ADVISORY COMMITTEE ON RULES FOR CIVIL PROCEDURE

Meeting October 22-27, 1936.

Transcript.

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Thursday, October 22, 1936.

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ADVISORY COMMITTEE ON RULES FOR CIVIL PROCEDURE

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THURSDAY, OCTOBER 22, 1936.

Supreme Court of the United States Building,
Advisory Committee Hearing Room,
Washington, D. C.

The Advisory Committee met in the hearing room at 10 o'clock a.m., Honorable William D. Mitchell (Chairman) presiding.

Present: William D. Mitchell (Chairman), George Wharton Pepper (Vice-Chairman), Edgar B. Tolman (Secretary), Charles E. Clark (Reporter), Wilbur H. Cherry, Robert G. Dodge, George Donworth, Joseph G. Gamble, Monte M. Lemann, Scott M. Loftin, Edmund M. Morgan, and Edson R. Sunderland. Mr. Pepper at 10:20

Also present: Representing the Patent Section of the American Bar Association: Mr. Howe, Chairman; Mr. Wallace R. Lane, of the Chicago Patent Law Association; Mr. Merrell E. Clark, of the New York Patent Law Association.

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The Chairman. We shall come to order. Mr. Reporter, will you note the presence of the Chairman, William Mitchell; the Reporter, Charles E. Clark; the Secretary, Edgar B. Tolman; George Donworth, Mr. Loftin, Mr. Morgan, Mr. Cherry, Mr. Dodge, Mr. Lemann, Mr. Gamble, and Mr. Sunderland.

I have here a telegram from Judge Olney, stating that he has suddenly been involved in some matter that will prevent his attendance; and I have a message from Senator Pepper, that

his train will not arrive until 10:30 this morning, and he will be somewhat late.

STATEMENTS OF MEMBERS OF THE PATENT BAR

The Chairman. The Committee will remember that at the last meeting we passed over all suggestions that came specially from members of the Patent Bar, with the understanding that we take them all up here in Washington at this meeting. It was also suggested that some representation from the Patent Bar be asked here, to present orally its views on these rules. And when it came to inviting some representatives of the Patent Bar to appear here, I found that there was a committee of the Chicago Association of Patent Lawyers that was active, and of the New York Association, and the Patent Section of the American Bar Association, also. The committee appointed for this purpose by the chairman of the Patent Section of the American Bar Association fortunately had on it very distinguished members of both the Chicago Association and the New York Association. So happily the matter worked out that by inviting the representatives of the Patent Section of the American Bar Association, we also were inviting the Chicago Association and the New York Association. I took the liberty, therefore, of asking the chairman of the committee of the Patent Section of the American Bar Association to designate someone to appear here before us. We have Mr. Howe, the chairman of the Section; Mr. Lane, of Chicago, and Mr. Clark, of New York. Mr. Cooper, the other member of that committee, was here a minute ago; but he has a case to argue this afternoon before the Supreme Court, and feels that he must give

his attention to that.

As to the manner of dealing with these subjects, subject to the Committee's wishes regarding it, I suggested to the Patent Committee here that we proceed at once to hear what they have to say on the whole subject. It does not seem feasible for us to sit here for a week and keep them in attendance during that time, having them sitting here to deal with patent matters when we are dealing with a great many other matters relating to each rule, and that are not patent matters. So, although I do not know how the members of the Advisory Committee feel about that, I thought that we had better hear the patent lawyers say what they have in their minds on the whole subject and on any rule they wish to discuss. We shall sit here and listen to them; any members of the Committee who wish to ask these patent lawyers questions will please do so. And everything that is said will be reported by the reporter. Then, having the benefit of all those suggestions, we can proceed in our own way to go through the rules as we have heretofore, and deal with the patent suggestions ourselves, as we get to each rule.

There has been some suggestion that some members of this Patent Committee may be able to stay in the city, subject to our call, if we get into any difficulties. I do not know whether that will be necessary or not.

Is that a satisfactory way of arranging the matter?

Mr. Loftin. I so move it, Mr. Chairman.

The Chairman. If there is no objection, it will be so handled.

STATEMENT OF MR. HOWE, CHAIRMAN OF THE PATENT SECTION, AMERICAN BAR ASSOCIATION.

The Chairman. Now, Mr. Howe, we are glad to have your committee proceed in such manner as you desire, and at your own time.

Mr. Howe. Thank you, sir. Shall I rise?

The Chairman. No, this is quite informal.

Mr. Howe. Thank you. With your permission, I have designated Mr. Clark, of New York, to speak on behalf of our committee. And he will speak regarding our views. Of course, if you have any desire to ask questions regarding anything, I suppose that any member of the committee is privileged to answer from his own viewpoint. But other than that, Mr. Clark will present our views.

Mr. Clark.

The Chairman. Mr. Clark, we are ready.

STATEMENT OF MERRELL E. CLARK, REPRESENTING THE PATENT SECTION COMMITTEE OF THE AMERICAN BAR ASSOCIATION, AND MEMBER OF THE NEW YORK PATENT LAW ASSOCIATION.

Mr. Merrell E. Clark. Mr. Mitchell, at the recent meeting of our committee in Chicago, there were prepared written suggestions regarding all the rules with the exception of chapter 5, relating to discovery, and so forth. The reason that was omitted was that at that time we had not received what we understood to be the final recommendations of this Committee with respect to chapter 5. We had some amendments with regard to the other rules.

If I may, I should like to direct my attention immediately to chapter 5, relating to the interrogatories, and discovery, and so forth.

The Chairman. Yes. When I heard that you had not prepared suggestions regarding those rules, I wired Mr. Howe, thinking it would be advisable for you to tell us what you have to say, because we should like to know what you think, before we undertake any revision of those matters.

Mr. Merrell E. Clark. Yes. Generally speaking, I think that the patent bar has found the present rules with regard to discovery, adequate. However, I do not wish this Committee to think that the patent bar objects to any changes which may be an improvement relating to proceedings relating to all equity and civil cases. I think the basic philosophy of the new rules in chapter 5 is this: that the interrogating party shall proceed, without sanction of the Court, unless and until he appears to be overstepping the rule or overstepping the relevant matters. And then there are adequate provisions, I think, in the rules as proposed, for checking him and bringing him up within relevant matters.

The feeling of this committee is that it would be better, so far as patent cases are concerned, to shift the burden to the interrogating party; that is, before one of the parties examines the opposing party, or one of his officers or agents, and so forth, to require that the court issue an order specifying the scope of the subject matter to be covered by that examination of witnesses. Many of our patent cases are directed, of course, to matters which are more or less trade secrets or at least "know-how" of carrying out processes, and things of that sort. And I think it is important to protect those to the extent that it is feasible, and still give a patentee whose rights are really infringed, an opportunity to

determine the facts that are relevant.

For example, in Rule 31, which is the rule providing for interrogatories by written or oral testimony, we feel that it would be preferable to provide that the party proceeding shall proceed only upon order of the court granting a motion duly made, and that the motion for such an order to take testimony should specify the subject matter of the testimony desired to be taken, and the names of the prospective witnesses; and any order issued upon such a motion should specify the scope of the testimony to be taken thereunder. The purpose of this is to limit at the outset a "fishing expedition" which might be carried on in a jurisdiction far away from that in which the action is pending. And I think that when that situation arises, you get not so good a consideration by the federal court in the distant jurisdiction as you do in the original jurisdiction; that is to say, it comes to the judges there, rather as an outside matter. And we feel it should be taken up initially by the court before whom the case is pending, and he should outline the scope which the questioning is to take. That is for the protection of a manufacturer, for instance, from a "fishing expedition" by a plaintiff who has brought a suit without any real knowledge of what the defendant is doing, but merely in an effort to find out something on which he can base a case.

I have here, written out, a few copies of the specific suggestions to those rules, which are really all along those lines, Mr. Mitchell, of transferring the burden to the interrogating party, and requiring initially an order of the court.

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Rule 37 is rather a new rule in our procedure; and this committee recommends either that that rule be eliminated or, again, that the burden be shifted; in other words, it shall be modified to require initially an order by the court specifying the scope of the discovery. I think the necessary protections are there, in section (b) of that rule -- that is, the respondent can bring the matter to the court, and object, and so forth. But we feel that the burden should be placed upon the party seeking the information, to get the order of the court initially.

That generally states our objections to these rules in chapter 5.

With regard to 41, which is also in that chapter, this committee feels that that portion of rule 41 which provides that a witness or an attorney shall be considered in contempt for refusal to answer questions by deposition, is rather harsh, and that there should be no considering a person in contempt, unless he refuses to answer a question which the court has directed him to answer. Here, again, it is rather a matter of shifting the burden: As the rule is now written, it provides that in taking any deposition before a notary, if a witness refuses to answer a question, or counsel suggests to the witness that he refuse to answer the question, both the witness and the counsel are considered in contempt. And then the next provisional rule provides for going to the court, and the court may rule upon the matter.

We feel that neither a witness nor an attorney should be considered in contempt unless a court has ordered a question asked and, thereafter, the witness has refused to answer the

question.

I think that that covers, in a general way, the specific suggestions we have with regard to chapter 5.

Mr. Dodge. May I ask one question, Mr. Chairman? A great many of the patent associations have raised that question about the application of this discovery principle to the case of the date of the invention, where in the patent practice you have to exchange sealed material.

Mr. Merrell E. Clark. Yes, sir; I am very glad you raised that point. That is another reason why we feel that the matter should originate with an order from the court. Because it has become rather an established practice, in all of the districts -- and I think a very good one -- that where one party asks the other for his dates of invention or of prior use, as the case may be, it is customary that the order require that they be exchanged simultaneously. And that seems to be a very salutary thing. I think it is a good procedure, that they should be exchanged. That could be effected if you made this rule to read that the order for those things should be issued initially. And that would provide for such an exchange. As it is now, in this rule there might be a good deal of jockeying about it. And that applies to both the taking of testimony and the list of documents, as provided in Rule 37. And I feel that that is another reason why we feel that the court order should precede the going ahead with this interrogatory.

Mr. Sunderland. Mr. Clark, may I ask if this objection of yours applies equally and without restriction to oral examination and written interrogatories of all kinds?

Mr. Merrell E. Clark. With regard to Rule 31, it is more important with regard to oral examinations. With regard to written interrogatories, of course the present practice is to object to them if they are out of line. But we have classed them all together, in our view, just as the committee has, in their view: Let them be ordered by the court initially.

Mr. Sunderland. So that you would make a general rule apply to all types of discovery?

Mr. Merrell E. Clark. Yes; I would do that.

Mr. Sunderland. And initially ordered by court?

Mr. Merrell E. Clark. Yes; I would do that.

Mr. Tolman. Mr. Chairman, may I ask a question?

Mr. Clark, to what extent do the patent lawyers use depositions on written interrogatories?

Mr. Merrell E. Clark. I should think that in the great majority of cases, written interrogatories are filed under the bill.

Mr. Tolman. I do not mean under the bill; I mean the taking of the evidence.

Mr. Lane. In patent jury cases, it may be done. But usually it is done by taking the depositions direct, and not by interrogatories. Of course, going abroad you have to take them as interrogatories. I think it may be done in that way.

Mr. Merrell E. Clark. I think there was some confusion there. At present there is no provision in the rule for a discovery by oral interrogatories. The only way in which information can be adduced by oral deposition is in case the witness resides 100 miles away from the place of trial. That just happens to be a provision for the deposition, and that is

sometimes used for the purpose of getting information from the adverse party. But where you are within 100 miles from the court where the defendant is -- for example, in a patent case -- then there is no provision now for taking oral depositions in advance of trial.

Mr. Lane. I thought you were asking about the question of taking depositions by interrogatories solely. There are a considerable number of cases, in which I have been, where a set of questions is prepared for the taking of depositions, as you are allowed to, under the statutes; and you send out interrogatories and cross-interrogatories, and they are handed to a notary, for both the plaintiff and for the defendant. That is sometimes used, in some cases, but very rarely.

Mr. Tolman. At least I have had the explanation I wanted. But I was prompted to ask my question because in ordinary cases the taking of written interrogatories is so futile that that is seldom used. But I was wondering when the patent bar used it.

Mr. Lane. Very little.

Mr. Merrell E. Clark. I think it is frequently used, however.

Mr. Lane. No; he is talking about depositions by interrogatories.

