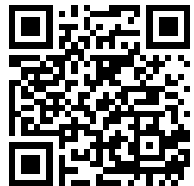

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SCHNACKENBERG, C. J.

Hastings, C. J.

In the
United States Court of Appeals
For the Seventh Circuit

No. 12387

JAY E. DARLINGTON,

Plaintiff-Appellant,

vs.

STUDEBAKER-PACKARD CORPORATION,

Defendant-Appellee.

Appeal from Northern
District of Indiana,
South Bend Division.

Honorable
Robert A. Grant,
Judge.

APPELLANT'S BRIEF AND APPENDIX.

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Defendant-Appellee.

} Appeal from Northern
District of Indiana,
South Bend Division.

}
Honorable
Robert A. Grant,
Judge.

APPELLANT'S BRIEF.

Statement of Facts.

Action by plaintiff-appellant for accounting for profits and damages for alleged patent infringement. Case was dismissed before trial, for alleged delay in prosecution, *under Local Rule 11*, from which plaintiff appeals.

Since the complaint was not dismissed on the merits, or disposed of in any fashion on the merits, it does not appear necessary to summarize here at length the contents of the pleadings, except for the incidental purpose of showing the nature and size of the case as bearing upon some aspects of the delay in prosecution.

Complaint.

Filed December 31, 1952. Alleges that defendant, The Studebaker Corporation, has infringed a design patent issued on June 14, 1949 to Tucker Corporation and assigned by the latter's trustee to the plaintiff pursuant to order of United States District Court (N.D. Ill.).

Prayer for accounting for profits and damages arising from the infringement.

Appendix, p. 1.

Answer.

Filed February 20, 1953, after stipulated extension of time. Admits that the patent issued but denies the alleged infringement, and alleges that the patent is invalid for lack of invention and that the same design was covered in a large number of specified patents and publications in this country and foreign countries.

Appendix, pp. 3-8.

The next step in the case was a Clerk's entry on September 1, 1953 reciting that the case was placed on the trial call calendar for the October 1953 term, "*and no request for trial was received.*"

Appendix, p. 8.

Substitution of New Defendant and Counsel.

No further action occurred in the case until March 4, 1955 when an order was entered substituting the defendant's successor, Studebaker Packard Corporation, as the defendant.

This was followed on June 9 and 23, 1955 by an order and entry substituting a completely new set of defense counsel.

Appendix, pp. 8-10.

*Defendant's Interrogatories and Requests
for Admissions.*

No further action occurred in the case until January 20, 1956, when the defendant filed 20 interrogatories and 101 requests for admissions, directed to the plaintiff, the two documents being very long and involved.

Appendix, pp. 10-28.

On April 23, 1956, time having been extended (Tr. 63-74), plaintiff filed answers and responses to these interrogatories and requests.

Appendix, pp. 28-35.

Clerk's Notice Under Local Rule 11.

The next action in the case was a mimeographed form notice sent on May 2, 1957 by the Clerk to the parties (Tr. 82):

“You are hereby notified that this cause *will* be dismissed on Thursday, June 6, 1957, pursuant to Rule 11 of this court, *unless prior thereto*, for good cause shown, the court *orders otherwise*. (Our italics).

/s/ Kenneth Lackey, clerk”

Appendix, p. 36.

The text of Local Rule 11, similar to the above language, is set out at page 10 *infra*.

Dismissal Order.

On June 6, 1957 an order, *apparently automatic* and without the presence of either side, was entered, which reads:

“Pursuant to notice given under Rule 11 of the Rules of this Court, cause dismissed for failure to prosecute at the costs of the plaintiff. (Our italics)

/s/ W. Lynn Parkinson, Judge”

Appendix, p. 37.

Motion to Vacate Dismissal.

On June 21, 1957, plaintiff filed his verified motion to vacate the dismissal under Rule 60 (b) of Civil Procedure, alleging facts to show the impossibility of complying with Local Rule 11 at an earlier date. This motion is discussed at more length under pages 18-20, *infra*.

Appendix, pp. 38-40.

Hearing and Denial of Motion to Vacate.

In the latter part of 1957, after the entry of the aforesaid dismissal order and filing of the motion to vacate it, and before the motion came on for hearing, the Judge who entered the dismissal order, Hon. W. Lynn Parkinson, was appointed to the United States Court of Appeals for the Seventh Circuit, and was succeeded as District Judge by Hon. Robert A. Grant.

The motion to vacate was heard by Judge Grant on oral arguments on March 14, 1958, with time given to

April 14 for plaintiff to file any desired memorandum of authorities and defendant given until May 5 to file any reply memorandum of authorities.

Appendix, p. 41.

An order was entered by Judge Grant on May 9, 1958 denying plaintiff's motion to vacate the dismissal.

Appendix, p. 51.

*Plaintiff's Motion for Judge to Disqualify Himself,
and Order Overruling Same.*

On April 14, 1958, during the interval between the aforesaid oral argument on March 14 and the order denying the motion to vacate the dismissal on May 9, the plaintiff filed a verified motion requesting said Hon. Robert A. Grant to disqualify himself to rule upon the pending motion and at future stages of the case, under 28 U.S.C.A. 455, because of the Judge's previous employment by the defendant, which fact first came to plaintiff's knowledge after the oral argument of May 14. This subject is covered in more detail under part II of the Argument, p. 21, *infra*.

Appendix, pp. 42-46.

The defendant, in Part III of its brief, filed on April 23, 1958, admitted the alleged employment of the Judge before his appointment to the bench, but argued that this was insufficient to disqualify him. (No other factual response was filed to plaintiff's motion. The "brief" was not verified.)

Appendix, pp. 47-50.

On May 8, 1958 (the day preceding the aforesaid denial of the motion to vacate the dismissal), the Judge entered an order overruling the motion for him to disqualify himself. The order, in language of 28 U.S.C.A. 455, categorically denies the statutory causes for disqualification, with no factual amplification.

Appendix, p. 50.

Appeal.

Notice of appeal was filed on June 7, 1958, from both of the above orders,—the order of May 8 overruling plaintiff's motion for disqualification, and the order of May 9 denying plaintiff's motion to vacate the dismissal.

Summary of Argument.

Since the points are simple and are concisely covered in our Propositions, *infra*, we believe it is appropriate to adopt the latter as our summary.

Contested Issues.

The contested issues on this appeal are:

I. Plaintiff-appellant's contention, resisted by defendant, that the District Court erred in its order denying plaintiff's motion to vacate the dismissal.

II. Plaintiff's contention, resisted by defendant, that the District Court erred in its order overruling plaintiff's motion for the Judge to disqualify himself.

Propositions of Law.

I.

The District Court erred in denying plaintiff's Motion to Vacate the Dismissal Order.

A.

Local Rule 11, which was the sole actual *basis* of the dismissal, was and is invalid because it is "inconsistent" with the Supreme Court's *Rule 41(b) of Civil Procedure*. It was beyond the local rule-making power granted by the Supreme Court to the District Courts under *Rule 83 of Civil Procedure*.

We find no reported decision construing or deciding the validity of Local Rule 11, but basic principles, as well as decisions on the analogous question of abatement, seem to sustain our position:

Messenger v. United States (2 Cir. 1956) 231
F. 2d 328, 329, point 1.

Hackner v. Guaranty Trust Co. of N. Y. (2 Cir.
1941) 117 F. 2d 95, 99.

The question here is not the general power of District Courts to dismiss for delay in prosecution outside of Rule 41(b) of Civil Procedure. The question is the validity of Local Rule 11 as it was applied in this case.

B.

If Local Rule 11 was valid, the District Court nevertheless abused its discretion in refusing to vacate the dismissal.

Langnes v. Green, 282 U.S. 531, 541-2, 51 S. Ct. 243.

Note: If the above point A is well taken, it disposes of the appeal and renders point B moot.

If either point A or point B are well taken, they dispose of the only final judgment presently existing in the case.

II.

**The District Judge erred in overruling plaintiff's motion requesting him to disqualify himself.
28 USCA 455.**

ARGUMENT.

I.

Error in Denying Plaintiff's Motion to Vacate Dismissal.

A.

Invalidity of Local Rule 11.

Historically, our research and the rule file in the District Court Clerk's office discloses only three sets of published Local Rules for the Northern District of Indiana in the last thirty years:

January 1, 1927 Edition contains 30 local rules on many subjects, necessary at the time but subsequently largely superseded by the uniform Rules of Civil Procedure. It contains no rule on the subject of dismissing cases for lack or delay of prosecution,—probably because the subject was then covered by the Conformity Act as to law cases and by the federal equity and admiralty rules and practice in those fields.

June 1, 1941 Edition contains only 14 local rules, probably in recognition that the uniform Federal Rules of Civil Procedure had superseded the local rules in many respects. It should be remembered, however, that in 1941 there had not yet occurred the major, liberalizing revisions of the Rules of Civil Procedure and the Judicial Code which occurred beginning in 1946. The 1941 Edition contains the following prototype of the present Local Rule 11. (So far as we have presently found, there is no precedent determining the validity of this 1941 rule on the point here involved,—though if there were, it would perhaps be antiquated):

“Dismissal of Civil Cases for Lack of Prosecution. Civil cases, except those for a Receiver in which no papers have been filed, excepting affidavits for continuance, for 4 consecutive terms, will be dismissed for want of prosecution after 10 days notice given by the Clerk to the Attorneys of record, at the costs of the plaintiff, and judgment rendered for costs, unless, within the time fixed in the notice of the Clerk, either party files a pleading or a written motion deemed sufficient by the Court to retain the cause on the docket.

Rule 6, U.S. District Court (N.D. Ind.) 1941 Edition.

September 1, 1955 Edition contains 20 rules, exclusive of bankruptcy, including the following:

“Dismissal of Civil Cases Because of Lack of Prosecution. Civil cases in which no action has been taken for a period of one year *may* be dismissed *for want of prosecution* with judgment for costs after thirty days notice *given by the clerk* to the attorneys of record *unless*, for good cause shown, the court orders otherwise.” (Our emphasis).

Rule 11, U.S. District Court (N.D. Ind.) 1955 Edition.

Applicable Rules of Civil Procedure.

“Rule 83. Rules by District Courts.

“Each district court by action of a majority of the judges thereof may from time to time make and amend rules governing *its* practice *not inconsistent* with these rules. Copies of rules and amendments so made by any district court shall upon their promul-

gation be furnished to the Supreme Court of the United States. In all cases *not provided for* by rule, the district courts may regulate their practice in any manner not inconsistent with these rules. (Our emphasis).

Commentaries

* * * * *

“The intention of the Committee was to provide a simple, *unified* system which would be governed by a *single*, brief body of rules. The Federal Rules of Civil Procedure do not, however, cover all situations. *To the extent* that the new rules, together with the federal statutes, *do not regulate the practice* and procedure, the district courts are permitted to formulate their own rules. * * * Daniel K. Hopkins, *23 Marq. L. Rev. 159.*” (Our emphasis).

Rule 83, Federal Rules of Civil Procedure and Commentaries, 28 U.S.C.A. pp. 504-505.

As appears on the face of the above Rule 83 and Commentaries, the Supreme Court’s purpose was a simple, unified, uniform system of Civil Procedure. The only field left to the District Court’s rule making power was in matters “not inconsistent” with, or “not provided for” in the Rules of Civil Procedure.

