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What the General Lawyer Should Know about the Patent Lawyer's Specialty

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Leading Articles

WHAT THE GENERAL LAWYER SHOULD KNOW ABOUT THE PATENT LAWYER'S SPECIALTY

Harold B. Hood *

Charles D. Emhardt **

The Nebraska Law Review is pleased to present the following article in which the authors, with both skill and wit, excellently discuss the specialty of the patent attorney. While designed to discuss the field of patent law generally, the article also emphasizes the technical nature of the patent law and the need for attorneys in general practice to secure the aid of the patent lawyer in meeting patent problems. Regardless of knowledge of patent law problems, the reader will find the article both interesting and informative.

The Editors

I. INTRODUCTION

It has been said that the general lawyer needs to know only enough about the patent law to realize that all matters relating to patents should be referred to a patent lawyer.

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It has also been said that, many years ago, when a prominent patent lawyer died he knocked on the pearly gates and announced to St. Peter that he would like to come in. Pete asked his name and occupation; and when the applicant said that he had been a lawyer, the gatekeeper replied "Everybody knows that lawyers aren't admitted here. Away with you!"; and started to close the gates. The newcomer, however, pleaded eloquently, pointing out that he had been a pillar of the church, had led an exemplary life filled with good deeds and, throughout his sojourn on earth had governed his actions invariably by the Golden Rule. He spoke so well and his arguments were so convincing that St. Peter was shaken and, although he well knew the general rule, he said that he would like to consult with the Recording Angel before making a final decision. Telling the applicant to wait, he closed and carefully locked the gates and called on St. Michael.

At first, Michael impatiently answered that rules are rules and that, since the man admitted that he had been a lawyer, of course he could not be permitted to enter Paradise. St. Peter, however, pleaded almost as earnestly as the suppliant and finally Mike said that he would talk with the man. Returning to the gates, Michael listened to the same recital and finally said that, while he was impressed and would like to let the man in, he was bound by the regulations and there was nothing he could do. As an afterthought, however, he asked "Did you specialize in any particular branch of the law?" "Yes", said the man, "I was a patent lawyer".

"Oh!", said Mike *"come right in! You weren't lawyer enough to hurt."*

Perhaps neither of these old sayings is strictly accurate. Actually, it would be well for the general lawyer to know enough about the law of patents at least to appreciate the basic facts which are generally determinative of the question of whether or not the patent law is really involved in the solution of any problem raised by a given set of circumstances. And actually, a patent lawyer has studied the same courses and passed the same Bar Examinations to which the general lawyer has been subjected. Additionally, most patent lawyers are graduate engineers and have passed a Qualification Examination administered by the Commissioner of Patents.

Practice before the Patent Office is not restricted to lawyers but is permitted, also, to non-lawyers who have satisfied the Commissioner of their qualifications. Heretofore, some of those practitioners have referred to themselves as "patent attorneys"; but a

Commissioner's order¹ which is to become effective in 1959 prohibits that practice, and henceforth those persons will be known as "patent agents". Many of them are highly skillful and successful in the preparation and prosecution of applications for patent.

A. WHAT IS A PATENT?

A patent is a contract whereby the Federal Government grants to an inventor the aid of its Courts in prohibiting others from making, from using, or from selling something which the inventor has newly created, in return for a full and complete disclosure of that creation, of such character that persons ordinarily skilled in the field of endeavor to which that creation most closely pertains can, with no further instruction than what appears in the inventor's disclosure, successfully practice the invention.² If the disclosure is deficient, the consideration for the grant fails and the patent will be held invalid. The law requires the inventor, further, to define, in "claims" appearing as a part of his application, the limits of the concept for which he solicits the aid of the Federal Courts as above; and if it appears, at a future date, that the inventor has sought protection broader than that to which he is entitled, that protection will be withdrawn by a holding that the patent is invalid, at least as to the subject matter which has been too broadly claimed.

Contrary to a widely-held misapprehension, a patent does not grant to the patentee the right to make, to use and to sell the structure disclosed and/or claimed in his patent; but instead grants only the right to prevent others from making or from using or from selling the structure claimed, as distinguished from the structure shown, in the patent.

Remembering that, by definition an invention which is patentable must be something new—something which has never existed before its creation by the inventor—it will be obvious that no Government grant is required to authorize the inventor to make, to use, or to sell embodiments of the thing which he has newly created. That right is inherent, unless such manufacture, use or sale is prohibited by some earlier-granted right to another. But a right to exclude others from copying the new creation is not inherent; and it is that right which is granted to inventors under the patent law.

¹ 22 Fed. Reg. 6898.

² *Buckingham v. Mc Aleer*, 108 F.2d 192 (6th Cir. 1940); *Strong-Scott v. Weller*, 112 F.2d 389 (8th Cir. 1940).

The question arises—How is it possible that there may exist an earlier-granted right prohibiting the manufacture, use or sale of a patentably-novel creation?

There was a day, in the evolution of civilization, when the only vehicles were sleds. Except on ice or snow, they were cumbersome, difficult to move, and almost impossible to turn when heavily laden. Eventually, Johnny Ug removed the runners from a sled, fastened two cross bars to the bottom of the body, rounded off the projecting ends of the cross bars and mounted wheels on them to produce the first wagon. It moved with much greater ease and, although it was still almost as hard to turn as a sled, was a tremendous improvement over the old sled; and if there had been a patent system similar to ours at that time, Johnny would have been entitled to a patent containing a claim reading substantially as follows:

A wheeled vehicle comprising a body and a plurality of ground-engaging wheels journaled thereon.

Later, but before the expiration of Ug's patent, Willie Lug, after an exhausting day of working one of Ug's patented wagons over a winding trail, conceived the idea of removing the solidly-attached front axle from the wagon body and remounting it through the medium of a central king pin. Attaching draft ropes to the opposite ends of the newly-pivoted axle, Willie found, next day, that he could easily steer the improved wagon through sharp turns and S curves without having to lift and pry and shove the leading end of the wagon laterally. Here, indeed, was a wonderful advance; and Willie would clearly have been entitled to patent protection for his advance or improvement over the "prior art". Therefore, Willie, through his patent lawyer, would have filed a patent application containing a claim reading, for instance:

A wheeled vehicle comprising a body and a plurality of ground-engaging wheels journaled thereon, certain of said wheels being movable relative to said body about a substantially vertical axis.

Since none of the wheels of the wagon *disclosed* in Johnny's patent were capable of movement relative to the body about any substantially vertical axis, and since the capacity for such movement, in the structure disclosed in Willie's application conferred a new and useful function upon the complete wagon, such a claim would have been patentable—or "allowable"—to Willie, and a patent containing that claim might have issued to him.

But the improved wagon, as disclosed in Willie's patent, still was "a wheeled vehicle comprising a body and a plurality of

ground-engaging wheels journalled thereon". In other words, in spite of Willie's improvement, his structure "responded to the terms of", and therefore infringed, the claim which was granted to Johnny; and since Johnny had been granted the right to prohibit others from making, using or selling structures within the scope of his patent claim, Willie would violate that right if he made even one new wagon with or without his own improvement; he would further violate that right every time he used or sold any such wagon; and anyone who purchased a wagon made by Willie, whether or not that wagon embodied Willie's improvement, would violate Johnny's patent right by using such a wagon.