Mr. Tolman. Oh, yes. If you have a case in California and a witness living in Seattle, who knows about the use, you do not take his testimony by deposition, do you?

Mr. Merrell E. Clark. Oh, no.

Mr. Tolman. I see. I really regard that as a part of the pleading.

Mr. Lane. I wonder if there would be any objection to my adding a word? This material did not get to us, so that we have not had a chance to discuss it. In Rule 40, where you give 10 days after service, I think there should be some provision providing that they should be filed 10 days in advance of the trial. The rule is that:

> "Any party to a civil action may at any time, by written notice, request any other party to serve upon him, within a designated period not less than 10 days after the service of such request * * * ."

I think there should be added, "and at least 10 days before the trial."

Because otherwise you may have this request coming along as the trial develops, and when you are not able to take care of it. That is Rule No. 40.

Mr. Donworth. Mr. Chairman, I should like to ask a question supplementary to that which Major Tolman has asked.

To what extent, if at all, are depositions taken in patent cases, of witnesses who are supposed to be about to testify or who may testify for the adverse party -- that is, in the nature of discovery, you might call it, and not of the adverse party himself, but of people who are supposed to be material witnesses for him?

Now, under this, it would be easy for each party. There is Smith, for example, out in Seattle, and I believe he is going to testify for the other side. I should like to know what he is going to say, of course. At present is anything of that kind done? Do you take a deposition of a man who is supposed to be a witness for the adverse party?

Mr. Merrell E. Clark. Not very frequently. I have never known of its being done, except one might take a deposition of someone who was going to be a witness for an adverse party, for the purpose of obtaining information on an infringement, if that party lived more than 100 miles away from the court. But I do not know of any case where such a witness has been examined merely for the purpose of learning what he is going to testify to, in court.

The Chairman. Mr. Clark, Equity Rule 58 provides generally in equity cases for the submission of written interrogatories to the other side. They are not directed to any witness; and it is quite a different procedure from examining a witness under written interrogatories. I have seen a number of criticisms from lawyers -- patent and otherwise -- saying that in our rules we have abolished the practice prescribed in Equity Rule 58 for the submission, after filing the bill, of written interrogatories directed to the other side generally, without reference to any particular person.

Do you understand that, under this preliminary draft as we have it, we have made no provision similar to that in Equity Rule 58?

Mr. Merrell E. Clark. I understood, Mr. Mitchell, that in Rule 31, in providing for depositions by written interrogatories, that was the kind of thing that you had in mind.

The Chairman. That is a deposition of a particular witness; and this Equity Rule No. 58 is dealing with interrogatories directed toward the defendant or the plaintiff generally, requiring the party to answer the interrogatories, not as a witness but as an admission or a denial.

Mr. Merrell E. Clark. That is true.

The Chairman. It seems to me that there is a sharp difference there.

Mr. Merrell E. Clark. Yes, I think there is.

The Chairman. And Rule 58 apparently is a rule that is applied and used.

Mr. Merrell E. Clark. That is used.

The Chairman. And there is no reason to strike it out. I was just asking the question of your committee, whether you understand that our draft here abolishes that practice or makes any provision for it.

Mr. Merrell E. Clark. It does not make any specific provision for that practice, which I think is a very helpful practice.

The Chairman. You think Equity Rule 58 ought to be preserved?

Mr. Merrell E. Clark. I think so.

Mr. Lane. I think if it is preserved, it does practically everything we need. I do not like to burden the committee; but I was not able to be here last night, and we have had to handle these things very informally. I want to say just a word, if I may; and after a word on this subject, I shall say nothing further, if that is agreeable.

I think that the purpose of the present equity rules was to do away with this work we have in patent cases, of taking the depositions and of trying the case entirely by depositions. The Supreme Court, when it adopted its present rules, was to do away with the practice theretofore obtaining, of trying equity patent suits by depositions solely. They

thought that the records were padded, and the criticisms of the courts were such that it was very difficult for the bar to explain why these tremendous records went in.

6 And in my judgment they have accomplished a great deal by practically compelling the patent cases to be tried in open court. The depositions shall be taken only when you cannot get the witness there. That was the practice adopted, and that was one commendable thing when they adopted the rules in 1913.

Now, Rules 31 to 38 inclusive seem to cast the inference that you can do about as you please with regard to depositions. As I interpret Rule 33, anyone by agreement can take the deposition of any person at any time. And then you get the kind of abuse that existed in the Standard Oil Company case in Louisiana, where the parties took over a million dollars worth of depositions that were never used, but which were held up to the industry as a threat of what would take place if the proceedings were proceeded with. And the master received $100 a day. He asked for $150 a day, and that was denied. And then afterward he filed suit for $40,000; and the Court of Appeals ordered him to pay back $45,000 that was already paid him.

I think the main hearing should take place in open court, or otherwise you do away with the main object of the equity rules. I think I speak for the committee in saying that we did not find anything in the section that is peculiar to the practice of patent law. The trial of patent cases is very much the same as the trial of any other case. And I think you will notice that instead of taking exceptions, as put in

by various patent associations, we have made no special mention of patent cases; and I think they should not be specially mentioned. Because after all, men who are engaged in the practice of patent law are engaged in the practice of law, first. And I think that we should all recognize that all of the patent law of this country has been made by federal judges who were not patent lawyers; first you start with Marshall, and then on down; and every judge who has been on the federal Court of Appeals, to my knowledge, has not been a specialist in patent cases. And our patent law has been made by general practitioners.

I think there are no exceptions, except to bring out the fact of the disclosure, that has been asked about, and this change of dates. Now, in a contract matter, the matter of dates may be very important. And it might be just as important to have the parties disclose what their actual date of entry was, as in a patent case, and not to let one man go in and get an adverse witness and fix up a title in advance. So I think there ought to be some provision at the beginning of the rule, that the depositions could be taken only in exceptional cases where the witness is not available.

The Chairman. Mr. Lane, if you will turn to Rule 31, at the bottom of page 55, on the subject of "Use", there are certain provisions on page 55 that can be used to impeach. And then it goes on to say that generally speaking these depositions taken before trial shall not be used, unless with the consent of the parties and approved by the court, or:

"if the court finds: (1), that the witness is dead; or

(2), that without the procurement of the party offering

the deposition the witness has gone out of the United States, or out of the district and to a greater distance than 100 miles from the place of trial or hearing; or (3), that the witness is unable to attend because of age, bodily infirmity or imprisonment; or (4), that the party offering the deposition has been unable to procure the attendance of the witness by subpoena."

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Now, that paragraph I have just read is incorporated in all existing law limiting the use of depositions. So we are not opening the door, as I read it, to the trial of patent or equity cases upon depositions, except -- and that is what I wish to talk to you about -- we provided there that you can use a deposition instead of a witness in court, by consent of the parties and if the court approves it. It just occurred to me there, and I am wondering, whether consent of the parties with the approval of the court may not be used by willing judges to upset the present equity rules which require the taking of testimony in court. Do you not think that we have covered all your points except that?

Mr. Lane. Exactly. And in Cleveland, for example, the judge will refer almost anybody's case to a master. In a good many jurisdictions, if you give them the slightest excuse, the courts will simply refer to a master, and you cannot control it.

The Chairman. If we simply struck out that restriction about 100 miles and left the others in, then we would have pretty well covered it?

Mr. Lane. I think so, if you say that except in exceptional cases, depositions may be used.

The Chairman. We have provided all special cases.

Mr. Lemann. Is Rule 50 a special provision?

Mr. Lane. Yes, I just wanted to be sure it was consistent with that.

The Chairman. I think your point is probably answered in large part by the rule at the top of page 56. But we still have left that matter of the court's agreeing to the use of depositions, which I think is a dangerous thing. And I think we ought to consider whether we allow the court to permit it, unless we hedge it about with some directions to him that it should not be done.

Mr. Lane. Yes; you are putting your finger exactly on the point I am making.

Mr. Sunderland. We had an objection from Judge McDermott that he thought we were too restrictive.

Mr. Charles E. Clark. Mr. Lane, I suppose you have considered the rules in England and elsewhere, that the ends of justice are better served by both parties' knowing what the proceeding is to be about? Have you done that with regard to patent cases?

Mr. Lane. No, I do not think so. Everything we have done is to try to reconcile our views to what the Committee has done.

Mr. Charles E. Clark. I think you have done very well; I appreciate that.

Mr. Lane. My notion is that the present equity rules and statutes enable us to take care of everything we ought to take care of without restating the rule. I think what we have is everything we need. I can go out and ask the adverse

witness any questions I want to, and I have done it repeatedly. To prove infringement, I go out and ask this particular man whether he made this particular device, and when. And if I cannot get the witness to answer my questions, I go to the court and get the testimony, just as you are now proposing.

The Chairman. Are you bound by it if you take it?

Mr. Lane. Not unless you choose to use it.

The Chairman. But there is a considerable difference.

Mr. Lane. I am talking about the effect of the material.

Mr. Merrell E. Clark. I think what Mr. Lane says is true. But it merely happens that they are more than 100 miles from the place of trial.

Mr. Lane. If you got the rule that provided you could take depositions without the court's ordering it, within 100 miles of the place of trial, you would get everything that is provided by these rules.

Mr. Donworth. Mr. Chairman, I am not sure that I have a clear understanding of this subdivision of Rule 31. You just referred to subdivision (b), which relates to the use of depositions. Now, I have the impression that up to the present time you cannot take a deposition unless there is some reasonable ground for believing that you can use it. Now, as I understand it, this changes that. This creates an absolute right to take the deposition of anyone, whether or not there is the remotest chance of your ever being able to use it. I may be in error, but that is the impression I have.

The Chairman. You are right.

Mr. Morgan. Of course you are right.

Mr. Donworth. It enlarges the taking of depositions for

discovery, to cover the whole field, not only to the adverse party but for everybody. Of course the court could prevent the taking of the deposition on an adverse ground, if there seemed to be any possibility that it is out. But this seems to change the old rule.

Mr. Howe. Suppose, under the old case, I wanted to take the deposition of John Jones regarding the practice, and he knows nothing about the practice: There is nothing to prevent me from taking it. I do not have to use it; but if I do take it, the other side may use it.

The Chairman. Mr. Clark, what does the committee think of the breadth of depositions before a trial matter? In some States the question of examination before trial is limited to the parties. And this preliminary draft allows either party not only to examine the adverse party and his officers and agents, if he is a corporation, but allows any witness to be examined. I have received a great many criticisms of that, by members of the bar generally. They say you can go through what amounts to a complete trial beforehand, which is futile, because you cannot use the depositions. If you could use them, you would be abolishing the present rules requiring trial in open court. So they complain about that and say, for instance, that under the English system if you go outside the examination of the parties and commence to examine witnesses generally, one of the standing masters steps in and says, "All right; you can do that" -- but he makes findings on you, upon that preliminary examination, and which are just as effective as those on the final trial.

And so they complain a great deal about broadening this

thing to take the examination of all witnesses, because it loads the party down with what amounts to a preliminary trial and which does not amount to anything. I am wondering if your committee has any views about that.

Mr. Merrell E. Clark. I do not think that the committee has specifically considered that. It was our feeling that if we proceeded by requiring the order of the court for the taking of such depositions, that would take care of it.

The Chairman. Take care of all that?

Mr. Merrell E. Clark. I mean, a witness might have been a former employee of a company, and who had information that was valuable, and you might want to get that information; and that could be presented to the court.

In answer to the question Mr. Clark asked a while ago, we are entirely in agreement with the philosophy of the thing: that that information should be secured. But we feel that it should be secured through the order of the court, rather than by just going ahead without any order of the court and then trying to jack them up if they appear to go beyond the proper bounds.

The Chairman. You think that would also operate to limit the useless preliminary trials, through examining witnesses generally, whose depositions cannot be really used at the trial?

Mr. Merrell E. Clark. Yes. I am not very familiar with the state court practice in New York; but as I understand it, that has pretty well resolved itself into going to the court before you get an examination before trial, anyway -- by motion to quash notice, or something of that sort.

Mr. Lane. You see, in the courts now, the parties file a motion for written interrogatories, and then the other side has a chance to object to it; and then the court rules upon that. That is very much as Mr. Clark suggests now. It makes no difference whether you call it interrogatories, or what you call it.

The Chairman. Mr. Clark, if you have said all you wished regarding this particular branch, will you proceed with your statement?

