PATENT LAW IN BRIEF.

A SUCCINCT TREATISE

ON THE

PATENT LAW OF THE UNITED STATES,

DESIGNED FOR

INVENTORS AND OTHERS INTERESTED IN PATENTS.

BY

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PREFACE.

It is not intended in this brief treatise to make the reader a patent lawyer; the attainment of that position requiring years of study and experience. But there are many intelligent inventors to whom a knowledge of the leading elementary principles of the patent law would be invaluable as a guide, and who vainly seek to acquire the same in the text-books; but these, abounding in refinements and technicalities intended only for the professional reader, naturally perplex and confuse one who is not a lawyer. Because of this fact, many inventors, anxious to learn the principles of the patent law, resort to the pamphlets issued from time to time by so-called solicitors, but such productions are neither serviceable nor correct.

The present treatise aims to plainly set forth, and correctly state in outline, the fundamental elements of patent jurisprudence now in vogue in the United States. It dispenses with all technicalities and subtleties, and yet embraces sufficient of the law to enable inventors to properly comprehend their rights, duties, and interests.

W. P. K.

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PATENT LAW IN BRIEF.

CHAPTER I.

HISTORICAL SKETCH.

THE Patent System, like the Right of Petition, Habeas Corpus, Trial by Jury, and many other great landmarks of Jurisprudence, is the direct result of determined measures resorted to by an oppressed people to abridge the rights of a tyrannical king.

From time immemorial, the English crown had claimed the right to create monopolies and royal grants for the benefit of favorite subjects, and although the injustice of the practice was apparent, still the right was never questioned, until the oppression became unbearable, when a bold stand was taken by the people to modify it. When the practice of making such grants first arose, does not clearly appear. It was in vogue under the ancient common law, though by that law grants in restraint of trade were illegal. The first monopoly of which there is any record was granted by Edward III, in the third year of his reign. Between that period and the reign of Henry VIII, comparatively few monopolies can be traced, and those that were granted appear to have been principally for new importations.

It was during the reign of Elizabeth, who lavished monopolies upon her favorites with an unsparing hand, that the privilege was most flagrantly abused, seriously

affecting, in consequence, the public trade of the realm. The patent rolls show that during her reign the commonest necessaries of life were the subject of monopolies, by which their cost was enhanced to a most burdensome degree. The preamble to these grants, as though apologizing for the flagrant wrongs they induced, usually set out some supposed public benefit as the occasion of the grant, as for instance a grant of a monopoly to sell playing cards was made because "divers subjects of able bodies which might go to plow did employ themselves in the art of making of playing cards."

These abuses led to many serious complaints in the house of commons, and angry debates took place, noticeably in the years 1565 and 1601, the latter year witnessing a proclamation which had some effect in checking the evils complained of, and some of the more odious monopolies were cancelled, others limited, and others again were left to the action of the ordinary law courts instead of the privy council, which body up to that time had sole jurisdiction in suits for their infringement.

The first recorded decision limiting monopolies was in the case of Darcy v. Allen, 1602, in which the court decided that "the king could grant to an inventor or the first importer of an invention from abroad, a temporary monopoly in his invention, but that grants in restraint of trade were illegal;" and this decision, though frequently evaded, was never overruled, and is the law of England to-day.

When James I came to the throne in 1603, imbued with the idea of the "divinity of kings" common to the Stuarts, he continued to grant monopolies of the most obnoxious character, and recognized no right in Parliament to restrain him. Many of his monopolies were however cancelled by Parliament. The king's arbitrary position

on the subject caused several bills to be introduced in Parliament, which resulted, after many attempts by James to compromise the matter by orders in council and promises, in the passage of the statute of monopolies in the year 1623. This act made all monopolies illegal except such as might be granted by Parliament, or were in respect of new inventions or manufactures. Upon the excepting clause of this statute is built the entire English patent system.

PATENTS IN AMERICA.

While the English patent system thus rests under the stigma of being the outgrowth of oppression, the American system, on the contrary, is the direct expression of the founders of our constitution for the advancement of the country's best interests. Patents in this country are not subject to the will of any ruler, but are recognized as property of the highest character. They are not monopolies in the harsh sense of the term, but the just compensation from the government to the inventor for his skill and labor and the benefit he bestows on society by making his invention public. The authority of congress to make laws for the protection of patent rights rests upon the federal constitution. Art. I, Sec. VIII. "The congress shall have power * * * to promote the progress of science and the useful arts by securing for a limited time to authors and inventors the exclusive right to their respective writings and discoveries."

Congress first exercised the power thus conferred, on the tenth day of April, 1790, by an act defining patentable subjects, and providing that they should be secured to the respective inventors by means of a written grant from the United States, to be named Letters Patent.

Though this act has been frequently amended and changed, the substance remains as originally enacted. The second act was passed February 21, 1793. Next followed the act of July 4, 1836, by which the patent office and the office of commissioner of patents were established. Under that act, patents ran for fourteen years, and a fee of $30 was required. Provision was also made in it for examination by the commissioner of patents into the novelty of an alleged invention. The act of August 29, 1842, made designs patentable. The next act, March 2, 1861, abolished extensions (created by the act of 1836), and made the term of patents seventeen years, the present term, and fixed the present fee $15, on filing application, and a final fee of $20. The act of 1870, and later acts, differ little from the act of 1836, and will be considered in detail in other parts of this book.

THE GENERAL NATURE OF PATENT RIGHTS.

Without discussing the question as to whether the inventor has a natural right to the exclusive use of his invention, consideration of which would involve divergence into the refinements of metaphysics and moral philosophy, the first principles of natural justice must dictate the equity of rewarding an inventor for his labor and the great benefit to society, and the great injustice of giving him no reward therefor.

The framers of our constitution, however, were not actuated by motives of philanthropy when they laid the foundation of the patent system. Their purpose was not to benefit inventors, but to improve and develop the country's resources. If therefore the original motive was a selfish one, the government must expect some benefit from in-

ventions; if the government *is* benefited, then it receives a consideration (the benefit), for which letters patent form the compensation, and for which the patentee is under no obligation, as he gives a greater benefit than he receives. Morse and McCormick are notable illustrations of the truth of this. For the invaluable benefits conferred upon the country by the electric telegraph and the reaper, it can hardly be claimed that the respective inventors were sufficiently compensated in the brief period of exclusive right to use and vend the same, given them by the government.

Patents being an absolute property, it follows that their owners cannot be interfered with in the enjoyment thereof without "due process of law," which means the judgment or decree of a court of the United States. The legislature cannot destroy or abridge a patent during the term for which it is granted, nor can the executive interfere in any way with the patentee's full enjoyment of his rights thus granted. The government has no more right to use a patented article without the consent of the patentee than an individual has. Patents cannot be interfered with by the legislature or courts of any State, nor has any State the right to tax any letters patent of the United States. A patent right cannot be seized under a common law execution for a debt, though it has been once decided by the Supreme Court of the United States that it can be reached by a creditor's bill under the general power of the court of chancery, notwithstanding which the author thinks that, on a properly presented case, that court would reverse its decision on that point.

CHAPTER II.

SUBJECTS AND REQUISITES OF PATENTS.

A PATENT is a deed of grant from the United States, which gives to the grantee, if he shall meet all the requirements of the law, the exclusive right to make, use, and vend to others to be used, the invention covered by the patent as set forth in the specification and claims attached thereto, for the term of seventeen years.

A patent is not conclusive proof of its validity for the term for which it is granted, because the inventor may do or fail to do many acts necessary, either anterior or subsequent to receiving his grant, that will render it invalid; but as the law presumes that the invention is a valid one, and that the inventor has complied with the law in all respects—for all persons are presumed in law to do their duty—the patent is evidence of its entire validity, till something is shown negativing that presumption.

The patent grant does not guarantee that the specification or claims attached to the patent deed, and made a part thereof, are correct, any more than an ordinary deed of land guarantees the validity of the title to the land it conveys. It only warrants the validity of the acts of the government; that the deed is properly executed in form, and that the government believes the inventor when he swore that he was the first inventor of the subject of the patent, and that it is one of the statutory subjects of a patent.

In the United States, to be the subject of a valid patent, the thing sought to be patented must be invented (not found), and must be an art, machine, manufacture, or composition of matter.

ART.