Of course, if we assume that the wagon into which Willie first built his improvement was originally built by, or under the authorization of, Johnny, then that specific wagon, even as modified, would not constitute an infringement of Johnny's patent; and Willie could use or could sell that specific wagon, and its purchaser could use it, without liability to Johnny.

Thus, it will be seen that a clearly patentable invention may be of such character that embodiments thereof will infringe a prior patent, and may not be made, used or sold, even by the inventor thereof, during the term of the prior patent, without the consent of the owner of the prior patent.

Now, in our suppositious case, Willie is delighted with his improved wagon and uses it widely to the amazed admiration of owners and prospective purchasers of Johnny's wagons. Owners, of course, may convert their own existing wagons to incorporate Willie's improvement if they obtain Willie's consent thereto; and presumably Willie will grant that consent upon payment of a reasonable fee or royalty. Or Willie may go into the business of converting existing wagons for a fee. But since Willie cannot manufacture and sell new wagons without Johnny's consent, and since Johnny cannot build Willie's improvement into wagons without Willie's consent, there is no source from which non-owners can obtain improved wagons. Newly-prosperous young men are eager to acquire wagons; but once they have seen a wagon with dirigible front wheels, they certainly are not going to spend their hard-earned currency for old-fashioned Ug wagons with rigidly-mounted front axles.

Thus, demand for Johnny's product wanes, pressure is brought upon him and upon Willie to supply the growing demand for new, improved wagons, and the economic pressure will ultimately force Johnny and Willie to compromise their differences through some sort of licensing arrangement whereby one or both of them shall

be free to manufacture wagons under both patents. Johnny may retire and license Willie to do all the manufacturing in return for a continuing royalty. Or Johnny may continue in business, paying Willie for the right to embody Willie's improvement in the famous Ug wagon. Or they may exchange licenses, with or without a "boot" in either direction, and compete with each other in the manufacture and sale of improved wagons.

Frequently it has been suggested that the whole idea of the patent "monopoly" is repugnant to our system of free enterprise and free competition. But such a suggestion is based upon a misapprehension of "monopoly", and overlooks the fact that the patent right of prohibition is granted only as to something which did not exist before the inventor's creation thereof and which the public could not have enjoyed at all (at least, as of the time of the application for the patent) had it not been created by the inventor.

A "monopoly" takes something from the public domain and confers it upon one individual or group. A patent merely grants to an individual or group the right, for a limited time, to exclude others from the enjoyment of something which, but for the efforts of the grantee, would not have been available to those others anyway. And in return, the inventor must so clearly disclose his creation that, after the expiration of that limited time, the public shall clearly understand how to make and to use that new creation fully.

It must be understood that the patent law is not designed primarily for the purpose of benefiting inventors. The patent law is, on the contrary, concerned primarily with the good of the general public.

Before the existence of patent laws, individual artisans, families, guilds and even city-states jealously guarded secret processes, formulae and, to some extent, even manufactured products. Some of these secrets were, it is presently widely believed, so effectively preserved as to have died with their ultimate guardians and to have become the legendary "lost arts". The reasons for such secrecy are apparent: Disclosure immediately deprived the inventors of any advantage in the market to reward them for time, money and ingenuity through which their improvements and discoveries were created.

The original definition of the word "patent" is "lying open; manifest to all; unconcealed". It is the primary purpose of the patent law, then, to persuade inventors to disclose their inventions—make them manifest to all—so that the general public may

enjoy the benefits thereof. The grant of a right to the exclusive enjoyment of an invention so disclosed is merely ancillary—the consideration offered by the Government as an incentive to persuade the inventor to make the desired disclosure.

B. TERRITORIAL SCOPE

Of course, since a patent constitutes the grant of a right by a Government, it confers no rights outside the territorial limits controlled by that Government. Obviously the Government of the United States has no power to authorize anyone to prohibit anyone else from doing anything in, for instance, Canada. Most countries have their own patent laws and issue patents upon the applications of citizens of any country; but the issuance of a patent by one Government is no guarantee that a corresponding patent will be issued by any other Government. One who desires patent protection in any country must file his application in that country, and that application will be treated in accordance with the laws of that country. As a general rule, a patent will not be issued by any country unless the application therefor is filed in such country before issuance of a patent for the same invention in any other country.

The patent systems of the several countries of the world vary in substantial respects; but the scope of this brief article will necessarily be limited to the patent system of the United States of America.

C. CONSTITUTIONAL AND LEGISLATIVE FOUNDATION

Article 1, section 8 of the Constitution of the United States confers upon Congress the power "To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Under the very earliest statutory provisions, patent applications were personally examined by Thomas Jefferson and the first few patents issued were signed by George Washington and Thomas Jefferson. As the volume of applications increased, the patent laws and regulations were changed in a make-shift manner until, in 1836, a comprehensive patent statute closely comparable to the presently-existing law, was adopted and a Patent Office was created. With very few substantial changes, the Act of 1836 was continued in effect until, effective January 1, 1953, the present "recodification" of the patent law was adopted. It is known as "Title 35, United States Code".

II. APPLICATION FOR A PATENT

A. WHAT SUBJECT MATTER IS PATENTABLE?

The basic statutory provision reads:

Whoever invents or discovers any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.³

The terms "machine", "manufacture" and "composition of matter" are reasonably self-explanatory; but the term "process" is frequently misleading to those who are not familiar with the decisional law.

It is settled that a "process", in the sense of the patent law, must consist of one or more manipulatory or procedural steps performed upon a physical thing whereby the form, nature, properties or characteristics of that thing will be modified.⁴ Thus, a method of playing a game, a bookkeeping routine, a procedure for sorting and distributing mail involving the use of a coding system to replace or supplement written addresses together with a machine or machines for scanning the code and sorting or routing the mail in accordance therewith, or a plan for facilitating the sale of a product are not "processes" within the meaning and scope of the patent laws but are "methods of doing business" which are inherently unpatentable. The apparatus or equipment used in playing the game, a machine, or even a tabulator element used in the bookkeeping routine, a machine for scanning the code markings in the mail-distribution system, or a gadget used in connection with the sales promotion scheme may be patentable under one or another of the statutory categories; but the procedures are simply incapable of protection under our patent laws.

The word "new" in the statutory provision must be read in connection with the word "invents", since mere novelty is not a sufficient basis for patentability, as is made clear in the subsequent "conditions and requirements" of the Act.⁵ Roughly stated, the novelty of a patentable invention must reside in features of distinction over what has been known before, which features would not have occurred to a person, having ordinary skill in the field of endeavor to which the invention pertains, and having full knowl-

³ 35 U. S. C. 101 (1952).

⁴ *Cochrane v. Deener*, 94 U. S. 780 (1877); *Expanded Metal v. Bradford*, 214 U. S. 366 (1909).

⁵ *Thompson v. Boisselier*, 114 U. S. 1 (1885).

edge of everything theretofore existing in that field and in directly analogous fields. Only someone who has been trained in the interpretation and application of prior disclosures is capable of formulating a reasonably accurate opinion on the question of the patentability of a given "process, machine, manufacture, or composition of matter". And even such an individual, of course, must have full information as to what has been known before if he is to reach a sound conclusion.