Mr. Merrell E. Clark. I think that is all I have to say on this particular branch. I agree with what has been said about Rule No. 33: If that is intended or could be construed in any way to change the present insistence of the present equity rules that the case should be tried in open court, it should be modified to make sure that it is not so changed. In patent cases there is a public interest in the decision of the case. They are not just private fights; because when one's patent has been sustained, the whole public suffers from that in the event the decision was in error. So I think that should be kept in mind regarding any such rule as No. 33, which would permit such things as Mr. Lane speaks of -- the going all over the country and taking depositions, and so forth, and not trying the matter in open court.

With respect to the other particular rules, I do not know that I have anything to add to the recommendations of the committee, which have been submitted in writing. And I do not want to take the time of the Committee to deal with those matters.

Mr. Charles E. Clark. I should like to ask several

questions, if I may. I want to say that I very much appreciate the way you have phrased your recommendations; I think they are very moderate and very much to the point. There may be minor differences of wording, of course.

The first question I have deals with the matter as to interventions; that is Rule 29. And your comment asking the insertion of the provision from the old Equity Rule No. 37, "but such intervention shall be only in subordination to and in recognition of the main proceedings", we have discussed quite a little in our meetings.

In view of the general breadth of action that we are providing for -- free joindure of claims, and so on -- is that really necessary, and is it clear, anyway?

9 The Chairman. We do not know what it means.

Mr. Lane. The reason for that is this: We have had discussion of the situation when a person comes in and intervenes, and of then whether he can set up a counterclaim. That was argued here this spring. But there the Court has held that the intervenor may not set up any defense of affirmative relief not available. I do not care a hoot whether you make it prior or not; but it may be perfectly plain that the intervenor may set up his right. Under the rule now, it looks as if the intervenor may assert his right. And the Supreme Court says he cannot, at the present time. It ought to be affirmatively made to appear that he can set up a counterclaim under your broad proposition.

Mr. Charles E. Clark. You have chiefly in mind to make it quite clear?

Mr. Lane. Yes.

Mr. Charles E. Clark. Of course I prefer the broader one.

Mr. Lane. I have no objection to that, provided it is made clear that the intervenor may assert his counterclaim. But I do not think that is what the Supreme Court has decided.

And then the last part has made it perfectly plain, to conform to the Supreme Court's decision.

The Chairman. What does this mean, in Equity Rule 37: "but the intervention shall be in subordination to, and in recognition of, the propriety of the main proceeding."

What does that mean?

Mr. Merrell E. Clark. I do not think it is clear.

Mr. Lane. I do not think it is clear, either.

The Chairman. But what does it mean? We discussed it and dropped it, not because we had any serious objection, but we thought it was an idle phrase. We had a vague idea that the intervenors could not guide and run the lawsuit; but they could not, anyway.

Mr. Lane. My suggestion is to leave your rules as you are proposing them, but add a suggestion that if the intervenor is made a defendant, he cannot assert a counterclaim that he has against the plaintiff -- if you want to go so far as that. And just to make it perfectly certain whether the intervenor can assert a claim of his, or cannot.

The Chairman. It is the defense of affirmative relief that you want to make clear?

Mr. Lane. Yes.

The Chairman. And you are not so strong on this subordination?

Mr. Lane. No. And it makes no difference to me which way it goes.

Now we have this suggestion: We come in as an intervenor and the court says they must assert a claim that arose out of the original transaction. Now, coming in as an intervenor, I do not know whether I would have to assert a counterclaim or would not. But the court said I could go elsewhere and assert it. But it ought to be perfectly plain whether you have to assert it or cannot.

Mr. Lemann. Is there any objection to permitting the intervenor to come in and assert a counterclaim if that is the only reason for his coming in?

Mr. Lane. I think so.

Mr. Charles E. Clark. Yes; that would be the philosophy that we had.

Mr. Merrell E. Clark. We frequently have this situation in equity cases: Instead of suing the manufacturer of an article, the suit is brought against a customer of the manufacturer, who resells it. And very frequently the manufacturer intervenes, to defend his customer. Under the present rule he cannot intervene and then assert a counterclaim, under a patent, which he has against the plaintiff.

Mr. Lemann. I was thinking of the broader aspects rather than restricted to patent cases. A defendant might say that the suit was being converted into a counterclaim by the intervenor against the plaintiff. Perhaps the answer is that the court can say you cannot do it.

Mr. Charles E. Clark. And also a separate trial provision, you know.

Mr. Lemann. Yes.

Mr. Merrell E. Clark. There is just one more thing from the notes we had from the committee: On page 90, with respect to the paragraph beginning on the top of that page --

The Chairman (interposing). You mean in our last revision?

Mr. Merrell E. Clark. Yes.

The Chairman. Page 90?

Mr. Merrell E. Clark. It says:

"Consideration of lines 48-57 was deferred for the suggestions of the patent bar. Notes, however, that Mr. Wiles, of the Chicago Patent Bar Association, recommends the omission of lines 48-57."

I think that is unanimous with the patent bar. That is a special exception with respect to the taking of testimony by affidavit, and it is not used and is entirely unnecessary.

The Chairman. We are glad to leave it out.

Mr. Merrell E. Clark. It is not of any real use.

Mr. Lane. No value whatever -- harm rather than good.

Mr. Charles E. Clark. As to your suggestion as to Equity Rule No. 64, we intended to cover Equity Rule No. 64, and I shall have to examine that very carefully. If we have not, we ought to. But the question is as to what Equity Rule No. 64 really granted. The statement is very broad, and does not seem to mean quite what it says. Should it not be limited to "or any proceeding in the action"?

Mr. Lane. Is the old rule there?

Mr. Charles E. Clark. This is the old rule. We puzzled a good deal as to what the old rule meant, and we did

not find a construction of it.

Mr. Lane. What I meant --

Mr. Charles E. Clark (interposing). Did you write the equity rule originally?

Mr. Lane. No, I did not.

Mr. Charles E. Clark. I wondered who did it.

Mr. Lane. Many times you get before a master inexperienced in federal cases; and such masters do not know whether they have any right to consider what has gone on in the case before. That is intended to take care of that.

The Chairman. Two questions arose under that. In the first place, as it is worded in Equity Rule 64, it allows any affidavit, deposition or document in any other proceeding or cause before the master.

Mr. Lane. I think it ought to be taken to read in the --

The Chairman (interposing). That is fairly obvious. It also says that any evidence, and so on, "previously made, read, or used in the court upon any proceeding in any cause or matter may be used before the master."

Suppose we make a preliminary application for an injunction, on affidavits, and then you come to the trial on the merits: Is it possible we ought to have a rule that you could use the affidavits that you used in your application for preliminary injunction, in lieu of oral testimony in court, on the merits? That does not seem right to me. Your affidavits on preliminary motion might cover the whole field of the merits; and yet under this rule you can offer affidavits at the trial without calling the witnesses.

Mr. Donworth. Mr. Chairman, do you not think that that

means that wherever an affidavit is offered, you may offer the old affidavit?

Mr. Lane. Of course sometimes you find affidavits for continuances made to the court, and that do not appear to the master. He can cover such things as that, that do not appear, where the court has taken consideration of the time element. I have seen that happen. It may be too broad.

The Chairman. As you construe it, you feel that the law ought to be applied to "affidavits, depositions, and documents in the same cause"?

Mr. Lane. Yes.

The Chairman. And secondly, if there are affidavits, they may be used later only if affidavits are permissible under the other rules at that state of the proceedings.

Mr. Lane. Yes.

The Chairman. That is Mr. Donworth's point.

Mr. Lane. Yes.

The Chairman. If we fixed it up in that way, it would be all right, would it?

Mr. Lane. I think so. We had to work rather rapidly here, and sometimes did not catch the significance, as in this instance. I think that is all wrong; I think it ought to be "in the cause of the proceedings".

Mr. Charles E. Clark. That has troubled us right along, and ought to be construed, it seems to me. Do you have Rule 74, "Record on Appeal"?

Mr. Merrell E. Clark. We did not have an opportunity to consider that.

Mr. Charles E. Clark. Then suppose your committee

11 consider Rule 74 as now suggested, and send us a memorandum on that. Will you do that?

Mr. Merrell E. Clark. Yes, we shall be very glad to do that.

Mr. Dodge. With regard to Rule 16 (b), some patent lawyers have raised the question. Section 16 (b) provides that "all objections concerning the sufficiency of process or its service, jurisdiction over the person, or venue, shall be raised by the defendant at one time by motion. This motion shall be made before the defendant takes any other steps to defend or contest the action; shall constitute only a special appearance without being denominated as such; and shall be decided as a preliminary matter. No such objection may be raised by a defendant at any other time or in any other manner."

The suggestion is: "Provided that in suits for patent infringement where venue depends upon the commission of acts of infringement in the district of suit, the defendant may raise the defense of non-infringement within the district in the answer, and if the defense is so raised it shall not be a waiver of the right to object to the venue."

Mr. Merrell E. Clark. This particular committee has considered that. And we feel, as a practical matter, that it is unnecessary to make that exception. Because it is very difficult to try the question of infringement without trying the whole patent case.

Mr. Dodge. If the defendant is sued in a particular venue, on the ground of an infringement practice, would he raise the point of non-infringement, there, by a motion?

Mr. Merrell E. Clark. He can appear specially, and

raise that point.

Mr. Dodge. But it has to be tried out as a question of fact, and really goes to the merits of the case, does it not?

Mr. Morrell E. Clark. It goes to the merits of the whole case, really. Of course, if he can show he has never done anything in that district at all, if he has never made or sold anything in that district, then the case should be dismissed on the motion -- appearing specially.

Mr. Lane. The rules take care of that.

Mr. Morrell E. Clark. Yes. But if the question arises as to whether what he has done in that district is an infringement, that really involves a trial of the whole case.

Mr. Dodge. Although it comes down to a question of the venue?

Mr. Morrell E. Clark. Yes.

Mr. Dodge. And cannot be tried on a motion?

Mr. Morrell E. Clark. Yes.

Mr. Lemann. In most cases he denies that he infringed.

Mr. Morrell E. Clark. Yes. And there might be a particular case where he had done one thing in one district and another thing in another district; that is the only case to which this applies at all. And we do not think that is sufficiently important to warrant any recognition being taken of it.

Mr. Lane. Also, most of the objections made had to do with the question of jurisdiction and venue. But Rule 91 as amended takes care of every objection made. And I think there is no use in repeating that four or five times.

The Chairman. Mr. Clark, in our revisions to the

pleading, in putting in an answer in a patent case, you have to plead a great many things that are covered now by a section of the federal statutes which says that in patent cases the general denial shall raise this, that, and the other issue. Is there any serious objection to our rule in that respect, from the patent lawyers' standpoint?

Mr. Morrell E. Clark. The New York Patent Law Association made a suggestion which I am not sure we have adopted, providing that the mere recitation of a government grant would be sufficient to establish that the conditions precedent had been complied with. And we adopted that.

Mr. Lane. It is all of this (indicating a passage).

Mr. Morrell E. Clark. That is, there is a difficulty now in patent pleading, that some of the courts have held that you must allege in your bill of complaint all the things that the statute provides as precedent to the issuance of the patent -- that it has not been used for more than two years, has not been published, and all that. So in all bills of complaint now we have to allege all that. When the new equity rules came out before, we tried a short bill of complaint, merely alleging that the patent had not been issued. And the courts held that that is not sufficient. But the proposed rules attempt to provide that that shall be sufficient, attempt to do it if there has been a government grant.

The Chairman. My recollection of that is that it deals with the answer and states that, without special pleading, certain things shall be put in issue by a general denial.

12 Mr. Donworth. I have that statute before me.

The Chairman. Read it, if you please.

Mr. Donworth. I should like to say, preliminarily, that my understanding is that this for many years related only to an action at law, and not in equity. But by an amendment some years ago, it was extended to equity. It is now section 69, headed "Pleading and Proof in Action for Infringement."

"In any action for infringement the defendant may plead the general issue, and, having given notice in writing to the plaintiff or his attorney 30 days before, may prove on trial any one or more of the following special matters:

"First, that for the purpose of deceiving the public, the description and specification filed by the patentee in the Patent Office was made to contain less than the whole truth relative to his invention or discovery, or more than is necessary to produce the desired effect; or,

"Second, that he has surreptitiously or unjustly obtained the patent for that which was in fact invented by another, who was using reasonable diligence in adapting and perfecting the same; or,

"Third, that it has been patented or discovered in some printed publication prior to his supposed invention or discovery thereof, or more than two years prior to his application for a patent therefor; or,

"Fourth, that he was not the original and first inventor or discoverer of any material and substantial part of the thing patented; or,

"Fifth, that it had been in public use or on sale

in this country for more than two years before his application for a patent, or had been abandoned to the public.