In the sense used in the statute, an art is a process or mode of producing a useful result, the discovery of which requires invention. In order to create a valid process there must be a rule for performing it, and the means employed must not be purely mechanical, for if a useful result is produced by a machine, the result, though useful, is not a process in the legal sense, but is simply the result or function of the machine. As for instance, a patentee of a machine for paring potatoes cannot exact royalty from all who pare potatoes, unless they use his machine.

A law of nature cannot be the subject of a valid patent, though the use of several principles or laws of nature for a particular purpose may be. For instance, the use of the electric current, combined with other laws, and certain mechanism, for the production of signals, created a valid patent, while a patent for the use of the electric current for making signals was declared void. In the one case several laws of nature were used for a specific purpose and for a specific result, produced in a certain way, while in the other case, the patent, if sustained, would have been a patent on the electric current, which, being a principle of nature, and one of the gifts of the Creator, cannot belong to any one, even though he may first discover it.

Every process must utilize one or more of the laws of nature, just the same as every machine must contain two or more of the six elements of machinery. But no one can obtain a patent on laws of nature or mechanical elements.

The rule by which to distinguish a process from a principle, is that the use of a specific principle or law of nature for any purpose, is not patentable, while the use of several laws of nature for a specific useful purpose, is patentable, if new, and if performed by a rule.

MACHINE.

A machine is a combination of two or more of the six mechanical powers, constructed to receive, apply, or impart motion. If an invention combines any two or more of the mechanical powers, to wit, wheel and axle, pulley, inclined plane, wedge, screw, or lever, it is a machine; if not, it is a manufacture or composition of matter.

MANUFACTURE.

A manufacture is anything produced by the hand of man, not a machine or composition of matter.

As a general rule, an invention is not injuriously affected by being called a machine, when it is a manufacture or composition of matter, and *vice versa*; but to *claim* one, when the other is meant, is generally fatal, and always dangerous. In one important case, a new process for spinning flax was discovered, by which a much finer manufacture was produced, at less cost than by the old way; through a mistake in draughting the specification, the patent was taken out on a "machine for spinning flax," and after years of litigation was declared void.

COMPOSITION OF MATTER.

This phrase includes all compositions of two or more composite things, whether solid or fluid, such as medicines, all kinds of powders, etc.

DESIGNS.

Section 4929, R. S., makes designs patentable. Under this provision of the law are protected patterns for wall paper, woven or printed goods, busts, statues, and other works of art, and forms of wearing apparel, furniture, glass and porcelain ware, shapes of vehicles, etc. Such patents are granted for three and a half, seven, and fourteen years, as the applicant may desire.

REQUISITES OF A VALID PATENT.

Any new and useful improvement of any of the statutory subjects of patents, is just as much an invention as the original creation; but the first patentee is entitled to a broad interpretation of his patent, therefore, many improvements that are patentable may be dependent upon some other patent, and incapable of useful operation without it.

A patent deed is no protection where the invention sought to be secured by it is wanting in any of the statutory elements necessary to the creation of a valid patent. A patent may be void for one or both of two reasons. First, where the invention sought to be secured by it is not a valid invention within the meaning of the patent law, though it may be novel; and second, where the invention is a valid one, but the patent is made weak by insufficient or unskilfully prepared specifications and claims. To constitute a valid patent, the subject of each of its claims must be able to withstand the tests of novelty, utility and invention. A claim for a combination that is not useful is void. Each claim taken by itself, if for a part of the whole combination, must contain enough elements to make a useful combination in itself, read in the light of the specifica-

tions and drawings only, without regard to the other claims.

Under the law, a patent, in order to be valid, must be for an *invention*, for a *new* and *useful* art, machine, manufacture or composition of matter, or a new and useful improvement thereof.

INVENTION.

First, there must be an invention. A mere aggregation, or a substitution of one element for another (except in some few special cases), is not an invention; nor is mere mechanical skill or mere mechanical improvement or ornamentation. There must be an actual new discovery, or valuable improvement of an old machine, or discovery creating a new combination, and the new parts must be clearly stated and explained in the specification, and distinctly set apart from the old parts in the claim, otherwise the patent is void.

NOVELTY.

Secondly, the invention must be *novel*. If it is not new, a valid patent cannot be obtained for it. An invention is not new where it has been substantially described in any printed publication; where it has been in public use or on sale for more than two years, or where it has been patented, unless the subsequent applicant can show that he made the invention prior to the application of the previous patentee. The invention may be new, though all the parts be old. A valid patent can be taken out for a new combination where all the elements of the combination are old, or are described in different combination in other valid patents. The description of the invention in a previous ap-

plication does not affect its novelty. Nor is it generally affected by a previously abandoned application. Novelty is not affected by anything occurring after the date of the invention, or by use for another purpose before the invention.

UTILITY.

Thirdly, the invention must be useful, and capable of practical application for a purpose from which some advantage can be derived. Mere use for some purposes is not sufficient, but it must be for a purpose beneficial to society. Thus, if an invention is useful, but is injurious or mischievous to society, it is not the proper subject of a patent.

WHY WEAK PATENTS ARE GRANTED.

Perhaps the most common questions put to a counsellor when he informs his client that his patent is weak, or void, are: "Why does the patent office grant weak or void patents?" "What protection is a patent?" Where the patent office grants weak patents, which are therefore no protection, the fault rests with the inventor, or his attorney, and not with the patent office. If an alleged invention described in an application for a patent contains the slightest novelty, the commissioner of patents is (in most cases) bound by law to grant a patent therefor. The use of different or cheaper materials, or the transposition of some of the elements of an old combination, may under some circumstances create sufficient novelty to warrant the commissioner in issuing a patent, if the applicant desires it, but such a patent, if attacked in court, could not withstand the tests of "invention," or the invocation of the principle of mechanical equivalents.

A United States patent is an absolute protection, if it is for a valid, statutory invention, and is properly described and claimed. The majority of inventions are valid, but comparatively few patents are. The fault with most patents, and the cause of defeat in court, grow out of badly written specifications.

CHAPTER III.

APPLICATION.

ANY person (citizen or foreigner, man, woman or child) who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not before known or in common use for more than two years next preceding the application for patent thereof, and not described in any printed publication, may, upon complying with the statute, on presenting a proper application, obtain a patent. If the inventor dies before making application, it can be made by, and the patent issued to, his executor or administrator, for the benefit of the inventor's heirs or legatees.

The application for a patent consists in a written petition to the commissioner of patents; the specification of the invention; the oath; the patent office fee; the drawing, where the nature of the case admits of a drawing; and in some cases a model; and where the invention is a composition of matter, specimens of the compound and of the ingredients must be furnished.

THE PETITION.

The petition is a communication addressed to the commissioner of patents, stating the name and residence of the inventor and requesting the grant of a patent to him for the invention described and claimed in the specification thereto annexed, or referred to therein by name, &c.

SPECIFICATION.

The specification is a written description of the invention, with proper reference to the drawings, sufficiently full and clear to enable others skilled in the art or science to which it relates, or with which it is most intimately connected, to make and use the same without further explanation, description or illustration.

The specification should begin with a preamble, which should state the name and residence of the inventor and the name of the invention, in order to connect it with the petition, and should state in what, if any, foreign countries, the invention has been patented, with the date of each foreign patent. If not patented in any foreign country it should so state.

Following the preamble there should be a general statement of the nature and function of the invention. Though important, and logically necessary, still the omission of such a statement will not destroy the validity of the specification, as it must appear in substance in the detailed description.

After the general statement there should be a short description of each figure of the drawing. This is of great aid in perfectly understanding it, and should always be inserted; if not, however, it may be gathered from the description, when no statutory provision is necessarily violated.

THE DESCRIPTION.

Next follows the detailed description of the invention, which MUST be FULL, CLEAR, CONCISE and EXACT enough to enable any person skilled in the art or science to which it appertains to make and use the invention. If the de-

scription is not thus perfect, the patent, if granted, will be utterly void, and the invention thrown open to the public. In case of a machine, the applicant is required (Sec. 4888, R. S.) to explain the principle thereof and the best mode in which he has contemplated applying that principle. The law does not compel him to explain infallibly the best of several good modes of operating his machine, but he must explain what he regards as the best mode, and the machine must successfully operate in the manner described in order to render his patent valid; because if the machine cannot be made to operate in any of the manners described by the inventor he has really invented nothing, but merely attempted to invent, to allow him to obtain a patent for which, would be to deprive others of a patent who may be able to make a valuable working machine. The description need not state every use to which the invention is applicable. It is enough to describe one particular mode by means of which the invention may operate with a beneficial result. The description is not defective because it fails to state something which contributes to the degree of benefit only, if the invention will beneficially work without it, though it may be desirable to have it inserted.