The purpose and logic of the situation appears to be that *general* procedural problems which are *common* to the various Districts should be governed by the Rules of Civil Procedure. The only *need* for local rules is to cover *local* problems, and even in this field the District Courts are circumscribed by the “not inconsistent” requirement of Rule 83.

The entire subject of dismissal of civil actions, voluntary and involuntary, including dismissal “for failure of

the plaintiff to prosecute”, is covered in Rule 41 of Civil Procedure, as follows:

Rule 41. Dismissal of Actions.

(a) Voluntary Dismissal: Effect Thereof.

“(1) *By Plaintiff: By stipulation.* Subject to the provisions of Rule 23 (c), of Rule 66, and of any statute of the United States, an action may be dismissed by the plaintiff *without order* of court (i) by filing a notice of dismissal at any time before service by the adverse party of an answer or of a motion for summary judgment, whichever first occurs, or (ii) by filing a stipulation of dismissal signed by all parties who have appeared in the action. Unless otherwise stated in the notice of dismissal or stipulation, the dismissal is without prejudice, except that a notice of dismissal operates as an adjudication upon the merits when filed by a plaintiff who has once dismissed in any court of the United States or of any state an action based on or including the same claim. As amended Dec. 27, 1946, effective March 19, 1948.

“(2) *By Order of Court.* *Except* as provided in paragraph (1) of this subdivision of this rule, an action *shall not be dismissed* at the plaintiff’s instance *save upon order* of the court and upon such terms and conditions as the court deems proper. If a counterclaim has been pleaded by a defendant prior to the service upon him of the plaintiff’s motion to dismiss, the action shall not be dismissed against the defendant’s objection unless the counterclaim can remain pending for independent adjudication by the court. Unless otherwise specified in the order, a dismissal under this paragraph is without prejudice.

(b) Involuntary Dismissal: Effect Thereof.

“*For failure of the plaintiff to prosecute or to comply with these rules or any order of court, a defendant may move for dismissal of an action or of any claim against him. * * * Unless the court in its order for dismissal otherwise specifies, a dismissal under this subdivision and any dismissal not provided for in this rule, other than a dismissal for lack of jurisdiction or for improper venue, operates as an adjudication upon the merits. As Amended Dec. 27, 1946, effective March 19, 1948.*” (Our emphasis).

Rule 41 of Civil Procedure, 28 U.S.C.A., pp. 203-204.

Comparison of Rule 41(b) with Local Rule 11.

Since it is fundamental that appellate courts deal with *the actual, concrete situation* presented in the record coming up from below, and they refuse to decide “might have been” questions which are not required for disposal of the appeal,—the actual question here is whether Local Rule 11 *as applied* in this case was invalid, (though if required for disposal of the appeal, we contend, and we think it is plain, that Local Rule 11 is basically and totally invalid).

Although Local Rule 11 says the case “may” be dismissed, the *actual practice* under the rule apparently was for the *Clerk* to go through the docket and send out mimeographed notices (Tr. 82a) that cases “will” be dismissed under Local Rule 11.

Appendix, p. 36.

The order of dismissal also shows on its face that it was an *automatic* type of order, entered *without motion* of any party, without the *presence* of any party,—and what is more important, without the Judge having or taking the opportunity to perform the important judicial function of considering the *nature, progress* and *status* of the case,—matters which could adequately become known to the Judge only upon a *motion* of the defendant to dismiss, or upon a pre-trial conference,—neither of which ever occurred in this case, as shown by the complete record which was designated and certified up.

Also, in approaching this comparison of *Rule 41(b)* and Local Rule 11, we believe it is logical and important to bear in mind that:

(a) The limit which *Rule 83* places on local rule-making power is that the latter be “not inconsistent”. They need not be in head-on collision with the Rules of Civil Procedure.

(b) Inconsistency can, and often does, exist not so much in violating the letter but the general scope and tenor of the superior document.

(c) The rights of a litigant are defined (and protected) not only by what the Rules of Civil Procedure require, but what they do *not* require of a litigant. This cautionary feature is many times stated in these Rules. It is implicit in all of them, including *Rule 41(b)*.

We respectfully urge that, tested by these standards and by all accepted standards, Local Rule 11, as applied in this case, is “inconsistent” with Rule 41(b) and with the general body of the Rules of Civil Procedure in obvious, fundamental respects, including the following:

(1)

It contemplated, and produced, an arbitrary automatic dismissal, *based upon an arbitrary period of one year*, without regard to the *nature, progress or status* of the case.

A reference to these factors would have shown that the case was a large and complicated one, wherein both the *court* and the *defendant* had allowed long periods to elapse without protest or invoking Local Rule 11, far exceeding the one year and two weeks of “delay” for which the plaintiff was arbitrarily thrown out of court.

This Brief, pp. 2, 3, *supra*.

Appendix, pp. 3-9, 28, 36, *infra*.

On the other hand, *Rule 41(b)* does not fix any arbitrary *period* standard, nor any such *automatic* dismissal.

(2)

Under Local Rule 11, as applied here, the moving party was the District Court's *Clerk*, whereas, under *Rule 41(b)*, the motion must come from the *defendant* or a like party, (as such an initiative should come, unless we are to convert the federal courts into arbitrary assembly lines or transmission belts).

This procedure, plainly specified by Rule 41(b), obviates the evils above mentioned under (1).

While we find no precedent in point on this conflict between Local Rule 11 and Rule 41(b), we find many cases

which *take it for granted* that the dismissal procedure is controlled by Rule 41(b), and also the following dealing with the analogous subject of conflict between local rules and the Rules of Civil Procedure regarding *abatement* of actions:

“After the adoption of the Rules, *some* of the *District* Courts adopted rules providing that actions *should abate* unless service be completed within a *specified time* after filing the complaint. *Cf. Koster v. (American) Lumbermens Mut. Casualty Co.*, 2 Cir., 153 F. 2d 888. But in *Hackner v. Guaranty Trust Co. of New York*, 2 Cir., 117 F. 2d 95, 96, *we questioned the validity of such rules*. That question it is not necessary now to decide since no such rule has been invoked in this case. However, the cases just cited hold that after the filing of the complaint, *the action remains pending in an inchoate state* until service is completed unless *and until* the action is dismissed for failure to prosecute *under Rule 41(b)*. The same holding is implicit in *Munro v. United States*, 303 U.S. 36, 58 S.Ct. 421, 82 L. Ed. 633, and *Bates Mfg. Co. v. United States*, 303 U. S. 567, 58 S. Ct. 694, 82 L. Ed. 1020.

* * *

“Holding, as we do, that service on the United States was never accomplished, clearly the court below was warranted in dismissing for failure to prosecute *under Rule 41(b)*. For some six years there has been a complete lack of any prosecutory effort; not even service of the action has been accomplished. *Under Rule 41(b)*, a motion to dismiss may be granted for lack of *reasonable diligence in prosecuting*.* * *”

Messenger v. United States (2 Cir. 1956) 231 F. 2d 328, 329, 330-331.

“* * * Now under the *rules* an action once commenced by the filing of a complaint—which is what

Eastman's 'amendment' amounted to—*remains pending until dismissed by the court under Rule 41(b)* for lack of due diligence in prosecution. Cf. *Bates Mfg. Co. v. United States*, 303 U.S. 567, 572, 58 S. Ct. 694, 82 L.Ed. 1020; 51 Harv. L. Rev. 1087; *Linn & Lane Timber Co. v. United States*, 236 U.S. 574, 578, 35 S.Ct. 440, 59 L.Ed. 725; *Genesee Valley Trust Co. of Rochester v. United States*, 2 Cir., 116 F. 2d 407, December 23, 1940." (Our emphasis.)

Hackner v. Guaranty Trust Co. of New York (2 Cir. 1941) 117 F. 2d 95, 99.

Opposing cases distinguished:

Some cases, including one or two cited in the order denying the motion to vacate dismissal, refer to the "inherent power" of a District Court to dismiss for lack of prosecution. None of these cases that have come to our attention involves construction of a local rule comparable to this one. Nor do any of them involve a comparable fact situation. They were cases where the plaintiff was grossly in default or was purposely dallying with a frivolous complaint. Moreover, in most instances, the District Court acted upon an existing or preceding motion of the defendant for relief from the plaintiff's misconduct (there never was any such motion in the case at bar).

So the situation in those cases was appropriate for application of Rule 41(b), though dismissal was predicated loosely upon "inherent power," an expression which, if not confined to the facts in the cases, obviously collides with the letter and purpose of *Rule 83 of Civil Procedure*.

Rule 83 is nowhere considered in these "inherent power" cases, so far as we have observed.

Further, the dismissal in our case was predicated expressly and solely upon Local Rule 11, so there is not now before this Court any questions as to the existence or scope of the District Court's "inherent power" of dismissal.

In fact, the "inherent power" doctrine implies that the District Court applies judicial consideration to each individual case, which is the antithesis of the one-year automatic dismissal practice applied in this case.

B.

If Local Rule 11 was valid, it was nevertheless an abuse of discretion to refuse to vacate the dismissal under the fact situation shown in plaintiff's Motion to Vacate the Dismissal.

Rule 60 (b) of Civil Procedure provides a comprehensive, flexible, liberal procedure for relief from all kinds of judgments and orders. Its more applicable provisions are:

"On motion and upon such terms as are just, the court may relieve a party or his legal representative from a final judgment, *order*, or proceeding for the following reasons: (1) *mistake, inadvertence, surprise, or excusable neglect*; * * * (4) the judgment is *void*; * * * or (6) *any other reason* justifying relief from the operation of the judgment. The motion shall be made within a *reasonable* time, and for reasons (1), (2) and (3) not more than one year after the judgment, order or proceeding was entered or taken. * * *" (Time was enlarged from six months to one year by 1946 amendment).

Rule 60(b) of Civil Procedure, 28 U.S.C.A., pp. 310-313.

Obviously, the above Rule affords ample procedural basis for granting us relief either on the theory that the District Court committed a mistake in dismissing the case under an invalid Local Rule, so that the dismissal was perhaps void or certainly erroneous, as contended in Point A, *supra*; or on the theory that the plaintiff committed a mistake, inadvertence or excusable neglect, as contended in the present Point B.

While the Motion to Vacate the Dismissal deals only with the *factual* grounds covered in Point B, because it was prepared in haste before the plaintiff had an opportunity to study the *law* question as to the invalidity of Local Rule 11,— a question of the latter type requires no formal pleading, and this law question was in fact *argued orally* at the hearing of March 14, 1958 and in subsequent briefs of both sides, and the question was entertained by Judge Grant,— in fact it was the only question he would listen to. See Appendix, middle of p. 44).

On the question presented by the present Point B,— mistake, inadvertence or excusable neglect of a party or attorney,—it is inherently impossible to lay down any hard and fast boundaries, and no two fact situations are alike, so precedents are not controlling one way or the other.

The standard of sound judicial discretion has been defined by the Supreme Court as—

“what is right and equitable *under the circumstances* and the law, and directed by the reason and conscience of the Judge to a *just result*.” (Our emphasis).

Langnes v. Green, 282 U.S. 531, 541-2, 51 S. Ct. 243.