"And in notices as to proof of previous invention, knowledge, or use of the thing patented, the defendant shall state the names of the patentees and the dates of their patents, and when granted, and the names and residences of the persons alleged to have invented or to have had the prior knowledge of the thing patented, and where and by whom it had been used; and if any one or more of the special matters alleged shall be found for the defendant, judgment shall be rendered for him with costs. And the like defenses may be pleaded in any suit in equity for relief against an alleged infringement; and proofs of the same may be given upon like notice in the answer of the defendant, and with the like effect."

Now, I am not sure of the action the committee took with respect to adding a note that this statute was continuous. But unless these gentlemen have some suggestion to make, it seems to me we should note in our schedule that that is not superseded but is to continue.

Mr. Merrell E. Clark. Yes, we agree to that, and understood it was to continue.

The Chairman. As it stands there, that statute is inconsistent with our pleading rules, as I understand it. Under that statute you plead a general denial, and then 30 days before trial you give notice of the defenses you want to prove. Under our rules you have to set up those defenses in an answer. But I am not at all sure that we do not abolish

the system of giving 30 days' notice instead of pleading in the answer in the first place. Of course, there are some advantages in that, from a patent lawyer's standpoint, because sometimes he does not have all the facts at the time he puts in his answer; and he digs away and gets up these facts, and he learns them 30 days before the trial, and then he can serve his notice. I can see some advantage in that.

But my impression has been that we substituted for that statute -- general denial plus 30 days before trial -- a requirement that the defenses must be set up in the answer.

Mr. Merrell E. Clark. Yes. But that never is pleaded in practice. The practice of the patent profession is to include everything in your answer that you know about then. But we always feel that if something new is discovered and you notify the other party 30 days before trial, you can use it.

The Chairman. But under the new proposal, if you discover something 30 days before trial, you can ask leave to amend.

Mr. Merrell E. Clark. Yes.

Mr. Charles E. Clark. Is this really a useful provision?

Mr. Lane. I think it is. You may find out something, 30 days before, that may affect the whole public. And if you give the opponent notice right away -- you can do it by giving notice to amend your answer; but suppose you just have 30 days: That is something that affects the whole public -- phonographs or mowing machines, for instance. I should like to see the statute stay the way it is.

The Chairman. But we are trying to establish uniform

rules in equity cases as well as in law cases. And then we would have a system in which one kind of case would require your defense to be pleaded either originally or by amendment, and in a patent case you would have to set up a general denial and then have a general notice.

Mr. Merrell E. Clark. We never use that -- general denial, and then give notice. All we want is an opportunity to add at a later date.

The Chairman. Judge Donworth thinks it is the other way. But, however that may be, there is no objection to your mind to make the procedure in patent cases uniform with that in others.

Mr. Lane. Does the Supreme Court provide that these shall supersede all others?

The Chairman. Oh, yes. They would not be worth much, otherwise.

Mr. Donworth. I think I shall withdraw my suggestion.

The Chairman. Yes. And I am clear in my own mind.

Mr. Merrell E. Clark. I am not clear that that practice is superseded in regard to all cases.

The Chairman. Yes.

Mr. Merrell E. Clark. So I do not suppose you would say that that statute was superseded so far as the substance is concerned?

The Chairman. No. Our rule says you must simply state what your defenses are, in your answer.

Mr. Merrell E. Clark. Well, so far as we have adequate privilege of amendment, we are satisfied.

The Chairman. Is there anything further, Mr. Clark?

Mr. Merrell E. Clark. No, I think not; except that I should like to emphasize, with respect to the discovery rules, our very definite feeling that the whole matter should be under the control of the court, from the beginning, rather than let them proceed until they go too far, and then asking the court to intervene.

The Chairman. Is there any member of the Committee who has questions?

Mr. Tolman. Mr. Chairman, I should like to ask the Committee regarding two rules. In Rule 45 you say: "We think the first suggestion made by Mr. Clark should have special consideration." And of course it will have special consideration and must have, because it raises a very important question. And this is the question: There is an absolute right of trial by jury in actions at law, preserved under the Constitution. In equity, however, the rule was that a jury was summoned by the chancellor to aid the conscience of the court; it was not a matter of right.

Does this committee favor abolishing the present distinctions, and does this committee favor an attempt to make trial by jury a matter of right in every equitable case?

Mr. Merrell E. Clark. Speaking for the patent profession, as a patent lawyer, we would rather not have a trial by jury in any case.

Mr. Lane. I do not think that.

Mr. Merrell E. Clark. I will say that for myself. I have been in a good deal of litigation and have never had a trial by jury, and I am not qualified to speak. Mr. Lane has had trials by jury, and can speak regarding those.

Mr. Tolman. I am not looking at it from the point of view of a patent lawyer at all. But in complicated cases, with things such as a resulting trust, which must be handled by a chancellor, it seems to me that the calling in of a jury, regarding equitable remedies, would be a mistake. It seems to me that it would be a mistake to permit such a thing. And I should like to know whether your views are contrary to what I suggest.

Mr. Charles E. Clark. I think Mr. Tolman has misunderstood my suggestion. The first suggestion simply deals with the machinery of making the request, and has nothing at all to do with the right for jury trial. This simply deals with the formal procedure of how you may proceed to ask the court to get either the discretionary trial or the trial as a matter of right.

Mr. Tolman. Of course, Dean Clark and I will have plenty of time to get together on that. I fear the rule as suggested.

Now, one more question: With regard to Rule 50, I refer to that practice which is so much used by patent lawyers, whereby you actually take evidence that the court thinks is incompetent in an equity case, in order that the Circuit Court of Appeals may have the evidence in the record and may therefore order such decree as the evidence would support. Now, unless that evidence is in the record in an equity case, the court must merely reverse and remand. It is only because it is actually in the record that the appellate tribunal may direct the entry of a proper judgment.

Do you think that system is tolerable at all, in a jury trial?

Mr. Morrell E. Clark. I think the jury could be dismissed and excused while that testimony is being taken.

Mr. Tolman. No, no; let me ask another question: Suppose they are dismissed and this evidence is taken, out of their hearing and out of their knowledge, and they retire and render a verdict, and the upper court says, "That evidence should have been introduced; that is error." Then can the court change that verdict and order the entry of a proper order, judgment, or decree?

Mr. Morrell E. Clark. No.

Mr. Tolman. Then it might work, in a jury case, to prevent a reversal.

The Chairman. But they do not use juries in patent cases.

Mr. Lane. Oh, yes; we have before. And if the patent has expired, the only way you can try such cases is at law; of course, you can waive a jury. But most of the old patent cases were tried at law. If there are damages, the profits are all recoverable at law.

Mr. Morrell E. Clark. It is definitely the exception.

Mr. Lane. Yes, it is the exception, since about 1870.

But answering your question, I was wondering if that situation arises in most patent cases. It is true, as you stated, Major; but assume that the Court of Appeals looked at that testimony and found that it did not affect the issue at all, and found it would be properly excluded. Then that would be the end of the matter. If they found it was not properly excluded, then there would have to be a new trial anyway.

Mr. Tolman. Before a jury?

Mr. Lane. Yes.

Mr. Tolman. My question is: Can you make that system effective without providing specifically in the rule that the excluded testimony shall actually be taken only in cases where there is no jury?

Mr. Lane. Then that certainly would apply to the patentee.

Mr. Tolman. Yes.

Mr. Lane. That would be all right there. Now you are asking whether it could be used in a law action.

Mr. Tolman. Could it be used to prevent a reversal, if there were a jury?

Mr. Lane. I do not see any way you can prevent a reversal if it is shown to be material testimony.

Mr. Tolman. Of course I concede at once that it can be taken out of the presence of the jury, and will serve to raise the point. But you do not save the new trial.

Mr. Lane. I do not see how you can.

The Chairman. Are you talking about juries called in by a special master in a patent case?

Mr. Lane. No.

The Chairman. Well, if it is a question of law, I do not see how that can be.

Mr. Charles E. Clark. The Major has a private battle with me and Mr. Morgan.

Mr. Morgan. He has been trying to get additional ammunition.

Mr. Tolman. I agree with them both in the major part;

and where they differ, I differ with both of them.

The Chairman. Are there any further matters?

Mr. Charles E. Clark. We had a question about forms. Major, don't you think it would be a good idea to give the committee the forms which our Committee has not yet considered? And then, Mr. Austin, of Philadelphia, sent in a simple form.

Mr. Tolman. Yes, I intended to speak of that. I think we have a very simple form for a bill of infringement.

Mr. Charles E. Clark. I think it would be very helpful to consider those. Mr. Leland Tolman, could you give the members of the committee the Committee's suggested forms, and also Mr. Austin's suggestion?

Mr. Donworth. In view of the peculiar wording of section 59, Mr. Chairman, I should suggest, without making any motion for the consideration of the Reporter, that perhaps a note would be well added, to the effect that it is the intention to supersede, only so far as pleading is concerned, this section.

The Chairman. Before the members go, I want to be sure that there are no other members of the Advisory Committee who wish to ask them questions.

Mr. Sunderland. I should like to ask this question, Mr. Chairman: In case the Committee should be of the opinion that in general an order of the court would not be advisable to initiate discovery, would you think that the patent law profession would prefer to have a special section put in, applying to all patent cases; or would they prefer to go in with the general rule?

Mr. Merrell E. Clark. I do not think I can speak for

the entire patent bar; but I think this committee would prefer, in patent cases, that there be no exception; we do not want the Advisory Committee to make any exception in patent cases, if that can be avoided. But we do feel quite strongly about this particular phase, so far as patent cases are concerned. And we should like to leave it with the Committee, with that statement.

Mr. Lane. I think there is no exception, speaking for myself.

The Chairman. Your objections are, really, that if they are sound, they go to all?

Mr. Lane. Yes.

The Chairman. Here are the exceptions from the Boston Patent Bar Association, that have just come in. And I am going to hand you three copies. And if you have any comments, we should like them.

Mr. Howe. We had the benefit of them at our meeting last night.

The Chairman. And you have no special comment?

Mr. Howe. No; only so far as chapter 5 is concerned.

The Chairman. All right.

Mr. Pepper. Mr. Chairman, I gather, however, from what the gentlemen have said, that their desire to safeguard the discovery procedure is really stronger than their desire that there should be uniformity; in other words, if the Committee, as has just been suggested, were to adhere to the present form of the drafted rule with regard to discovery, then the patent bar would adhere to that exception, as much as they dislike exceptions generally.

Mr. Howe. If I may speak, I would say that is the case -- as we have received it from the reports of the various individuals and patent associations. Just what our committee would do, I am not prepared to say. But we have had some talk about it.

The Chairman. There is one interesting thing about the attitude of the patent lawyers, practically unanimously: The patent lawyers are not divided, professionally, into plaintiffs' lawyers and defendants' lawyers; they appear on both sides. So they are looking at the thing from the standpoint of the administration of justice, no matter whichever side you are on. And that is rather significant. The objections you get generally from lawyers, about these discovery provisions, mainly come from those lawyers who are defending strike suits, and that sort of thing.

So that your position on it is rather illuminating, I think; I think it is disinterested, in a way.

Mr. Lane. The main thing is that we want a rule that will tell us what we are doing.

Mr. Merrell E. Clark. In retiring, I should like to say that this committee does not consider itself anything but a committee appointed by the American Bar Association, and there is no reason for considering our position differently from that presented by the other patent associations. And we hope they will all be considered.

The Chairman. We are very much obliged to you, for your help.

Mr. Lane. I am sorry to have had to interrupt so much, but we had to work separately to a certain extent.

The Chairman. That is quite all right, of course.

(Whereupon, at 11:25 o'clock a.m., the representatives of the Patent Section of the American Bar Association, withdrew from the hearing room.)

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RULE 1. SCOPE OF RULES.

Major Tolman and Dean Clark agree on change of notes in this rule.

RULE 2. ONE FORM OF ACTION AND ONE MODE OF PROCEDURE.

Reporter to change order of notes to all rules so the interpretive notes precede historical ones.