To that end, a patent lawyer to whom an invention has been submitted will usually recommend what is known as a "Preliminary Search" before filing an application for patent. A disclosure of the submitted invention is forwarded to a private searcher in Washington. The searcher, after digesting the disclosure, goes into the Public Search Room in the Patent Office where there is maintained a complete collection of United States patents, arranged and cross-referenced according to subject matter, and there searches for issued patents disclosing subject matter similar to the submitted invention. He will usually have to look at several hundreds, or perhaps thousands, of issued patents before he can be sure that he has effectively covered the appropriate field of search. As he goes, he makes notes of the identifying numbers of those patents whose disclosures most closely approximate the salient features of the submitted invention; and when he has completed his search, he orders copies of those most pertinent patents and forwards them to the submitting lawyer. That lawyer, in turn, examines the disclosures of the prior patents so cited to him, reaches his conclusions as to the patentability of the submitted invention thereover, and reports to the client with his recommendation as to whether or not the *patentably inventive* features of novelty in the submitted invention warrant the filing of a formal application for patent.

Occasionally, and upon the basis of his own past experience, a patent lawyer can advise an inventor off-hand that his invention is not patentable. But he can never properly give an off-hand opinion that a submitted invention is patentable, since he can never be sure, without a search of existing patents, that a submitted invention is new. Approximately 2,900,000 patents have been issued by this country alone; and no man can say off-hand that any specific concept is not disclosed in one or more of those issued patents.

B. WHO MAY APPLY FOR A PATENT?

Except in a few, strictly-defined situations, an application for a patent in this country must be signed by the true inventor, or

joint inventors, of the subject matter claimed in the application. An essential element of an application is an Oath which must be signed and sworn to by the inventor and wherein he alleges, among other things, that he believes the claimed invention to be original with him, that it has not been disclosed in any printed publication, or put into public use, or offered for sale by himself or anyone else more than one year before the execution of the Oath, and that it has not been patented in any country upon an application filed by, or on behalf of the applicant, more than one year before the execution of the Oath. Unless the application is actually filed in the Patent Office before the expiration of one year from the date of any such occurrence, no valid patent can be issued thereon.

Except in very special circumstances, a corporation cannot validly sign an application for patent in this country. If an application is signed by anyone who was not actually the sole or a joint inventor of the subject matter claimed, then unless the error is corrected before issuance, any patent issued on the application will be invalid.⁶ If a true joint inventor fails to sign an application, then a patent issued on an application signed by the other joint inventor or inventors will be invalid.⁷

If A makes an invention and B learns of it and files an application for patent thereon in his own name, any patent issued on that application will be invalid; and A, who fails to file an application in his own name, cannot later obtain any benefit from the patent issued on B's application by requiring B to assign the patent to A, because that patent, having been issued on a perjured Oath and upon the application of one who was not the true inventor, is void *ab initio*.⁸ In such a case, however, and provided he acts before the end of the statutory year as above outlined, A may file an application of his own, copying the claims of the patent issued on B's application, demand an interference⁹ with that patent and, upon proof of the above-stated facts, have a corresponding patent issued to him. While the Commissioner has no power to cancel or revoke the patent erroneously issued to B, the issuance to A of a patent containing the same claims incorporated in the B patent

⁶ 35 U. S. C. 111 (1952); *Hotchkiss v. Greenwood*, 52 U. S. 248 (1850); *Welsbach v. Cosmopolitan Light Co.*, 104 Fed. 83 (7th Cir. 1900); *Standard Computing Scale v. Computing Scale Co.*, 126 Fed. 639 (6th Cir. 1903).

⁷ *City of Milwaukee v. Activated Sludge*, 69 F.2d 577 (7th Cir. 1934); *Larson v. Crowther*, 26 F.2d 780 (8th Cir. 1928).

⁸ *Crook v. Bendix*, 68 F.Supp. 449 (D. C. Del. 1946).

⁹ *Infra*, p. 591.

would make it a certainty that any Court acquiring jurisdiction of the patent issued to B would hold it invalid.

C. PATENT OFFICE PROCEDURE

Since the law provides that patents shall be issued only for inventively novel disclosures, some mechanism must exist for determining whether or not a patent should be granted in each individual case, and if so, in what form the grant should be made. This is the function of the Patent Office, and that Office operates under a body of Rules based on the statutes and on the case law which has been developed over the years since 1836.

The Commissioner of Patents administers the Patent Office, which is a bureau of the Department of Commerce, and all patents are issued in his name. The actual work of examining patent applications is divided among seventy-three Examining Divisions, each of which consists of a Primary Examiner, who administers the work of his Division, and from about ten to about thirty Assistant Examiners and a suitable clerical force.

All of the approximately 2,900,000 patents which have been issued by this country alone are classified and cross-referenced according to subject matter; and other millions of publications and of patents issued by other countries are also available to the Examiners and are appropriately arranged in the classification system. That system comprises approximately three hundred main classes, each of which is broken down into named and specifically defined subclasses. Some main classes consist of as few as five or six subclasses, while others include as many as eight or nine hundred subclasses.

Certain main classes are assigned to each Examining Division, and each such Division handles only applications whose claims fall within the definitions of the classes assigned to that Division. Each Assistant Examiner is assigned a certain class or group of subclasses, and he handles all applications which fall within the scope of his assignment.

By requirement of Statute and Patent Office Rule, an application for patent must comprise a full, clear and concise written description of a preferred embodiment of the invention for which protection is solicited, a drawing of such embodiment if the nature of the invention is such that illustration thereof is feasible, and a claim or claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention".¹⁰

¹⁰ 35 U.S.C. 111 to 113 (1952).

The application must also include an Oath in prescribed form, incorporating a number of allegations which are necessary to the right to receive a patent, and signed by the applicant.

When an application is received in the Patent Office, it is assigned to the appropriate Examining Division, and the Primary Examiner of that Division assigns it, according to the subject matter claimed, to the appropriate Assistant Examiner in the Division. It then takes its chronological position, according to filing date, among the cases awaiting action by that Assistant.

When the Assistant reaches that application (in most Divisions, the current backlog of work is such that this will be about eight months after filing) he reads the drawing and the specification with sufficient care to assure himself that he understands the disclosure; and then he studies the claims to determine precisely what are the features which, in the opinion of the applicant, are new and patentable. Then he turns to his files of prior patents and publications and searches for disclosures of those features in the appropriate subclasses. During his search, he selects those patents or publications whose disclosures most closely approximate the features recited in the claims of the application.

After completion of his search, the Examiner more closely studies the references which he has selected and compares their disclosures with the language of the applicant's claims. He then prepares a letter, directed to the applicant's attorney, in which he sets forth the identifying data of the prior patents or publications on which he relies, and treats each claim of the application. He may reject one or more claims on the ground of complete anticipation by the disclosure of a single reference. He may reject other claims on the ground that, in one or more respects, they fail to conform to numerous technical or formal requirements which have been laid down in the Rules of the Patent Office or have been built up through custom and experience. While a real effort is made to maintain uniformity of practice throughout the Examining Corps, the fact is that certain Divisions (and even, to some extent, individual Assistant Examiners within a Division) have their separate idiosyncracies upon which they insist. Since the statute provides that a patent shall not be granted "if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains,"¹¹

¹¹ 35 U.S.C. 103 (1952).

the Examiner may reject still other claims on the ground that it would not involve patentable invention to modify the structure shown in one reference by importing thereinto certain structural details shown in one or more other references. In the same letter, known as an "Office Action", the Examiner may indicate that still other claims are considered to be allowable.