The motion to vacate the dismissal, filed on June 21, 1957, promptly after the dismissal order of June 6, 1957, made a strong, sworn factual showing that earlier compliance by the plaintiff with Local Rule 11 had not been reasonably possible, and that the dismissal had occurred through mistake, accident and excusable neglect on his part, because, among other things:

*“Continuously since January 3, 1957, until the present time, the plaintiff, Jay E. Darlington, an attorney practicing at Hammond, Indiana, has been under a continuous and heavy burden of trial work and matters immediately connected therewith, which could not be avoided or delayed, including principally the case (specifying cases in the District Courts in Chicago, Miami and Puerto Rico). * * * Due to this situation and the burdens of said other litigation, plaintiff overlooked the requirement of taking action in this case under Rule 11, and if it had not escaped his attention, it would not have been possible anyhow to take such action within said time, due to the aforesaid situation of the plaintiff. * * *”*

Appendix, pp. 38-39.

There is more factual matter in this Motion to Vacate the Dismissal, for which we respectfully refer the Court to the Appendix, pp. 38-40.

If the plaintiff had been able to prepare and *file* the above showing a few days *before* the dismissal of June 6, 1957, it certainly *should* have sufficed to constitute the undefined “good cause” mentioned in Local Rule 11. (p. 10, *supra*) This would have been true even though the plaintiff’s filed response had been held in abeyance and its sufficiency not ruled upon by the Court until May 9, 1958.

Then why should not the same showing filed a few days *after* the dismissal be accepted by the District Court, particularly in view of the showing of inability to file it sooner, plus the fact that the entry sought to be vacated was an automatic formal one involving no hearing and no labor or hardship imposed upon the Court or the defendant.

II.

Error in Judge's Refusal to Disqualify Himself.

The relation of this question to the ones already discussed is this:

If it be determined that Local Rule 11 was valid, and that the Court of Appeals cannot say that the District Court abused its discretion,—then we come to this final question:

Was the plaintiff deprived of his right to have a fair and impartial Judge *exercise* the discretion?

It is no answer to say that the Court of Appeals does not find from the record that the discretion was *abused*.

It is precisely in *discretionary* matters that a totally fair and impartial frame of mind in the District Judge is most *needed* and most important,— to the parties, to the public and to the reviewing courts.

The applicable statute is 28 *U.S.C.A.* 455, quoted in the Appendix, p. 45. As shown in the annotations in *U.S.C.A.*, this statute has undergone progressive amendments and clarifications in the direction of disqualifying Judges.

Hence, earlier decisions against disqualification are likely to be out of point.

The factual basis is concisely set forth in the "Plaintiff's Verified Motion for the Judge to Disqualify Himself," to which reference is made to avoid needless repetition here.

See Appendix, pp. 42-46.

The only factual response by the defendant to this motion is an admission in its unsworn Brief which considerably strengthens the motion.

Appendix, p. 47, middle.

It is not essential to disqualification to show that the Judge has been counsel in the *case*, or that he has any *direct* connection with a party. The statute aims at the possible *indirect* sources which *might* bias or influence a Judge. It requires:

"Any judge * * * shall disqualify himself in *any* case in which he * * * is * * * so related to *or connected* with any party * * * as to render it *improper*, in his opinion, for him to sit on the trial, appeal, or other proceedings therein."

28 U.S.C.A. 455.

Necessarily, the statute leaves this matter to the Judge's "opinion" in the first instance, and most (not all) Courts of Appeals hold that the matter is not reviewable *until* the case comes up on appeal from a final judgment. But it is universally recognized, we believe, that the matter *is* reviewable,—otherwise the statute would be a mockery.

No factual light or disclosure of facts is contained in the Judge's order overruling the Motion to Disqualify,—only categorical denials couched in the language of the statute.

Plaintiff was entitled to obtain, and we believe this Court ought to have a more complete factual picture of the admitted prior connection between the Judge and the defendant.

This apparently was not a routine legal retainer but one of *confidential* and *important* nature, as shown in plaintiff's motion.

Appendix, pp. 42-43.

This feature seems to be circumstantially corroborated by the admission of defendant's counsel that he had not known of the connection prior to reading it in plaintiff's motion.

Appendix, p. 47, middle.

In the light of these undisputed facts, the plaintiff is not bound, and *this Court* is not aided, by the self-serving, conclusory statement in defendant's Brief that the undefined "certain legal matters" in which the present Judge was admittedly acting for the defendant "continuously from July 1950 to the end of 1954" had "no connection whatsoever with the *present case*".

The statutory test is not "connected with the present case," but "connected with any *party*".

The defendant could have, and we think should have, filed a frank factual response to plaintiff's motion in this unusual situation.

The Judge, while not required to do so, could properly have clarified the factual picture by filing a factual memorandum with his order refusing disqualification. Such factual disclosures are often freely volunteered, usually orally in open court, by Judges when questions arise concerning possible interest or connection of the Judge. No factual disclosure of any kind has ever been made on

this subject by the Judge in this case, except the recitals in the order.

Or, the Judge could have ordered the defendant to file an adequate factual response.

The plaintiff's motion showed the need for discovery and prayed discovery of these matters under Rule 34.

Appendix, p. 43, par. 3, and p. 45, par. 2.

The defendant's Brief, while not itself making any adequate factual disclosure, expressly stated that it "would *have no objections* to any discovery order with regard to inspecting defendant's *records* as requested by plaintiff" except that the scope be not too broad and burdensome.

Appendix, p. 49, bottom.

Yet the Court ignored plaintiff's prayer and defendant's consent and simply entered the order refusing disqualification.

In this situation, we believe the only fair and feasible remedy for this Court to apply is the doctrine that facts not disclosed by the party or person having the power of disclosure will be assumed to be in favor of the party seeking the disclosure.

Thus aided, or even without such aid, we believe that the facts presented in plaintiff's motion and admitted in defendant's brief, with the fair factual inferences therefrom, clearly entitled the plaintiff to have his Motion to Disqualify granted.

Therefore, it is respectfully submitted that this cause should be reversed with directions as may seem proper and just to this Court.

OWEN W. CRUMPACKER,
Attorney for Appellant.

APPENDIX

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APPENDIX.

2

C O M P L A I N T
(Filed Dec. 31, 1952)

Plaintiff complains of defendant and says:

1. Jurisdiction exists in this Court by virtue of the fact that the defendant corporation has its home office and principal place of business in this district and division, and this is a civil action arising under the Acts of Congress relating to patents.

2. On June 14, 1949 United States Letters Patent No. Des. 154, 192 were duly issued to plaintiff's predecessor in title, P. T. Tucker, for a new original and ornamental design for an automobile, a true copy of which patent is attached hereto as Exhibit A and made a part hereof. Said Tucker duly assigned said invention and patent to Tucker Corporation, which became the sole owner thereof. Thereafter, all the right, title and interest of said corporation in and to said invention and patent was duly sold and assigned by the duly authorized trustee of said corporation to this plaintiff on July 17, 1951 pursuant to order of the United States District Court for the Northern District of Illinois, Eastern Division, in cause No. 48 B 530. Plaintiff is now the sole owner of said invention and said patent, and is the sole real party in interest in this action.

3. Defendant has for a long time past been and
3 still is infringing those Letters Patent by making, selling and using a design for an automobile, and parts of an automobile, embodying the patented invention, and will continue to do so unless it is enjoined by this Court.

2a

Complaint

4. Plaintiff has given written notice to defendant of its said infringement.

Wherefore, plaintiff prays an accounting for profits and damages, an assessment of costs against defendant, and all further just and proper relief.

/s/ Edwin S. Booth
135 So. La Salle St.
Chicago, Illinois
Randolph 6-9272

/s/ Benedict E. Dankovis
306 Hammond Building
Hammond, Indiana
Sheffield 167
Attorneys for Plaintiff

4-5 (Exhibits not printed.)

10

STIPULATION
(Filed Jan. 20, 1953)

It is hereby stipulated and agreed by and between the parties hereto, through their respective attorneys, the Honorable Court consenting, that the time within which defendant may file its answer or otherwise plead to the complaint herein be extended to and including the 21st day of February, 1953.

/s/ Benedict E. Dankovis
Attorney for Plaintiff

January 16, 1953

/s/ Edward C. Grelle
Attorney for Defendant

It is so ordered

/s/ Luther W. Swygert
Judge of U.S. District Court

Jan. 20, 1953

13

A N S W E R
(Filed Feb. 20, 1953)

Now comes the defendant, The Studebaker Corporation, and for its answer to the complaint states:

1. Defendant admits the allegations contained in paragraph 1 of the complaint.

2. Defendant admits that on June 14, 1949, United States Letters Patent No. Des. 154,192 were issued to Preston T. Tucker, assignor to Tucker Corporation for Design for an Automobile, but defendant denies that said Letters Patent were duly issued and denies that they were for a new, or original or ornamental design for an automobile. Defendant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations contained in paragraph 2 of the complaint.

3. Defendant denies each and every allegation contained in paragraph 3 of the complaint.

4. Defendant admits that it received a letter from plaintiff dated September 7, 1951, stating as follows:

14 "In order to protect my investment as the largest Class A stockholder of Tucker Corporation, I recently purchased from its trustee all its patents, patent rights, designs, engineering data, etc. Among these is design patent #154,192 issued June 14, 1949 to P. T. Tucker upon application filed March 15, 1947.

The front end design of your 1950 and 1951

Studebaker automobiles is practically identical with the front end design shown in figure 3 of this patent. Since this is self-apparent, elaboration by me seems unnecessary. It consists, among other things, of the circular design near the center of the front of the automobile, the position of this circular design relative to the headlights, its position relative to the bi-lateral grill, the backward slope of the hood from this center piece so as to produce the torpedo shape of the front end, the combination of these, and the strikingly similar over-all impression made by the front end design of the Studebaker cars in comparison with this patent design shown in figure 3.

I plan to commence appropriate action in the Federal Court against Studebaker Corporation seeking (1) an injunction to prevent further infringement of this patent, and (2) an accounting and assessment of the profits which have resulted to Studebaker Corporation from the use of this design.

However, as a matter of courtesy to you and your counsel, I felt that before filing the action I should write and ascertain if you care to discuss the matter before litigation is commenced. If so, I shall be glad to sit down with appropriate representatives or counsel of your corporation. For your convenience, in the event you may wish to submit this letter to counsel, I enclose an extra copy of this letter and also a couple of copies of the patent."

but denies that it received any other notice as alleged in paragraph 4 of the complaint.

5. Defendant avers upon information and belief that the said Design Letters Patent No. 154,192 are invalid and void for want of invention and because the subject matter thereof does not relate to a proper patentable invention within the meaning of the Statute in such case made and provided, in that the same does not constitute any new, original or ornamental design for an article of manufacture.

15 6. Defendant avers upon information and belief that said Design Letters Patent No. 154,192 are invalid and void and do not involve invention or patentable subject matter because in view of the common public knowledge disclosed by the state of the art prior to the alleged invention of said Tucker, it did not require or involve invention to produce the purported design of said Letters Patent, but that on the contrary involved merely mechanical skill and such ordinary adaptation and utilization of well known designs as was within the common knowledge and ability of any person possessing the ordinary average skill and knowledge of those familiar with the automobile industry in that the said design simply simulates designs of automobiles well known and in extensive use.