RULE 3. COMMENCEMENT OF ACTION.

Moved and seconded that this rule be left as decided at New Haven. Voted upon with Messrs. Morgan, Clark, Mitchell and Cherry opposing.

Judge Donworth moved to add to present rule - "

"but delivery of process to the marshal for service shall be necessary to avoid the operation of the statute of limitations".

Seconded by Major Tolman. Carried.

Include in above addition after word "marshal" the words

"or other person appointed by the court".

Reporter - note cases commenced other than by process.

RULE 4. SUMMONS: FORM AND SERVICE

Lines 3-4 of (a) - Reporter to consider words "names of the parties" and the use of the word "file" instead of the word "served" in Line 7. "Who served" — why. — Cf Rule copy "names of parties" as one also

Line 14 and Line 29 - Add after "United States" - "or upon any officer, department, commission or other body of the United States sued in his or its official capacity".

Line 29 - Strike "by serving" and substitute "by delivering a copy of".

Line 67 - Strike "other" and insert "to any".

Substitute (c) - First nine words to be revised - "order summoning defendants" suggested.

Mr. Hammond - Check Bureau of Internal Revenue for suits against Collectors as individuals re service upon district attorney and mailing copy to Attorney General.

Return to Mr. Holtzoff suggestion re Solicitor of Department of Interior as to service of process upon United States in certain Indian suits as rule does not affect it. (44 Stat. 239).

Style Committee - insert some such provision - "The plaintiff shall furnish required number of copies of complaint to the marshal (or other person specially appointed by the court) for service.

RULE 5. PROCESS: TERRITORIAL LIMITS OF EFFECTIVE SERVICE; SERVICE AND PROOF OF SERVICE; AMENDMENT.

Page 12 - Note to Supreme Court - Line 7 - change "Committee" to "Court".

Minnesota Bar prefers the marshal to serve.

Line 18 - Strike "of the district wherein the service is made".

The last sentence of (b) is to be moved to (c).

RULE 6. SERVICE AND FILING OF PLEADINGS AND OTHER PAPERS.

No Change.

RULE 7. PERIODS OF TIME: ENLARGEMENT; UNAFFECTED BY EXPIRATION OF TERM; FOR MOTIONS; COMPUTATION.

Line 25 - Insert period after "order". Strike "or by a standing rule of a district court".

Lines 31-33 - Change "5" to "10".

Mr. Dodge made a motion to change the rule so that if the time specified for taking any action is less than a week, Sundays and holidays shall be excluded from computation of time. Seconded. All in favor say "Aye". Opposed - Dean Clark. Motion carried.

Suggestion made that half-holidays should be treated as non-holidays. All in favor. So ordered.

RULE 8. USE OF FORMS.

Forms to be considered after rules are completed.

RULE 9. PLEADINGS DESIGNATED; MOTION DEFINED.

Moved and seconded that rule be allowed to stand as presented by Reporter in re reply. Carried.

Mr. Pepper moved that the words in lines 12-13 "on an ex parte application or" be stricken. Seconded by Major Tolman. Carried. See suggestion under Rule 17.

RULE 10. SIGNING OF PLEADINGS.

Amend first sentence to read - "Every pleading shall be signed by one or more of the individual attorneys of record for the party, etc."

Lines 12-13 - Strike "in wilful violation" and substitute "with intent to defeat the purpose".

RULE 11. FORM OF PLEADINGS: CAPTION; PARAGRAPHING; SEPARATE STATEMENT; INCORPORATION BY REFERENCE; EXHIBITS.

No change.

RULE 12. GENERAL PLEADING RULES.

Line 4 - Style Committee - change "effectuate" to "do".

Lines 30-37 - re qualification of an averment - to be "when a pleader desires to deny only a part or a qualification of an averment, it shall not be sufficient for him," etc.

Lines 41-42 - Style committee to note.

Moved and seconded that draft by Mr. Morgan and Reporter be adopted as substitute for lines 37-42. Carried.

Strike out lines 52-60 - and add after line 51 - "; and it may be as provided in Rule 63."

RULE 13. PLEADING SPECIAL MATTERS.

Motion to adopt recommendation of New York Patent Law Association on abstract of patent lawyers - seconded and carried with following changes - "form" strike "grant or registration as basis for suit" - and to follow line 37 as separate paragraph , the following sentence:

"In pleading an official document or any official act, it shall be sufficient to plead that the same was issued or executed in compliance with the provisions of the law".

Senator Pepper: Can it be understood that the Style Committee would have jurisdiction to consider at various places in these rules the propriety of using an expression, which I personally object to, characterizing a corporation by calling it an artificial person. I am a realist on that subject and I do think it ought to be a subject of real consideration whether we are going to perpetuate a medevial expression like that.

Chairman - Style Committee has unlimited authority except to change substance.

Line 9 - Change "artificial person" to "organized associations of persons". Referred to Style Committee.

Line 33 - Suggested after "precedent" to add "or provisions of law". ? is this cured by 1st correction under Rule 13 ?

Style Committee to consider change in headings of Rules 13, 14, 15 and 16.

RULE 14. COMPLAINT.

Senator Pepper moved that the question of whether we shall retain the language "the complaint shall be sufficient if it contain" or so provide that it read "the complaint shall contain 1, 2, 3". So ordered - left for Style committee.

RULE 15. ANSWER; REPLY.

See Rule 14.

RULE 16. DEFENSES--WHEN AND HOW PRESENTED.

Substituted paragraph (a) - Line 1 - Substitute for words "in subdivision (b)", the words "or as provided in subdivision (b)". Question for style committee.

Substituted paragraph (a) - Lines 2-3 - Strike bracketed phrase and substitute "an order of the court summoning parties".

Substituted paragraph (a) - Line 9 - Strike from "court" to

end of sentence and substitute therefor "within 20 days after such order unless the Court shall otherwise direct".

Reporter - consider TVA suggestions in revision of 16(b).

Chairman suggested as follows to be inserted after "matter in Line 19 -

"That in suits for patent infringement where jurisdiction depends upon the commission of acts of infringement in the district of suit, the court may order the pleadings completed and postpone hearing of the motion to the trial on their merits.

Final form left to Style Committee.

Senator Pepper made a suggestion somewhat similar.

Line 34 - Limit to/17(a) - striking reference to/17, 42 and 43.

Professor Sunderland to note Rules 42 and 43 and revise, if necessary.

Take out exception clause at beginning of 16(c) and substitute another clause to take care of changes made in Rule 17(a).

16(c) to be revised by Reporter, and redraft to be submitted to Patent Lawyers Committee for comment.

RULE 17. MOTIONS ATTACKING PLEADINGS.

See (a) under Rule 16.

Typewritten page 2, line 2 - after "rule" insert "which".

Line 6 (a) - Substitute "sufficient grounds" for "any claim".

Line 10 -(a) - Substitute "sufficient grounds" for "a claim".

Lines 7-9 (a) - Strike - and insert adopted motion after "relief" -

"After the pleadings are closed but in such time as not to delay the trial any party may make a motion for judgment on the pleadings".

Rule to contain note as to effect of general appearance and cite Federal cases.

Reporter - Insert provision for patent lawyers re reserving motion - See Boston Patent Lawyers suggestion.

Line 6 - (b) - Strike "5" and substitute "10".

Restore lines 16-21 of old Rule 17.

In Rule 9 put in the following:

"The affidavit, if any, must be served with motion. Opposing parties affidavit must be submitted at hearing unless the court otherwise directs."

(Motion made by Major Tolman, seconded by Senator Pepper, carried).

(c) Line 1 - Transpose "at any time" so that it comes after "or" instead of after "may".

Senator Pepper: I move that the time limit be the same irrespective of the character of the decision on the motion. Seconded by Mr. Loftin - See Rule 7, lines 31-33 and Rule 22, lines 11-16.

Moved that in Rule 22 or some other proper place the Reporter selects, the clause in 22(a), lines 11-16, shall be amended so that ten days shall be allowed unless otherwise ordered by the court. Carried.

Mr. Morgan - Does that apply to all motions?

Senator Pepper: Yes.

RULE 13. COUNTERCLAIM AND CROSS-CLAIM IN THE ANSWER.

Emphasize (on page 35) the note re counterclaims and Rule 91.

Motion made and carried that Mr. Pepper's substitute for the lst sentence be adopted - "The answer must state as a counterclaim any claim not the subject of a pending action which at the time of filing the answer the defendant has against any plaintiff".

See Rule 49.

Line 9 - insert - "But counterclaims seeking affirmative relief may only be asserted against the United States or an officer of the United States acting in his official capacity to the extent to which an original action may have been maintained against the United States in the district court."

Reporter - to look up regarding district court of District of Columbia's jurisdiction under Tucker Act.

Mr. Mitchell: Major Tolman - Send draft to Department of Justice for comment.

Line 29 - Strike "be permitted to" and substitute "by leave of court".

Lines 59-60 (substituted material bottom page 34) - Recast. Referred to Committee on Style. Check Patent Law Section's recommendation on Rule 18.

Minnesota Committee provision for separate trial applies to counterclaim, cross-claim, and cases of joinder.

Mr. Mitchell suggested that some appropriate sentence dealing with discretion to grant separate trials, cross-claims, counterclaims, and joined claims be inserted either in Rule 49 or elsewhere.

Insert somewhere in the rules sentence such as deleted from Rule 25, lines 9-12. Moved and carried.

RULE 19. CLAIM AGAINST ONE NOT A PARTY TO THE ACTION--THIRD-PARTY-COMPLAINT; COUNTERCLAIM AND CROSS-CLAIM BY THIRD-PARTY-DEFENDANT.

No change.

RULE 20. WHEN ACTION AT ISSUE--REPLY, WHEN REQUIRED; COUNTERCLAIM AND CROSS-CLAIM IN THE REPLY.

Line 3 (a) - insert after "initiative" (striking remainder of sentence) "Unless the court shall order a reply to an affirmative averment in the answer, no reply shall be made". Referred to Committee on Style.

Next to last line (b) - Suggest "avoided" instead of "controverted". Referred to Style Committee.

(a) last sentence - make into two sentences.

(b) - make into two sentences.

RULE 21. SHAREHOLDER'S ACTION.

No change.

RULE 22. AMENDED AND SUPPLEMENTAL PLEADINGS.

Line 21 - Style Committee or Reporter to rephrase "be deemed amended" (See transcript of New Haven meeting).

(a) lines 11-16 - see Rule 17 (also see Rule 7, lines 31-33).

Line 29 - after "(2)" insert "shall"

Line 30 - insert after "and" the word "may".

RULE 23. ORDER FORMULATING ISSUES TO BE TRIED.

No change.

RULE 24. REAL PARTY IN INTEREST; CAPACITY TO SUE OR BE SUED.

Lines 13-15. Mr. Lemann moved that these lines read as follows:

"The capacity of a corporation to sue or be sued shall be determined by the law under which it was organized." Seconded. Carried.

Line 22 - Judge Donworth moved - as a matter of clarity after words "created by" insert "the Constitution or laws" - striking out "any law".

Mr. Loftin moved alternative form of lines 24-36 be retained. Seconded and carried.

RULE 25. JOINDER OF CLAIMS.

Lines 9-12 - delete from this rule and put elsewhere in rules. (See Rule 18).

RULE 26. PERSONS WITH A JOINT INTEREST; SUING BY REPRESENTATIVES; EFFECT OF NON-JOINDER.

RULE 27. JOINDER OF PARTIES.

Page 47 - lines 21-27 - Strike out sentence and in Rule 26 or some other appropriate place substitute for the class suit the correct rule as to proper class suits so as to cover the three classes. Moved by Mr. Dodge, seconded by Mr. Morgan.

Dean Clark requested to look up to see what harm it will do to leave out spurious class.

Rule to be drawn to state the spurious class suit with the effect of the judgment in it.

Senator Pepper: The attempt that I made to restate the reporter's classification resulted in the following three categories, two of which are class actions in which the classes are composed of plaintiffs or those who might be plaintiffs and the other of which is composed

of defendants or those that might be defendants. The first of the plaintiffs classes is that in which those who appear as plaintiffs and those who might appear with them are joint owners or co-owners or owners in corporate firm of common rights or property; the second of the plaintiff classes is that in which, while the rights of the plaintiffs are several rights their rights in respect of property which, if recovered will be available for the benefit of the whole class. The third category or defendant category is that in which the defendants are co-owners or joint owners and not corporate owners of common property, and in that case, there may be a joinder of some defendants in lieu of all witha right on the part of those not joined to come in, and in that case, as in the first two, the decree or judgment ultimately entered will be binding upon all of the class insofar, of course, as the subject matter of the class is concerned.

