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BY

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INDEX.

INTRODUCTION.

This little book was written particularly for inventors, manufacturers and authors, for the purpose of setting before them in a practical and non-technical manner the principles of the Law of Patents, Copyrights and Trademarks. It does not attempt to state the entire body of the law, for the exceptions to and variations from the general rules laid down are so numerous and obscure that they cannot be given in a book of this size, nor is it intended to take the place of counsel, and the person who attempts to dispense with legal advice will, except as to the fundamental principles, probably err on some material point.

The writer's experience as an Examiner in the United States Patent Office, and subsequently in practice before the United States Courts and the Patent Office, has made it evident to him that a great number of the mistakes made by inventors and manufacturers occur, not because they have not read the law, but because they do not clearly understand how it should be applied to their everyday experiences. Technical legal expressions do not convey a definite idea to the average person. Even if the inventor reads that "laches in reduction to practice will bar his right, as against a later conceiver, to carry his date of invention back to his original conception," it does not usually give him much practical information, for in most cases he cannot be sure of just what acts constitute laches, or reduction to practice, or conception. If, however, these points are explained with practical illustrations from the work-room, he has a more definite understanding of what is necessary to be done, and can avoid many of the legal pitfalls which are continually in his path. The writer has attempted, so far as possible in the limited space, to give a general statement of the law, with frequent practical examples such as are continually occurring in every machine-shop and factory, and he will feel repaid if by it his clients arrive at a more definite understanding of the law and can the more intelligently co-operate with him in obtaining full protection of their rights.

EMERSON R. NEWELL.

18 WALL ST., NEW YORK.
October 1st, 1900.

PURPOSE OF THE PATENT LAWS.

An inventor has no natural right to the exclusive control of his invention. Such a control is given him, not because of any such right, but on the grounds of public policy.

The Patent Laws of the United States are founded on Art. 1, § 8 of the Constitution, which says: "The Congress shall have power * * * to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." In accordance with this delegation of power, Congress has enacted laws giving to authors and inventors the exclusive control of their writings and discoveries. This exclusive control is not given to them because an inventor has any moral *right* to prevent others from enjoying the fruits of his new ideas, but because it was recognized that, by giving him the exclusive control of his invention for a short period, the arts would be encouraged, the public would obtain the right to enjoy the invention after that period, and the prosperity of the country would be increased thereby. That these results have been accomplished is evident. Morse would probably not have struggled to produce the telegraph, nor Eli Whitney to produce the cotton gin, Goodyear would not have gone through years of abject poverty in order to accomplish the successful vulcanization of rubber, Edison would probably not have given to the world the incandescent electric light, nor Bell the telephone, without the hope of a reward,—and these are only a few of the many inventions which have been the result of years of experiment and which have made this country the manufacturing center of the world.

This reward is not, however, given to the inventor for his mere *production* of the new thing. The Government enters into a contract with him, and gives him a patent in consideration of his disclosing the invention in

his patent "in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains or with which it is most nearly connected, to make, construct, compound and use the same," to the end that the public may be able, at the expiration of the "limited time," to reproduce and enjoy the invention. If the patent does not so disclose it, the patent is void.

WHO MAY OBTAIN A PATENT.

The basic statute of the Patent Laws is § 4886 R. S., which says: "Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements thereof, not known or used by others in this country before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, *or more than two years prior to his application*, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

This is the law as it now stands. The clause in italics was inserted by the Act of March 3, 1897, and does not apply to any application filed prior to Jan. 1, 1898, nor to any patent granted as a result of any such application. The effect of this change in the law is explained hereafter (p. 20). Certain other changes were made at the same time which merely served to explain more clearly the meaning of the statute.

"*Any* person who has invented or discovered * * * may * * * obtain a patent." The protection of the patent law is not confined to citizens of the United States, but is also extended to foreigners. A minor may obtain a patent, or a married woman. The applicant must, however, if alive, be the inventor or discoverer of the subject-matter sought to be patented, except in the case of a person who becomes insane after having made his invention. In the latter case his guardian, conservator, or legal representative may apply. If the inventor be dead his executor

or administrator may apply for and obtain the patent. If the applicant for the patent is not the inventor, except as specified above, the patent is void. Great care should therefore be exercised that the person who is the actual inventor, and only such person, should be the applicant.

Invention and Discovery.—These words have practically the same meaning in the Patent Law, and are used indiscriminately.

The invention is not "made," *i. e.*, complete, when merely the idea has occurred to the inventor, no matter how complete in its details the invention may appear to his mind. There has been nothing produced as yet which would benefit the world. Nor is the invention complete even though the inventor tells someone else about it and describes the invention fully to him, nor if he has even gone so far as to make a drawing of the subject-matter of his idea. It has not been proved that the invention is operative. It may be an absolute failure. When, however, the inventor "reduces the invention to practice," for instance, in the case of a machine, by constructing and successfully operating a full-sized machine, or, in the case of a process, by successfully performing the process, the inventive act is complete. A model is not, in most cases, a reduction to practice. Filing an allowable application has been held to be a constructive reduction to practice.

