

LITIGATORS CORNER: In Favor of Brainstorming



BY JOSEPH N. HOSTENY,
OF NIRO, SCAVONE,
HALLER & NIRO

Regular IP Today columnist Joseph N. Hosteny is an intellectual property litigation attorney with the Chicago law firm of Niro, Scavone, Haller & Niro. A Registered Professional Engineer and former Assistant US Attorney, his articles have also appeared in Corporate Counsel Magazine, The Docket (American Corporate Counsel Association), American Medical News, Inventors' Digest, Litigation Magazine and Assembly Engineering Magazine. Mr. Hosteny is on the Board of Editors of Patent Strategy & Management (a monthly publication of American Lawyer Media), for which he writes periodic guest columns. Mr. Hosteny can be reached at (312) 236-0733, or by e-mail at jhosteny@hosteny.com, or by visiting his web site at <http://www.hosteny.com>.

I am happy to report I have been noticed by that august newspaper, the *New York Times*. Well, not exactly noticed, but at least indirectly referred to. On March 21, 2005 in the Books Section, John Strausbaugh wrote an article, "Books of the Times; For Every Predicament, a Thingamajig to Solve It." The book he reviewed is *Patently Ridiculous*, by Richard Ross, who is a photographer. Mr. Ross collected what he calls improbable and off-beat patents. Mr. Strausbaugh is more critical, saying that the PTO grants too many patents on "chindogu," a Japanese word Mr. Strausbaugh says literally means "weird tools," or more facetiously, "unuseless inventions" in English.

One of the examples of an unuseless invention the article gives is the "Canine Scuba Diving Apparatus," a patent granted in 2001. I wrote that patent for an inventor and friend, Dwane Folsom of Boynton Beach, Florida. In fact, when I searched the Internet concerning Richard Ross, I found that his book had Figure 1 from the patent application for the Canine Scuba Diving Apparatus on the cover. Wow! I fell for it. I bought the book. Here's that drawing:

I was pretty darn proud of this patent. And I started to wonder: the Canine Scuba Diving Apparatus certainly is whimsical, and it certainly is useless, if use is to be gauged by how much money is made from the invention.

But Dwane Folsom didn't pursue this for money. Rather, he was an inventor and proud of what he had accomplished. His invention was not trivial. He is a scuba diver, and he wanted to take his dog, Shadow, scuba diving with him. A dog, unlike a human scuba diver, cannot control its breathing in order to affect its buoyancy. As anyone who has dived knows, buoyancy control is essential to good diving. You don't want to go up and down like a yo-yo. Controlling breathing (deliberately expanding or contracting your body) controls buoyancy. A dog can't do it. Shadow needed a large, clear helmet or she would panic. The large volume of the helmet Dwane invented gave Shadow room to move her head and avoid panic, but it also increased her buoyancy, interfering with Shadow's ability to control her depth. Dwane had to compensate for this with other features of his invention, including a special harness. The

regulator a human scuba diver uses is a demand regulator; it does not provide air automatically. The regulator for Shadow had to be different. Dwane worked out these problems and the details of the apparatus in over two hundred dives with Shadow.

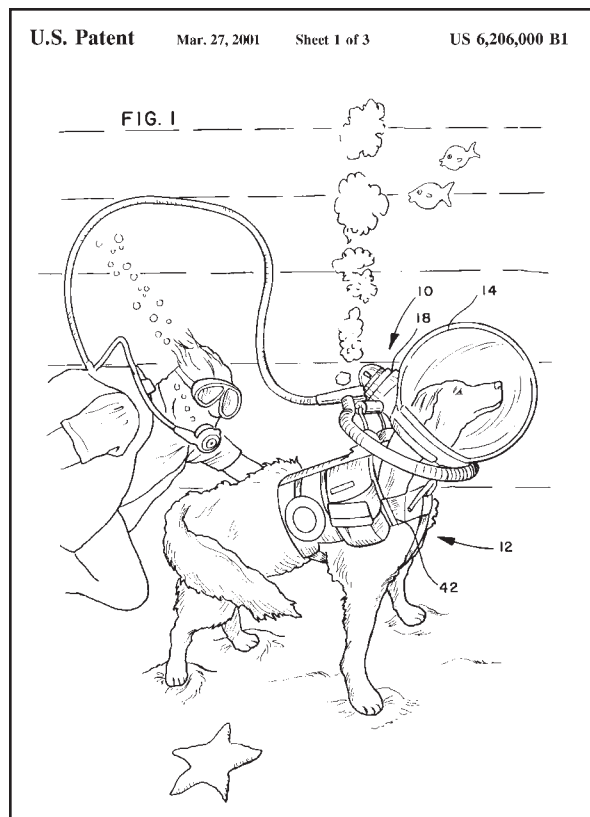
On a vacation, I saw Shadow dive, wearing Dwane's invention; and she did so in the middle of a bunch of stingrays. I was amazed. So were many other people. One of the things we submitted to the PTO was a videotape of the shows and news programs that featured Shadow's diving.