You may have a case not in either of those two plaintiff categories that I have mentioned - but where, just because those who do figure as plaintiffs are asserting a right or an interest in which other people have a similar interest although not a common or joint one, there may follow a similar jurisdictional result which would not follow if they did not claim to be suing as representatives of a class.

Moved that Reporter is to redraft Rule 26 to include the three types of cases described in Senator Pepper's statement (Motion made by Mr. Dodge, seconded, carried).

Mr. Morgan moved that the Reporter also draft a statement concerning the spurious class suit with the effect of it as to res judicata. Seconded by Senator Pepper. Carried.

Reporter stated "that brings us back to T.D.I with modifications.

Mr. Mitchell - Is there any reason why he should not state it in the other to clear it up so that lawyers can understand - the way the court did in the equity rule - go the whole way and do a decent job? So ordered. (Opposed by Mr. Lemann) - Note to indicate Equity Rule 38 is superseded.)

clearer Leave in 2 rules To There will be a rule on joinder containing the substance of Rules 26 and 27 not included in class suits.

RULE 28. INTERPLEADER.

No change.

RULE 29. INTERVENTION.

Mr. Dodge moved that first half of final clause of Equity Rule 37 be put back in this rule. Seconded by Mr. Loftin. Carried.

Motion made that the rule as drawn be supplemented by restoring in an appropriate way the phrase "Anyone claiming any interest in the litigation may at any time be permitted to assert his right by intervention."

Put "may" clause first and "must" clause after - Unanimously voted.

"Note to Court" calling attention to the fact as to why this rule is adopted as just suggested.

Lines 21-25 - Strike out.

Mr. Dodge moved that the discretionary power be limited to cases of intervenors claiming an interest in the litigation and that the last sentence of our draft be omitted as being inconsistent with the decision in joinder.

Mr. Mitchell: Judge Donworth suggests that we put in the first half of the final paragraph of Equity Rule 37 "interest in the litigation" - next that we omit the printed form of Rule 29, page 50 by placing at the beginning of sentence on line 21, the following:

"unless the court in its discretion limits the nature of the intervention the intervenor shall have the right," etc.

Rule 29, in substance, then will read:

"Rule 29. Intervention. Any one claiming an interest in the litigation may at any time be permitted to assert his right by intervention but such motion must be granted in any action in which the application is to be bound by the judgment," etc. Retain two provisions making it compulsory and then say - generally - in the discretion of the court intervention may be permitted in the language of Equity Rule 37, and then you would have a rule that the court could construe as to the discretionary part.

All in favor say "aye" - Three opposed, Clark, Morgan and Cherry.

Recorded vote - All in favor - Tolman, Donworth, Loftin, Dodge, Lemann, Gamble, Sunderland, Mitchell. Opposed Morgan, Cherry and Clark.

Mr. Hammond called attention to non-reference in rule to right to intervene given by certain statutes.

Mr. Mitchell: Provision should be made so that nothing in these rules shall operate to effect the right of intervention given by the following statutes and name those specified in the notes.

Reporter to check list of statutes.

Mr. Dodge moved to add a clause that "Nothing in this rule shall defeat any right to intervene given by any Act of Congress". Agreed do.

RULE 30. SUBSTITUTION OF PARTIES.

Lines 1-2. "In case a party or one or more of several parties dies" to be substituted in place of "in case a party dies".

Line 3 - Mr. Mitchell suggested that after "abate" the following be inserted - "if the claim is joint the action shall proceed by or against the surviving parties; if the claim is joint or several the claim may proceed without substitution.

Referred to Reporter and Style Committee.

Page 51 - next to last line - insert "on them" after "service" - limit kind of service to those not parties.

Section (d) tentatively stricken out - to be referred to Department of Justice for comment.

Line 24 - insert "only" before "survives".

Line 25 - insert "only" after "against".

Line 29 - Mr. Lemann suggested the following be added - "And in cases where the right of action survives not only to the surviving plaintiff but to the estate of the other plaintiff, etc.

Line 28 - change "may" back to "shall".

Rephrase lines 21-29.

(b) 3rd line - strike out "or successor".

Mr. Hammond - 1st line of (b) - Does this put any limit on time? Reporter to change so service may be made as provided in subdivision (a).

Refer (c) to Attorney General's office for suggestion.

2nd sentence mimeographed sheet - Strike out. In place thereof insert - "The filing of a notice of appeal shall not effect the appeal notwithstanding the respondents have deceased and no substitutions made."

Agreed in principle that we should have an express provision that when you are filing notice of appeal it is effective even though other parties may die before appeal is taken.

Agreed that nothing need be said after appeal is taken, that being up to the upper court.

Moved that the first sentence of the proposed draft be eliminated altogether - seconded by Mr. Dodge.

Subdivision (a) - Line 10 - Dean Clark suggested "If such motion is not made within two years the court on proper motion may dismiss the action or render judgment as the case may be."

All in favor of eliminating first sentence of mimeographed sheet allowing a lawyer to take an appeal on the death of his client say Aye - Agreed.

Page 53 - Note to the Committee - Reporter stated that no rule was needed on the first matter as it was not within the authority of the Committee.

Moved that recommendation of reporter be adopted - so ordered.

Same action on second and third matters of this same note.

Page 51 - line 10 - after "death" - Reporter to phrase appropriately something along these two suggestions "The action shall be dismissed so far as concerns such parties" or "The Action shall abate as to such party."

RULE 31. DEPOSITIONS: THEIR FORM; PURPOSES; SCOPE; USE AND EFFECT; COSTS.

Professor Sunderland - I have a substitute for Rule 31(b) - provision for taking depositions to perpetuate testimony. I do not exactly like the way we have sidestepped the problem by saying that depositions may be taken in accordance with the provisions of 28 USC 644 or in accordance with the practice of any state wherein the deposition is taken. To get rid of old chancery practice and differences involved

in state provisions I have drafted a substitution of a rule on that subject for your inspection. (Separate sets handed to members of Professor Sunderland's new drafts).

At end of (b) (typewritten sheet) ad single sentence from 28 U.S.C. 645 - "Any court of the United States may, in its discretion, admit any evidence in any cause before it any deposition taken in perpetuam rei memoriam which would be so admissible in a court of the state wherein such cause is pending, according to the laws thereof."

2nd line from bottom - after "service" Judge Donworth suggested a new sentence - "Such order shall be served upon the person named personally either within or without the district".

5th line from bottom - Mr. Dodge suggested that after "notice" method of service should be inserted.

Professor Sunderland - The persons to be considered as parties for the purpose of service of notice and the manner in which notice shall be served upon each of them, subject of notice to be left to court.

Motion made that Professor Sunderland should redraft Rule 31(b) along lines suggested with some modifications and coupled with the provision that it incorporate § 645 re depositions, and then submit it to the Committee on Style or to full committee. So ordered.

Page 55 - printed Preliminary Draft - line 50 - After "The deposition of a party" add "or any one who at the time of the taking thereof was" and strike "or of".

Mr. Mitchell - Leave in (1), and then strike out (2), and then provide in (3) as you have it except to strike out "who is neither a party" etc. in lines 61-63, so it reads - "The deposition of a witness may be used by any party for any purpose" etc., "but the deposition of a party or an officer, director, or managing agent may be used by the adverse party whether or not he is 100 miles away",etc.; or leave (2) in and eliminate everything after line 54.

Line 71 - Strike out "has gone" and insert "is".

Line 72 - Insert "and at" instead of "and to".

Judge Donworth stated procurement should go out; that presumption should be in favor of admitting deposition.

Mr. Mitchell: The proposal is - as I understand it - that (2) and (3) are to be recast. Mr. Dodge so moved; Mr. Loftin seconded - So ordered - to be left to Professor Sunderland to recast.

Line 75 - After "attend" add "or testify"

Line 76 - Strike out "bodily".

(d) - page 2 of typewritten sheets - Motion adopted that it be added after line 79. (Matter of style - instead of "for any other good cause shown" say "any exceptional circumstances for good cause shown.")

Lines 66-68 - Suggested that "if the parties affected thereby consent thereto with the approval of the court" be stricken out - and then in (5) put in provision that "notwithstanding these conditions do not exist, the court, with the consent of the parties or on an application of either one and due cause shown, may permit the deposition to be used if there are exceptional circumstances and the ends of justice require it, having due regard for the interest of trying the case in open court."

Line 70 - Procurement to prevent testifying to be stated so that its proof will be like a condition subsequent.

Lines 98-111 - Professor Sunderland's redraft - Moved that they be substituted for original lines 98-111. Adopted.

Lines 38-45 - may be inconsistent with Rule 34.

Lines 93-97 to be transferred to Rule 36(c).

(Line 6 of Rule 34 - Motion adopted that the words "who may be affected thereby" should be stricken.)

Page 57 - Reporter to check reference, etc., on cases.

(c) Lines 112-115 - Strike out entirely.

Lines 17-22 - Stike out - and substitute Judge Donworth's motion that "the provisions of Rule 50 shall apply to the examination of witnesses whose testimony is taken by deposition as far as applicable."

Reporter cross reference this rule to subpoena rule (Rule 51).

Minnesota Committee by Prof. Cherry makes same point as contained in suggestion of O. B. Rose.

Lines 36-37 - Reporter to consider language to be submitted re "opportunity for inspection", etc.

Mr. Dodge stated that the Boston man with whom he discussed the Patent Bar Section suggestions stated that the patent law practice should be preserved.

(c) - page 55 - Add to end - "But no requirement for the production of any books, documents or paper shall be made and no inspection thereof required except pursuant to an order of court".

Lines 36-37 - Strike out.

Line 37 - at end add - "but no list of documents shall be required and no documents shall be required to be produced or submitted for inspection except by order of the court as provided in Rule ____." (Professor Sunderland to put in appropriate place). Vote taken for list with Judge Donworth and Mr. Lemann for it - and Prof. Cherry, Mr. Dodge, Mr. Gamble, Dean Clark and the Chairman against it.

Line 35 - Motion made to strike out "subject matter" - All agreed but Mr. Gamble.

Mr. Dodge - Moved that the defendant does not have the right to take these depositions without an order of the court until after he has answered.

Mr. Mitchell - Neither side may have an examination before issue is joined, except by order of court.

Professor Sunderland proposed "at any time after an answer has been filed."

Line 6 - Strike "res in any" and substitute "property which is the subject of the".

RULE 32. OFFICERS BEFORE WHOM DEPOSITIONS MAY BE TAKEN; EXAMINATIONS NOT CONDUCTED IN GOOD FAITH.

(a) Lines 11-15 - Suggested that they read as follows:

"Outside of the United States they shall be taken before a Consul of the United States or a notary public if no commission or letters rogatory are issued or before any person or officer appointed by commission or letters rogatory (or before such other person)".

Line 16 - Substitute "may be issued when necessary or convenient on application or notice accepted" for "shall be issued on application and notice".

Mr. Hammond to find out proper titles of United States officers attached to consul offices, etc.

Page 60 - line 13 - insert "before" before "such".

Page 60 - line 16 - Insert "may be issued when necessary or convenient on application or notice accepted" in place of "shall be issued on application and notice".

(c) (page 61) - at end add - "Nothing in this rule in patent cases shall prevent the court from limiting or refusing examination of any person regarding a secret process or to prevent the court from requiring exchange of sealed documents."

(b) - Professor Sunderland's redraft of this section and the original (b) (lines 24-30) not to be adopted.

C O N T E N T S .

Sunday, October 25, 1936.

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Rep. by C. MacPherson

ADVISORY COMMITTEE ON RULES FOR CIVIL PROCEDURE

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SUNDAY, OCTOBER 25, 1936.

Supreme Court of the United States Building,
Advisory Committee Hearing Room,
Washington, D. C.

The Advisory Committee met in the hearing room at 9:30 o'clock a.m., Honorable William D. Mitchell (Chairman) presiding.

Present: William D. Mitchell (Chairman), George Wharton Pepper (Vice-Chairman), Edgar B. Tolman (Secretary), Charles E. Clark (Reporter), Wilbur H. Cherry, Robert G. Dodge, George Donworth, Joseph G. Gamble, Monte M. Lemann, Scott M. Loftin, and Edson R. Sunderland.

