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Pioneer patent lawyer made history — still at it at 82

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He obtained the original patent on the videotape recorder in 1960, only a year after he got out of law school, and he enforced it in the courts, according to his law firm.

John F. Flannery still works on cases at his law firm, Fitch, Even, Tabin & Flannery, 51 years after the videotape recorder. He's 82.

"I'm the only name partner still working," he said.

"I love it. I like the challenges and it's better than sitting around the house."

When Flannery obtained the patent on the videotape recorder for his client, Ampex, the machine was for commercial broadcasts and it cost $50,000.

It allowed East Coast shows to be taped and played later on the West Coast, Flannery said.

He was also lead trial counsel in a landmark case that held software-based diagnostic systems were patentable, according to his firm.

"I still work with him a lot today," said partner Karl R. Fink, who joined the firm in 1995.

"We've reversed roles now," Fink said. "I'm the trial lawyer and he is the second chair. He's stepped into that role with gusto and I still count on him to fulfill the responsibilities of that role, sometimes sending him to depositions to California and elsewhere.

"He and I recently traveled to Taiwan to inspect a plant and a manufacturing process that we contended was infringing a patent in a pending lawsuit.

" I recently asked his wife if it was OK to keep John working so hard and she said yes it keeps him happy."

"He's still a present day, hard-working lawyer, as crazy as that sounds," Fink said.

Telling the videotape story, Flannery said in the early years of television, the only way to record a show to broadcast later was on film and "It wasn't very good for transmission."

Ampex, of Redwood City, Calif., came up with a workable videotape recorder that it showed at the National Association of Broadcasters convention in 1956. "But they were really having a problem getting it through the patent office," Flannery said. "They (the patent office) didn't think it was an invention."

Flannery had joined Fitch, Even (then known as Soans, Anderson, Luedeka & Fitch) as an associate writing patent applications while he was still a student at Loyola University Chicago School of Law.

He was already an experienced electrical engineer with two engineering degrees. He got his law degree in 1959.

"The partner who got Ampex as a client didn't have much of a background in electronics," Flannery said. "I had the background, so he put me on it as the prime lawyer on obtaining the patent."

"We took over the prosecution" after other lawyers had failed to get the patent. Ampex videotape recorders were already in use in the the television industry.

Flannery said he went to Washington to talk to the patent examiner. "I had to explain to him why this was a big invention; how it did change the television industry."

Flannery secured the patent and then had to defend it against a challenge from RCA. "We won the patent case … in a declaratory judgment," he said.

To get into the Japanese market, Ampex had to grant Sony a license to also manufacture commercial videotape recorders, Flannery said.

But in the mid-1960s, Sony produced a home videotape recorder that Sony tried to market as its own, "and we sued Sony," Flannery said.

"We sued just about every one of the Japanese" manufacturers. They all settled and agreed to buy licenses.

"The home recorder was based on the same technology" that Ampex had patented and that patent was good until 1977. Thus, the Japanese companies had to pay Ampex a royalty to make videotape recorders.

Flannery said, "Ampex was making over a million in royalties every year."

In another major case, Flannery represented Arrhythmia Research Technology in a dispute over whether software-based diagnostic systems were patentable.

"Back then," Flannery said, "if a product used a mathematical algorithm as part of its procedure through the computer," the patent office often would not allow a patent. "They didn't think it was patentable subject matter."

In this instance, the patent office allowed the patent for the Arrhythmia's systems that analyzed electrocardiographic signals. But another company, Corazonix, infringed on the patent on the basis that the systems were not patentable.

Flannery won that case in *Arrhythmia v. Corazonix* (958 F. 2d 1053).

"This was the first case in which the federal circuit ruled that mathematical calculations determined by a computer were patentable," he said. "There are at least hundreds of patents like that since then."

Among his other favorite cases, he said, was a lesser known matter, *Rosemont v. Beckman Instruments* (727 F. 2d 1540 1984).

This was an improvement in the development of pH meters to measure acidity, but "the invention was very slight," Flannery said. "There wasn't much of a difference between that and prior art."

Still, the new device worked better.

Flannery said he based his argument on what are called "secondary considerations."

"I was arguing there were serious problems with prior pH meters. Nobody was able to calibrate them. I argued all this real world history of development. The court went along with me completely."

In its decision, the federal circuit cited the importance of "human events surrounding the birth of the invention and its effects on the industry … real people facing real problems."

Flannery was born in Chicago in 1928 and raised in the Cragin neighborhood. His parents were from County Mayo, Ireland, and his father was a Chicago policeman.

He said he started working as an engineer for various firms, but found himself "being pushed back into a corner designing transistor circuits."

"It didn't appeal to me," he said. "I had no contact with people. … I wanted to get into being an executive."

He went to law school to become an executive, but instead became an intellectual property lawyer.

Flannery also saw the development of jury trials as an important factor in patent cases. He said when he began practicing, jury trials were rare until the U.S. Court of Appeals for the Federal Circuit was established in 1982.

"I had one of the first jury trials," he said. "Nowadays, most patent cases are jury trials." He said he has tried 10 to 15.

"Judges tend to rule on technical issues," Flannery said. "Juries tend to get a feel for secondary considerations," whether the thing "could do something."

Juries became important, he explained because "the federal circuit seemed to go for jury trials. If a jury ruled one way, the federal circuit affirmed it."

Fitch, Even's managing partner, Timothy P. Maloney, said, "John was really the leader of the firm's litigation practice for several decades. He attracted a lot of clients to the firm … and a lot of lawyers to the firm, including people like myself."

Flannery's style, Maloney said, is to "roll up his sleeves and dive into the details of a patent case," both the technology and the law, even when he had a high level role and supervised others who might be expected to do this.

"He expects a lot out of young lawyers, the same dedication and enthusiasm he brings."

"You can trust him," Fink said. "I've seen a lot of lawyers where you might question whether you could trust them, but not with John."

Also, even today, Fink said, "he and I often sit together and talk over issues and strategies in an unhurried way, even

though we are overwhelmed with the press of so much work to do, deadlines, etc. We will often sit together … and just talk and think, often with long periods of silence, as we consider our points of discussion and think through the issues that we are facing in lawsuits. I consider this time of mutual thinking together to be our most valuable time together."

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