7. Defendant avers upon information and belief that the said Design Letters Patent No. 154,192 are invalid and void as not involving invention or patentable subject matter in view of the art prior to the date of Preston T. Tucker's alleged invention; that it required no invention to produce the design of the patent in suit, and that said design did not differ in any patentable respect from what was before said alleged invention known and used in this country or described in the following patents and printed publications:

United States Patents

Design No.	Date	Inventor
89,346	Feb. 28, 1933	Hughes
93,995	Dec. 4, 1934	Northup
95,495	May 7, 1935	Earl

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102,852	January 19, 1937	Fitzmaurice
107,644	December 28, 1937	Gregorie
108,322	February 8, 1938	Fitzmaurice
146,206	January 14, 1947	Andreau
149,430	April 27, 1948	Lupinski
149,824	June 1, 1948	Lawson
150,161	July 8, 1948	Sanmori
150,578	August 17, 1948	Kasnicka
155,829	November 1, 1949	Mendes

United States Publications

Name of Publication	Date	Page
Automotive Industries	Jan. 14, 1933	35
Automotive Industries	Aug. 18, 1934	204
Motor	Oct., 1941	130 & 132

British Publications

Name of Publication	Date	Page
The Autocar	Aug. 10, 1934	231
The Autocar	June 25, 1943	452, 453 & 455
The Autocar	Nov. 12, 1943	822 & 823

Australian Publication

Name of Publication	Date	Page
The Coach and Motor Body Builder	Sept. 15, 1933	106

German Publications

Name of Publication	Date	Page
Allgemeine Automobil Zeitung	Nov. 23, 1935	17
Allgemeine Automobil Zeitung	Dec. 7, 1935	3
Allgemeine Automobil Zeitung	May 25, 1940	372 & 373
Motor-Kritik	Dec., 1935	781
Motor-Kritik	May, 1936	375
Motor-Kritik	Sept., 1937	636 & 637
Atz Automobiltechnische Zeitschrift	July 25, 1934	382

French Publications

Name of Publication	Date	Page
L'Auto Carrosserie (No. 119)	Sept.-Oct. 1935	11269
Automobilia	July, 1936	14 & 15

Italian Publications

Name of Publication	Page	Date
Motor Italia	Dec., 1933	45, 46, 47 & 48
L'Auto Italiana	Mar. 30, 1935	34 & 35
L'Auto Italiana	Feb. 28, 1939	21

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and others to which the defendant has not now the dates, numbers and patentees thereof, and the names of the publications, titles and authors identifying the same and which defendant prays leave to furnish when sufficiently informed thereof.

Wherefore, defendant denies that plaintiff is entitled to the relief prayed for or to any relief and prays

8a *Case on Trial Calendar—No Request for Trial*

18 that plaintiff's complaint be dismissed and defendant be awarded its costs and attorneys' fees in this suit.

The Studebaker Corporation
By /s/ George N. Beamer
811-812 J.M.S. Building
South Bend 1, Indiana

Of Counsel

/s/ John A. Dienner

/s/ Arthur C. Johnson

/s/ Edward C. Grelle

53 West Jackson Boulevard
Chicago 4, Illinois

19 And afterwards, to wit, on the 1st day of September, 1953, the following further proceedings were had in the above entitled cause, to wit:

Now here this cause is placed on trial call calendar for the October, 1953 term, and no request for trial was received.

23

O R D E R
(Filed Mar. 4, 1955)

It appearing to the satisfaction of the Court that Studebaker-Packard Corporation, a Michigan corporation, is the successor of the defendant, The Studebaker Corporation, which has been dissolved, on motion of the attorney for said Studebaker-Packard Corporation, it is hereby

Ordered that said Studebaker-Packard Corporation be and it is hereby substituted as defendant in this action in the place and stead of The Studebaker Corporation, without prejudice to the proceedings heretofore had here-

in and the clerk of this Court is hereby directed to change the title of this action accordingly on his records.

/s/ W. Lynn Parkinson

Judge of U.S. District Court

Dated March 4, 1955

26

O R D E R
(Filed Jun 9 1955)

Comes now Studebaker-Packard Corporation, a Michigan corporation, and respectfully shows the Court by affidavit of its Assistant Secretary, Ralph I. Heikkinen, and by motion of its attorney, Ralph E. Allen, that since the beginning of this action wherein The Studebaker Corporation is named as one of the defendants, the said The Studebaker Corporation has transferred all of its assets and liabilities to Studebaker-Packard Corporation and Studebaker-Packard Corporation has been substituted as defendant in the above action in place of the said The Studebaker Corporation.

That The Studebaker Corporation was represented by George N. Beamer, attorney, and by John H. Dienner and Edward C. Grelle both of 53 West Jackson Boulevard, Chicago, Illinois, of counsel.

That Studebaker-Packard Corporation desires to be represented in said action by its attorney Railph E. Allen of South Bend, Indiana and by attorneys of its Patent Department, Alfred E. Wilson, Allan R. Redrow and Clifford L. Sadler of 1580 East Grand Boulevard, Detroit, Michigan, of counsel, in place of the said George N. Beamer, John H. Dienner and Edward C. Grelle.

Upon consideration of the said affidavit of Ralph I. Heikkinen and the said motion of Ralph E. Allen, it appears to the satisfaction of the court that there is good cause for the granting of said motion.

10a *Substitution of Defendant and Counsel*

It Is Hereby Ordered that George N. Beamer, John H. Dienner and Edward C. Grelle be withdrawn as counsel representing Studebaker-Packard Corporation in this action and that in place thereof appearance shall be entered for Studebaker-Packard Corporation by its attorney Ralph E. Allen of South Bend, Indiana, Alfred E. Wilson, Allan R. Redrow and Clifford L. Sadler 27 of 1580 East Grand Boulevard, Detroit, Michigan and the Clerk of the Court is hereby ordered to withdraw the representation of said George N. Beamer, John H. Dienner and Edward C. Grelle and substitute in place thereof the said Ralph E. Allen, Alfred E. Wilson, Allan R. Redrow and Clifford L. Sadler.

By the Court

/s/ W. Lynn Parkinson
Judge

Dated: June 9, 1955

28

ENTRY

(Filed June 23, 1955)

Now here Attorney Joseph A. Roper, 301 St. Joseph Bank Bldg., South Bend, Indiana, files appearance for the defendant and proof of service of same, and attorney Ralph E. Allen 635 S. Main St., South Bend, Indiana, files a withdrawal of appearance for defendant and proof of service of same, which appearance and withdrawal pleadings read in the words and figures following, to wit: (not printed).

34

INTERROGATORIES PURSUANT TO

RULE 33 F. R. C. P.

(Filed Jan. 20, 1956)

Attached hereto and identified as Exhibits A through H are eight (8) photographs which show Defendant's 1950 and 1951 Commander 4-Door models. The Exhibits are identified as follows:

Exhibit	Model Year	View
A	1950	Side
B	1950	Top
C	1950	Front
D	1950	Back
E	1951	Side
F	1951	Top
G	1951	Front
H	1951	Back

1. Referring to paragraph 3 of Plaintiff's complaint filed December 31, 1952, specify by year which Studebaker automobiles in Plaintiff's opinion infringe Design patent 154,192.

2. Attached hereto are photostats of two brochures showing Defendant's 1950 and 1951 passenger car models and identified as Exhibits I and J respectively. Identify the models shown in Exhibits I and J which Plaintiff contends infringe Design patent 154,192.

3. Referring to paragraph 3 of Plaintiff's complaint filed December 31, 1952 and specifically to the portion "and parts of an automobile", specify by name the parts of an automobile Plaintiff is referring to in said paragraph 3.

4. With regard to Defendant's 1950 and 1951 models shown in Exhibits A to H, does Plaintiff contend that the portion of either of these models between the rear 35 bumper and a vertical plane through the front wheel axles is of a design having any features of the corresponding portion of the design shown in Design patent 154,192?

5. If the answer to Interrogatory No. 4 is in the affirmative, specify the features.

6. Specify all the features of the design of the automobile shown in Design patent 154,192, between the windshield and the front bumper, which are not shown in Design patent 149,824 to G. S. Lawson which issued June 1, 1948.

12a *Defendant's Interrogatories to Plaintiff*

7. What features, if any, does the design of the automobile shown in Design patent 154,192 have in common with the design of the model of Defendant's automobile shown in Exhibits A to D which are not found in the design of the automobile shown in said Lawson patent?

8. What features, if any, does the design of the automobile shown in Design patent 154,192 have in common with the design of the model of Defendant's automobile shown in Exhibits E to H which are not found in the design of the automobile shown in said Lawson patent?

9. Was the design shown in Design patent 154,192 reduced to practice by being applied to one or more vehicles which were actually built?

10. If the answer to Interrogatory No. 9 is in the affirmative, specify how many vehicles the design was applied to and the respective dates the vehicles were built.

11. If the answer to Interrogatory No. 9 is in the affirmative, state the cities where the respective vehicles were displayed to the public, the dates the respective vehicles were so displayed, and what notice appeared on each vehicle regarding Design patent 154,192.

12. What is the name and address of the draftsman who prepared the drawings for the patent application of Design patent 154,192?

36 13. In whose possession are the drawings and/or photographs from which the drawings for the patent application of Design patent 154,192 were made?

14. In whose possession is the first drawing showing the completed design of Design patent 154,192.

15. Will Plaintiff rely upon a date prior to March 15, 1947 as the conception date for the design covered by Design patent 154,192?

16. If the answer to Interrogatory No. 15 is in the affirmative, specify such date.

17. What was the conception date of the design shown

in Design patent 154,192 and what evidence exists to prove this date?

18. Identify and describe all documents, drawings, sketches, papers, books, letters, photographs, objects and other tangible things which Plaintiff purchased from the trustee of the Tucker Corporation relating to the design of the automobile shown in Design patent 154,192.

19. Identify and describe all documents, drawings, sketches, papers, books, letters, photographs, objects and other tangible things in Plaintiff's possession or under Plaintiff's control relating to the design of the automobile shown in (a) Design patent 154,192 and (b) Design patent 149,824 to G. S. Lawson.

20. Referring to the "Request for Admissions by Plaintiff Pursuant to Rule 36 F. R. C. P." served on Plaintiff the same date as these "Interrogatories", for each requested admission answered by the Plaintiff in the negative, if any, specify in detail the reason or reasons upon which the negative answer is based.

Wilson, Redrow & Sadler
Attorney's for Defendant
By /s/ Wayne B. Easton

Of Counsel:

Wayne B. Easton
Studebaker Division
Studebaker-Packard Corporation
635 South Main Street
South Bend 27, Indiana

(Exhibits of Interrogatories not printed. Tr. 38-47)

48 REQUEST FOR ADMISSIONS BY PLAINTIFF
PURSUANT TO RULE 36 F. R. C. P.
(Filed Jan. 20, 1956)

Exhibits A to H referred to herein showing Defendant's 1950 and 1951 Commander 4-Door Model automobiles respectively are attached to Defendant's "Interrogatories" served on Plaintiff the same day as this Request for Admissions.

Defendant Studebaker-Packard Corporation requests Plaintiff Jay E. Darlington within ten (10) days after service of this request to make the following admissions:

1. The scope of protection of Design patent 154,192 is defined by a single claim reading as follows: "The ornamental design for an automobile, substantially as shown and described."

2. The ornamental design for an automobile covered by the single claim of Design patent 154,192 is shown by a series of four figures described in said patent as being (1) a view in side elevation of an automobile embodying the design of this invention; (2) a top plan view; (3) a view in front elevation; and (4) a rear end elevational view.

3. The characteristic features of the design of Design patent 154,192 reside in the portions of each one of the Figs. 1 to 4 thereof shown by means of full lines.

4. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein a portion of the radiator grill is visible in side elevation is a part of the ornamental design for an automobile claimed in said patent.

49 5. The feature referred to in Request for Admission No. 4 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

6. The feature referred to in Request for Admission No. 4 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side eleva-

tion of each exhibit the radiator grill is completely hidden by a front fender.

7. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein the contour of the hood as viewed in side elevation is concave at the forward end of the hood is a part of the ornamental design for an automobile claimed in said patent.

8. The feature referred to in Request for Admission No. 7 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

9. The feature referred to in Request for Admission No. 7 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit the contour of the hood at the forward end of the hood is convex.

10. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein the rearward continuation of the contour of the front fender defines an embossed portion on the front door having a diminishing taper is a part of the ornamental design for an automobile claimed in said patent.

11. The feature referred to in Request for Admission No. 10 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

12. The feature referred to in Request for Admission No. 10 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit the rearward part of the front fender, the front door and a separating cowl portion consists of a smooth unbroken surface to a level just above the door handles and a continuation of the contour of
50 the front fender does not define an embossed portion on the front door having a diminishing taper.

13. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein a lower portion of the front fender between the front wheel and the front door has an embossed

portion having a contour which extends upwardly and rearwardly and joins the contour of the tapered embossed portion referred to in Request for Admission No. 10 is a part of the ornamental design for an automobile claimed in said patent.

14. The feature referred to in Request for Admission No. 13 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

15. The feature referred to in Request for Admission No. 13 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit the lower part of the front fender between the front wheel and the front door extends with a smooth and unbroken surface towards the front door.

16. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein the portion of the front fender beneath the headlight extends vertically downward is a part of the ornamental design for an automobile claimed in said patent.

17. The feature referred to in Request for Admission No. 16 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

18. The feature referred to in Request for Admission No. 16 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit the portion of the front fender beneath the headlight slopes downwardly and towards the rear of the vehicle.

19. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein the contour of the rear fender is entirely rearwardly of the rear door of the vehicle is a part of
51 the ornamental design for an automobile claimed in said patent.

20. The feature referred to in Request for Admission No. 19 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

21. The feature referred to in Request for Admission No. 19 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit a continuation of the contour of the rear fender extends to and is formed on the rear door of the vehicle.

22. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein the contour of the rear fender defines a diminishing tapered portion which is embossed relative to a portion of the vehicle beneath the tapered contour is a part of the ornamental design for an automobile claimed in said patent.

23. The feature referred to in Request for Admission No. 22 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

24. The feature referred to in Request for Admission No. 22 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit, in contradistinction, it is the surface of the lower portion of the rear fender which is embossed relative to the surface of the upper portion.

25. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein a lower portion of the rear fender has a contour which extends upwardly and rearwardly and merges with the contour of the tapered portion referred to in Request for Admission No. 22 is a part of the ornamental design for an automobile claimed in said patent.

26. The feature referred to in Request for Admission No. 25 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

52 27. The feature referred to in Request for Admission No. 25 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit the surface of the lower portion of the rear fender consists of a smooth unbroken surface, the lower edge of which is nearly horizontal.

28. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein a window opening is provided in the body rearwardly of and immediately adjacent the rear door is a part of the ornamental design for an automobile claimed in said patent.

29. The feature referred to in Request for Admission No. 28 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit this feature is entirely lacking.

30. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein the contour line of the roof as viewed from the side, the lower edges of the three window openings on the side of the vehicle, the contour line of the rear window as viewed from the side, and the upper contour line of the rear fender as viewed from the side, all appear to converge with respect to a point near the rearward end of the upper contour line of the rear fender when the vehicle is viewed from the side.

31. The feature referred to in Request for Admission No. 30 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

32. The feature referred to in Request for Admission No. 30 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit the contour line of the roof as viewed from the side, and the lower edges of the two window openings on the side of the vehicle are generally parallel to the ground; and the contour line of the rear window

as viewed from the side is transverse relative to both
53 the contour line of the roof and the upper contour line
of the rear fender.

33. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein the contour line of the rear window is colinear with the contour line of the roof when the vehicle is viewed from the side is a part of the ornamental design for an automobile claimed in said patent.

34. The feature referred to in Request for Admission No. 33 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

35. The feature referred to in Request for Admission No. 33 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit the contour line of the rear window extends in a transverse direction relative to the contour line of the roof when the vehicle is viewed from the side.

36. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein the contour line of the roof slopes downwardly and unbroken to the rear of the vehicle is a part of the ornamental design for an automobile claimed in said patent.

37. The feature referred to in Request for Admission No. 36 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

38. The feature referred to in Request for Admission No. 36 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit the contour line of the roof is substantially parallel with the ground and terminates abruptly and sufficiently short of the vehicle to allow space for a deck lid.

39. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein the body style is of a style referred to in the automobile industry as a sweep-back design is a part

of the ornamental design for an automobile claimed in said patent.

54 40. The feature referred to in Request for Admission No. 39 is not present in either of the automobiles shown in Defendant's Exhibits A and E.

41. The feature referred to in Request for Admission No. 39 is not present in either of the automobiles shown in Defendant's Exhibits A and E because in the side elevation of each exhibit the body style is of a style referred to in the automobile industry as a bustle-back design.

42. The feature of Design patent 154,192 shown in Fig. 2 thereof wherein the centrally located light or ornament between the headlights is positioned more towards the front of the vehicle than are the headlights is a part of the ornamental design for an automobile claimed in said patent.

43. The feature referred to in Request for Admission No. 42 is not present in either of the automobiles shown in Defendant's Exhibits B and F.

44. The feature referred to in Request for Admission No. 42 is not present in either of the automobiles shown in Defendant's Exhibits B and F because in the top plan view of each exhibit the ornament and headlights are in alignment with regard to being positioned the same distance forward of the vehicle.

45. The feature of Design patent 154,192 shown in Fig. 2 thereof wherein as viewed from the top the lower edges of the body beneath the rear doors curve inwardly towards the longitudinal centerline of the vehicle is a part of the ornamental design for an automobile claimed in said patent.

46. The feature referred to in Request for Admission No. 45 is not present in either of the automobiles shown in Defendant's Exhibits B and F.

47. The feature referred to in Request for Admission No. 45 is not present in either of the automobiles shown in Defendant's Exhibits B and F because in the top

55 plan view of each exhibit the lower edges of the body beneath the rear doors are substantially parallel to the longitudinal centerline of the vehicle.

48. The feature of Design patent 154,192 shown in Fig. 2 thereof wherein the rear fenders, as they appear in a top plan view, are tapered so that they occupy at least three-fourths the width of the vehicle at the rear end thereof is a part of the ornamental design for an automobile claimed in said patent.

49. The feature referred to in Request for Admission No. 48 is not present in either of the automobiles shown in Defendant's Exhibits B and F.

50. The feature referred to in Request for Admission No. 48 is not present in either of the automobiles shown in Defendant's Exhibits B and F because in the top plan view of each exhibit the rear fenders occupy only about one-third the width of the vehicle at the rear end thereof.

51. The feature of Design patent 154,192 shown in Fig. 2 thereof wherein the rear window opening as viewed from the top is generally rectangular in shape with rounded corners and bulging sides is a part of the ornamental design for an automobile claimed in said patent.

52. The feature referred to in Request for Admission No. 51 is not present in either of the automobiles shown in Defendant's Exhibits B and F.

53. The feature referred to in Request for Admission No. 51 is not present in either of the automobiles shown in Defendant's Exhibits B and F because in the top plan view of each exhibit the rear window opening is crescent shaped.

54. The feature of Design patent 154,192 shown in Fig. 2 thereof wherein the body portion between the rear fenders as viewed from the top is tapered so that it occupies less than one-fourth the width of the vehicle at the rear

56 end thereof, as viewed from the top, is a part of the ornamental design for an automobile claimed in said patent.

55. The feature referred to in Request for Admission No. 54 is not present in either of the automobiles shown in Defendant's Exhibits B and F.

56. The feature referred to in Request for Admission No. 54 is not present in either of the automobiles shown in Defendant's Exhibits B and F because in the top plan view of each exhibit the portion of the body at the rear end of the vehicle between the rear fenders occupies about two-thirds the width of the vehicle.

57. The feature of Design patent 154,192 shown in Fig. 2 thereof wherein the width of the roof between the front and rear doors is about sixty percent (60%) of the width of the vehicle at that point is a part of the ornamental design for an automobile claimed in said patent.

58. The feature referred to in Request for Admission No. 57 is not present in either of the automobiles shown in Defendant's Exhibits B and F.

59. The feature referred to in Request for Admission No. 57 is not present in either of the automobiles shown in Defendant's Exhibits B and F because in the top plan view of each exhibit the width of the roof between the front and rear door is about eighty percent (80%) of the width of the vehicle at that point.

60. The feature of Design patent 154,192 shown in Fig. 1 thereof wherein a generally L shaped member extends from the centrally located light or ornament (see Fig. 2) above the grill vertically downwardly to a point in front of and below the front bumper then horizontally towards the rear of the vehicle is a part of the ornamental design for an automobile claimed in said patent.

57 61. The feature referred to in Request for Admission No. 60 is completely lacking in the automobiles shown in Defendant's Exhibits A and E.

62. The feature of Design patent 154,192 shown in Fig. 2 thereof wherein the front portion of the hood includes a generally V-shaped plateau which is recessed relative to the remainder of the hood is a part of the ornamental design for an automobile claimed in said patent.

63. The feature referred to in Request for Admission No. 62 is not present in either of the automobiles shown in Defendant's Exhibits B and F.

64. The feature referred to in Request for Admission No. 62 is not present in either of the automobiles shown in Defendant's Exhibits B and F because in the top plan view of each exhibit the external surface of the hood is convex in shape from the front to the rear except the side portions from front to rear which are concave in shape.

65. The feature of Design patent 154,192 shown by Figs. 1, 2 and 3 thereof wherein the grill area between the front fenders and beneath the centrally located light or ornament extends in a straight downwardly direction and is generally wedge shaped is a part of the ornamental design for an automobile claimed in said patent.

66. The feature referred to in Request for Admission No. 65 is not present in either of the 1950 and 1951 automobiles shown respectively in Defendant's Exhibits C and G.

67. The feature referred to in Request for Admission No. 65 is not present in either of the 1950 and 1951 automobiles shown respectively in Defendant's Exhibits C and G because in each of said 1950 and 1951 automobiles the grill area is curved and slopes both downwardly and towards the rear of the vehicle and, when viewed with the hood and the centrally located ornament, gives the
58 front of the vehicle between the fenders a shape like the nose of a bullet.

68. The feature of Design patent 154,192 shown in Fig. 3 thereof wherein each of the grills are generally rectangular in shape is a part of the ornamental design for an automobile claimed in said patent.

69. The feature referred to in Request for Admission No. 68 is not present in either of the automobiles shown in Defendant's Exhibits C and G.

70. The feature referred to in Request for Admission No. 68 is not present in either of the automobiles shown in Defendant's Exhibits C and G, which are front elevational views, because the grills shown in Exhibit C are each kidney shaped and the grills shown in Exhibit G are each oval shaped.

71. The feature of Design patent 154,192 shown in Figs. 1 and 3 thereof wherein the front fenders are formed with the portion beneath each headlight extending straight downwardly and generally parallel to the grills which also extend straight downwardly is a part of the ornamental design for an automobile claimed in said patent.