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M I N U T E S

RULE 32 (b). DEPOSITIONS BEFORE A MASTER.

It was agreed that 32 (b) be stricken out, subject to the agreement to transfer certain parts of it to (c).

RULE 33. STIPULATIONS REGARDING THE TAKING OF DEPOSITIONS.

Rule 33 adopted without change.

RULE 34. ORAL EXAMINATION; PREPARATION OF RECORD.

34 (a) agreed to in the following form:

"(a) Notice of Examination; Time and Place. A

party desiring to take a deposition upon oral examination shall give reasonable notice in writing to every other party to the action not in default stating the time and place for taking it and the names and addresses of the persons to be examined, if known, and, if not known, a general description sufficient to identify them or the particular class or group to which they belong. The court, on application of the party upon whom the notice is served, may, for cause shown, enlarge or shorten the time."

Rule 34 (b). It is understood that lines 41 to 50 of Rule 51 will be transferred to and added to subdivision (b) of Rule 34. It is agreed that the Reporter's draft of a proposed additional subsection, on page 4 of the Reporter's draft, will not be used.

Rule 34 (c). Lines 40 to 47 changed to read as follows:

"The deposition shall be taken stenographically unless the parties agree otherwise. Objections presented to questions or answers shall be noted upon the deposition. Either party shall be entitled to a copy of the stenographer's transcript of the deposition on payment of his reasonable charges therefor. Parties served with notice of taking of deposition may, in lieu of oral examination, transmit written interrogatories to the officer taking the deposition, who shall propound them to the witness and record the answers verbatim. Objections presented to questions or answers shall be noted on the deposition."

Rule 34 (d). Changed to read as follows:

"(d). Submission to Witness; Changes; Signing. When the testimony of the witness is transcribed it shall be submitted to the witness for examination and be read over to or by him, unless such examination is waived by the deponent and by the parties present at the examination. Any changes in form or substance which the witness desires to make, shall be entered upon the deposition by the officer with a statement of the reasons given by the witness for making them. The deposition shall then be signed by the witness, unless he cannot be found or in case of illness, or unless the parties shall by stipulation waive such signing or the witness shall refuse to sign. If the deposition is not signed by the witness the officer shall sign it and state on the record the fact of the waiver or the fact of the refusal, together with the reason, if any, given therefor, and the deposition may then be used as fully as though signed, except insofar as the reasons assigned for refusal justify its rejection in whole or in part."

Rule 34 (e). Line 63. Strike out "thereafter".

RULE 35. EXAMINATION UPON WRITTEN INTERROGATORIES; PREPARATION OF RECORD; OBJECTIONS TO EMPLOYING THIS METHOD.

It was agreed that Equity Rule 58, or its substance as reformed by the Reporter, be included in this chapter as a separate rule.

In the consideration of the Reporter's proposed draft of 35 (a) in connection with Equity Rule 58, it was agreed that

the 21-day limit be eliminated, and that the defendant may proceed any time after the filing of the bill, and without any order.

It was agreed that the second paragraph of Equity Rule 58 be eliminated, and that language be inserted in the first paragraph to make it clear that it applies to cases where an individual is a party, and also where a corporation, private or public, is a party.

The Reporter was instructed to draw a separate rule to cover Equity Rule 58, subject to the changes noted herein.

Rule 35 (a) in the printed preliminary draft, page 65, was changed to read as follows:

> "(a) Serving Interrogatories; Notice. A party desiring to take a deposition upon written interrogatories shall serve upon every other party to the action not in default the written interrogatories and a statement of the names and addresses of the persons who are to answer them and the name and address of the officer before whom the deposition is to be taken. Within 10 days thereafter any party so served may serve cross-interrogatories upon the party proposing to take the deposition. The latter may within 5 days thereafter serve re-direct-interrogatories upon any party who has served cross-interrogatories. And within 3 days after being served with re-direct-interrogatories, a party may serve re-cross-interrogatories upon the party proposing to take the deposition."

Rule 35 (b). No changes.

Rule 35 (c). No changes.

(Thereupon, at 1 o'clock p.m., a recess was taken until 2 o'clock p.m.)

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AFTERNOON SESSION

The Committee reconvened at the expiration of the recess at 2 o'clock p.m.

RULE 36. EFFECT OF ERRORS AND IRREGULARITIES IN DEPOSITIONS.

Heading changed to "Waiver of Errors and Irregularities in Depositions. Effect of Errors."

Rule 36 (a) changed to read as follows:

"(a) As to Notice. All errors and irregularities in the notice for taking a deposition are waived unless written objection is promptly served upon the party giving the notice.

Rule 36 (b). Line 10, strike out "must be" and insert "is waived unless".

Add at end of line 13: "The objection, if made, shall be noted by the officer upon the deposition."

Rule 36 (c). Changed to read as follows:

"(c) As to Taking of Deposition. Objections to the competency of witnesses or to the competency, relevancy or materiality of testimony are not waived if not made when the deposition is taken, unless the ground of the objection is one which might have been obviated or removed if presented at that time. Errors and irregularities in the manner of taking the deposition, or in

the form of the questions or answers, or in the oath or affirmation, or errors of any kind which might be obviated or removed if promptly presented, are waived unless seasonable objection thereto is made. Such objection shall be noted by the officer upon the deposition. Objections to the form of written interrogatories are waived unless served in writing upon the party propounding them not later than the time allowed for serving the succeeding cross or other interrogatories."

Rule 36 (d). Lines 29 to 32 changed to read as follows:
--"unless a motion to suppress is made with reasonable promptness after notice of the return of the deposition."

Rule 36 (e) stricken out.

RULE 37. DISCOVERY REGARDING THE EXISTENCE AND LOCATION OF DOCUMENTS AND TANGIBLE THINGS.

It was agreed to eliminate Rule 37.

RULE 38. PRODUCTION OF DOCUMENTS AND THINGS FOR INSPECTION, COPYING OR PHOTOGRAPHING.

Lines 11 to 16 changed to read as follows:
--"things, constituting or containing evidence material to any matter involved in the action, which are in his possession, custody or control, or may order that a party shall permit access to designated land or other property in his possession or control for the purpose of inspecting or photographing the same or anything thereon."

RULE 39. PHYSICAL AND MENTAL EXAMINATION OF PERSONS.

Rule 39 (a). Lines 6 to 8 changed to read:

--"is pending may order him to submit to a physical or mental examination."

Rule 39 (b) stricken out.

RULE 40. ADMISSION OF FACTS AND OF GENUINENESS OF DOCUMENTS.

Rule 40 (a) changed to read as follows:

"(a) Request for Admission. A party may at any time after the pleadings are closed serve a written notice upon any other party requesting the admission by the latter of the genuineness of any relevant documents described in and exhibited with such notice, or of the truth of any relevant matters of fact set forth in the notice. Copies of the documents shall be delivered with the notice unless copies have already been furnished. The notice shall state that each of the matters regarding which an admission is requested will be deemed admitted unless the party to whom the notice is directed shall, within a designated period not less than 10 days after service of the notice, file a specific denial thereof under oath and serve a copy of such denial upon the other party."

Rule 40 (b). No change.

RULE 41. CONSEQUENCES OF REFUSAL TO ANSWER QUESTIONS OR OTHERWISE TO GIVE DISCOVERY.

Rule 41 (a) changed to read as follows:

"(a) Contempt for Refusal to Answer. If a party or other witness, after being duly sworn, refuses to answer any question after being directed so to do by the court in the district in which the deposition is being taken, the refusal shall be considered a contempt of that court."

Rule 41 (b). Substitute for lines 22 to 32 the following:

"If the application is granted the order shall, if the court finds that the refusal was without substantial basis, also require the refusing party or witness, or the party or attorney advising refusal, or all of them, to pay to the examining party the amount of the reasonable expenses incurred by him in obtaining the order, including reasonable attorney's fees."

Rule 41 (c) stricken out.

Rule 41 (d) stricken out.

Rule 41 (e) stricken out.

Rule 41 (f) changed to read as follows:

"(f) Expenses on Refusal to Admit. If a party, after being served with a request under Rule 40 to admit the genuineness of any documents or the truth of any matters of fact, shall, by filing and serving a denial thereof, refuse to make such admissions, and if the party requesting the admissions shall thereafter, in the action prove the genuineness of any such document or the truth of any such matter of fact, he may apply to the court for

an order requiring the other party to pay him the reasonable expenses incurred by him in making such proof, including reasonable attorney's fees. Unless the court shall find that there were good reasons for such refusal or that the admissions sought were of no substantial importance, the order shall be made."

Rule 41 (g). No change.

Rule 41 (h) stricken out.

Rule 41 (i). The redraft submitted by the Reporter (which will become Rule 41 (h)) on page 10 of the Reporter's memorandum, was adopted as drawn.

RULE 42. MOTION FOR SUMMARY JUDGMENT UPON PLEADINGS, DEPOSITIONS AND ADMISSIONS.

RULE 43. MOTION FOR SUMMARY JUDGMENT UPON AFFIDAVITS.

Mr. Lemann suggested a heading for a new rule, combining Rules 42 and 43, as follows: "Motion for Summary Judgment Where No Fact Controversy."

(At 6 o'clock p.m. a recess was taken until 8 o'clock p.m.)

EVENING SESSION

The Committee reconvened at the expiration of the recess, at 8 o'clock p.m.

CONTINUATION OF THE DISCUSSION OF RULES 42 and 43.

The Reporter was instructed to redraft and consolidate Rules 42 and 43, omitting reference to oral testimony, but

retaining the provision for the use of depositions.

Rule 42. Line 14, strike out "substantial".

Rule 43 (a). Lines 5 and 6 (page 76 of preliminary draft), strike out words "serving the pleading presenting the claim" and substitute "the filing of the answer to said claim".

Rule 43 (a). Line 13, page 76, changed to read: "forth facts in denial or in avoid-".

Rule 43 (b). Line 27, page 76, strike out "substantial evidence" and substitute "facts".

Rule 43 (c). Changed in accordance with above instructions to the Reporter.

RULE 44. DEFINING THE ISSUES WHEN CASE NOT FULLY ADJUDICATED ON MOTION FOR JUDGMENT.

Line 21, page 79, after "sets aside" insert "or modifies".

PROPOSED NEW SYSTEM OF NUMBERING

A proposed new system of numbering the rules herein, the so-called Wisconsin system, was briefly discussed, but no action taken thereon.

(Whereupon, at 10 o'clock p.m., an adjournment was taken until tomorrow, Monday, October 26, 1936, at 9:30 o'clock a.m.)

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RULE 45. CLAIM FOR JURY TRIAL; WAIVER.

Title - Change to "Jury Trial as of Right; Waiver."

Lines 5-7 - Second suggestion of (a) in Note to Committee adopted by motion.

Lines 10-13 - Strike out. Reporter to substitute phrase along following manner:

"Provided that if the case is called for trial within a shorter period the claim shall be made before the trial has actually begun".

Line 14 - Change "or" to "and" before "to file".

Line 16 - Motion adopted to strike out/inserted words following "jury".

RULE 46. TRIAL BY JURY; BY THE COURT.

Title - Change to "Trial by jury; Order of trial of several issues; Discretionary jury trial".

Line 14 - After "United States" insert - "Issues not claimed for jury trial as provided in Rule 45 shall be tried by the court but" etc.

Line 16 - Voted to keep "or" out, as follows: For - Major Tolman, Prof. Cherry, Mr. Dodge, Mr. Lemann, Prof. Sunderland , and Chairman. Against - Dean Clark and Mr. Gamble -(because of split cause of action).

Moved to strike out "or upon motion by any party" and to substitute therefor "upon motion and with the consent of the parties".

Line 17 - Moved to add after "jury" the words "if so triable as a matter of right". Carried.

Insert either in line 20 or in line 17 - "the verdict so rendered shall have the same effect as if the jury trial were had as a matter of right."

Lines 14-25 - Moved that Reporter arrange along the lines of the following suggestion of Mr. Dodge:

"Notwithstanding the failure of a party to claim a jury in any action in which such a claim might have been made as of

right the court may, on motion of such party, order any issue or issues to be tried by a jury. In all actions not triable by jury as of right the court may on motion or in its discretion try any issue with an advisory jury or, with the consent of both parties, with a jury whose verdict shall have the same effect as if trial by jury had been a matter of right."