Within six months from the date of any Office Action, a full response thereto must be filed in writing. Such response must similarly treat every rejected claim of the application, either by cancelling it, by amending it, or by arguing that the Examiner's rejection of it is, for stated reasons, unwarranted. The response must also set forth reasons why it is believed that every retained claim in the application should properly be allowed. When this response has been filed, the application again takes its chronological place in the Examiner's files, based on the date of filing of the response, to await further action by the Examiner.

This correspondence is continued until the Examiner and the attorney reach a final agreement as to what claims may be allowed, or until they reach a final disagreement as to at least one claim. If they agree, a formal notice of allowance is issued by the Examiner and the patent will issue upon the payment, within six months after the notice of allowance, of the prescribed issue fee. If they come to a final disagreement, the applicant may appeal to the Patent Office Board of Appeals.

If the applicant is dissatisfied with the decision of the Board of Appeals he may appeal further to the Court of Customs and Patent Appeals in Washington; or, in the alternative, he may bring a civil action against the Commissioner in the Federal District Court for the District of Columbia, seeking an adjudication authorizing the Commissioner to issue a patent to the applicant notwithstanding the holding of the Board of Appeals.¹²

Thus, it will be apparent that both preparation and prosecution of patent applications are tasks of some complexity, not to be lightly undertaken by one who lacks specific training and experience therein.

D. PRIORITY

The law of this country provides for the issuance of a patent to the *first* to make a given invention. Not infrequently, two or more people independently conceive substantially the same patent-

¹² 35 U.S.C. 141, 145 (1952).

able invention. This is not too surprising since, in this day of widespread, rapid communication, problems which arise are recognized by people all over the country; many of these people are characterized by an inherent urge to solve any problem encountered; and there are only a relatively few reasonably satisfactory solutions for any problem.

It would have been a simple matter for our legislators to have authorized the Commissioner of Patents to issue a patent to the first person to apply therefor, and that would have made the problem of plural inventors easy to solve; but it would not have served the real purpose underlying the Constitutional authorization, and it is not what the statute provides. The Commissioner, of course, has no independent way of knowing the invention date to which any applicant may be entitled; and therefore a procedure has been set up for resolving the question of priority among plural independent inventors of common subject matter.

Whenever it is found that patentable subject matter being claimed in one application is disclosed in a copending application filed by another applicant, the Patent Office institutes an "Interference". An interference is a procedure similar to a legal action in which the parties introduce evidence to prove facts tending to establish their respective dates of invention. It sometimes happens that such a proceeding may involve applications filed by more than two separate and independent inventors. The procedure, which is quite technical and somewhat complicated, is the sole subject matter of many voluminous texts and cannot be discussed in any detail within the scope of this article.

Briefly, however, it may be stated that each party is required to file a sworn statement setting forth: (1) that he made the invention in issue; (2) whether or not he made it in the United States; (3) the date on which the first drawing illustrating the invention was made by or for him; (4) the date on which the first written description of the invention was made by or for him; (5) the date on which he first disclosed the invention to another person; (6) the date and character of his first act (other than 3 or 4 above) which would establish the fact of his conception of the invention; (7) the date on which a full sized embodiment of the invention was first built and tested by or for him; and (8) the date when active exercise of reasonable diligence toward (a) building a full-sized embodiment of the invention or (b) filing a patent application for the invention was begun by or for him. These sworn statements have no probative effect, but are binding on their signers, in that subsequent proof of dates earlier than those stated will be held to establish only the dates stated.

After these sworn statements have been opened in the Patent Office, each party may obtain a copy of his opponent's application. After preliminary technicalities have been disposed of, the party who was last to file his application is required, within a specified period, to produce evidence to prove the allegations of his sworn statement. Testimony is taken by deposition, wherever the party on whose behalf it is taken elects, and the opposing party or parties may attend, in person or by counsel, and may cross examine. After the "junior" party's time for taking testimony has expired, the next senior party has an opportunity to introduce evidence to prove his own allegations, and so on until all parties have had such opportunities. Thereafter, the parties have, in reverse succession, opportunities to offer rebuttal evidence. After all such periods have expired, all of the evidence is filed in the Patent Office, the parties are permitted to file and exchange briefs, a time is set for oral argument, and ultimately the Patent Office, through its Board of Patent Interferences, renders judgment, awarding priority of invention to one of the parties. Unless that judgment is reversed, a patent covering the contested issue will be granted to the winning party and the applications of the other party or parties will be treated as though the application of the winning party were a previously-issued patent.

Appeal may be taken from the decision of the Board of Patent Interferences to the Court of Customs and Patent Appeals¹³ or a party who is dissatisfied with such decision may bring a civil action in a Federal District Court against the winning party, in which a judgment in favor of the plaintiff may authorize the Commissioner of Patents to issue a patent to the plaintiff, rather than to the party who was successful before the Board of Patent Interferences.¹⁴ Such an action will usually be brought in the District of residence of the party who was successful before the Board, but may, in certain cases, be brought in the District of Columbia.

As a general rule, priority in an interference proceeding will be awarded to the party who was first to conceive the invention, provided he was diligently proceeding toward reduction to practice (the construction and testing of a full-sized embodiment of the invention or the filing of an application for patent thereon) at the time when the later conceiver entered the field and began to exercise diligence, and provided the diligence of the earlier conceiver

¹³ 35 U.S.C. 141 (1952).

¹⁴ 35 U.S.C. 146 (1952).

was then reasonably continuous to the date of his own reduction to practice.¹⁵

In a proper case, an interference will be declared between an issued patent and a pending application. If the patentee is held to be the prior inventor of the subject matter in issue, the application is held subject to the patent as prior art. If the applicant is held to be the prior inventor, a patent containing claims identical with the claims (involved in the interference) of the patent will be issued to the applicant. Even in such a case, the Commissioner has no power to revoke the claims improperly granted to the first patentee; but his award of the same claims in a later patent to the successful interferant will usually be respected by the Courts, and those claims will be held invalid in the formerly-issued patent if that patent is subsequently involved in litigation.

Obviously, a hotly-contested interference is time-consuming and expensive, and thus is to be avoided if reasonably possible. In the writer's thirty-two years of practice, he has never carried an interference proceeding to the point of filing evidence, but has always managed to work out a plan of settlement, mutually satisfactory to the parties. Needless to say, the technicalities and complications of such a procedure are such as should not be attempted except by counsel thoroughly skilled in the patent law.

E. PATENT OWNERSHIP

Of course, an inventor may assign his patent rights freely. Therefore, although the application must be signed by, and filed in the name of, the true inventor or inventors, the application, any patent to issue thereon, and the invention covered thereby may be owned by any person or persons, including a corporation.

An assignment of a patent or of an application therefor must be by an instrument in writing, and unless that instrument is recorded in the United States Patent Office within the three months next following its date, or prior to a subsequent purchase or mortgage, it will not be effective against an innocent purchaser or mortgagee for value.¹⁶

By a similar instrument, an undivided interest in a patent or application may similarly be assigned, in which case the original owner and the assignee or assignees become joint owners. Formerly, it was not unusual to find patents owned of record in

¹⁵ *Brown v. Barton*, 102 F.2d 193 (C.C.P.A. 1939).