When the inventor has thought out all the essential parts of his invention, so that nothing remains to be done except to embody it by mere mechanical skill in a complete device, he has "conceived" the invention. It must be a definite and permanent conception of the complete and operative invention. A mere hazy idea is not enough. When James Watt saw the lid of the kettle lifted up by the steam within it, and the idea occurred to him that steam could be utilized to move a machine, he had not, in the eye of the law, "conceived" the invention of the steam engine. It was necessary for him to think out the *means* by which steam could be harnessed, before his conception was complete. In a patent suit, and also in the Patent Office, it often becomes necessary to prove which of two persons was the first inventor of the device in question. As it usually takes some time, depending on the nature of the invention,

to reduce an invention to practice after it has been conceived, the law allows an inventor to take his date of conception of the invention as the date on which the invention was made, providing he has been diligent in reducing his invention to practice (see p. 8). The proof of this date of conception may, therefore, be of the utmost importance. The unsupported statement of an inventor that he conceived an invention in January, 1897, for instance, would probably not be accepted as proof in a court of law, but if a description in a diary, or a dated drawing, witnessed by some other person, were introduced, it might prove this date of conception. Inventors and all manufacturers should bear this in mind, and endeavor to have their inventions evidenced in permanent, visible form, and duly witnessed *as to the date*, as soon as possible. Evidence as to this is often gotten from the time-slips of workmen, but a better plan, and one which inventors and manufacturers would do well to follow, is to have a broad blank book for the entry of all experiments and their results, as well as for rough or complete sketches.

We will suppose James Watt has just thought of the utilization of steam in an engine, and Thomas A. Edison is working in the same room to invent the incandescent light.

The entries in the book might be as follows:

Jan. 5, 18—. Saw steam raise lid of kettle last night. Thought steam power might be applied to running a machine. To-day made the sketch shown on opposite page of engine to utilize steam.

Witness, J. Smith. J. Watt.

Jan. 8, 18—. Thought that as oxygen supports combustion, why could not a current of electricity be sent through a conductor in a vacuum and become white hot to produce light without being burned up.

Witness, J. W. T. A. Edison.

Jan. 11, 18—. Tried sending current of electricity through fine copper wire in exhausted glass bulb. Wire doesn't give much light. Bulb tagged No. 15.

Witness, J. S. T. A. E.

Feb. 23, 18—. Completed engine as per sketch of Jan. 5, and ran it to-day. Works all right. Ran lathe by it in presence of Edison.

Witness, T. A. E. J. Watt.

Feb. 25, 18—. To-day tried carbon filament (length 10 inches, resistance 220 ohms) in exhausted bulb with current of 110 volts pressure. Gives good light and filament not burned up. Bulb and filament tagged No. 16.

Witness, J. Watt. T. A. Edison.

This would show a conception of the invention by Watt on Jan. 5, because the reduction to practice on Feb. 23, by the successful engine, in accordance with the drawing made on Jan. 5, proves that on Jan. 5 Watt knew just *how* to build a successful engine. On the other hand Edison did not conceive the successful incandescent light till Feb. 25, the same day as his reduction to practice, because on Jan. 8, he had only a hazy and undefined idea, and his experiment of Jan. 11 was a failure. Watt could therefore carry his date of invention back to Jan. 5, but Edison only to Feb. 25. The bulb No. 15, and bulb No. 16 would be put away for future reference, and, in proving his date of invention, bulb No. 16 would show just *what* was invented on Feb. 25. Such entries might be made on separate sheets of paper and filed away, although a book used for such purposes alone is the better. The reports are full of patent suits which have been won or lost by taking or neglecting these simple precautions. Just *what* was thought of or done, and the results, should be stated, and the means by which the results were accomplished should be identified, *and everything dated and witnessed.*

Diligence in reduction to practice does not mean that an inventor must spend all of his time, or even part of every day, in working on his invention, but he must show that he has not abandoned the idea. It may take months, and perhaps years even, to reduce the invention to practice. Six months might be a long time in which to reduce a conception of a new button to practice, but it would be a very short time for the reduction to practice of a new linotype machine or submarine boat.

A device, to be a reduction to practice, must be operative. This does not mean that it must be perfect, but it must accomplish, to a reasonable extent, the purpose for which it was intended. It may be rough, not constructed of the best materials, the parts might be better proportioned, etc., but yet be a reduction to practice.