This rule to be called to attention of full committee.

Mr. Hammond called attention of Committee to the suggestion of the Department of Justice that under the Tucker Act it is provided that there shall be no jury trial and that an exception ought to be made in regard thereto.

Reporter to include in rephrasing of rule something along the following suggestion: "In suits against the United States brought under the Tucker Act a jury shall not be ordered.

Lines 26-29 - Moved and carried to strike out (Liberty Oil case to be cited in note).

RULE 47. ASSIGNMENT OF CASES FOR TRIAL.

No change.

RULE 48. DISMISSAL OF ACTIONS.

(a) Line 5 of Reporter's redraft - after words "stipulation of dismissal" insert "without prejudice". Following suggestion of Mr. Dodge was moved to be considered by Reporter:

"An action shall be dismissed without action by the court (1) if the plaintiff serves at any time before service of the answer a notice of dismissal provided a prior action for the same cause has not been previously dismissed with(out?) prejudice or (2) if a stipulation of dismissal is filed signed by all the parties who have appeared generally in the action. The dismissal in either case shall be without prejudice unless otherwise stated in such notice or stipulation.

Reporter to recast (a) along lines suggested so as to include stipulation for dismissal on the merits.

(b) Motion made that plaintiff be never allowed to get a discontinuance which shall affect any counterclaim and if it is a "must" counterclaim plaintiff must stay in or be dismissed with prejudice.

Moved that brackets around last eight words (b) be removed, leaving language as is.

(c) Moved that (c) be made the same as (b) in connection with counterclaims.

(d) (See Rule 56). After "defendant" line 4, add "without waiving his right to offer evidence in the event that the motion is not granted".

Line 3 - page 2 of typewritten redraft - Moved to change "without" to "with".

Moved that substance of Rule as drafted is approved of and that entire rule be referred to Reporter and Professor Cherry for re-drafting and to include some provision for successive dismissal.

Moved that same rule be had with respect to the necessity of the defendant resting his case whether it is a motion to dismiss at the conclusion of the plaintiff's case or a motion for a directed verdict.

Mr. Gamble stated that he did not agree with substance of (d) as drafted if it requires defendant to rest before making the motion.

Entire rule referred to Reporter and Prof. Cherry for redrafting.

RULE 49. CONSOLIDATION AND SEVERANCE.

See Rule 18.

RULE 50. TESTIMONY AND EVIDENCE.

Lines 27-35 - Redraft so that first shall appear the sentence in substance of Major Tolman's suggestion on his page 2 - referring to cases tried by a jury; that next shall appear the sentence of Rule 50, lines 35-39; that next shall appear a redraft of Dean Clark's suggestion embodying Equity Rule 46 with the exceptions from the Dowglas case to apply only to cases tried without a jury, and that shall be followed by the material on lines 39-45 as redrawn at New Haven.

Lines 48-57 - Moved to Strike out - Carried.

Dean Wigmore's suggestion on this rule to be taken up at end of meeting if there is time.

RULE 51. SUBPOENA.

Line 12 of (b) as inserted - Strike out "who is of sound mind". Change "21" to "18".

(e) - Strike out and substitute a sentence in (a) taking care of matter.

Line 24 - Insert after "named" the words "or described".

Line 26 - Add at end of sentence "and the subpoenas may be issued in blank as provided in subsection (d) of this rule".

Line 28-30 - Strike all after "court"

Professor Sunderland to check subdivision (b) as to the limits within which a subpoena can be served (See 28 USC 644).

Line 72 (f) - Strike "just cause" and retain "adequate excuse".

RULE 52. EXCEPTIONS ABOLISHED.

No change.

RULE 53. EXAMINATION OF JURORS BY THE COURT; ALTERNATE JURORS.

No change.-

RULE 54. JURIES OF LESS THAN TWELVE--MAJORITY VERDICT.

No change.

RULE 55. SPECIAL VERDICTS AND INTERROGATORIES.

Lines 3-6. Moved to strike "with the consent of the parties, or of its own motion in cases not triable of right by jury under the Constitution or a statute of the United States". Against - Gamble and Tolman. For - Dodge, Sunderland, Mitchell, Clark and Cherry.

Line 34 - Moved to substitute for "matters" the words "material issues".

Consider possibility of saying "one or more questions of fact, the decision of which is necessary for a verdict".

Reporter - check state statutes providing for this practice to determine the usual form of expression.

Chairman suggested that Reporter consider combining subdivisions (a) and (b).

RULE 56. MOTION FOR A DIRECTED VERDICT.

Lines 1-6. Moved to retain the original printed lines 1-6 and to eliminate the substitute at top of page, and in Rule 48(d), 4th line, after "defendant" insert "without waiving his right to offer evidence in the event that the motion is not granted".

Lines 12-26. Substitute adopted.

Matter of form re "leave to take its verdict".

Lines 33-36. Moved to restore these lines and strike substitute.

Moved that alternative rule be placed in note to court instead of body of rule.

RULE 57. INSTRUCTIONS TO JURY; OBJECTION.

No change.

RULE 58. REFERENCE TO MASTER--EXCEPTIONAL, NOT USUAL; PRELIMINARY HEARING.

Title - Change "Preliminary hearing" to "Beginning the hearing" or "the first meeting".

Strike out "certified" in 2nd line of typewritten matter.

RULE 59. PROCEEDINGS BEFORE MASTER.

Line 7. Change "at the time" to "at a time".

Line 8. Omit the inserted material after "appointed".

RULE 60. POWERS OF MASTER.

Line 6 - After "only" add "and may fix the date for beginning and closing and the time of filing his report with the court".

RULE 61. MASTER'S REPORT; OBJECTIONS; JUDGMENT THEREON.

Mr. Dodge's redraft - (a) Line 4 - after "file" add "with him, unless otherwise directed by the order of reference".

Line 5 - Insert "transcript of proceedings and the evidence" in place of "transcript of evidence".

(b) last sentence - Strike out, "to be".
(c) " " - Strike out.
(e) to remain.

RULE 63. JUDGMENTS; COSTS.

(a) Line 2 - strike out "final". Strike last sentence.

(b) Moved that redraft on the margin be adopted.

(c) Strike out lines 21-23. Line 16 - "final" stays in.

(d) Moved to insert "or decree" after "order". Strike bracketed sentence. Add in note statutes on forma pauperis.

Insert lines 52-60 from Rule 12 in this rule.

(In Rule 12, strike out lines 52-60, and add after line 51 "; and as it may be provided in Rule 63.)

RULE 64. ENTRY OF DEFAULT; JUDGMENT BY DEFAULT BY THE CLERK AND BY THE COURT.

Reporter to rewrite according to his suggestions.

Line 16 - Strike "proof by" and "or otherwise".

RULE 65. NEW TRIALS.

Add provision for motion to amend findings - to be hooked up with new trial motions - to be made within time for motions for new trials, in alternative - applicable to court cases.

RULE 66. RELIEF FROM JUDGMENT OR ORDER.

Strike second bracketed clause at top page 115, leaving "suspend its operation".

(b) Title - leave out "for Newly Discovered Evidence". Under (b) put note to the effect that the intent of entertaining such a motion does not stop the time for appeal running.

RULE 68. FINDINGS BY THE COURT.

Insert in 1st paragraph "no request for findings shall be necessary. Consideration of fundamental questions postponed until final meeting.

RULE 70. MATERIAL ERROR MUST AFFIRMATIVELY APPEAR.

Line 10 - Strike "has" and insert "may have".

RULE 72. APPEAL FROM A DISTRICT COURT TO A CIRCUIT COURT OF APPEALS.

Judge Donworth suggested that there be added to (a) after "notice of appeal" the following:

"The appeal is completed upon the filing of such notice of appeal. Failure by the appellant to take any of the further steps with respect to the appeal shall not affect its validity but shall be granted only for such remedies as are specified in this rule or in situations where none are specified for dismissal of the appeal the other party ---

Agreed in principle but left to Reporter and Style Committee for later consideration as to arrangement.

Suggested as follows:

"He shall give notice by mail of the filing of such notice of appeal and of any amendment thereof to all parties to the judgment other than the party or parties taking the appeal but failure to do so shall not affect the validity of the appeal. Notification to a party who is represented by an attorney at the time the judgment was entered shall be made to such an attorney and shall be sufficient notwithstanding the death of the party or of his attorney prior to the taking of the appeal. The notification shall consist of the mailingof a copy of the notice of appeal including a copy of the class filing marked thereon. If a party was not represented by an attorney ~~and~~ or if the address of the attorney is unknown to the clerk, a copy shall be addressed to the party if his address is known, but if the address of neither the party nor of his attorney is known to the clerk a copy of such notice shall be retained by the clerk for him until the proper address is known. The clerk's memorandum or minutes showing the mailing of such copy of notice shall be sufficient evidence thereof.

Agreed in principle but phraseology left to Reporter and Style Committee, and to make shorter. Avoid going into detail wherever it is possible.

Lines 19-20 Moved to strike "No assignments of error need be filed in the District Court".

Put in note to rule, the sentence stricken from lines 19-20 and add "but see Rule 74 as to definite statement of the points on which he intends to rely".

Line 40 - Strike "has been filed".

(e) page 126 - line 2 - Strike "sureties" and brackets, but retain "surety companies".

Put in (e) something to this effect: "This shall not preclude the use of other qualified sureties".

Agreed to revise typed material on page 125, after line 55 - and to amend it so in substance it will provide that in either case of supersedeas or appeal bonds the district court will deal with bonds up to time case is docketed in Appellate Court and acted on in Appellate Court. (but thereafter only the appellate court may do so).

Put in "supersedeas bond section" - "no appeal bonds shall be required if supersedeas is given". Amount of appeal bond fixed at $250.

Check lines 52-53, 63-64, and 77-78, for repetitious language re damages.

RULE 73. APPEAL FROM A JOINT JUDGMENT OR ORDER.

Title - add - Summons and Severance Abolished.

Lines 23-24 - Strike out.

Put in rule note that we are attempting to get rid of this procedure and that it is meant to have the same effect as summons and severance.

Phraseology of typewritten material on page 130 to be revised so to provide in substance that "any one or more may appeal separately or may may appeal jointly".

RULE 74. RECORD ON APPEAL

Mr. Mitchell to redraft this rule.

In discussing rule following suggestions were made - (Revised) -

Agreed that in all cases where a secondary record is being made that the appellant shall be required to file with the clerk two copies of transcript of the proceedings of the trial including the testimony, unless the court otherwise orders.

Strike out provision regarding thereto in (c).

(b) - strike out "exhibit" next to last line.

(a) - Provision to be made for requiring that record should be approved by the court.

Primary and secondary record provisions to be eliminated as to requirement that appeal action must be taken ten days after appeal has been taken.

(a) line 2 - insert after "containing" "copies of".

(b) strike out bracketed clause.

Moved that rule be drawn to require two copies of transcript, one for the district court and one for court of appeals, so that appellate court could require printing as now required or by abstracts.

(b) - Line 1 - substitute "as soon as practicable" for "10 days".

(c) - Line 1 - substitute "as soon as practicable" for "10 days".

RULE 75. RECORD ON APPEAL - AGREED STATEMENT.

Approved.

RULE 76. STAY OF PROCEEDINGS.

Line 1 - "Cases" to be used instead of "situations".

Line 11 - Insert "stay the enforcement or operation" instead of "stay the operation".

Line 12 - Insert after "judgment" - "for a period not exceeding ten days without supersedeas in case supersedeas is required by these rules and in order to enable any party to perfect an appeal," and strike all after "judgment" to "therefrom" in line 13.

Line 19 and Line 25 - "Case" to be used instead of "situation".

Reporter - to check statute.

Meeting adjourned at 4:15 P.M. October 27th.

Mr. Mitchell appointed Major Tolman as a subcommittee to go over problems in which the United States is especially interested. Definite specific amendments to be made for each rule involved.

Throughout the rules the expression "direction for the entry of judgment" is to be used instead of "order for the entry of judgment".

Mr. Mitchell requested that a mimeographed draft of the rules as they were presented at the beginning of this meeting be made as a fair copy for the Reporters and Style Committee to note thereon the changes made at this meeting before submitting to the full committee for final action.

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Copy for The Committee.

Thursday, October 22, 1936.

Hearing Before the

ADVISORY COMMITTEE ON RULES FOR CIVIL PROCEDURE.

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