is not present if the following:

1 All right. If disclosed in the prior art the exact  
2 invention, then you have a Section 102 defense. And finally,  
3 we get to 101 and 102; you have the Section 103 hurdle which  
4 is: was it an obvious invention claim?

5 And I think, in essence, this is the restating of  
6 the way you had it, but I thought it might be helpful to re-  
7 state it in my own language.

8 Q I take it you rely rather strongly on the  
9 testimony of the military engineer who dealt with the laying of  
10 asphalt pavement on airports.

11 A I certainly rely upon his testimony; I also  
12 rely upon the testimony of Mr. Witkowski who was a former head  
13 of the Research Laboratory in the Pennsylvania Highway Depart-  
14 ment.

15 Q And you say that neither -- that there is no  
16 testimony in this total record which disputes their statement  
17 that this was not an obvious invention?

18 A None whatsoever; no such testimony at all, any-  
19 place in the record.

20 I do know of some other testimony which goes the other  
21 way, and that testimony is of the Defendant's equipment foreman.  
22 And even at the time of the trial he said, "Well, I'm not quite  
23 sure why we do this, but we do it." Now, here's the man who's  
24 actually out in the field, who I think is the skilled worker in  
25 the art; even then he hadn't been able to see it. I think that



1 shows a complete lack of obviousness.

2 Now, I want to say one word very briefly about the  
3 cases which have been referred to here by the Petitioners.  
4 They have referred primarily to Lincoln Engineering against  
5 Stewart-Warner. I think all of the other cases which they  
6 have cited are of the same stripe and they all stand or fall  
7 on the same proposition.

8 I think that Lincoln Engineering against Stewart-  
9 Warner is entirely in accord; Graham against John Deere,  
10 U. S. v. Adams and the decision of the Court of Appeals in this  
11 case.

12 In short, I think the decisions in the patent field  
13 are about as consistent as the decisions you will find in any  
14 body of law. I don't think they are inconsistent at all.  
15 The problem arises on the application of the law as to the  
16 facts.

17 Q Mr. Blenko, is this the first litigation that  
18 has involved your patent?

19 A I'm sorry --

20 Q Is this the first litigation which has in-  
21 volved your patent?

22 A Yes, this is the only action on this patent,  
23 Your Honor.

24 Q Have you made any other claims of infringement  
25 or had occasion to?

1           A       No; there haven't been any formally made.  
2 There have been some suggestions made but there has been  
3 nothing brought forward beyond that point.

4           Now, I want to say this with these cases, as I see  
5 it, are all consistent. In the Celanese case which was cited  
6 by Counsel as the argument, is again entirely consistent, as  
7 I heard him read it. And those stand, as I see it, to the  
8 proposition if you have several elements but each independently  
9 owned and if you bring them together and if they co-act to  
10 produce a new result -- in other words, if the co-action adds  
11 up to something more than their individual actions, then you  
12 have a patentable invention. That was so in Lincoln Engineer-  
13 ing against Stewart-Warner, where a number of the claims were  
14 held out.

15           And we think that that is properly so here, for this  
16 reason: that if you omit the radiant energy generator you will  
17 get the cold joint. If you omit the spreader you won't have  
18 a pavement. If you omit the shaper you won't have a pavement.  
19 You must bring these three together to operate together in order  
20 to get the new and admittedly beneficial result which is the  
21 elimination of the cold joint.

22           Now, my difficulty, as I understand it here, is that  
23 the Petitioner declines to deal with the overall results.  
24 It's no answer to say that these aren't mechanically connected.  
25 Of course they aren't mechanically connected; they are acting

1 at different places. But when they act at different places  
2 and the process is finished, you have a new result brought  
3 about by this machinery.

4 The difficulty, it seems to me, is one which was  
5 characterized by Mr. Justice Holmes a good many years ago in  
6 a trademark case, I believe of breaking the faggot, stick by  
7 stick. They declined to look at the overall situation which  
8 exists here and we think that when that overall situation is  
9 examined, as we think was properly done by Judges Haynesworth  
10 and Sobeloff in the Court of Appeals, that the necessary  
11 result is that you have here a new and beneficial combination,  
12 one which is not obvious.

13 We think that the District Judge and Judge Craven,  
14 ignored the overall result and focused if you will on two  
15 narrow a point of view of looking at the individual elements  
16 and not looking at the overall combination and recognizing  
17 that the new results did result.

18 Accordingly, we ask that the judgment below be  
19 affirmed.

20 Thank you.

21 MR. CHIEF JUSTICE BURGER: Thank you.

22 Mr. Borst, you have two minutes left and that's  
23 just about what's left before lunch hour.

24 MR. BORST: Yes, sir.

25 The Petitioner refers to the error of ads of

1 extolling some part of this invention. While it is true at  
2 some part of this invention, as claimed, Aeroil only makes the  
3 heater and so it hardly would be extolling the combination  
4 which is framed as the heater plus the paver.

5 The best testimony adduced on behalf of Petitioner  
6 and on behalf of its assertion that there is an aggregation  
7 here is in the Appendix on 38-A and on the trial transcript on  
8 Page 113 through 114 at one point. I know there is other  
9 testimony in the record.

10 Q I notice that there are three expert witnesses  
11 here who testified rather explicitly that this was not obvious  
12 to them and they have large credentials. Did you have any  
13 expert witness to testify who said that this was obvious in  
14 their minds?

15 A They testified that there was no invention  
16 here because they --

17 Q That's a conclusion of law; that is for us.

18 A That's right, but their contention has been  
19 that use of radiant energy is old and therefore the continued  
20 use of it should be permitted.

21 Q Of course the use of radiant energy is used on  
22 football players and baseball players.

23 A I overstated that. The use of radiant energy  
24 to form an asphaltic bond or joint between two abutting lanes  
25 of highway. That is in the art and whether or not it has been

1 used is not necessarily relevant to the question here; it's of  
2 the prior art.

3 There is no --

4 Q I think that's your time, Mr. Borst. Thank  
5 you for your submissions, gentlemen. The case is submitted.

6 (Whereupon, at 12:00 o'clock p.m. the argument in  
7 the above-entitled matters was recessed to reconvene at 12:30  
8 o'clock p.m. this day).

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