The description need not be sufficiently clear to enable any intelligent man to fully understand it, but only one skilled in that particular art. A patent for an improvement on a steam engine, for instance, need not be in such clear terms as to enable a person skilled in turbine water wheels to make and use it, but it must be so clear that any one familiar with the steam engine can clearly understand its nature and mode of operation. The use of technical terms in descriptions should be avoided so far as possible.

THE CLAIMS.

No matter how perfect the description of the invention may be in the specification, or how clearly it sets out the improvement and separates the new from the old, still, nothing described in any part of the application, or letters patent, is secured thereby, unless it is covered by a claim. The construction of the whole patent, therefore, depends upon the construction of the claims. The claims, however, are construed in light of the description and drawings, but no matter how much more comprehensive the description and drawings, they cannot enlarge the claims, though claims may be narrowed by limitations in the description.

Writing a claim requires more care and information, legal and mechanical, than is generally required for any other legal composition of ten times the length. Each word must be carefully considered and put in the right place, and its exact legal meaning and construction, both generally and in the light of the description of the particular invention, must be thoroughly understood. Each claim should be so perfectly drawn that if taken alone it would constitute a valid patent. It should be brief and to the point. A claim is not strengthened but weakened by the use of adjectives and adverbs, or by vague phraseology. The abhorrent practice ignorant solicitors of patents have of drawing unnecessary claims, and writing them in loose phraseology, hoping to strike the right combinations, though they have no idea how it should be done, cannot be too strongly condemned. It is not only calculated to deceive the public and cause unintended infringements, but often makes a patent void which would otherwise be valid.

The statute requires that the inventor "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention." To secure a particular part of a machine, a claim must specify that part; and to secure a particular combination of some of the parts, a claim must specify all those parts (and no more), and the description must explain their joint mode of operation and function. Where the invention is a whole machine, the inventor may (if the whole is novel) secure it by one claim, but it is not best to do so, as such a claim is easily evaded. The better practice is to make a separate claim for each new part or combination. A claim secures a process, machine, manufacture or composition of matter, and never the function, or result of either.

The applicant must sign his name at the end of the specification, in the presence of two attesting witnesses.

OATH.

The specification must be accompanied by the oath of the applicant, that he believes himself to be the first and true inventor of the invention or discovery described and claimed in the specification; that the same has not been in public use or on sale with his knowledge or consent for more than two years previous to his application, and that it has not to his knowledge been patented in any foreign country, except as stated in his petition for patent. In case of joint inventors the oath must be made by both. The oath must in all cases be made by the inventor (if he be living), even though the whole interest in the invention has been previously assigned; and if he be dead, it must be made by his executor or administrator.

THE DRAWING.

A drawing must be filed where the nature of the case admits of a representation by drawing. If it is not filed at the time, or before the specification is filed, the application is not complete, and no action will be taken by the patent office till it is filed. All drawings for the patent office must be exactly 10 x 15 inches, with a one inch margin line. The paper must be stiff enough to stand in a portfolio, and only India ink must be used. Each sheet must refer to the specification by letters or figures, and must be signed by the inventor or his attorney, in the presence of two attesting witnesses.

A model is not necessary unless called for by the patent office after the application is filed.

THE COMPLETED APPLICATION.

The petition, specification and claims, oath and drawings being completed and executed as required by law, must be filed in the patent office with fifteen dollars, first government fee, when the application will be deemed complete. If sent to the patent office by mail or express, the wrapper should be addressed in a plain hand to the Commissioner of Patents, Washington, D. C.

EXAMINATION, AMENDMENTS, ETC.

When such an application is made, if the subject is *prima facie* patentable, the commissioner of patents causes an examination to be made of the previous American, English and French patents, for the purpose of ascertaining whether the supposed invention is new; if so he causes letters patent to be issued to the applicant.

If an application for letters patent is rejected, it is the

duty of the commissioner to notify the applicant thereof, giving him the reasons for such rejection, together with such references and other information as may be useful to him in amending his specification, or judging of the propriety of prosecuting an appeal. After the first rejection the applicant may insist upon a rehearing; or amend so as to meet the objection made upon the first examination.

Though the right to amend applications for patent has never been established by statute, it has been the custom of the patent office since its foundation to allow amendments, and the right is now well established, not only by custom but by many decisions of the commissioner of patents and the courts. It is one of the most important rights to inventors, and one frequently exercised. The applicant may amend as often as the examiner presents any new references or other new reasons for rejection.

APPEALS.

Where an application has been finally rejected by the primary examiner, and the applicant believes that the examiner has erred, and that the claims are justified by the state of the art, or that the references cited by the examiner do not anticipate his invention to an extent sufficient to affect the novelty thereof, he may appeal to the board of examiners in chief. As a rule, if there is novelty in the invention, it is seldom necessary to take an appeal. The objections of the primary examiners can generally be met by carefully considered amendments or argument.

It is often, however, important to the inventor, in view of some rule of construction, or decision of a court, that the specification should contain certain statements, or that a claim in certain form be allowed, in which case, if the primary examiner finally rejects it, and there is any

chance of reversing his decision, an appeal, even to the last resort, may be the only way of securing the most valuable part of the invention.

Before an appeal is taken the application must be in such shape that if the decision of the primary examiner be overruled the patent can issue at once, as the only question that can be decided on appeal, is whether the primary examiner erred in refusing to allow the claim or claims in dispute. If his decision is reversed, the patent must issue on payment of the final fee. And if his decision is sustained the applicant must abandon the claims appealed on, or amend so as to conform to the references or reasons cited, and on which the application was rejected.

If rejected by the examiners-in-chief an appeal may be taken to the commissioner, and from him to the supreme court of the District of Columbia. If rejected there a bill in equity may be exhibited in any circuit court of the United States praying the court to compel the commissioner to issue letters patent for the invention described in the bill, and if satisfied that the petitioner is entitled thereto the court will enter a decree to that effect; if not the court will dismiss the bill, which is final. The costs of such proceeding must be borne by the petitioner, whether he prevail or not.

CHAPTER IV.

REISSUES.

THE statute provides, that "whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he has a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner SHALL, on the surrender of such patent * * * cause a new patent for the same invention, and in accordance with the corrected specification, to be issued to the patentee."

A review of the history of the law of interference is unnecessary for our present purpose. It is sufficient to say that the first act authorizing reissues was passed July 3d, 1832, in accordance with a decision of the supreme court in the case of Joseph Grant and others v. E. & H. Raymond (6 Peters' Repts. 243), and that the law has remained substantially the same since, with the exception of the third clause above quoted, which was added by the act of 1837.

Where the patentee has claimed more than he had a right to claim as his invention, the defect is generally cured by disclaimer, rather than reissue, as that remedy is both better and cheaper; therefore that provision of the act is more properly discussed under the head Disclaimer, chapter V of this book.

To entitle a patentee to a reissue, the patent must be either "inoperative," or "invalid," or both; and must be

so because of a "defective" or "insufficient" specification, which must be the result of inadvertence, accident, or mistake; and the reissue must be for the same invention as the original patent. Hence it follows that a reissue of a patent, not previously inoperative, or invalid by reason of defective or insufficient specification, the result of inadvertency, accident, or mistake, is void. Though all patents, to be reissuable, must be inoperative or invalid, still all patents that are inoperative or invalid are not reissuable. The patent may be invalid because of want of novelty, utility, or invention, in any of which cases a reissue is not proper, and if proper, would not be effectual, because a reissue cannot render a useless invention useful, or negative the want of novelty or invention, without making a new invention, which is forbidden both by the statute and decisions.

But the statute requires something more than inoperativeness or invalidity; it requires that such faults *must* exist by reason of a defective or insufficient specification, in order to entitle the patentee to a reissue. Every defective or insufficient specification will render a patent inoperative or invalid; but, as shown above, every patent that is inoperative or invalid, is not necessarily so because of defective or insufficient specifications. Therefore it follows that whenever a specification is defective or insufficient the patent is inoperative or invalid, and if such defects arose from inadvertence, accident or mistake, the statute has been complied with and a reissue is proper, and not otherwise.