After reading Mr. Strausbaugh's review, I began to wonder if the perception of silliness or "unuselessness" depends upon one's perspective. Second, I wondered, whether a patent system should preclude "silly" patents.

The Canine Scuba Diving Apparatus is not useless to me, nor to Dwane. Perhaps it seems useless or silly to others. I suspect which conclusion you draw depends upon your experience. Invention is hard work, as real inventors know. I suspect many viewers might look at a photograph — perhaps one by Mr. Ross — and yet fail to understand the effort which went into choosing or arranging the subject matter, picking the right light, selecting the proper camera, film and viewpoint. I have heard that Henri Cartier-Bresson was on a stroll with a friend one day. Bresson's friend commented that a

particular scene would photograph nicely; Bresson did not agree. His experience supposedly caused him to predict the month and time of day the light would be right to photograph a scene. In other words, two of us may look at something, but one of us may perceive much more than the other. Inventors experience the difficulty in creating something that works. The creation is useful and rewarding in and of itself, even without economic reward. Non-inventors miss that.

For another example, consider the Wright Brothers. Their airplane could barely carry a single person. It could not carry any cargo at all. It could not travel more than a few hundred feet, much less to the next town. A wagon with one sturdy horse could carry more weight and go farther. By any reasonable mea-



sure, the Wright Brothers were engaged in folly. Their prospects of economic reward were remote. The Frenchman, Marshal Ferdinand Foch, Commander in Chief of the Allied Armies during World War 1, is reported to have said, "Airplanes are interesting toys, but of no military value." Marion Donovan invented disposable diapers, but for ten years could not persuade anyone to manufacture them. Chester Carlson made his first xerographic copy in the late 1930s, but it was about twenty years before the marketplace accepted his invention. David Sarnoff sought investors who told him, "The wireless music box has no imaginable commercial value. Who would pay for a message sent to nobody in particular?" (I can't square this lack of insight with my mother's description of the stunned expression on her father's face when he first heard a crystal radio.) There is Tesla, who invented alternating current transmission, and who also pursued the wireless transmission of power. He, too, was laughed at.

There is skepticism about inventions these days, frequently coming from those never involved in the inventive process or who, like Sarnoff's inventors, lack vision. One example is that we hear that there are too many software patents, and too many computer-related inventions, and that none of them really are new. The Internet, a way for any number of computers to communicate with speed and reliability, was begun as a project funded by the Department of Defense quite a few years ago. The invention addresses how to link machines that already existed. It may be one of the greatest achievements of the 20th century. But, were the Internet invented only a year or two ago, some critics would say it does not merit treatment as an invention because it "only" uses computers and software.

I do not mean to say that every inventor is the equal of the Wright Brothers, or Carlson, or a world-famous photographer. Nor do I mean to equate the Canine Scuba Diving Apparatus (or many other patents) with the airplane, the Xerox machine, the Internet, or even the disposable diaper.



BILLIONS OF BYTES SERVED

metroPatent™

On Line File Histories
Quick. Secure. Easy.

Visit us at www.metroPatent.com
www.OnlineFileHistories.com
 Or call us at 800-298-4624

But, if we start to shut the door to the Patent Office, how far should we close it, and what will we lose by exercising such caution? We don't need second-guessers who discourage invention. We need creativity. If we cannot brainstorm lots of ideas, practical and impractical, we will not be able to create.

We don't have the power to see into the future and determine whether a particular invention is unworthy because it lacks economic utility. A Commissioner of Patents in 1899 unwisely concluded that there were no more inventions of any kind in the future; he supposedly said, "Everything that can be invented has been invented." Nor should we impose new criteria for patentability when we can't do a good job of applying the criteria we have now. Fooling ourselves into believing that

economic utility should be a requirement of an invention would be a new criterion. It wouldn't be the only harmful consequence of closing the door to the Patent Office. For every gem of an idea, there are probably a thousand, or ten thousand, losers. To decide that certain inventions are not worthy of protection, even though they meet the statutory criteria, simply because they are perceived as "unuseless" to someone would be to tell would-be inventors: "Don't bother. Your invention won't be patentable, so don't waste your time." By doing this, we would discourage brainstorming and creativity. We need to give free rein to creativity, not impose a requirement of economic utility resulting from hindsight and the ability to second-guess the inventive process. **IPT**