Joint Inventors.—Joint inventors are entitled to a joint patent, and neither of them can legally obtain a patent for an invention jointly invented by them. Independent inventors of distinct and independent improvements, even in the same machine, are not joint inventors in the eye of the patent law. Where two persons, working together, are striving to accomplish a certain result and they go forward by mutual suggestions and consultations, one contributing one idea and the other another idea, they are joint inventors. A joint application must be filed by them, for the patent will be void if only one applies. If, however, the patent is to issue to only one of them, the proper course is for both to apply and one make an assignment of his right to the other.

This question of joint invention often arises between employer and employee. For example, suppose the employer comes to the skilled workman and gives him drawings of the invention and says to him, "John, I want you to make a drill chuck as shown here. You may have to alter some of the parts to get the best results, but I want the clutching arrangement to be as shown in the drawings." The workman then constructs the chuck, following the instructions of the drawings, but substitutes a spring for the weight shown in the drawing, or a screw for the wedge shown, or makes other alterations such as would occur to a skilled mechanic but which do not materially change the operation of the device. The workman is not a joint inventor with the employer, for he has merely exercised his mechanical skill in making the chuck according to the instructions given him. It is true he may have turned out a better chuck, because of the substitutions mentioned, but those changes were such as would suggest themselves to any skilled chuckmaker, and do not rise to the dignity of invention.

On the other hand, suppose the employer comes to the workman and says, "John, that chuck on our lathe doesn't work well. There ought to be some sort of an arrangement to get more power out of it, and it ought to hold the drill steadier. I want you to change that chuck to do this." The workman then goes ahead by himself and alters the chuck to accomplish these results. The workman is in this case the only inventor, for the employer gave him directions

only as to the *results* to be accomplished, but the workman alone originated the *means* to accomplish those results.

The fact that a device has displaced other similar devices in public favor and has had a wide sale may be persuasive, but is not conclusive, evidence of invention.

WHAT MAY BE PATENTED.

Sec. 4886 R. S. says: "Any person who has invented or discovered any * * * art, machine, manufacture, or composition of matter, or any * * * improvements thereof * * * may * * * obtain a patent therefor."

An Art.—The word "art" has two different meanings in the patent law. One is "the practical application of knowledge or natural ability," such as the "art" of wood-carving, the saddle-maker's "art," the "art" of painting, etc., which are collectively called *the* arts. This is the meaning of the word in Art. 1, Sec. 8 of the Constitution, which says that "The Congress shall have power * * * to promote the progress of science and the useful arts * * *." The word does not, however, have this meaning in § 4886. In that section of the statute the meaning is narrower, and is used to distinguish a certain class of patentable inventions, and its definition is the same as that of the word "process" or "method." A process, a method, and an art are therefore the same, with reference to this section of the statute.

An art, process or method has been defined by the Supreme Court to be "an act or series of acts performed upon the subject-matter to be transformed and reduced to a different state or thing"; they have also said that it "requires that certain things should be done with certain substances in a certain order"; and "it may be said that processes of manufacture which involve chemical or other similar elemental action are patentable, though mechanism may be necessary in the application or carrying out of such process"; "the machinery pointed out to perform the process may or may not be new or patentable." It will be evident from the above definitions that there are many operations which may involve invention, but which are not patentable because they do not answer these require-

ments. It will be observed that the steps of a process or art must reduce the substance acted on "to a different state or thing." This does not mean that the substance must be changed in appearance or that chemical action is absolutely necessary. The Supreme Court said that processes which involved chemical action were patentable, but they did not say that a process which did not involve chemical action might not be patentable, and they did not define what they meant by "elemental action." The line of distinction between those acts which may be the subjects of valid patents and those which cannot be, has not yet been well defined. The majority of operations may be easily classified. It is evident that the addition of water to calcium carbide to produce acetylene gas is a patentable process under the above definitions, but it is equally obvious that a new series of steps for computing interest, or a new scheme of advertising in a newspaper, are not patentable processes, because neither answers the requirements laid down by the Supreme Court as mentioned above. The Supreme Court has said that a process which requires machinery in carrying out the steps thereof *may* be patentable, but that those processes "which consist solely in the operation of a machine are not." Accordingly the so-called "method" of propelling a bicycle which consists in transmitting power to the hind wheel by means of a crank, a chain and a pair of sprockets, would not answer the requirements of a patentable method or process, because the material acted on (the bicycle) is not changed in any way or "reduced to a different state or thing."