¹⁶ 35 U.S.C. 261 (Supp. V, 1958).

specified fragments,¹⁷ but that practice has been largely abandoned for the reason that joint ownership does not accomplish what the parties obviously desire and, on the contrary, sets up a highly undesirable situation in which, in the absence of any collateral agreement to the contrary, each joint owner, regardless of the proportional "size" of his share, is free to make, to use and to sell the patented invention, and to license others non-exclusively to do so, without accounting to the other joint owner or owners.¹⁸ The same condition obtains with regard to a patent issued to joint inventors. Therefore it is preferable, even in the case of joint inventors, for title to reside in a single individual, the distribution of any proceeds from the invention being controlled by a written contract among the interested parties.

F. PATENT MARKING

The legends "Patent Applied For" and "Patent Pending" and their abbreviations have no legal effect whatsoever toward protection of their users, but merely constitute a "friendly warning". In effect, they say, "Patent protection for this device is being sought. If you begin to copy it, it may be that, at some undetermined future date, you may be compelled to stop making or using or selling such devices, to your considerable embarrassment".

It does not mean that a copier will incur any liability for anything which he may do prior to the date of actual issuance of a patent upon the application in question. Except in a case involving a breach of confidence, neither making nor using nor selling embodiments of an invention covered only by an application for a patent is an actionable offense, because the right to exclude under the patent laws arises only upon the issuance of a patent. Thus, one who manufactures, uses, or sells such embodiments throughout the pendency of an application by another for a patent incurs no liability if he instantly discontinues all of those acts on the day of issuance of the patent. Fabrication of his remaining parts-inventory thereafter, however, is an infringement of the patent. So is the sale of his remaining inventory of finished articles, or his personal use of any such articles. And the patentee has the right to move against each individual who purchased such an embodiment prior to issuance of his patent for an injunction against its further use and for damages for whatever use occurred after the issue date.¹⁹

¹⁷ For example: 2½% to X; 7½% to Y; 25% to Z.

¹⁸ 35 U.S.C. 262 (1952).

¹⁹ 35 U.S.C. 271; 281; (1952).

Although these legends have no legal protective effect, the use of either of them, or of any expression importing that an application for patent is on file in the Patent Office, when that is not true, for the purpose of deceiving the public, is a violation of the statute punishable by a fine of not more than \$500.00 for each offense; and any person may sue for the penalty and recover one-half of any fine levied against the offender, the other half going to the use of the United States.²⁰ Continuation of the use of such a legend after abandonment of an unsuccessful application for patent is such a violation.

Unless a patent owner, or anyone making or selling a patented article for or under him, uses the word "Patent" or the abbreviation "Pat.", together with the number or numbers of the applicable patents, directly in connection with such articles as they are offered for sale, he will not be entitled to recover damages in any action for infringement of such patent or patents "except on proof that the infringer was notified of the infringement and continued to infringe thereafter, in which event damages may be recovered only for infringement occurring after such notice."²¹ Thus, such marking may be said to constitute constructive notice; and is almost always advisable.

While the statutory provision is permissive rather than mandatory, the benefits attainable through strict compliance are such as to make such compliance usually worth while for the patent owner. Omission of the number, or of the word "Patent" or its equivalent, renders an attempted marking wholly ineffective. Use of the statutory form of notice in advertising is not effective to gain the benefit of the statute.

Any form of marking used with the intent of deceiving the public into the erroneous belief that an article is covered by a patent is a punishable²² violation.

The writers know of no decision bearing directly upon the question of whether or not it is a punishable offense to continue, after expiration of a patent, to use a previously-proper form of patent marking, and have no settled personal opinion thereon.

From the standpoint of the prospective copier, of course, it is reasonably safe to copy any article which is found on the open market and which does not bear any one of these legends, so long

²⁰ 35 U.S.C. 292 (1952).

²¹ 35 U.S.C. 287 (1952).

²² *Supra*, note 20.

as the copying is not so slavish as to run afoul of the common law of unfair competition.

G. WHAT RIGHTS MAY A PATENT OWNER EXERCISE?

Until about the second quarter of the present century, it was generally conceived by the Courts that "A patentee is a Czar in his own domain";²³ and that he could withhold any right to practice his patented invention at his whim and could grant any right thereunder in return for whatever consideration might meet his fancy. Gradually, however, the freedom (or perhaps the word is "license") with which a patentee may use the right granted to him has, within more recent years, been whittled away.

Thus, even an individual owning a single patent may not lawfully use his patent right to create even a partial monopoly in some unpatented commodity by, for instance, requiring, as a condition of a license under a patent for a dispensing machine, that only salt tablets purchased from a specified source shall be dispensed through the machine;²⁴ or, as a condition of a license to practice a patented process or to produce a patented material, that an unpatented ingredient for use therein must be purchased from a specified source.²⁵ While such an individual may still lawfully specify a price above which or below which his licensee may not sell the patented device,²⁶ he may not impose any price limitation upon the reseller of a device so purchased from his licensee,²⁷ nor may he require his licensee to impose any such limitation upon such resale.²⁸

One who owns a plurality of patents relating to a common field, whether by original invention or by purchase, must be doubly cautious in his management of his patent property lest he be found guilty of achieving an unlawful monopoly by misuse of patents;²⁹ and if such a patent owner is a corporation rather than an individual, the necessary precautions are multiplied.³⁰

²³ *Rubber Tire Wheel Co. v. Milwaukee*, 154 Fed. 358, (7th Cir. 1907).

²⁴ *Morton v. Suppiger*, 314 U.S. 488 (1942).

²⁵ *American Lecithin Co. v. Warfield*, 105 F.2d 207 (7th Cir. 1939).

²⁶ *Bement v. National Harrow Co.*, 186 U.S. 70 (1902).

²⁷ *U.S. v. A. Schrader's Sons*, 252 U.S. 85 (1920).

²⁸ *Bauer v O'Donnell*, 229 U.S. 1 (1913).

²⁹ 15 U.S.C. 2 (Supp. V, 1958).

³⁰ *Standard Oil v. U.S.*, 283 U.S. 163 (1931).

It has been held that, where two or more corporations, in concert, have deliberately set out to dominate the market in a given commodity by acquiring control of a relatively large proportion of the patents relating to that field, by cross-licensing each other, and by refusing to license others under such patents except upon prohibitive terms, such actions constitute an unlawful conspiracy in restraint of trade;³¹ and, in some instances, such conspiring corporations have been required by Court order to grant non-exclusive licenses under their patents to all comers, on such terms as may appear to the Court to be reasonable.³²

Thus, any patent license agreement should always be drafted, or reviewed, by a patent lawyer before execution.

III. INFRINGEMENT

Broadly stated, a patent is infringed when, and only when, every limitation of any one of its claims finds direct or equivalent response in an accused process, machine, manufacture or composition of matter.³³ An accused structure may differ widely in appearance from the structure shown in the patent drawings, may have additional structural features and functional advantages, may be made in whole or in part from materials different from those described in the patent specification and may be made up of more or fewer parts as compared with those shown in the patent drawings; yet if it incorporates an equivalent for every element recited in a claim of a patent, and if those elements cooperate substantially in the same manner in which the recited elements in the patent disclosure cooperate, it will infringe the patent.