The first question, therefore, to be answered before deciding whether a patentee is entitled to a reissue is, whether the specification is defective or insufficient, and great care should be taken not to mistake a de-

fective or insufficient invention for a defective or insufficient specification; the statute provides a remedy for the latter, not the former. This mistake has been made repeatedly and has cost many inventors their patents.

The words "defective" and "insufficient" are used in the disjunctive in the statute, and therefore were not meant by the legislature to be understood synonymously. "Defective" means faulty; while "insufficient" means incomplete, ambiguous.

The reissued patent must be for the same invention described in the original specification. What changes or additions will be considered as forming a new invention, and therefore rendering a reissue void, will be discussed later on in this chapter.

The rule was for several years erroneously supposed by some lawyers to be, "that the patentee was entitled to claim anything in his reissue that he might have claimed in his original patent," in consequence of which many worthless reissues were taken out, which the courts must declare void when the same are brought before them, as they are clearly for different inventions from those described in the original specifications. The construction was most absurd, and had no reason to support it, though one or two decisions may have pointed that way, notwithstanding which any good patent lawyer would see such could not logically be the law. If such a rule were permanently established an unconscionable inventor could embody in his reissue all the improvements made after the original patent was granted, and that had been made after years of experiment, if justified by the state of the art, for if so justified he might have claimed them at the time of taking out the original patent, if they had been known, and whether or not they were known

to him is a matter only within his own mind and could not be disproved if sworn to. The law-makers never intended to open so wide a gate to fraud on the public, for such a law would have a tendency to discourage rather than "promote the science and useful arts," as no one would try to improve a machine when a previous patentee of another part thereof, could at any time spring up and claim it as his, and say that it was left out of his specification by inadvertence, accident or mistake.

The object of the reissue law is to allow honest patentees and certain persons claiming under them to correct defective specifications, wrong dates, clerical errors, etc., and not to aid applicants in making inventions, or giving validity to previously worthless ones, and thereby exclude all other honest experimenters from improving the art to which the invention belongs. If the reissue law had not been passed the courts of equity of the United States would have power to order the commissioner of patents to correct clerical and other slight errors in letters patent, by virtue of its general equity jurisdiction; and the object of the reissue act was simply to allow the same things, and nothing else, to be done by the cheaper and more expeditious procedure of reissue.

As has been before stated the only effective part of a patent, and the only part that secures anything to the patentee, is the claims; hence, if the claims are inoperative, the specification is defective, and the patent is thus "inoperative * * * by reason of an * * * insufficient specification," which being the case the patent is reissuable. This may happen where the inventor has described two or more inventions, which could legally have been made the subject of one patent, but has failed to claim one or more of those inventions. In such a case the patent is *inopera-*

tive as to the unclaimed parts, because of an insufficient specification; but the specification is not invalid for that reason, for it claims one valid invention, and the inoperative description of the other inventions or combinations is simply surplusage and abandoned to the public, unless speedily reissued. A reissue for such inoperativeness is called a broadened reissue, which will be meant hereafter whenever the term BROADENED REISSUE is used.

A patent on the other hand is *invalid* because of ambiguity in the specification. There are two kinds of ambiguity, to wit: *patent* ambiguity, which occurs where an instrument is void on its face, and no construction can make it valid; and *latent* ambiguity, which occurs where an instrument is void or illegal, but such illegality is not apparent, and can only be ascertained by a legal construction of the instrument. Letters patent may be a patent ambiguity when lacking in any of the statutory requirements to a valid patent, appearing on the face of the instrument, *e. g.*, want of the signature of the secretary of the interior, or of the commissioner of patents, or of the inventor; want of seal; absence of witnesses to the signature on the drawings, or to the specification; and similar defects, the result of inadvertence or accident. A latent ambiguity generally occurs from mistakes, as where the description is not sufficiently clear; or where unnecessary elements or ingredients are described as essential; or where different elements or ingredients are mentioned as being equally good, when in fact some of them cannot be effectually used; or where the claims are nebulous, though not on their face invalid; or where any other similar defect exists. Ambiguity arising from any of the causes above described, and similar causes, will render a patent void until corrected by reissue or disclaimer.

Where a patent is invalid solely because of an ambiguous description of the invention, a reissue, if the claims are not broadened, cannot injuriously affect any rights of the public; for though the description may not have been perfectly clear, it was sufficiently full to warn all persons experimenting in that art and put them on inquiry. The absence of a seal or signature, likewise, though rendering the patent void, unless corrected, is apparently on its face an accident or mistake, and one for which the statute gives a remedy; but when the claims are broadened the rights of the public may be seriously infringed by the government securing to the patentee something that the public had good reason to think had been abandoned to it.

REISSUES REVIEWABLE IN THE COURTS.

The supreme court has never decided whether the decision of the commissioner of patents, in granting a reissue, is conclusive proof that the defects described in the statute existed in the surrendered patent. The author has no hesitation in saying that in his opinion the decision of the commissioner is not conclusive, but is clearly reexaminable by the courts. Though it has been decided at circuit that the court had no authority to review his decision, there are as large a number of equally authoritative decisions the other way; and besides which, the supreme court has twice stated that the commissioner's decision is *prima facie* evidence that the statute had been complied with. If it is *prima facie*, it is only presumptive and not conclusive evidence. The acts of any public officer are *prima facie* evidence that the officer did his duty in perform-

ing such acts, but the court can always inquire into their legality where the same are put in issue.

The statute provides that "whenever any patent is inoperative, &c., * * * by reason of, &c., * * * *that the commissioner* SHALL, on the surrender of such patent, * * * cause a new patent * * * to be issued." He is invested with no discretion, where the applicant comes within the requirements of the statute, but must grant the reissue, and where he is not within the statute the commissioner has no jurisdiction. The statute does not say that he "may" grant it, but is mandatory—"he shall" grant it. Therefore, so far as the granting of reissues is concerned, his duties are purely ministerial.

If the courts have no right to review a reissued patent, they have no right to review an original patent, for in both cases the statute provides that the commissioner *shall*, upon the requirements of the statute being complied with, cause in the one case the original, and in the other case the reissued patent to issue. Section 4916, Revised Statutes, provides that where the statutory defects exist, the commissioner "*shall*" grant a reissue; and section 4893, that where an original application is made, the commissioner shall cause an examination to be made, and if found that the applicant is entitled to a patent, he "*shall*" issue a patent. In each case he is compelled to grant a patent, where the statutory requirements are met, or statutory defects exist, and has no jurisdiction otherwise.

If the court can review his examination in original applications, and inquire into the question of novelty (which he is especially directed to inquire into before granting patents), and declare the patent invalid, notwithstanding his decision, which, as every one knows, is constantly being done, why has not the court the right to in-

quire into the question of inoperativeness of the original patent, and declare the reissue void, when the statutes are both mandatory and substantially the same?

To say that reissues are conclusive evidence of the statutory defects in the original letters patent, and cannot be reviewed by the court, is to say that reissued patents depend entirely upon the will of the commissioner. If reissues depend upon his will, then original patents must also, which, being the case, the commissioner is the sole judge of his own jurisdiction, and all patents issued by him are conclusive proof that they are novel, and rightly issued; in which event patents at once become odious monopolies, instead of rewards to encourage the sciences and useful arts, as they are declared to be by the constitution.

The question is one of the most important in the patent law, and when decided in the affirmative by the supreme court, as it will unquestionably soon be (there being two cases now pending there involving this point), will have the effect of invalidating about nine-tenths of the reissued patents now in existence, which must work many individual hardships, as some invalid reissues have no doubt been honestly accepted or purchased by their inventors or owners, though in the majority of cases they were taken out to deceive the public. But the hardships wrought by the settlement or construction of the law cannot be considered by the court, and if they could be, are secondary and unimportant objects, when it is taken into account that to hold the commissioner's decision final would be to deprive the public of valuable rights, wrongfully taken from it by the carelessness or mistakes of the commissioner of patents, or the misunderstanding or dishonesty of inventors.

All persons who have taken reissued patents have done

so with their eyes open. The lawful subject of a reissue is well defined by the statute, and easily susceptible of logical analysis. There is no excuse for a mistake. It was not designed to secure new improvements; the statute authorizing the embodiment of new improvements in old patents was abolished by act of 1861. Nor is it designed to antedate new inventions; but its design is to allow honest inventors and certain persons claiming under them, to correct defects caused by mistakes or ambiguities inadvertently inserted in, or omitted from, letters patent.