There is a further class of so-called "methods" or "processes" which are less easily distinguished, but which are also unpatentable. It is often said, for example, that a board is undergoing the "process" of being planed, and the operation seems at first sight to answer the requirements of an "art" as defined by the Supreme Court. It in fact does not. The reduction "to a different state or thing," referred to by the Supreme Court as necessary, is not merely a change in form. It must be something further than this. The board is reduced to a different state in the sense that it is made more smooth, but the wood of the board is not changed in any way. It is the same wood

as before and has the same characteristics. If the planing effected some change in the wood itself, such as making it less liable to rot, or changed it from a fibrous to a cellular formation, the process would probably be patentable because of the chemical "or other elemental action" which altered the wood itself. On the other hand a court has said, regarding the treatment of paper by moistening it and then pounding the sheets, that "the treatment of paper in this instance is of a character to change its quality, giving it new and useful attributes." Acts, apparently insignificant, performed on a substance, such as the application of heat, cold, electricity or moisture, etc., may in some cases give patentability to a process. The fact that a machine is used to carry out a process does not necessarily make the process unpatentable. The dividing line between processes which are patentable and those which are not is not well defined, and each case must be decided in view of the particular circumstances surrounding it.

It will be evident that if it is desired to patent an operation the patent will be broader, *i. e.*, more comprehensive, if the operation is claimed as a process than if it is claimed as a machine, for a process is the same whether it is carried out by hand or by means of a machine.

A machine is an instrument composed of one or more of the mechanical powers, and capable, when set in motion, of producing certain physical results. It may be automatic, as an ordinary clock, or it may run by the application of external power, as a sewing machine. An attachment to a sewing machine for forming buttonholes may be a machine distinct from the sewing machine itself.

Manufacture.—The limits of this class of inventions are not well defined in the patent law, but it includes nearly all those articles made by hand or machinery and which are not machines or compositions of matter.

A composition of matter has been defined to be "an instrument formed by the intermixture of two or more ingredients, and possessing properties which belong to none of these ingredients in their separate state." A chemical compound is a good illustration of a composition of

matter. The artificial production of a substance which has previously existed in nature—salt, for example—is not the production of a new article, although the process which produces it may be new.

Improvements on pre-existing subjects of invention are patentable, and justly so, for the improvements made on an original invention are often as meritorious as the original invention itself.

A principle or law of nature is not patentable (although the means for making use of that law may be), because it is not a means, and furthermore is not new. It cannot be originated because it has always been old, although it may be newly observed. When Newton saw the apple fall from the tree he reasoned from it and "discovered" the law of gravitation, but that law had been in force from the beginning of the world. A new pile-driver which makes use of that principle is, however, patentable.

UTILITY.

An invention, to be patentable, must, according to § 4886 R. S., be "useful." It must be capable of conferring a benefit on the public. This does not mean that the mere fact that an invention can be used is sufficient. It must be helpful to mankind. If it is immoral, unavoidably injurious, or useful only to commit a breach of the laws, it is unpatentable. If, however, it is legally useful even to only a slight degree, it is patentable. It might be contended that the invention of a new and subtle poison would tend to increase crime, and that on that account the invention would not be "useful"; but the poison might be of great benefit in ridding a locality of locusts or rabbits, or it might be used as a powerful stimulant in medicine, as certain poisons are now used, and thus become a great help to the world. Practically any legal utility will be sufficient. It is obvious that absolute lack of legal utility in an invention will seldom be found.

NOVELTY.

An invention, to be patentable, must, by § 4886 R. S., be "new," that is, the difference between it and what is already known to the public must be sufficient to have involved invention to produce. Until 1836 it was necessary that an invention, to be patentable, should be absolutely new. Knowledge by persons in a foreign country, no matter how remote or for how short a time, would prevent the grant of a patent in the United States and would render void a patent already granted, even if the domestic inventor believed himself to be the original discoverer. This injustice was remedied in the law of 1836, which prevented mere knowledge or use in a foreign country, before the invention here, from barring the grant of a patent. Prior knowledge and use are discussed hereafter (p. 17).

Two inventions may be legally the same, except in designs (p. 50), although they are embodied in widely different forms. A railroad locomotive, a steam drill and a stationary hoisting engine are widely different forms, each containing the invention of a sliding piston and a valve for admitting steam to the piston on alternate sides. Those means for harnessing the expansive power of steam are broadly the same, and operate in substantially the same manner. Salt is the same whether it is dug out of the earth, made by the union of two chemicals in the laboratory, or by the evaporation of sea water. On the other hand, an invention may appear to be the same as something already known, but on examination will be found to have characteristics or a mode of operation entirely different, and to produce different results, which may make the invention legally new.

Identity or diversity of size, shape, materials, or arrangement, unless those characteristics form the gist of the inventions, are not *proof* that the inventions are the same or different.

Mechanical Skill.—The exercise of mere mechanical skill does not involve invention. A workman will make changes or substitutions in a device, which his experience

teaches him would be advantageous, without exercising anything more than mere work-room skill. If it would occur to a skilled workman to make those changes, he has invented nothing—has produced nothing patentably "new,"—although that particular form of the device may never have existed before. Carpenters, machinists and almost all workmen are called upon every day to adapt the materials they are working on to some new situation and to construct devices which have never before existed in that precise form, without exercising their inventive faculties.