A patent claim is a meticulously worded definition of the subject matter which is included within the patent owner's statutory right of exclusion. A patent may, and usually does, include a plurality of claims, each of which must stand or fall on its own merits and each of which differs, in form of wording and in ultimate scope, from every other claim of the patent. Each must define structure, procedure or composition which distinguishes inventively over what was known prior to the patentee's concept; and infringement of any one claim of a patent subjects the infringer to the same liabilities that would result from infringement of all of the claims of the patent.

³¹ *Hartford-Empire Co. v. U.S.*, 323 U.S. 386 (1945).

³² *Ibid.*

³³ *United Carbon Co. v. Binney Co.*, 317 U.S. 228 (1942); *Universal Oil Products Co. v. Globe Refining Co.*, 322 U.S. 471 (1944).

A patent right is enforceable, of course, only by a Court action. The Federal District Courts have exclusive jurisdiction over actions for patent infringement.³⁴ Such an action may be brought only in the District in which the defendant resides or in any District in which the defendant (1) has a regular and established place of business *and* (2) has committed acts of infringement.³⁵ An "act of infringement" may consist of *making* or *using* or *selling* the patented invention.³⁶ Neither diversity of citizenship nor any critical amount in controversy is essential to jurisdiction in patent infringement actions, since the right of action originates in a Federal statute.

A defendant in any such action may allege that the patent in suit is invalid; and the Courts have the power so to hold, upon proper proof.³⁷ Of course, if the Court holds the patent invalid, the patent owner will be entitled to no relief against the defendant. Similarly, judgment will be for the defendant if the Court is satisfied that the defendant's practices have not actually infringed any valid claim of the patent in suit.

If the plaintiff is successful, he will usually be awarded an injunction³⁸ against further infringing acts by the defendant, as well as "damages adequate to compensate for the infringement but in no event less than a reasonable royalty for the use made of the invention by the infringer."³⁹ In flagrant cases, the Court may, in its discretion, "increase the damages up to three times the amount found or assessed"⁴⁰ or award a recovery of "reasonable attorney fees to the prevailing party",⁴¹ or both.

Such actions usually are tried to the Court without a jury. Either party may appeal a District Court decision to the Court of Appeals for the appropriate Circuit.⁴² A party who is dissatisfied with the decision of the Court of Appeals may petition the Supreme Court of the United States for a writ of certiorari⁴³; and the Court

³⁴ 28 U.S.C. 1338 (1952).

³⁵ 28 U.S.C. 1400 (1952).

³⁶ 35 U.S.C. 271 (1952).

³⁷ 35 U.S.C. 282 (1952).

³⁸ 35 U.S.C. 283 (1952).

³⁹ 35 U.S.C. 284 (1952).

⁴⁰ *Ibid.*

⁴¹ 35 U.S.C. 285 (1952).

⁴² 28 U.S.C. 1292 (1952).

⁴³ 28 U.S.C. 1254 (1952).

usually issues such writs in cases involving legal issues of general importance.

While the decision of any such Court of Appeals is strongly persuasive upon the Court of Appeals of any other Circuit faced with a decision upon the same patent, it is not binding.⁴⁴ Thus, a patent owner may bring separate actions against different defendants in two or more Circuits; and may get opposite results in separate Circuits. In such a case, the Supreme Court will almost always accept jurisdiction to resolve the conflict between the different holdings by the separate appellate Courts.

Patent lawyers, as a general rule, are trained and adequately skilled in litigation to conduct such actions. Since engineering or scientific issues are usually involved to a degree of importance at least equal to that of legal principles or courtroom tactics, it is ordinarily quite unwise for the general practitioner to undertake patent litigation, at least without the assistance of patent counsel.

A. WRITTEN RECORD AND PHYSICAL EVIDENCE AS "INSURANCE" POLICIES

From what has already been said, it will be clear that, at times, written records and other physical evidence may become vitally important to the acquisition and maintenance of patent rights. Again and again, the patent lawyer hears "But that patent *can't* be valid! We did the same thing ten years ago"; or "He can't beat me in this interference. I tried his same structure three years before his alleged date of conception"; only to find that such statements are based solely on recollection, unsupported by physical evidence of any kind. And as a general rule, a litigant's uncorroborated testimony is utterly ineffective to prove any fact in issue.

Personal, "scrap-type" notes have relatively little probative value; but entries in a bound, regularly-kept diary are fairly good evidence. And if the inventor makes a regular practice of showing his diary entries, in detail, to one or more disinterested persons capable of understanding what he is doing, and having that person or those persons, at intervals, write into the diary some such entry as "Pages 121 to 147 disclosed to, and understood by, me this 4th day of October, 1958. John Doe", such a diary becomes very strong evidence of conception, disclosure, and, sometimes, diligence. It will be obvious, of course, that the value of such a diary depends, to a very great extent, upon the completeness and clarity of the inventor's entries. While sketches may be rough

⁴⁴ Triplett v. Lowell, 297 U.S. 638 (1936).

they must usually be present and should be fully explained by means of legends or accompanying descriptive matter. Preferably, entries should be in relatively permanent ink to minimize charges of subsequent modification.

Corporate clients, particularly, should be instructed to require at least their research and engineering personnel to keep diaries as above suggested; and the details of such instructions can best be formulated by patent lawyers.

For the casual inventor, as distinguished from the professional inventor, research man or engineer, a good way to establish a date of conception is through a self-addressed, mailed disclosure. A clear drawing of the concept, together with a description thereof, all on a single sheet and in ink or in the form of a blue print or photostat, can be folded and sealed with tape or the like. On the outside of the folded sheet, and thus on the back of the drawing or print, the inventor writes his name and address and then posts the sheet, preferably by registered mail. In cancelling the postage, the Post Office will, of course, impress a dated postmark on the address-carrying surface of the sheet; and that mark, appearing directly on the back of the drawing or print, becomes almost irrefutable evidence of a date of conception, drawing and written description.

Alternatively, the drawing and description may be sealed together in an envelope and similarly mailed. In that case, however, the inventor must obviously keep the envelope in sealed condition until it may be needed as evidence; and even then the disclosure is open to attack on the ground that the envelope might have been opened and resealed after modification of the drawing, or even that the disclosure might have been transferred to some earlier-mailed envelope.

B. OUTSIDE SUBMISSIONS

Manufacturers receive tremendous numbers of unsolicited communications from the general public, suggesting new products or alleged improvements upon the "line" of the recipients. If freely accepted and considered by any officer or managerial employee of the company, such communications can be very dangerous.

One of the leading cases in this field is *Booth v. Stutz*,⁴⁵ in which Booth, an individual with considerable experience in the

⁴⁵ *Booth v. Stutz Motor Car Co.*, 56 F.2d 962 (7th Cir. 1932).

field of automobile design and manufacture, spontaneously but in confidence submitted a complete set of drawings and specifications for an automobile embodying a number of unconventional features to Stutz Motor Car Co. which was currently experiencing a rather serious decline in its business. Stutz management expressed interest in Booth's design, and he left his material with the company, where it was subsequently studied by officials and the Chief Engineer of the company. Primarily for lack of funds, a decision was made against adoption of the Booth design, his disclosures were filed away, and shortly thereafter, in connection with a refinancing arrangement, the entire top echelon of management was replaced.