The warning note against the abuses of the reissue privilege was sounded by the supreme court more than twenty years ago, in which instances the court took occasion to pointedly and strongly condemn the practice, then lately sprung up, but now the almost established custom, of surrendering valid patents, and obtaining reissues, for the purpose of inserting later improvements or expanded claims.

That many patents have been reissued where the original patents were neither inoperative or invalid, and where the specifications were neither defective or insufficient, can admit of no doubt; and that each of those patents is void is equally certain.

EFFECT OF DELAY TO APPLY FOR REISSUE.

The supreme court struck an effectual blow at the abuses of the reissue act, in 1881, in the now famous case of Miller v. Brass Co., in which it was decided that the right to take out a broadened reissue is forfeited by any unreasonable delay in making the application, and the laches is reckoned from the date of issue of the original patent, and not from the date of discovery of the defects,

as was formerly supposed to be the law. This decision was rapidly followed up by four others to the same effect, and is undoubtedly the established law on the subject.

What lapse of time is sufficient to destroy the right to a broadened reissue is not made clear by any of those decisions, but from the reasoning of the court it would seem that no such application can, under any circumstances, be made more than two years after the issue of the original patent, and that the right will be destroyed under some circumstances by a much shorter delay. The following extract from the decision states sufficient to justify the above assertion: "Where a specific or combination is claimed, the non-claim of other devices or combinations apparent on the face of the specification, is, in law, * * * a dedication of them to the public, and will so be enforced, unless he, with all due diligence, surrenders his patent for reissue, and proves that his omission to claim them arose wholly from inadvertence, accident or mistake. * * * Such lapse of time as indicates his want of due diligence is fatal, and the reissue, if granted, will be void. * * * Two years' public use and enjoyment of an invention, with the consent of the inventor, is evidence of abandonment, and a bar to application for patent. A public disclaimer in the patent itself should be construed equally favorable to the public."

The decision just quoted from is a most important one. Its effect will be, and has been, to render void some of the most profitable patents in the country, and throw open to the public many valuable inventions, of which the owners theretofore had monopolies, and could have continued to have, were it not for their carelessness, dishonesty, or ignorance of the law.

NO NEW MATTER CAN BE ADDED.

It is provided by section 4916 of the Revised Statutes, among other things, "but no new matter shall be introduced into the specification, nor in case of a mechanical patent shall the model or drawings be amended, except each by the other." By "new matter," the statute is not to be understood to mean that new words, clauses or paragraphs cannot be added, for in fact the whole specification and claims may be re-written in a proper case; but the description of no new substance, element or combination can be introduced, nor can anything else be added or taken away from the former description by reason whereof a substantially new invention is produced. As for instance, one element of a combination cannot be substituted for another in taking out a reissue, for by such a change, if a new invention is produced, the new combination should be made the subject of a separate patent if sufficiently novel and useful to be made the subject of a valid patent, and if such substitution does not create a new invention it is unnecessary to put it in the reissue, because it will be secured by the original patent, on the principle of mechanical equivalents.

If a patentee desires to alter his invention by the insertion in the specification of a reissue patent of new elements, or by the substitution of elements or specifics, he desires to do so because he believes that such addition or substitution would give him a broader or better patent, and that very belief is proof that he desires to secure by reissue a different invention from that described and claimed in his original specification, which is an express violation of the statute. For, if the substitution be not a substantial change its insertion in the reissue is

unnecessary, because the substituted element was secured by its equivalent being claimed in the original patent, and the mere description and claiming of it in the reissue can impart no new strength to that instrument; and if it be a substantial improvement it is a different invention, and should be embodied in new letters patent, and not in the reissue.

Therefore it may be stated as a general rule that any material alteration of the description in reissuing a patent, whether by addition, subtraction or substitution, cannot enlarge or improve the invention without invalidating the reissued patent. Reissue may improve a patent, but never an invention, without rendering the patent void. Where certain things were claimed in combination in the original patent, one or more of them may be claimed separately in the reissue, where the parts so claimed are patentable inventions, and could have been thus claimed at the time of taking out the original patent. So also things claimed separately in the original may be claimed in combination in the reissue. Either in the specification or claims any elements properly set forth may generally be transposed without danger.

CANNOT REISSUE ON DRAWINGS.

Though it has never been decided by the supreme court whether a reissue can be supported on the drawings or model alone (*i. e.*, something shown in the drawings but not described in the specification or claims), still there can be no doubt—for many reasons—but that the clause in the statute, "no new matter shall be added," referred to the specification and not to the drawings or model.

Only that part of the drawings which is described in the specification by letters or figures of reference, or otherwise

specifically described, is any part of the specification. It is a common thing for inventors to show imperfectly conceived and impracticable supposed modifications of their inventions in drawings. This is done for one of two stupid or dishonest reasons; first, because they think their inventions will not be understood by the patent office unless shown in all possible positions; or, second, because they are dishonest or stupid enough to think that by showing parts, combinations and modifications which they cannot claim, they can thereby secure at any subsequent date, by reissue, any improvements that may be made by ingenious experimenters in the particular branch of science to which their inventions relate.

It was formerly the rule in the patent office to allow a patentee to go into interference with a subsequent applicant for patent, where the patentee had shown something in his drawings but had failed to claim it, upon the ground that the patentee was entitled to a reissue for the parts so shown, and being entitled to such reissue was entitled to notice of the subsequent application, to the end that he might go into interference at once instead of waiting till he should make application for reissue.

That supposed principle of law was for many years the subject of old rule 94 of the patent office, which was modified in 1881 upon a decision in the following case, in which the author was engaged: In 1879 a patent was taken out for certain improved mail bag fastenings. In order to show the utility and simplicity of their invention to a better advantage, the patentees showed certain modifications of the bag itself, which modifications or arrangements were subsequently made the subject, with many other elements, of a valuable invention in mail bags, with which the above mentioned fastenings

could be used to great advantage. Upon the second application being filed, the office notified the patentees of such filing, and allowed them to go into interference with the applicant. At this point the author was engaged by one of the applicants as counsel, and at once took the position that the rule was not authorized by any statute then in force; that the drawings were no part of the "description," within the meaning of the reissue law (on which the rule was based). That the drawings and model were both matters of record to aid the public and the patent office officials in understanding the working of the invention. After several appeals, re-examinations and arguments, the case was finally, in October, 1881, appealed to Secretary Schurz, on the single issue whether rule 94 was authorized by any statute, which he decided in favor of the applicants, and ordered the patent to issue and the rule to be ma[illegible], which was accordingly done November 1st, 1881.

A drawing is only an illustration of the invention, which makes it more readily understood by the patent office and persons who desire to make the invention after the patent expires. It is only a part of the specification, in so much as it is referred to by the specification, and the latter cannot easily be understood without it; therefore only that part of the drawing illustrating the invention described and claimed is a part of the specification, and that only for the reason that without the drawing or that part of it described, the specification would be ambiguous and might mislead the public. For example, if a new bridle is invented and the inventor choses, for the purpose of making a better drawing, or illustrating the application of his invention, should show a horse in full harness, would any one pretend to claim the horse or harness as a part of the patent if issued for such bridle; or claim that if an appli-

cation for patent were made for an improved harness, that the patentee of the bridle would be entitled to go into interference with him; or that the patentee would have a right to make application for reissue for any subsequent improvement that he might make on harness? Though there may be no case on record where it was endeavored to carry the principle that far, still it is the same principle, and in practice there would be no point at which the line could be drawn, for if allowed in one case it must be allowed in all cases, and indefinitely.

An applicant for patent is compelled by section 4888 to "particularly point out and distinctly claim the part, improvement or combination which he claims as his invention." By the next section he is compelled to illustrate his invention by a drawing, where the nature of the case admits of a drawing. If he claims a patent for improvements in the gates of water-wheels, he is only required to show the gates, and not the whole wheel; and if he clearly illustrates the gates, and chooses in addition thereto, to show a plan view of the wheel, he cannot thereafter, for that reason, come into the patent office and demand a reissue, covering the horizontal plate and the means of supporting the gates, because he happened to show some kind of a horizontal plate, and showed that the gates were in some way supported and pivoted.

It has just been decided in an important case in the circuit court for the Southern district of New York, that where in the original patent the patentee showed certain levers in his drawing, but failed to describe their function in the specification, that he could not subsequently describe their function in a reissue.