So too a skilled workman will substitute one means of accomplishing a result for another which his experience tells him will do as well, or perhaps slightly better. He makes a pipe of brass in place of lead, substitutes a cam in a machine for a lever originally there, a spring for a weight, or a wedge for a screw, and accomplishes the same results as before. They perform the same functions in substantially the same way, and are known as "equivalents." The substitution of one mere equivalent for another does not involve invention. The Supreme Court decided that as doorknobs had been made of metal it did not involve invention to make them of earthenware, it being a mere substitution of materials. What may appear to be a mere substitution of equivalents may, however, be a patentable invention. If the substituted element has some decided advantage over the former element whereby a result is accomplished which it was not known the substituted element would accomplish, the change may be sufficient to confer patentability on the new device. The decision as to whether or not a change involves patentable invention depends on the circumstances of each particular case, and no invariable rule can be laid down in regard to it.

Coming under the head of mechanical skill is the question of "double use," which is akin to the above-discussed "doctrine of equivalents." The United States Supreme Court recently said that "doubtless a patentee is entitled to every use of which his invention is susceptible." Conversely, if the public has the right to use an invention, it is entitled to all the uses to which that invention *alone* may be applied. The discovery of a mere new use to which an invention may be put is not the discovery of anything

patentable under the laws of the United States. It is not the discovery of any new process or thing. A bellows used to blow a fire is the same bellows if used to blow insect powder over plants. The discovery of the new use to which it could be put did not charge the bellows in the least. The process of treating plants by blowing powder over them may be new and patentable, but the bellows itself is old. The Supreme Court has said, in regard to this doctrine of double use, "when a patented device is a mere improvement upon an existing machine, * * * the solution is ordinarily free from difficulty. But where the alleged novelty consists in transferring a device from one branch of industry to another, the answer depends upon a variety of considerations. In such cases we are bound to inquire into the remoteness of relationship between the two industries; what alterations are necessary to adapt the device to its new use, and what the value of such adaptation has been to the new industry. If the new use be analogous to the former one the court will undoubtedly be disposed to construe the patent more strictly, and to require clearer proof of the exercise of the inventive faculty in adapting it to the new use—particularly if the device be one of minor importance in its new field of usefulness. On the other hand, if the transfer be to a branch of industry but remotely allied to the other, and the effect of such transfer has been to supersede other methods of doing the same work, the court will look with a less critical eye upon the means employed in making the transfer."

To be an anticipation of an invention the invention must be clearly and fully disclosed. A mere hazy, undefined description, which might or might not have been intended as a description of the particular invention under consideration, is not enough. The disclosure must be complete and clear and leave nothing to conjecture or to the imagination. On the other hand, as explained heretofore, two inventions which differ widely in form, materials, capacity, size and finish may be identical or equivalents in the eye of the Patent Law.

PRIOR KNOWLEDGE OR USE.

Section 4886 R. S. provides that, to be patentable, an invention must not have been "known or used by others in this country before his invention or discovery thereof."

In the first place, the *mere* knowledge or use of the invention in a foreign country is not sufficient to anticipate an invention made in the United States. If an inventor, at the time of making his application for a patent, believed himself to be the original and first inventor or discoverer of the thing applied for, the patent will not be refused, nor declared void if already granted, merely because the invention or discovery had been known or used in a foreign country before his invention or discovery thereof, if it had not been patented or described in a printed publication. Prior patents and publications are discussed hereafter (pp. 19, 22).

Until 1836 knowledge or use in a foreign country prevented the grant of a patent here, but since then this unjust restriction has been removed. The knowledge or use, even in this country, must be before the invention or discovery here. In England, Germany, France, and most other foreign countries, knowledge or use in the home country before the *application* for the patent is fatal. It must be absolutely new "within the realm" at that time. In the United States, however, such knowledge or use, to be a bar to a patent, must, unless public (p. 23), have been before the invention or discovery. This gives the inventor a chance to perfect his invention before he files his application, which is obviously a just and equitable provision. The invention or discovery which must antedate any knowledge or use in this country need not be complete, that is, the invention need not be reduced to practice at that time. If the invention has been conceived before, and followed up by diligence to a reduction to practice after, the knowledge or use in this country, it will be a sufficient compliance with this requirement of the statute. Conception and reduction to practice of an invention have been discussed (pp. 6-8).

The prior knowledge meant in this section of the statute is not the *mere* knowledge that the invention exists somewhere or has existed. It has been held that where a person goes to a foreign country and sees an invention

there and comes to the United States with the information he has obtained, that mere fact does not constitute the "knowledge," as meant by this section of the statute, if that knowledge has not been followed up by a production of the invention itself in this country.