The new management of the company did not know of the Booth disclosure and never saw his papers. The Chief Engineer of the company was retained, but never again looked at the Booth disclosures. In the year following the Booth disclosure, the new president of Stutz, who never had seen the Booth disclosures, collaborated with the Chief Engineer of Stutz to design a new model for Stutz to manufacture, based upon uncommercialized designs which he had seen some years earlier when employed in the Marmon Motor Car plant; and the Stutz company manufactured a line of cars conforming to the results of that collaboration.

Meantime, Booth had applied for a patent based on the designs which he had disclosed to the old Stutz management; and, upon issuance of his patent, he sued Stutz for patent infringement and for violation of confidential disclosure. Though it was held that Booth's patent was invalid for lack of invention over what had been known before his alleged invention, it was further held that, in certain other features for which Booth had failed to obtain patent protection, the Stutz car, built to the independent Stutz design, conformed to details, unconventional in automobile construction at the time and included in the Booth disclosures made before the change in Stutz management; and the Stutz company was held liable for heavy damages because of its use of those unpatented features which had been originally disclosed in confidence to the company by Booth.

The principle of the *Booth Case* has been followed in other decisions; and manufacturers therefore must be extremely wary of examining unsolicited disclosures from outside their own organizations.

Most large corporations do, and all manufacturers should, protect themselves rather elaborately against such results as those just outlined. Roughly stated, it is usually sufficient to set up

regulations such that, when a voluntary suggestion is received in the mail, it is referred to a purely clerical employee who immediately addresses to the submitter a carefully-drafted form letter which acknowledges receipt of the suggestion, explains that it cannot be given consideration on its merits in a "confidential" category, and encloses a form of waiver contract, together with a statement that, if the submitter will sign and return the contract, his suggestion will be considered by management, but that otherwise it will be filed without examination.

A patent lawyer is best qualified to prepare such a form letter and such a waiver agreement.

C. PATENTS AND APPLICATIONS AS DEFENSIVE MATERIAL

Although, contrary to a widely-held misapprehension, ownership of a patent does not ensure the right of the patent owner to manufacture, use or sell the subject matter disclosed or claimed in the patent⁴⁶, patents and applications therefor do have substantial defensive values. In the case of Johnny Ug and Willie Lug, for instance, Willie's innovation, if it could have been freely manufactured, would have driven Johnny out of business quite promptly. But, since Johnny's patent was unexpired, he had trading material with which to keep himself in the field. Similarly, Willie's patent was a lever which enabled him to force Johnny to grant a license to Willie under the earlier wagon patent, thus making it possible for Willie, too, to go into business.

Even applications for patent have their value. First of all, there is an appreciable "prestige value" which clings to the "Patent Pending" legend. Additionally, that legend is at least a slight deterrent to prospective competitors. But still further, the act of filing an application for patent automatically establishes a substantially self-proving record of completion of the invention disclosed therein. For the last reason alone, many manufacturers make a fixed practice of filing an application for patent on every structure which they decide to build and offer for sale and which differs in any significant detail from structures previously actually known to them.

Of course, since patent Examiners are human, there is always a possibility that a patent may be granted on a feature of supposed novelty even though its character may be such that, in the opinion of counsel, it "does not rise to the dignity of patent-

⁴⁶ *Supra*, p. 578.

able invention". But even if no patent results from such an application, the above-mentioned dated, readily-proved record has been established, and that record will remain available, in the archives of the Federal Government, for at least twenty years.⁴⁷

Let us suppose that manufacturer A introduces a new product to the market and, because his attorney is of the opinion that it lacks any substantial degree of patentability, he decides not to file an application for patent on it. Some years later, B independently conceives substantially the same thing and does file a patent application. The application comes before Examiner C who, because he has no way of knowing about A's commercial product, and because he makes an incomplete search of prior patents or because he happens to be personally impressed with the cleverness of B's slight improvement over what has been known before, or is "snowed under" by the vigorous prosecution-technique of B's patent solicitor, grants a patent to B containing claims which "cover" A's commercial product. B, with his new and shining patent figuratively in hand, charges A with infringement of B's patent right.

A, of course, replies that he has been making the accused structures for years and since prior to B's invention date, but B says "Prove it!"; and, since the records of most corporations are destroyed after three years, that may not be easy to do. Consequently B sues and A is put to legal proof of his priority. If he can't prove completion of the invention prior to B's completion date, or public use or offer for sale of physical embodiments of the invention more than one year prior to B's filing date "beyond a reasonable doubt", A may actually lose, be enjoined from further "infringement" and be mulcted in damages. Even if he succeeds in his proof, A will have spent thousands of dollars in litigation expense.

If, however, A had filed, at a cost of a few hundred dollars, an application for patent on the new device at about the time when he introduced it on the market, then even if that application had come before Examiner D who had refused to grant any patent on it, and even though Examiner C might still have granted a patent to B, A's position would have been substantially improved. For when B said "Prove it", A could have obtained from the Patent Office, at a cost of only a few dollars, a certified copy of his abandoned application which, alone, would have constituted incontrovertible evidence of the fact that A had com-

⁴⁷ Patent Office Rule 14 (1955).

pleted the invention in question at least as early as the official filing date of A's application. Almost certainly the production of such a document would have dissuaded B from filing suit; and even if B had sued in spite of it, A's defense could have been based on that document alone and thus would have been immeasurably less expensive and more certain.

D. REISSUE OF PATENT

The term of a United States patent is seventeen years from its date of issue,⁴⁸ and that term cannot be renewed or extended except by special Congressional action directed to the specific patent. However, if it is discovered, after issuance of a patent, that, through inadvertence, accident or mistake, it does not effectively provide the protection to which the patentee is entitled, the Commissioner has the power, upon a proper application, to grant a reissue of the patent, correcting the fault which has rendered it so ineffective.⁴⁹ The original patent must be surrendered upon the filing of an application for reissue, and the new application is subject to examination *de novo*. If the reissue is granted, a new document is delivered to the applicant, showing on its face the fact that it is a reissue, the number and issue date of the original patent for which it is a substitute, and the differences between the original patent and the reissue. The term of a reissue expires on the date on which the corresponding original patent would have expired.

IV. OTHER PROTECTION FOR INDUSTRIAL PROPERTY

Thus far, this article has dealt primarily with "patents of utility". Under separate statutes, the Patent office grants, also, patents for designs and patents covering certain types of vegetation. Most patent lawyers are versed in the laws relating to these additional types of patents, as well as in the laws of trademarks and copyrights, and are equipped to advise and assist clients in connection with their rights under those laws.

A. DESIGN PATENTS

Under the design patent statute,⁵⁰ patents are granted to protect the aesthetic values, or "eye appeal" of articles. Utility or

⁴⁸ 35 U.S.C. 154 (1952).

⁴⁹ 35 U.S.C. 251 (1952).

⁵⁰ 35 U.S.C. 171 (1952).

the mode of cooperation of parts are of no moment in determining the patentability of a "new, original and ornamental design for an article of manufacture". A design, to be patentable, must differ from previously-known designs to a degree requiring the exercise of invention as distinguished from the ordinary skill of the calling; but the standard of "invention" applied under the design statute is somewhat less stringent than that applied to patents of utility.

A design patent may be issued for a term of three-and-one-half years, of seven years or of fourteen years at the election of the applicant made prior to issuance,⁵¹ the Patent Office fees being graduated in accordance with the elected term.