72. The feature referred to in Request for Admission No. 71 is not present in either of the automobiles shown respectively in Defendant's Exhibits A and E and Exhibits C and G.

73. The feature referred to in Request for Admission No. 71 is not present in either of the automobiles shown respectively in Defendant's Exhibits A and E and Exhibits C and G because these exhibits show that the front fenders are formed so that the portion beneath each headlight is curved and slopes both downwardly and towards the rear of the vehicle.

74. The feature of Design patent 154,192 shown in Figs. 2 and 3 thereof wherein an ornamental fillet is disposed immediately above the bumper and between each grill portion and the adjacent fender is a part of the ornamental design for an automobile claimed in said patent.

75. The feature referred to in Request for Admission No. 74 is completely lacking in the automobiles shown in Defendant's Exhibits C and G.

76. The feature of Design patent 154,192 shown in Fig. 4 thereof wherein the upper and lower edges of the rear window opening appear curved when viewed from the back of the vehicle and give such opening a crescent shaped appearance is a part of the ornamental design for an automobile claimed in said patent.

77. The feature referred to in Request for Admission No. 76 is not present in either of the automobiles shown in Defendant's Exhibits D and H.

78. The feature referred to in Request for Admission No. 76 is not present in either of the automobiles shown in Defendant's Exhibits D and H because in the rear and elevational view of each exhibit the upper and lower edges of the rear window open are straight and parallel.

79. The feature of Design patent 154,192 shown in Fig. 4 thereof wherein the body portion is tapered so that the rear doors of the vehicle can be seen from the back is a part of ornamental design for an automobile claimed in said patent.

80. The feature referred to in Request for Admission No. 79 is not present in either of the automobiles shown in Defendant's Exhibits D and H.

81. The feature referred to in Request for Admission No. 79 is not present in either of the automobiles shown in Defendant's Exhibits D and H because in the rear end elevational view of each exhibit the rear doors of the vehicle are not visible.

82. The feature of each of Defendant's 1950 and 1951 automobiles shown in Exhibits A and E wherein the wheel cutout of the front fender is of a semicircular shape, 60 as viewed in side elevation, is not present in the automobile shown in Design patent 154,192.

83. The feature of each of Defendant's 1950 and 1951 automobiles shown in Exhibits A and E wherein the rear fender is cutout relative to the lower edge of the body to expose most of the rear wheel, as viewed in side elevation, is not present in the automobile shown in Design patent 154,192.

84. The feature of Defendant's 1950 automobile shown in Exhibit B wherein a top plan view reveals two cylindrically shaped supports positioned between the front fenders for mounting the front bumpers is not present in the automobile shown in Design patent 154,192.

85. The feature of Defendant's 1951 automobile shown in Exhibit F wherein a top plan view reveals a pan positioned between the front fenders and in closely spaced relation to the front bumper is not present in the automobile shown in Design patent 154,192.

86. The feature of Defendant's 1950 automobile shown in Exhibit C wherein two openings having recessed grills mounted therein is not present in the automobile shown in Design patent 154,192.

87. The feature of each of Defendant's 1950 and 1951 automobiles shown in Exhibits C and G wherein the centrally located ornament between the headlights is of larger diameter than the diameters of the headlight lenses is not present in the automobile shown in Design patent 154,192.

88. The feature of Defendant's 1950 automobile shown in Exhibit C wherein the two grill portions are positioned entirely below the centrally located ornament between the headlights is not present in the automobile shown in Design patent 154,192.

89. The feature of Defendant's 1951 automobile shown in Exhibit G wherein the sheet metal between the 61 two grill portions and between the two grill portions

and the centrally located ornament is generally Y shaped is not present in the automobile shown in Design patent 154,192.

90. The feature of Defendant's 1950 and 1951 automobiles shown in Exhibits C and G wherein the front wheels are positioned very close to the outer sides of the fenders and directly in line with the headlights is not present in the automobile shown in Design patent 154,192.

91. In the automobile shown in Design patent 154,192 the front wheels could not be positioned immediately adjacent the outer sides of the fender without having the front wheel tires encounter turning interference because, as viewed in the side elevation of Fig. 1 of the patent, the front fender has a portion which overlaps the front wheel tire.

92. The feature of each Defendant's 1950 and 1951 automobiles shown in Exhibits C and G wherein the two grill portions are separated by an elongated strip of sheet metal is not present in the automobile shown in Design patent 154,192.

93. The features of each of Defendant's 1950 and 1951 automobiles shown in Exhibits D and H wherein a rear end elevational a portion of the body of the vehicle beneath the rear bumper is not present in the automobile shown in Design patent 154,192.

94 Exhibits A to D authentically show Defendant's 1950 4-Door Model Commander automobile.

95. Exhibits E to H authentically show Defendant's 1951 4-Door model Commander automobile.

96. Plaintiff alleges that Defendant's 1950 Commander automobile shown in Exhibits A to D infringes Design patent 154,192.

28a *Defendant's Request for Admission*

97. Plaintiff alleges that Defendant's 1951 Commander automobile shown in Exhibits E to H infringes Design patent 154,192.

62 98. For the purpose of comparison, the position of Defendant's automobile shown in each of the Exhibits A and E corresponds with the position of the automobile shown in Fig. 1 of Design patent 154,192.

99. For the purpose of comparison, the position of Defendant's automobile shown in each of the Exhibits B and F corresponds with the position of the automobile shown in Fig. 2 of Design patent 154,192.

100. For the purpose of comparison, the position of Defendant's automobile shown in each of the Exhibits C and G corresponds with the position of the automobile shown in Fig. 3 of Design patent 154,192.

101. For the purpose of comparison, the position of Defendant's automobile shown in each of the Exhibits D and H corresponds with the position of the automobile shown in Fig. 4 of Design patent 154,192.

Wilson, Redrow & Sadler
Attorney's for Defendant
/s/ Wayne B. Easton

Of Counsel:

Wayne B. Easton
Studebaker Division
Studebaker-Packard Corporation
635 South Main Street
South Bend 27, Indiana

75 **PLAINTIFF'S ANSWERS AND MOTION TO
DEFENDANT'S INTERROGATORIES.**

(Filed April 23, 1956)

1. Answer: All of those in Exhibits A to H inclusive. (These answers do not necessarily imply that plaintiff's complaint is limited to the years and models shown in the exhibits of defendant's interrogatories).

2. Answer: All of those models shown in Exhibits I and J.

3. Answer: All of those parts which comprise the exterior appearance of the automobile (excluding color). This includes, but not in limitation, the body, trim, lights, grille, bumpers and exterior accessories.

4. Answer: Yes.

5. Answer: The general configuration and appearance of the automobile body. This includes, but not in limitation, the front fenders, hood, windshield, doors, windows and rear fenders.

6. See motion appended to these answers.

7. See motion appended to these answers.

8. See motion appended to these answers.

9. Answer: Yes.

South Bend Division.

76 10. Answer: Approximately 50 automobiles. They were built commencing approximately November or December, 1946 and ending approximately July or August, 1948. Plaintiff is not presently able to specify the exact beginning and ending dates, nor the production dates of the individual automobiles.

11. Answer: The first public display of one of these automobiles was made on June 19, 1947. Between that date and the fall of 1948, various of these automobiles were displayed in Chicago, Washington, D. C., Philadelphia, New York City, Boston, Los Angeles and other major cities which plaintiff is not presently able to specify. The abovementioned displays were made by Tucker Corporation. Further, from about the summer of 1947 down to the early part of 1955 (at least) various Tucker

dealers, former dealers, individual promoters and owners displayed various of these automobiles to the public in various parts of the country, including, to plaintiff's present knowledge, displays of the automobile at state fairs in midwestern states and also a public display in Miami, Florida. Plaintiff is not presently able to state what, if any, notice appeared on these automobiles regarding this patent. Because they were all produced before the patent issued, plaintiff believes they carried no notice of the patent itself.

12. Answer: Plaintiff does not presently know.

13. Answer: Plaintiff does not presently know.

14. Answer: Plaintiff does not presently know.

15. Answer: The design was conceived prior to March 15, 1947, which was the date the application for patent was filed. Plaintiff does not presently know if he will rely upon a conception prior to March 15, 1947.

16. Answer: The conception date was a substantial interval prior to March 15, 1947. Plaintiff is not
77 presently informed as to the exact date.

17. Answer: Same as answer to No. 16. In addition, plaintiff believes that certain knowledge on this and related matters exists in the memory of Preston T. Tucker.

18. Answer: Plaintiff purchased from the trustee the things specified in the Order of July 17, 1951 in Consolidated Causes No. 48 B 530, in the United States District Court for the Northern District of Illinois, Eastern Division. Plaintiff believes defendant already has a copy of this Order, and if not, he will furnish defendant one upon request. Up to the present time, the trustee has not delivered anything to plaintiff relating to this particular patent.

19. Answer: None in plaintiff's possession, and, so far as plaintiff presently knows, none in his control.

20. Answer: See motion appended hereto.

/s/ Benedict E. Dankovis
Attorney for Plaintiff.

State of Indiana }
County of Lake } —ss:

Jay E. Darlington, being first duly sworn, says he is the above-named plaintiff, that the above answers are true in substance and in fact to his best knowledge and belief.

/s/ Jay E. Darlington

Subscribed and sworn to before me this 23rd day of April, 1956.

/s/ Rose Wilder
Notary Public

(Seal)

My commission expires
July 9, 1957

78

MOTION.

Plaintiff moves that defendant's aforesaid Interrogatories Nos. 6, 7 and 8 be rejected and that he be excused from answering same for each of the following reasons:

1. These interrogatories are not properly within the scope or intent of Rule 33.
2. These interrogatories ask plaintiff to give an answer of mixed ultimate fact and law.
3. These interrogatories improperly seek to argue with the plaintiff upon the legal effect of the Lawson patent.
4. Outside of their aforesaid argumentative purpose, these interrogatories elicit no factual matter which is not as apparent to the defendant as to the plaintiff.

Plaintiff further moves that Interrogatory No. 20 be rejected because it improperly seeks to make a cross-tie to defendant's "Request for Admissions", which is improper under the rules. The Request has to stand as a separate document in the case and is governed by a separate rule.

/s/ Benedict E. Dankovis
Attorney for Plaintiff

79 PLAINTIFF'S RESPONSE TO DEFENDANT'S
REQUEST FOR ADMISSIONS.

(Filed April 23, 1956)

1. Plaintiff admits that the patent in question contains a single claim reading as quoted in request No. 1. He says "the scope of protection" is a matter of law.

2. Plaintiff admits that the ornamental design covered by the claim in this patent is shown by a series of four figures as stated in request No. 2. This request, like No. 1, is simply an excerpt from part of the patent.

3. Plaintiff admits request No. 3,—this again being simply an excerpt quoted from the patent.

4-93. See written Objections appended hereto.