The prior knowledge which will prevent the grant of, or invalidate, a patent, must be a complete understanding of the invention itself, and the invention must be operative. If a knitting machine, for example, was imported into this country in a closed box and lay in a storehouse in that condition for a year, and during all that time the importer knew that the machine was there but had not seen it, this knowledge of his would probably not be a knowledge of the machine sufficient to invalidate a patent granted for an invention of the same thing in this country. He knew there was a knitting machine in his storehouse, but he did not know how it was constructed or how it operated, and if the machine had been destroyed before he obtained a more complete knowledge of its construction, the public would be no better off than before the machine was imported, for the importer could not disclose to it what he himself did not know. The knowledge required must, in the case of a machine, be an understanding of the construction of the essential parts of the invention sufficient for the reproduction of the same.

The prior use referred to in this section of the statute is not necessarily a public use, although the two are often confused. A knowledge and use may not be accessible to the public generally, and yet be an anticipation of an invention. The process by which the well-known Lea & Perrins' Worcestershire Sauce is made is carefully guarded by the makers in this country, and is known to only a few persons, but such persons have a knowledge of this process which would probably be sufficient in the Patent Law to anticipate a later invention of the same process.

An invention may have been known and used for years in this country before a later invention, and yet be insufficient to prevent the grant of a patent therefor. This is the case in the so-called "lost arts" where an invention, once well known and employed, has been forgotten, so that no one can now practice the same. An illustration of this is the process of tempering copper in use by the Aztecs in

Mexico at the time of the conquest. We still have their swords and other implements of tempered copper, but no one knows what the process was, and although it may have been practiced for years in this country it is now a "lost art," and would probably not prevent a later discoverer from obtaining a patent for such process.

Prior knowledge or use, to anticipate a later invention, must be proved clearly and convincingly.

PRIOR PATENT.

If an invention is disclosed in a prior patent it is an anticipation, and it is immaterial whether the prior patent was granted by the United States or some foreign power. It must, however, be a public document, must be accessible to the public, issued before the date of the other invention, or more than two years before the application for the other invention (except as specified on p. 20), must be for the same invention, and must disclose the invention in such a full and complete manner as to put persons skilled in that art in full possession of all the essential parts of the invention.

The patent must not only be issued by some government, but it must be a public document. If it is private, a communication open only to one or a limited number of persons, it is not sufficient as an anticipation. Thus an application for a patent, or a provisional specification in England, or even an English complete specification when first published, is not a patent. The date of sealing the patent usually determines the date of the patent in the sense used in § 4886. The patent must be accessible to the public. It is not necessary that the public should have actually inspected it,—if the public had the right to inspect it when they wished, it will be sufficient. It seems unjust that an obscure patent in a foreign country, which would probably have rested in a pigeon-hole for years without being seen by a single person, should serve to invalidate a later patent granted in this country, but the theory is that the public *could* have obtained the knowledge of the invention. The prior patent must have conferred some exclusive privilege in the matter patented. The prior patent

must, to be an anticipation, disclose the same invention as the one to be anticipated, and it must be clearly the same. The disclosure must also be complete, so as to put the public fully in possession of the disclosed matter. If the description is vague, uncertain, ambiguous or leaves any essential part to be invented, it is insufficient. It often happens that a patent, set up as an anticipation, discloses an invention from which, using our present knowledge of the art, it would seem that it did not involve invention to produce the invention alleged to be anticipated. It is not, however, our present knowledge of the art which is the guide, but the knowledge of the art as it was at the time the patent was granted. The advance in the arts is so rapid that what may be a well-known work-room expedient to-day may have involved a high degree of invention to produce ten years ago.

As the law stands at present, a patent or printed publication will prevent the grant of a patent, or invalidate one if already granted, unless the application for the later patent was filed within two years of such patent or publication. This seems to mean that if an invention is disclosed in a patent or printed publication, a patent cannot in any case be obtained therefor unless the application is filed within two years thereof. This apparently prevents an inventor from carrying his date of invention back more than two years in order to antedate such an alleged anticipation. This rule, however, does not apply to any patent granted prior to Jan. 1, 1898, nor to a patent granted on an application filed prior to such date. The words "or more than two years prior to his application" in § 4886 were inserted by the law of March 3, 1897, which instituted the rule above noted. Before that time a patent or printed publication, to be an anticipation, must have been before the invention or discovery. By the law as it then stood an applicant or patentee might carry his date of invention back and antedate a patent or printed publication, although his application had been filed more than two years thereafter. For example, *A* makes an invention in May, 1895, and works on the same in perfecting it until November, 1897, when he applies for a patent. A patent granted in July, 1895, is cited against his application, but *A* can carry his date of invention back to May, 1895, and prove that he

made the invention at that time, previous to the grant of the patent. If, however, he had not applied till January, 1898, he could not obtain his patent, as the anticipating patent would have been granted more than two years before his application.

In consequence of this change in the laws, inventors cannot now safely delay the filing of their applications, as a patent or printed publication more than two years old at the date of their application will apparently be an absolute bar to the grant of a patent.