Nor is the rule different in the case of a model, though a noted and logical text writer on the subject attempts to

draw a distinction, principally because drawings are extensively published and models are not, and that models may be surreptitiously altered in the patent office. Though copies of all drawings are sent to public libraries, are sold to any person who wishes them, and attached to the original letters patent, still all of those acts are not sufficient to make the drawing anything more than a public record, which the model is also. A thing cannot be more public than public. A drawing may be more extensively circulated than a model, but it is not any more a public record than a model. If a patent could be reissued on a drawing solely, there is no reason why it should not be reissued on a model also, for one is as much a part of the application as the other, except the part of the drawings specifically described. But let the reasons be as they may, it is neither proper or necessary to discuss it here, for the law no doubt is that *a patent cannot be reissued on a model alone.*

CHAPTER V.

DISCLAIMER.

It is provided by the act of July 8, 1870 (sect. 4917, R. S.), that whenever, through inadvertence, accident or mistake, and without any fraudulent or deceptive intention, a patentee has in his specification claimed more than that of which he was the first inventor, his patent shall not be void therefore, if the part invented be a substantial and material part of the invention, but that the patentee or his representatives may enter a disclaimer of such parts of which he was not the inventor, and that such disclaimer shall thereafter be considered a part of the original specification, provided such disclaimer be entered within a reasonable time.

EFFECT OF DELAY.

What constitutes unreasonable delay in filing a needed disclaimer will depend more or less upon the circumstances of each particular case, and no certain rule can be laid down by which to determine what length of time the courts will consider proof of unreasonable neglect on the part of the disclaimant. If the defects are very glaring, it is the plain duty of the owner to enter the disclaimer at once. In ordinary cases, the delay commences from the time at which knowledge of the need of the disclaimer is brought home to the person entitled by law to file it. This knowledge, however, may be constructive as well as actual, as for instance, proof of knowledge by disclaimant of a

previous valid patent, legally claiming one or more of the combinations claimed in the patent in dispute, or proof that after further experiment he found that some of the specifics or ingredients described would not answer the purpose set forth for them in the specification, or any other circumstances clearly showing that the owner of the patent in dispute had notice of facts sufficient to warn him that his patent was defective by reason of too much having been claimed. But the proof must be clear and certain as to the circumstances relied upon, and they must be at least sufficient to put an intelligent person, familiar with the art, on inquiry, and considerable time must have elapsed since he became possessed of such knowledge.

Inasmuch as no suit can be maintained if brought on a patent where the owner thereof has unreasonably delayed in filing a needed disclaimer, it follows that proof on part of the defendant, in an infringement action, that plaintiff has thus unreasonably delayed, will be sufficient to defeat the action. Where defendant shows that a disclaimer by plaintiff is necessary, but does not prove unreasonable delay, the plaintiff may file his disclaimer while the action is pending, but if filed then, he will lose all his costs, even though he may recover damages.

WHAT MAY BE DISCLAIMED.

The remedy by disclaimer may be resorted to whenever "a patentee has claimed more than that of which he was the first inventor," therefore it can only cure such defects as can be cured by simply expunging something from the specification, and not by substitution or addition. Anything described in the specification, of which the patentee

was not the first inventor, may be taken therefrom by disclaimer, provided the remainder be a substantial part of the alleged invention and the proper subject of a patent.

A claim void for want of either of the statutory requirements of *invention* or *novelty* may be disclaimed. If void for want of *utility* only, it is not necessary to disclaim; for if there is but one claim, and that is void for want of utility, there is not a valid patent, and a disclaimer will not help it, and if part only of the claims are void for that reason and no other, and the remaining claims are valid, a disclaimer is not necessary, because the useless claims do not injuriously affect the valid ones. Part of a claim may be disclaimed where the part disclaimed and the part retained are clearly distinguishable from each other.

WHO MAY DISCLAIM.

A disclaimer may be filed by the patentee or his assignee, whether of the whole invention, an undivided part, or territorial interest, and will thereafter be considered as part of the original specification to the extent of the interest owned by the disclaimant at the time of the disclaimer.

The effect of a disclaimer is merely to strike something out of the specification, and it is a rule that the part so struck out cannot afterwards be read in explanation of what remains. This rule was established years ago in England, and has been followed by the courts of the United States in many cases.

CHAPTER VI.

ABANDONMENT.

ABANDONMENT of an invention is fatal to any patent that may be granted for such invention. Abandonment is either actual or constructive. Actual abandonment is generally the result of intention, or the relinquishment of all hope or desire to obtain a patent for the invention. Constructive abandonment generally results from carelessness or neglect on the part of the inventor, which ensues by the operation of some statute. Actual abandonment seldom becomes the subject of judicial inquiry; but when it does, it can be proved by the declarations of the inventor, made either in writing or verbally, or by proof of things done by the inventor, inconsistent with any expectation of ever obtaining letters patent; but where it requires proof by circumstances, or proof showing an abandonment by operation of law, it becomes constructive.

The presumption of abandonment is raised by long delay in applying for letters patent, but that presumption can be rebutted by proof of any circumstances consistent with an expectation of ultimately securing a patent, as for instance, extreme poverty, mental disorder, constant experiments of the inventor in perfecting or improving his invention, and the like; in fact, any incident tending to show that he expected to obtain a patent, will remove the presumption, for the law favors inventions, and encourages experiments, and will not deprive the inventor of the benefits of his invention, where the delay is caused

by circumstances over which he had no control, or where it is the result of honest experiment with a view to improvement.

If an inventor allows his invention to be used by others, whether with or without profit, or uses it himself for profit, he will be considered to have abandoned it.

Use for experiment is not public use, and such use need not be conducted secretly. Where the invention is such that its utility can be tested only by long use and exposure, as a windmill, waterwheel, pavement, and the like, such use is not public use, within the meaning of the statute. In a recent case it was decided that continued use for many months of a number of mail-bags, was not abandonment, as the use was for the purpose of testing the practical utility of the invention, and aiding the inventor in making improvements.

The sale of one specimen of the invention, occurring more than two years before the application for patent, is sufficient proof that it was on sale within the meaning of the act. A conditional sale of specimens of the invention is equally fatal, unless clearly shown that it was for the purpose of experiment.

Where a patent has been allowed, and the inventor has failed to pay the final government fee within two years after such allowance, it is conclusive proof of abandonment.

ABANDONED APPLICATION.

As in the case of invention, an application may be actually or constructively abandoned. An actual abandonment of an application will necessarily work an actual abandonment of the invention; but a constructive abandonment of an application will not necessarily work a constructive abandonment of the invention.

Withdrawal of an application from the patent office is not necessarily an abandonment of the invention, if at the time of such withdrawal the inventor intends to file a new application, and actually does so, even though long after the withdrawal.

Nor is it necessarily an abandonment of an application to allow it to lay in the patent office for a long time without action after a rejection, if the applicant expected to obtain a patent, or was experimenting with view of improving the invention.

Presumptions arising from the above and similar neglect may be overcome by proof satisfactory to the commissioner that the delay was unavoidable, but the same question can be reviewed by the courts if ever put in issue in an infringement action.

CHAPTER VII.

INTERFERENCE.

It is provided by section 4918 of the Revised Statutes, that "Whenever there are interfering patents, any person interested in any one of them may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent, and the court * * * may declare either of the patents void in whole or in part, or inoperative or invalid in any part of the United States, according to the interest of the parties represented."

Interfering patents may issue from either of two causes: first, inadvertence or erroneous judgment on the part of the patent office; and second, because the subsequent patentee was awarded priority in a patent office interference.

The claims need not be identical in their wording in order to interfere, but if they are for substantially the same combination, there is an interference.

Where two or more patents have one or more claims in common, they are interfering patents, and all but one of such patents are therefore void, as to the interfering claim or claims, though all of them may be perfectly valid as to other claims. An interference suit may be maintained by the patentee, or any assignee or grantee of the whole or part interest in either of the interfering patents, or any person claiming under them. The only question for the court to determine is priority of invention, and the only decree which the court can make, is one dismissing the bill, or

awarding priority to one of the patents, and declaring the others void in whole or in part, according to the interests represented in the action. A decree declaring both patents void (even though both may actually be void), is unauthorized by the statute, and cannot be made. If the court thinks both patents are invalid, a decree will be entered dismissing the complainant's bill, leaving the parties to test the validity of their patents in an infringement action.

WHO AFFECTED BY INTERFERENCE.