94-95. Plaintiff admits, upon information and belief, that Exhibits A to D of the defendant's Request are photographs of defendant's 1950 4-door Commander automobile, and that Exhibits E to H are photographs of defendant's 1951 4-door Commander automobile. Plaintiff denies, however, that these photographs "authentically show these automobiles, and denies that these photographs correctly exhibit those automobiles or correctly exhibit defendant's automobiles generally which it manufactured and sold in those years. The reason for this denial is: After carefully inspecting these photographs, plaintiff states upon information and belief, based upon past 80 personal observations of various of defendant's auto-

mobiles for those years, that these photographs do not exhibit, but rather conceal, the similarity of defendant's said automobiles to plaintiff's patent. This characteristic of the photographs appears to be due to the manner of lighting and technical photographic features not fully familiar to plaintiff which result in a flat appearance which fails to adequately show the elevation and contour of the various parts of the automobile covered by the photograph.

96-97. Defendant's 1950 and 1951 Commander automobiles which are purportedly pictured in Exhibits A to H are included in plaintiff's allegation in the complaint that defendant has infringed plaintiff's patent. However, plaintiff wishes to point out that the alleged infringement is based upon the automobiles as actually made and sold by defendant rather than the automobiles "shown" in these exhibits, which plaintiff claims to be inaccurate representations of defendant's automobiles as set forth in the preceding paragraph.

98-101. So far as plaintiff can ascertain from looking at the photographs, the Exhibits A to H mentioned in requests Nos. 98-101 show the automobile in positions corresponding with the similar figures in plaintiff's patent. However, the accuracy of this statement is presently better known to defendant than to plaintiff because the photographs were taken by or for the defendant, and plaintiff is not presently able to state what, if any, variation in the position of the camera or other photographic detail may be involved which might cause these photographs to be at variance with the position of the figures in the patent. Again, plaintiff says that the infringement complained of is based upon the actual automobiles made and sold by the defendant, rather than upon these photographs, and that the determination of the similarity will need to be made from an inspection of the actual

80a automobiles rather than photographs. Further, plaintiff points out that the alleged infringement is not confined to the particular models covered by these photographs.

/s/ Benedict E. Dankovis
Attorney for Plaintiff

OBJECTIONS.

Plaintiff objects to each of defendant's requests Nos. 4 to 93 inclusive. These requests are all similar in character, illustrated by Nos. 4-6 wherein the defendant mentions some detail in the over-all design shown in one of the particular figures and then seeks an admission of this detail "as part of the ornamental design for an automobile claimed in said patent," following which defendant asks plaintiff to admit that this particular "feature" is "not present in either of the automobiles shown" in defendant's photographs, and also asks plaintiff to admit that this feature is not present in the automobiles "shown" in the photographs "because" the feature does not look that way in the photograph. In view of these common characteristics and common purpose of all these requests, plaintiff objects to each of them on each of the following grounds:

1. The requests are immaterial and misleading for the reason that a comparison of these isolated differences of detail (if there be such differences) does not solve the question as to whether there was an infringement of the design covered by plaintiff's patent.
2. The requested admissions are argumentative and are mixed questions of ultimate fact and law.
- 81 3. Even if it were otherwise proper for the defendant to make requests for these admissions of

alleged differences in detail of the design, it is not reasonably possible for plaintiff to base such admissions upon these photographic exhibits of the defendant because, as plaintiff states on information and belief based upon personal observation of various of defendant's automobiles for those years, these photographs do not fairly exhibit but conceal the similarity of defendant's said automobiles to the design in plaintiff's patent, due apparently to the flatness of the photographs, their failure to exhibit the elevation and contour of the various photographed parts of the automobile, and other technical photographic discrepancies not presently fully known to plaintiff.

Wherefore, Plaintiff prays that each of said requests Nos. 4 to 93 inclusive be rejected and that he be not required to admit or deny same, and for all further just and proper relief.

/s/ Benedict E. Dankovis
Attorney for Plaintiff

State of Indiana }
County of Lake } —ss:

Jay E. Darlington, being first duly sworn, says that the allegations of fact in the foregoing Objections are true in substance and in fact to his best knowledge and belief, and that these objections are filed in good faith for the purpose of preserving material rights of the plaintiff under Rule 36.

/s/ Jay E. Darlington

Subscribed and sworn to before me this 23rd day of April, 1956.

/s/ Rose Wilder
Notary Public

My commission expires
July 9, 1957

82

And afterwards, to wit, on the 2nd day of May, 1957, the following further proceedings were had in the above entitled cause, to wit:

Now here a Notice was mailed by the U.S. Clerk, to attorneys of record, that this cause will be dismissed on June 6, 1957 pursuant to Rule of this court, unless prior thereto for good cause shown the court orders otherwise, which Notice reads in the words and figures following, to wit:

(Caption)

82a

You are hereby notified that this cause will be dismissed on Thursday, June 6, 1957, pursuant to Rule 11 of this court, unless prior thereto, for good cause shown, the court orders otherwise.

/s/ Kenneth Lackey
Clerk

South Bend, Indiana

May 2, 1957

Notices mailed to:
135 South LaSalle Street
Chicago, Illinois

Mr. Joseph A. Roper
301 St. Joseph Bank Building
South Bend, Indiana

Mr. Benedict E. Dankovis
306 Hammond Building
Hammond, Indiana

Alfred E. Wilson,
Allan R. Redrow and
Clifford L. Sadler
1580 East Grand Boulevard
Detroit, Michigan

83

And afterwards, to wit, on the 6th day of June, 1957, the following further proceedings were had in the above entitled cause, to wit:

Now here an order is entered by the court, dismissing this cause under Rule 11 of this court, which order reads in the words and figures following, to wit:

83a

ORDER

(Filed June 6, 1957)

Pursuant to notice given under Rule 11 of the Rules of this Court, cause dismissed for failure to prosecute at the costs of the plaintiff.

/s/ W. Lynn Parkinson
Judge

South Bend, Indiana

June 6, 1957

Copies mailed to all counsel of record

6/6/1957 HM

(Defendant's motion to tax costs not printed.
Tr. 84-89. No order thereon).

91

MOTION TO VACATE DISMISSAL

(Filed June 21, 1957)

Comes now the plaintiff and respectfully moves the Court to vacate the order entered herein on June 6, 1957, dismissing this action under local Rule 11, and shows:

1. Said dismissal occurred because of mistake, accident and inexcusable (stenographic error—means excusable) neglect on the part of this plaintiff, due to the following circumstances, among others: Continuously since January 3, 1957, until the present time, the plaintiff, Jay E. Darlington, an attorney practicing at Hammond, Indiana, has been under a continuous and heavy burden of trial work and matters immediately connected therewith, which could not be avoided or delayed, principally in the Federal Courts in various parts of the country, including principally the case of *Burns v. Jaffe et al*, No. 53 C 5639, in the United States District Court at Chicago, the case of *Peckham v. Family Loan Company, et al*, No. 2900 M Civil, in the United States District Court at Miami, and the case of *Peckham v. Ronrico Corporation et al*, No. 4639, in the United States District Court for Puerto Rico. This situation, consuming all of plaintiff's time and attention, including much work at night, was in existence
92 at the time this Court's order was made on May 2, 1957, requiring some action in this case to prevent dismissal under local Rule 11, and the same situation continued at the time the aforesaid dismissal order was entered. Due to this situation and the burdens of said other litigation, plaintiff overlooked the requirement of taking action in this case under Rule 11, and if it had not escaped his attention, it would not have been possible anyhow to

take such action within said time, due to the aforesaid situation of the plaintiff. Moreover, although the plaintiff has counsel of record representing him in this action, he has taken the responsibility of communicating to them and instructing them upon all matters in the case, such as the matter in question, and they have left such matters to his initiative. Due to the aforesaid facts, plaintiff was unable to and did not communicate to his said counsel the necessity of their taking action under Rule 11, and they did not act because of their reliance upon the plaintiff to take such action. Accordingly, the failure of both the plaintiff and his counsel to take the required action under Rule 11 was caused by the professional burdens and situation of the plaintiff above described.

2. From the commencement of this case continuously until the present time, it has been and is the intent and purpose of the plaintiff to prosecute this action to trial and conclusion, but plaintiff has been delayed in so doing, not only because of the above described burdens of his work since the beginning of 1957, but due to previous similar heavy professional work in the preceding years, plus the fact that the case requires a large amount of discovery and pre-trial preparatory work on the part of plaintiff because of its nature, plus the fact that the plaintiff has considered it appropriate not to present this action involving an alleged liability of many millions of dollars against the defendant during the period of the last several years while the defendant was extricating itself from financial difficulties.

3. Plaintiff desires and is ready to proceed with the necessary pre-trial work and preparation of this case for trial. In view of its large and important character, it would be a great and unnecessary hardship upon plaintiff to have this case dismissed without a hearing on the merits.

Motion to Vacate Dismissal

Wherefore, plaintiff prays that said order of dismissal under local Rule 11 be vacated.

/s/ Edwin Booth
/s/ Benedict E. Dankovis
Attorneys for Plaintiff

State of Indiana }
County of Lake } ss:

Jay E. Darlington, being first duly sworn, says the allegations of the above motion are true in substance and in fact.

Affiant further says that he mailed a true copy of this motion on June 20, 1957, to defense counsel of record, Mr. Wayne B. Easton, c/o Studebaker-Packard Corporation, South Bend, Indiana.

/s/ Jay E. Darlington

Subscribed and sworn to before me this 20th day of June, 1957
(Seal)

/s/ Rose Wilder

My commission expires July 9, 1957

Notary Public

95

E N T R Y
(Filed March 14, 1958)

Plaintiff, being present in person and as his own counsel and defendant being present by counsel, Wayne B. Easton, hearing is had on plaintiff's Motion to Vacate Dismissal and the matter is taken under advisement. Plaintiff is given thirty (30) days, or on or before April 14, 1958, within which to file any memorandum of authorities in support of the Motion and defendant is given thereafter on or before May 5, 1958, within which to file any reply memorandum of authorities.

/s/ Robert A. Grant
Judge

Enter:

March 14, 1958

42a *Plaintiff's Motion for Judge to Disqualify Himself*

97 PLAINTIFF'S VERIFIED MOTION FOR
THE JUDGE TO DISQUALIFY HIMSELF

(Embodying Motion for Discovery of Defendant's
Records Supporting Same)
(Filed April 14, 1958)

The plaintiff respectfully moves the regular Judge of this Court and Division, who is sitting in this case, Hon. Robert Grant, to disqualify himself and certify his disqualification to the Chief Judge of the United States Court of Appeals for the Seventh Circuit, to sit further in this case, including decision of plaintiff's pending Motion to Vacate Dismissal and subsequent proceedings and trial in this case (except only to pass upon the subsidiary Motion for Discovery of Defendant's Records in the event more specific data supporting this Motion for Disqualification be deemed to be required by said Judge to demonstrate his disqualification), and respectfully shows: —

1. Plaintiff states upon information and belief derived from the most diligent inquiry he knows how to make outside of the defendant's own secret records: Said Hon. Robert Grant, while maintaining a law office in South Bend, during the approximate period beginning about 1950 and extending down to the approximate close of the Korean War in 1954 or 1955, was employed by defendant Studebaker-Packard Corporation in a legal or quasi-
98 legal capacity, for which he was paid a salary plus expense account by said defendant, in connection with work by him in Washington, D.C. on its behalf in connection with the procurement or negotiation of contracts on behalf of said defendant with various military, or other agencies of the United States Government for defendant to supply motor vehicles and other equipment to the United States Government, some of which efforts on his behalf resulted in such contracts (including, as plaintiff has good reason to believe, Studebaker automobiles).