Limitation by Foreign Patent.—The law, as it controls applications, and patents granted on applications, filed before Jan. 1, 1898, stated that "every patent granted for an invention which has been previously patented in a foreign country shall be so limited as to expire at the same time with the foreign patent, or, if there be more than one, at the same time with the one having the shortest term, and in no case shall it be in force more than seventeen years." The effect of this was to limit the United States patent so that it expired at the same time with the earliest expiring previously granted foreign patent. Of course the foreign patent must have been for the same invention, and taken out, or caused to be taken out, by the same party. If the foreign patent was granted before the grant of the United States patent, the latter patent was limited, whether the application here was filed first or not. If the foreign patent expired before the patent here was granted, it made void any patent granted in this country.

The statute was changed by the law of March 3, 1897, to read: "No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than seven months prior to the filing of the application in this country, *in which case no patent shall be granted in this country.*" This change in the law probably removes all limitation of a United States patent by a foreign patent except where the former is rendered void because the foreign application was filed more than seven

months prior to the application in this country. An inventor in a foreign country especially should be careful to see that his United States application is filed as soon as possible, at least within seven months after the filing of the foreign application. The statute states in effect that the invention must have been "first" patented in a foreign country, *i. e.*, the foreign patent must have been granted before the United States patent is granted, consequently even if the application in this country has not been filed within said seven months, a patent may be issued here providing the grant of the foreign patent is kept back until after the United States patent is granted. The statute as now in force does not apply to any application filed before January 1, 1898, nor to any patent granted on such an application.

PRIOR PUBLICATION.

Much that has been said heretofore in regard to the effect of a prior patent is applicable in the case of a prior publication. It must be a work of a public character—*i. e.*, intended for general use,—must be accessible to the public, published before the date of the invention alleged to be anticipated (or more than two years before the application in this country if the application was filed since December 31, 1897. See p. 20), it must disclose the same, and an operative invention, and must be clear and complete in its disclosure. A private letter has been held to be not a publication although read by a number of persons; it must have been directed, or accessible, to the public in general. A trade circular sent to the persons interested in a particular trade only has been held to be not a printed publication, but one which had been deposited in a public library became thereby a printed publication. The publication may not be of general interest, but if the public have general access to it, whether they have actually inspected it or not, the public character of the disclosure is assured. For this reason the printing and offering for sale to any one of the drawings and complete specification of an English application some weeks before the patent is finally sealed constitutes a "publication" in the eye of the law, although technically it is not then a patent. The publication must

disclose the invention so fully that any one skilled in that particular art could practice and reproduce the invention. As in the case of a prior patent, the publication, if more than two years before the application in this country, or before the date of invention, will be an anticipation; but in the case of an application filed before January 1, 1898, it must have been before the date of invention.

PUBLIC USE OR SALE.

Section 4886 R. S. states that, to be patentable, an invention must not have been "in public use or on sale in this country for more than two years prior to his application." This does not mean that, to be an anticipation, the use must have actually been by, or the sale to, the public. If the invention has been used before the public, or even by or before a single member of the public, with no promise by that person to keep it secret, it may constitute a "public use." The unrestricted wearing of a corset, in which were the newly invented steels, by one woman for several years has been held to be a "public use." Likewise the offering for sale to any one of an article has been held to place that article "on sale" whether it was actually sold or not.

An *experimental use*, carried out for the purpose of testing the capability or merits of the invention, is not a public use. The inventor shows by a use for experiment that he does not yet consider his invention is perfected, and this use, although it may go on for years, will not, if in good faith, prevent him from obtaining a valid patent. If the inventor uses the invention in public, or allows the public to use it, he must be extremely careful to be able to show that such use is for experiment, or his patent may be declared invalid. For example, suppose he has invented a new drinking fountain. He might set one up in a public square and allow every one to use it for the purpose of testing it in actual operation; but he should keep track of how it operated, examine it at intervals to see if it is working properly or does not need a change in some of its parts, and make needed changes, etc. Such a use is always dangerous in its possible effect on the patent. An inventor cannot be too careful to make it evident that the use is for ex-

periment only, and he should make his application as soon as he is satisfied that the invention is reasonably perfected. Receiving money for the use of the invention is not *proof* of public use, but is in some cases very persuasive evidence to that end. On the other hand, it may be necessary to sell a device to have it operated experimentally. It might be necessary to use a railroad locomotive for several years to determine, by the experiment of continued wear, if a certain invention was perfected, and it would be none the less an experimental use because the inventor sold the locomotive instead of using it himself. In this connection it may be well to state that sales "to test the market," *i. e.*, to see whether a device will "take" with the public, are a commercial experiment, and not an experimental use in the sense meant by the patent law.