The only persons affected by interference proceedings are the parties actually before the court; for example, if A., the assignee of the right to manufacture under B.'s patents in the State of New York, should bring an interference action against C., a subsequent patentee, and the court should decide in favor of C., awarding him priority of invention, the decree of the court would only declare B.'s patent void as against A., and in the State of New York only, and B. and his assignees could still grant other State and county rights under his worthless patent, and practically defy the real inventor, or compel him to bring an action in every circuit in the country, in each of which actions the plaintiff would lose all damages up to the date of the decree. While this may work a great hardship in some cases, still it is a fundamental rule of equity that no person having a substantial interest in the subject-matter of a suit shall be affected by the decree of the court therein, unless made a party thereto, by service upon him of process. The justice of the rule cannot be questioned, and no one can doubt but that in most cases it proves most equitable. Notwithstanding which, however, there really seems no good reason for requiring a readjudication where the

patentee or assignee of the whole interest has been once before the court, and had a full opportunity of establishing the date of his invention, but such is the law. The only way to avoid the dangers and embarrassments described, is to act promptly and institute proceedings before the mischief is done.

FIRST PATENTEE.

The action may be brought by the owners or grantees of any one or more of the interfering patents, and against all persons interested in the other patents, who reside, or may be found in the district in which the suit is brought. If there have been no interference proceedings at the patent office, the presumption of invention is in favor of the first patentee; but that presumption is removed by proof on the part of the defendant that he conceived the invention at an earlier date than that on which the plaintiff alleges to have made his invention, and that he used due diligence in perfecting it.

SECOND PATENTEE.

Where the second patent was issued after interference proceedings were had at the patent office, the presumption is strongly in favor of such patent. The commissioner's decision in the office interference is the best evidence, but not conclusive. This presumption in favor of the second patent can be overcome by any competent evidence tending to show that the first patentee was the first inventor. Either party can be questioned on any matter sworn to by him in the patent office proceedings, or in any previous interference proceeding; and certified transcripts from such evidence may be used to contradict him.

THE ISSUE.

As before stated, the only issue in an interference cause is that of priority of invention, and the evidence must all be on that point. The defendant cannot set up want of utility, abandonment, want of invention, or any other defense that could be set up in an infringement action. Nor can he show that the invention was described in a printed publication before either patent was taken out, or any other matter or defense tending to affect the novelty, or otherwise invalidate either or both patents, except that the one is invalid, because previously invented by the first patentee; the party who fails in this, fails in the action.

The patent decided to be entitled to priority is still open to all the objections of want of novelty, utility and invention, in any infringement action subsequently brought on that patent, as fully as though the interference proceedings were not had, except that its novelty cannot be assailed on the patent with which it has been in interference.

INTERFERENCE IN THE PATENT OFFICE.

An interference in the patent office is a proceeding instituted to determine the question of priority of invention between two or more persons claiming patents for the same invention.

An interference will be declared between a patentee and a subsequent applicant for a patent for the same invention, or between two or more applicants claiming patents for the same invention, or between a caveator and subsequent applicant. Where the interference is between a patentee and applicant, or caveator and applicant for patent for the same invention, notice is sent by the patent

office to the patentee or caveator. All the parties must then file in the patent office a sealed preliminary statement, under oath, showing the date on which the invention was conceived, when the first drawing was made, and when the invention was reduced to practice. Time is then given each party within which to take testimony, and a day set for argument. The rights of the contesting parties are then decided by the examiner of interferences upon the testimony, and the patent adjudged to the prior inventor. An appeal can be taken to the board of appeals by any party to the proceeding who feels himself aggrieved by the decision of the examiner of interferences, and from thence to the commissioner of patents. There is no limit to the number of interferences, to which a patent or an application may be subjected.

The testimony adduced on either side must be on the one issue of priority only. The ordinary rules of evidence, such as to the production of the best evidence, the exclusion of hearsay evidence, and leading questions, etc., apply with full force in patent office interferences, which proceedings should be as carefully and as skillfully managed as though in court.

CHAPTER VIII.

INFRINGEMENT.

INFRINGEMENT of a patent is the unauthorized making, using, or vending to others to be used, an invention, or any material part thereof secured by a letters patent, during the term for which such patent is granted. The statute (sec. 4886, R. S.) gives to the patentee the sole right to make, use, and vend to others to be used, his invention, during the period for which the patent is granted. And hence, to constitute an infringement, one or more of those exclusive rights must be violated. It cannot be attempted, in a treatise of this brevity, to go into the refinements of the law of infringement; for such information the reader is referred to the text-books on that subject, or to the advice and services of skilled patent counsellors. It will only be attempted, therefore, to give the fundamental principles governing the law of infringement, by showing and explaining what constitutes an infringement, the principal defenses to an action for infringement, and other observations of a general nature.

If a patent is for a valid statutory invention, which is properly described in the specification and claims, it will fully protect the patentee's rights meant to be secured to him by the statute; but if wanting in any of those qualities, he must fail in an action brought on the patent, just the same as he would fail if suing on any other kind of an invalid contract. A patent is a contract with the government, whereby the latter, in consideration of the inventor at

once explaining, and at the expiration of seventeen years giving to the public his invention, with all privileges and benefits thereto belonging, grants him a monopoly thereof for that period. If the inventor does not fully explain and clearly claim his invention, or if he attempts to claim something of which he was not the first inventor, he commits a breach of his contract, which terminates it, and the government is no longer bound, either morally or legally, to protect him. The government tenders the inventor a valuable consideration for his invention, which it is ready and willing in good faith to pay him, and demands, as it has a right to do, like good faith on his part. The answer that the inventor intended to perform his part of the agreement, but did not because of the incompetency of his agents or attorneys, whom he intrusted to take out his patent, is no defense, because he is as fully responsible for the acts of his agent as for his own acts; and besides, the government gives him the remedies of reissue or disclaimer, by which he can cure any honest defects in his patent.

Presuming, now, however, that the inventor has a valid patent, and has complied with all the requirements of law in relation thereto, the law gives him the power to enforce his rights and punish those who fail to respect them, by an action in the courts of the United States, whereby he can recover damages for past infringements, and prevent further infringements and damage, by the writ of injunction.

ACTS CONSTITUTING INFRINGEMENT.

Any making of the patented article, except for experiment with a view to improving it, is an infringement, whether it be used by the maker or not. If the invention

be a machine, the making of any material part thereof is an infringement; or if it be any other of the statutory subjects of a patent, described in several combinations, the making of any one or more of the combinations is an infringement by the person so making. So, also, the using, although not made by the user, of a patented article, or of any material part or combination thereof, is an infringement. Where one makes and another uses, both are infringers. Where one knowingly contracts for articles to be made by a patented machine, he is equally liable with the maker for infringement. The use of articles made by a patented machine, where the user does not know of the infringement, will not make him liable; but the use of patented articles made by another, whether known or not, is an infringement. Where the patent is for a process, and articles of the same kind as made by the process are made or used, the law presumes that they were made by the patented process until the defendant shows that they were not. A mere variation in the mode is an infringement, so also where the same result is accomplished by a circuitous method, the patent is infringed.

ACTS NOT INFRINGEMENT.

It is no infringement to use a process which the patentee has kept back, though he may be the inventor. In case of a composition where the proportion of the ingredients are essential, it is no infringement to use them in different proportions, but otherwise where the proportions are not material. Where the patent is for a new combination of old elements, it is no infringement to use any or all of the elements, unless used in the same combination, and for substantially the same purpose.

DEFENSES TO ACTIONS FOR INFRINGEMENT.

If proved, any one of the following defenses will defeat an action for infringement: That defendant is not guilty of infringing as charged; that he acts under license from plaintiff; that plaintiff has not a good title; that the invention is not novel; that the invention was described in some printed publication, previous to the alleged invention by plaintiff; that the invention is not patentable; that it is not useful; that it is mischievous to society, and hence void on public policy; that the letters patent were not duly issued; that the specification is not intelligible; that the patent was surreptitiously obtained; that the patent has been abandoned to the public; that the reissued patent is not for the same invention claimed in the original patent; that plaintiff has failed to mark the articles "patented"; and any other matter touching the validity of the patent, or the right of the plaintiff to sue.

PRELIMINARY STEPS.