2. As shown by the record in this case, this case was commenced during the period of said Judge's said employment by the defendant and thereafter continued throughout said Judge's employment. It is an action seeking an accounting and many millions of dollars of judgment in favor of plaintiff against said defendant arising out of the alleged fact that said defendant's automobiles infringed a patent owned by plaintiff and his predecessors in title. Accordingly, whether said infringing of automobiles was directly connected with said Judge's employment by the defendant or not, said Judge is nevertheless unable to exercise that degree of disinterestedness and impartiality required of him toward the plaintiff in this action, because the action vitally affects the purse and future fortunes of the defendant for whom said Judge has acted during a large part of the pendency of this action as aforesaid.

3. It is presently impossible for plaintiff to state more specifically the details regarding said Judge's aforesaid employment, compensation and expense account with the defendant, because said details can only be obtained, so far as he knows, from the private and secret records of defendant, but if further specification is required, plaintiff believes with good cause based upon the facts aforesaid, that he can and will obtain same from a discovery of defendant's records under Rule 34 of Civil Procedure.

99 4. It was not reasonably possible for the plaintiff to discover the aforesaid grounds for disqualification of said Judge prior to this time because:

(a) He had no knowledge thereof, except some vague rumors, prior to the hearing on his said Motion to Vacate Dismissal in the middle of March, 1958, and he did not previously investigate said rumors because of the fact that it was impossible for him to devote the necessary time and

44a *Plaintiff's Motion for Judge to Disqualify Himself*

attention thereto, due to urgent litigation which fully occupied his time in several United States District Courts and Courts of Appeal and in the trial and appellate courts of Indiana, plus the fact that he discounted said rumors upon the belief that said Judge would not assume to sit in this case if same were true. He had no cause to believe the contrary, until said hearing convinced him that said Judge had a pre-conceived prejudiced and hostile attitude toward his case (referring to oral statements of said Judge at said hearing wherein the Judge at the outset and before hearing plaintiff indicated that he already had his mind made up to deny the motion, plus the Judge's adverse attitude and comments throughout the hearing, plus the Judge's statement at the close of the hearing that he was only concerned with the law question of alleged conflict of Local Rule 11 with Rule 41(b) of Civil Procedure and indicating that his mind was still made up and closed on the fact questions presented in said Motion to Vacate, — all of which matters the plaintiff is prepared to elaborate by further affidavit if so requested by said Judge).

(b) As a result of the disclosures coming to his knowledge as described in the latter part of (a), plaintiff promptly started to inquire concerning the matters set forth in paragraphs 1 and 2 of this Motion, following said hearing, from whatever sources he could find outside of defendant's secret records, and from said inquiry, he recently ascertained the above facts from sources which he believes 100 with good cause to be reliable, and he makes and files this verified motion for disqualification at the earliest reasonable opportunity thereafter. Moreover, said Judge did not assume said office until the second half of 1957. The aforesaid hearing before him in the middle of March, 1958, was the first appearance by plaintiff before him in connection with this case or any case, and prior thereto

plaintiff was a total stranger to said Judge and did not even know him by sight.

Wherefore, Plaintiff prays:

1. That said Judge forthwith disqualify himself to sit further in this case, including the determination of the pending Motion to Vacate Dismissal and the Brief filed herewith supporting same, and all further matters in this case, pursuant to applicable basic judicial principles and applicable sections of the Judicial Code, including 28 U.S.C.A. 455, which reads:

“Any justice or judge of the United States shall disqualify himself in any case in which he has a substantial interest, has been of counsel, is or has been a material witness, or is so related to or connected with any party or his attorney as to render it improper, in his opinion, for him to sit on the trial, appeal, or other proceeding therein.” (June 25, 1948, c. 646, 62 Stat. 908.

2. And as ancillary relief to the above prayer No. 1, plaintiff prays that in the event said Judge deems further specification of the grounds of the above motion to be necessary, that plaintiff may forthwith have an order from him for the discovery, inspection and copying of defendant's records relating to the subject matter of this motion only, with leave to the plaintiff to file a supplemental affidavit embodying said specific matters, and that thereafter said Judge may forthwith declare and certify his disqualification as prayed in No. 1.

/s/ Jay E. Darlington
Plaintiff

101

State of Indiana }
County of Lake } ss:

Jay E. Darlington, being first duly sworn, says that the fact allegations of the foregoing motion are true in substance and in fact to his best knowledge and belief, and that those alleged on information and belief are based upon diligent inquiry from sources which he with good cause believes to be truthful and accurate, and that a more specific allegation thereof is presently impossible due to the facts stated in said motion.

Affiant further says that he caused a true copy of the above motion to be delivered by his messenger to defense counsel, Wayne B. Easton, Esq. at the latter's office at the general office of Studebaker-Packard Corporation in South Bend on April 14, 1958.

/s/ Jay E. Darlington

Subscribed and sworn to before me this 14th day of April, 1958

(Seal)

/s/ Rose Wilder
Notary Public

My commission expires
July 9, 1961

(Plaintiff's Brief Supporting his Motion to Vacate Dismissal, filed April 14, 1957, not printed. Tr. 102-104.)

106

BRIEF BY DEFENDANT

(Filed April 26, 1958)

This brief is in three parts as follows:

Part I is a reply to plaintiff's "Motion to Vacate Dismissal" filed June 20, 1957.

Part II is a reply to plaintiff's arguments in his brief filed April 14, 1958 regarding the validity of "local" Rule 11.

Part III is a reply to "Plaintiff's Verified Motion For The Judge To Disqualify Himself".

(Note: Parts I and II are not printed. Tr. 106-123.)

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PART III.

With regard to plaintiff's motion for the presiding judge to disqualify himself, defendant freely admits that the presiding judge was retained with a fee of \$400.00 per month by the former Studebaker Corporation to handle certain legal matters having no connection whatsoever with the present case continuously from July 1950 to the end of 1954. This was not known to the undersigned attorney prior to being informed of it by reading plaintiff's motion.

A pertinent case is Carr v. Fife, 44 F. 713 wherein it is stated:

"When the case came on for hearing, the plaintiff filed a motion to defer the trial, on the ground that the district judge who was presiding, and the only judge of the court in attendance, had been employed by some of the defendants as an attorney on matters not connected with the case since the suit was commenced, though prior to his appointment. It is not asserted that the judge is legally disqualified, and it is only insinuated that, because of transactions in the past, he is liable to be partial, and incapable of render-

ing a just decision. It would result in clogging the operations of the courts, and intolerable delays in most cases, to adopt the principle that no case can proceed before a judge who at any time may have had any business relationship with any party to it; and it would be more weakness on the part of a judge to refuse to perform the functions of his office merely because of insinuations against his ability to act impartially. For these reasons, the motion to postpone was denied, and the case proceeded to a hearing upon the merits.”

125 With regard 28 U.S.C.A. 455, plaintiff quotes this section in his brief and has underlined the words “connected with any party”. In construing a prior statute having these same words, and from which 28 U.S.C.A. 455 is derived, it is held in *Duncan v. Atlantic Coast Line R. Co.*, 223 F. 446, that the words “connected with any party” do not apply to a case where a judge formerly acted as counsel for one of the parties in a different matter.

The *Duncan* case has the following pertinent summary:

“The presiding judge in this case does not come within the letter or the spirit of the prohibition of the statute. He is not concerned in the pending litigation; he has no interest in it, and has never been connected with it in any way; he never was counsel in the case for either party, and is not related to or connected with either party; he has never heard of the case before, and knows nothing about the facts or issues involved; and he feels that his mind is absolutely impartial between the parties to the cause, and that it is therefore neither illegal nor improper for him to preside at the trial of the case. He holds, therefore, that he is not disqualified.

The circumstances involved in this matter and the prevailing law are such that it appears that the presiding judge should not disqualify himself in this case. To do so would apparently establish a precedent such that, to be consistent, he would be obliged to disqualify himself from all cases in the future in his court in which Studebaker-Packard is a party. While the undersigned attorney would have no concern whatsoever if this case were assigned to another judge for a decision on plaintiff's motion to vacate the dismissal, the establishing of the precedent referred to would probably be effective for many years in the future so as to cause difficulties for the defendant from the 126 standpoint of delays and red tape involved in referring all future cases to substitute judges.

It would seem that fact situations similar to that in the present case must arise with great frequency. Most judges are former practicing attorneys and it must often happen that former clients have cases before these judges. It is shown above that such cases are not included within the scope of 28 U.S.C.A. 455. The possibility of a judge showing bias or favor to a former client is negated by reason of the judge having been sworn to administer impartial justice to all who appear before him.

Furthermore, if the presiding judge were to disqualify himself in this case, he would logically have to disqualify himself in all other cases where former clients become involved as parties in suits in his court.

Defendant would have no objections to any discovery order with regard to inspecting defendant's records as requested by plaintiff except to the extent that the scope thereof should not be broader than necessary so as to not be burdensome to defendant. Defendant freely admits the retainer alleged by plaintiff, however, and such order is therefore not believed necessary.

50a *Order Overruling Motion to Disqualify*

For the reasons given above it is respectfully urged that plaintiff's motion that the presiding judge disqualify himself be denied.

/s/ Wayne B. Easton
Attorney for Defendant

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O R D E R
(Filed May 8, 1958)

Plaintiff's Motion For the Judge to Disqualify Himself is hereby overruled, as the present occupant of this bench:

- (1) Has no interest in this present action;
- (2) has not been of counsel as to this action and has not been a material witness therein;
- (3) has not been and is not now, to his knowledge and in his opinion, so connected with any party in this matter, or any attorney therein, as to render it improper for the present occupant of this bench to preside in this matter.

/s/ Robert A. Grant
Judge

Enter:
May 8, 1958

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O R D E R
(Filed May 9, 1958)

The Complaint in this action was filed on December 31, 1952.

On May 2, 1957, notice was mailed by the Clerk of the United States District Court that the case would be dismissed, under Rule 11 of the Rules of the United States District Court for the Northern District of Indiana, unless good cause to continue were shown.

On June 6, 1957 the Court dismissed the case for failure to prosecute this action.

On June 20, 1957 plaintiff filed a Motion to Vacate Dismissal. Plaintiff asserts many frivolous reasons for not having prosecuted this suit and for having completely ignored the notice sent out under date of May 2, 1957.

Plaintiff has failed to prosecute this action with reasonable diligence and plaintiff's Motion to Vacate Dismissal of this action is hereby denied.

Shotkin v. Westinghouse Electric & Mfg. Co., 169
F. (2d) 825;

Hicks v. Bekins Moving & Storage Co., 115 F. (2d)
406;

Reed v. South Atlantic S. S. Co. of Delaware, 2
F.R.D. 475;

Cyclopedia of Federal Procedure, Vol. 9, Section
29.16, p. 104.

/s/ Robert A. Grant
Judge

Enter:

May 9, 1958

NOTICE OF APPEAL
(Filed June 7, 1958)

The plaintiff in this cause hereby gives notice that he appeals to the United States Court of Appeals for the Seventh Circuit from each of the following orders of the District Court herein:

1. The order filed May 8, 1958 overruling Plaintiff's Motion for the Judge to Disqualify Himself.
2. The order filed May 9, 1958 denying plaintiff's Motion to Vacate Dismissal of this action.

/s/ Jay E. Darlington
Plaintiff

Copy mailed to W. Easton, attorney for Studebaker
Packard Company 6-7-1958 HM

(Appeal Bond and Clerk's Certificate not printed. Tr.
135-138).

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