A design patent will be infringed only by an article which is substantially identical in appearance with the patent disclosure. The usual test is: If the average individual who sees the patented article one day and sees the accused article the next day would think that he had seen the same thing on both occasions, then and only then does the accused article infringe the design patent.

B. PLANT PATENTS

A plant patent will be granted to one who "invents or discovers and asexually reproduces any distinct and new variety of plant . . . other than a tuber propagated plant or a plant found in an uncultivated state".⁵² Its term is seventeen years from its date of issue, and it will be infringed by the asexual reproduction of the plant covered by the patent or by the sale or use of the patented plant so reproduced.⁵³

C. TRADEMARKS

Generally speaking, a right to the exclusive use of any mark which is capable of identifying the goods of one trader and distinguishing them from the goods of other traders, is acquired by the act of adopting and using such a mark.⁵⁴ This principle comes to us, of course, from the common law of unfair competition or "palming off". Once such a mark has been adopted and used in commerce, it may be registered in most of the individual States,

⁵¹ 35 U.S.C. 173 (1952).

⁵² 35 U.S.C. 161 (Supp. V. 1958).

⁵³ 35 U.S.C. 163 (1952).

⁵⁴ *U.S. v. Steffens*, 100 U.S. 82 (1879); *Morse v. Steccone*, 86 F.Supp. 796 (D.C. Cal. 1949).

provided it is not deceptively similar to a mark previously so registered to another trader in similar goods. Again speaking generally, State registration warrants the use of the legend "Trade-mark Registered", but accomplishes very little more.

Federal registration of a mark on the Principal Register, on the other hand, confers substantial substantive rights upon the registrant, and is almost invariably worth while if it is available. An absolute prerequisite to an application for Federal registration is use of the mark on or in connection with the goods or services in commerce between the States, with foreign countries or with Indian tribes.⁵⁵ Further, a mark to be Federally registrable must generally be neither primarily merely descriptive nor deceptively misdescriptive of the goods, it must not be primarily merely a surname or merely geographical, and it must not be scandalous or the individual name of any living person without that person's written consent. Of course, it must not be deceptively similar to any mark previously registered to another.

Not only trademarks but service marks, collective marks, and certification marks may be Federally registered; and, under certain circumstances, even descriptive marks and surnames may be entitled to registration. Additionally, a Supplemental Register⁵⁶ is maintained for the registration of marks which "may consist of any trademark, symbol, label, package, configuration of goods, name, word, slogan, phrase, surname geographical name, numeral, or device or any combination of any of the foregoing" which is capable of distinguishing the applicant's goods or services. Registration on the Supplemental Register does not carry with it all the benefits of registration on the Principal Register.

In all cases, interstate use, or use in trade with foreign countries or with Indian tribes, must precede application for Federal Registration because of the Constitutional limitation upon the powers of the Federal Government.

After Federal registration, the trademark owner is entitled to use the symbol "®" in connection with his mark⁵⁷; or, if he prefers, he may use the legend "Trade Mark Registered U.S. Patent Office", or "T.M. Reg. U.S. Pat. Off." which became familiar under the statutes in effect prior to 1947.

⁵⁵ 15 U.S.C. 1051 (1952).

⁵⁶ 15 U.S.C. 1091 (1952).

⁵⁷ 15 U.S.C. 1111 (1952).

The term of a Federal registration is twenty years,⁵⁸ and it is renewable for a like term at the end of each term,⁵⁹ for so long as the proprietor continues to use the mark.

Before the Patent Office actually grants registration of any mark, it publishes the mark in the Official Gazette,⁶⁰ a weekly periodical for which the public may subscribe and which carries, as well, an abstract of every patent issued that week. Anyone who feels that he would be damaged by the registration of any mark so published may file in the Patent Office, within thirty days from such publication, a Notice of Opposition to such registration.⁶¹ If such a Notice of Opposition is filed, the Commissioner will withhold registration of the opposed mark until, in an *inter partes* proceeding, the merits of the controversy have been determined. If no such Notice is filed within the prescribed period, the registration will be granted. This opposition procedure is not, however, available as to marks for which registration on the Supplemental Register is sought.⁶²

A registered trade mark will be infringed by the use of a deceptively similar mark by another on or in connection with the sale of goods or services of such character as to be likely to mislead prospective customers for such goods or services into the supposition that such goods or services have a common source of origin.

Licensing others to use a trademark is a ticklish matter and, if improperly handled, may result in complete destruction of the exclusive right. *It should never be undertaken except by counsel thoroughly informed and skilled in the law of trademarks.*

While trademark practice is considerably less complex and technical than patent practice, it does require specialized knowledge which, in most cases, is foreign to the practice of the general lawyer.

D. COPYRIGHT

The right to reproduce an original work of literature, music, painting, sculpture, photography or the like is inherently exclusive to the originator until such work is made public; but once

⁵⁸ 15 U.S.C. 1058a (1952).

⁵⁹ 15 U.S.C. 1059 (1952).

⁶⁰ 15 U.S.C. 1062a (1952).

⁶¹ 15 U.S.C. 1063 (1952).

⁶² 15 U.S.C. 1092 (1952).

it has been made public that inherent right disappears. The copyright statute⁶³ provides a means whereby the originator of such a work may retain a right to exclude others in spite of publication.

The procedure for acquiring copyright protection is quite different from that relating to patents or trademarks. The first step required under the copyright statute, as to most categories of works, is to *publish* the work *with claim of copyright thereon*. Such claim must be precisely in one of several statutorily-prescribed forms, the best of which is "©" together with the year of first publication, the name of the copyright claimant and preferably the city of residence of the copyright claimant. Depending on the character of the work, the notice of claim must appear at specified locations on the work. Each published copy of the work, including the very first one, must bear the notice of claim.

Within a reasonable time after first publication, a specified number of copies of the work must be filed with the Register of Copyrights in Washington, together with a proper application for registration. If the application is in proper form and is accompanied by the appropriate fees, and if the work is proper subject matter for copyright registration, registration will usually be granted as a matter of course. It has been held that a delay of as much as seven years between first publication and application for registration was not unreasonable, in the sense of the statute.

The term of a copyright registration is twenty-eight years, and it may be renewed for one further term of twenty-eight years.

Copyright is exactly what the name implies — the right to *copy*. Novelty is not required, and no search to determine novelty is conducted by the Register. Similarly, the proprietor's right is violated only by one who *copies* the registered work or a substantial part of it. Thus, a copyright cannot be infringed by one who has never had access to the registered work or a copy thereof. Even one who, independently and without any knowledge of the registered work, might produce an exact duplicate of the registered work would not infringe the copyright of the proprietor.

⁶³ 17 U.S.C. 1 to 216 (1952 and Supp. V. 1958).

V. CONCLUSION

Necessarily, this article is filled with generalizations to which, in many instances, there are numerous exceptions. The leading work on patent law, which seeks to set forth all of the exceptions and ramifications of the subject, comprises more than three thousand printed pages,⁶⁴ and even it must be supplemented by numerous other texts if the law is to be fully comprehended. If the general lawyer, however, has here been given such a view of the high spots as will enable him to know when to advise his client to consult a patent lawyer, then the primary object of this paper has been accomplished.

⁶⁴ Walker on Patents (Deller ed., 1937, with 1957 Supp.).