Though nearly every patent for an invention of any value is more or less infringed, still a suit is seldom necessary to stop the infringement, if the patentee has judicious counsel. It is always best to avoid a suit when possible, and the skillful counsellor will exhaust every other means in his power before bringing suit, unless the patent has been sustained by a decision of some court, in which case it is sometimes best to proceed at once by injunction; because, if notified of the intended action, the defendant may destroy evidence that would materially affect the result of the accounting or the amount of damages, by disposing of the machines or articles, or by destroying books, receipts, etc. In other cases, a suit should be avoided. In many instances

a positive letter, written by a counsellor of reputation, will result in an offer of compromise, either by payment of royalty, buying the patent, or a right under it, or by paying damages, which is better than the expense and risk of a suit, unless the amount involved is large, and a suit must ultimately be brought, in which case, the sooner it is brought the better. The counsellor who keeps his client out of court, and gets his rights without a suit, is entitled to more credit than one who defends him after he is in court.

Suit should never be brought unless the patent is beyond all reasonable doubt valid. The exact state of the art should be ascertained, all the principal publications, both American and foreign, should be examined, and the patent should be tested and found able to withstand each of the above-named defenses, before bringing action. Nothing is more important, and requires more care and skill, than the preliminary steps in infringement actions. A slight mistake or omission may result in defeat, when otherwise success was sure.

CHAPTER IX.

ASSIGNMENTS AND LICENSES.

THE law authorizes the patentee to assign the whole or any part of his invention, either before or after patent is issued, or to grant rights to make or use the thing patented in a particular place, or for a particular purpose. Such assignments should be recorded in the patent office, within three months after delivery thereof. A failure to do which will render it inoperative, should the patent be assigned to an innocent third person having no notice of the previous assignment. (Sec. 4898, R. S.) Some care should be taken in the preparation of assignments. They must express the consideration for which given, the names of all the assignors and assignees, and should convey no more than the interest desired to be conveyed, and that to the extent of the rights which were before vested in the grantor, for otherwise he will be held to warrant the patent, and if it were subsequently declared void, would be liable to respond in damages in an action for breach of warranty.

A license, where all the consideration is not paid down, should expressly provide that the exercising of any right under it, after a failure to pay as agreed, will be considered an infringement. Licenses need not be recorded. If the grantor reserves royalty, the assignment or license should state specifically the amount of royalty, or how computed, and the times of payment.

CHAPTER X.

GENERAL OBSERVATIONS.

It is purposed in this chapter to treat, in a cursory way, certain topics not of sufficient relative importance to be made the subjects of separate chapters.

CAVEATS.

A caveat may be filed in the patent office when the invention is not complete in all its details; or when the inventor desires to further experiment, with a view to improving his invention, and wishes to secure it in the meantime.

A caveat is an application or prayer to the commissioner of patents for protection while completing the invention. It must set forth the leading characteristics and functions of the invention, with drawings or sketches sufficiently clear to show all material parts thereof.

It remains in force for one year and can be extended for one year more. During the time it remains in force a patent for the same invention cannot be granted until the caveator shall have had notice and an opportunity to defend it in an interference proceeding. If a caveat is complete enough in the description of the invention, it is conclusive proof, in an interference proceeding, that the invention was made by the caveator at least as early as the date of filing the caveat, and he may establish as much earlier a date as is possible.

If an invention is complete enough to clearly describe it, a caveat is not desirable, but the proper course is generally to take out a patent, and embody improvements in a subsequent patent.

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The author or inventor of any book, map, chart, dramatic or musical composition, engraving, cut, print, photograph, painting, drawing, chromo, statuary, etc., may secure the same by copyright upon recording in the office of the librarian of congress a printed title, if a book or other composition, or a printed description if photograph, etc., before the work is completed, and on completion thereof, or within ten days thereafter, two copies or specimens. A failure to send such copies, within the time specified (if the title of description be filed), subjects the author or inventor to a fine of twenty-five dollars.

MARKING ARTICLES "PATENTED."

It is the duty of every patentee, assignee, or licensee, or other person lawfully manufacturing under letters patent, to mark or stamp each of such articles or machines "patented," together with the date or number of such letters patent. If the nature of the invention is such that it cannot be so stamped or marked, then it is the duty of the patentee, etc., to mark each package or box containing any one or more of such articles, or permanently attach thereto a card or label, giving the date and number of the letters patent under which such articles are manufactured.

In case of a failure to so mark patented articles, the complainant in any action brought on the letters patent, under which he manufactures such articles, can recover no damages for infringement thereof, committed pre-

vious to the date on which the complaint can prove that actual knowledge of the existence of such patent was possessed by the defendant.

Any person who shall unlawfully mark any article "patented," "letters patent," "patentee," or any other words calculated to mislead the public into a belief that such articles were manufactured under letters patent, shall be liable to pay a penalty of not less than one hundred dollars, to be recovered by any person who will sue for the same: one-half for the use of the party suing therefor, and the other half to be paid to the United States.

FOREIGN PATENTS.

The increasing commercial intercourse between nations and the rapid growth of the arts and science is greatly increasing the value of patents in all civilized countries.

The American centennial and the Paris exposition of 1878 both contributed to a marvelous extent to growing popularity of American inventions abroad.

There has been a larger number of English patents granted for American inventions, in the past eight years, than have been granted for English inventions.

By the law of England before January 1st, 1884, the first importer into the realm of a new improvement or invention, was entitled to a patent therefor, whether he was the first inventor or not. Since the first of January, however, their law on that subject is pretty much the same as ours.

ATTORNEYS AND COUNSELORS.

A common mistake among inventors is to confound "patent attorneys" with attorneys and counselors at law, There is a wide difference between the two classes of

men. To become a counselor at law of the supreme court, requires at least three years legal training under the direction of some practicing attorney of good standing, before admission to the State bar, and three years membership of some State bar and proof of good moral character, before admission to the United States supreme court bar, which must be based on a diploma from some reputable college, or on a thorough examination as to fitness, before entering upon the study of the law at all. Thus at least six years study is necessary before admission to practice in the highest federal court. And when it is considered that the law is a science of the most complex character, this preliminary preparation to entitle a person to hold himself out to the world as competent to practice it, is by no means more than adequate.

The majority of so-called "patent solicitors," or "patent attorneys," on the other hand, are not even State lawyers, but persons who have picked up a smattering merely of forms of procedure in the patent office, but who know nothing whatever about the law as a science.

They adopt the name of "solicitor" or "attorney" without any authority of law. In many States the use of the title "patent attorney" is prohibited by statute under a penalty, except by those regularly admitted to the bar. In such States the law is evaded by the employment of some term meaning "attorney in fact," as distinguished from "attorney at law." Any person may be an "attorney in fact" for another, but only duly admitted practitioners can hold themselves out as attorneys at law.

The "patent attorney" has sprung up within the past few years, through a fatal error in the patent law in failing to declare it necessary that an attorney before the patent office should be a counsellor at law. They can only do

business in the patent office, and when a case is appealed from thence to the courts (as frequently occurs) are obliged to employ lawyers to conduct it for them.

Their whole stock in trade is a circular, describing in the most extravagant manner the facilities, both natural and cultivated, that they possess over all others, and in which they style themselves "attorneys," knowing that the majority of persons who read the same will be misled into a belief that they are lawyers, instead of which, they bear a lower relation to the patent counselor than an attendant in a hospital bears to a skilled physician.

In many proceedings before the patent office, the exercise of a thorough knowledge of the law of pleadings and evidence, which requires years of study, is absolutely necessary to successful results, and in all cases before that department a full knowledge of the patent law is essential; and the man who, not being trained in the law, attempts to conduct such business, is either a consummate knave, or too hopelessly conceited to be intrusted with anything.

It is a matter of history of the country, that not more than one patent out of ten is sustained by the courts; and a careful examination of the reported cases show that more than eighty per cent. of the patents declared void by the courts in the past twenty years, were so declared for reasons resulting from badly written specifications and claims, or other defects, directly chargeable to "patent attorneys." It is also an open secret that of the 10,500 reissued patents that have been granted, fully nine-tenths of those not yet expired are utterly invalid and secure nothing to their owners, chargeable to the ignorance or dishonesty of the same class of men.

Specifications and claims should be written not only in the light of the state of art, but of an intelligent legal com-

prehension of the whole patent law, and all the decisions thereon and constructions thereof. Without such knowledge the drafting of strong claims is impossible.

It is a palpable fraud on an inventor for one of these "patent attorneys," not a lawyer, to give and charge for "opinions" on patents. Their "opinions" must necessarily be not only worthless, but misleading, and must frequently result in great damage to those to whom they are given. Money paid to such persons could be recovered back in any court of law, with interest and damages.

Ck. W.E.K.
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