The consent of the inventor is not a prerequisite to a "public use" of his invention. If he discloses it to a person without any injunctions of secrecy, and that person then goes out and uses it publicly, that use is a "public use." On the other hand, if the inventor makes the other person promise to keep the matter secret, but such person nevertheless then uses the invention in public without the knowledge of the inventor, or if he steals the device from the inventor and then uses it in public, it is not such a public use as is contemplated by this section of the statute.

ABANDONMENT.

Section 4886 R. S. states that an invention may be patentable "unless the same is proved to have been abandoned." The word "abandonment" has been used with a variety of meanings. Where a person conceives an invention and takes some steps to reduce it to practice, but becomes indifferent to the outcome and throws the invention aside without intending to complete it, he has abandoned his intention of becoming an inventor. This is what is known as an abandoned experiment. Where the inventor has produced the new invention but then relinquishes it and, without communicating it to the public, forgets it completely, it becomes a lost art. In neither of these cases has the invention been abandoned to the public, as the public has not known

of the invention nor had access to it, consequently it is not in possession of the invention, and the inventor or any other person can then re-invent the same thing and obtain a patent therefor. Where, however, the invention is given to the public and the inventor relinquishes his claim to it, the public obtains full possession of the invention, and neither the inventor nor any one else is entitled to a patent thereon.

Abandonment is a question of fact, and depends on the intent. If the inventor's intent was to give it to the public, the gift is irrevocable. This intent may be presumed from many different acts or omissions by him. Public use or sale by him, or with his consent or allowance, before his application, is *evidence* of abandonment. After his application it will not, alone, constitute abandonment. By a careless description or definition of his invention in his application papers he may waive the right to something disclosed therein. He may also abandon a part of his invention by failing to claim it in his patent, although it is disclosed therein. These are two common causes of constructive abandonment. If he has on file a contemporaneous application, claiming the same matter, the failure to claim such matter in the other application does not work an abandonment. Narrowing or cancelling claims in consequence of alleged anticipating references cited by the Patent Office is constructive abandonment of the scope of the invention so omitted from the claims. This becomes of vital importance in the prosecution of applications before the Patent Office, and will be discussed hereafter (p. 33). The abandonment of an application does not necessarily constitute an abandonment of the invention. As to abandonment of application by failure to prosecute, see p. 34.

The inventor's right to recover for infringements of his patent may be abandoned so far as a particular person is concerned, or as to the public absolutely (see p. 48).

PATENTING OF INVENTIONS.

Caveats.—When a person has conceived an invention, and desires further time to mature the same, he may file in the Patent Office a caveat. This is a paper setting forth

the invention in a general way and the distinguishing characteristics thereof, and praying protection of the inventor's right until he shall have matured his invention. The caveat is preserved in secrecy in the Patent Office and is operative for one year. If an application is made within that year by any other person for a patent for the same invention as is apparently set forth in the caveat, the other person's application is not passed to issue, but is withheld, and a notice is sent to the caveator that such an application has been filed. If the caveator files his application within three months of the time the notice was sent and it is found that his invention interferes with that of the other person, an interference (p. 35) is declared, and the parties then proceed to fight out the question of which was the prior inventor. If the caveator does not file his application within said three months the other application is passed to issue. Caveats can only be filed by a citizen of the United States or an alien who has resided in the United States for one year next preceding the filing of the caveat and who has made oath of his intention to become a citizen. The caveat may be renewed from year to year. It does not entitle the caveator to notice of an application for the same invention if that application was filed before the filing of the caveat or after the expiration of the year or an extension thereof. The Government fee is $10.

A caveat is not necessary in the majority of cases. In an experience of three years as an Examiner in the Patent Office in Washington, the writer had occasion to send notices to only two caveators, and when those caveators filed their applications neither of the inventions interfered with the subject of the previously filed application. Where an inventor has reason to think another person is likely to steal his invention and apply for a patent thereon, a caveat is a wise precaution and may preserve his rights. This is often so in the case of an experimental use of the invention in public before application. A caveat is not a patent nor an application therefor, and does not give the caveator the right to sue makers, sellers or users of the invention, nor to mark his invention "patent applied for." The Office makes no examination of the invention for novelty, therefore the caveator does not by it learn whether or not his invention is patentable.

Preliminary Searches.—When a person has made an invention whose novelty is doubtful, a preliminary search may be advisable. This is a search, by my correspondent in Washington, through the class or classes in the Patent Office where the invention is most likely to be found if it has been previously patented in this country. If it has been so patented, such a search will usually disclose that fact, and the inventor be saved the expense of filing an application for an unpatentable device. The cost of such a search is $5.00 for a single invention, and includes a copy of the nearest patents which the search discloses.

It is not necessary, unless the invention is complicated, to send me the device itself, even when an application is to be made. A drawing, and a written explanation of what the inventor considers is his improvement over what is already known, will usually be sufficient, although a sample of the invention itself or a working model is desirable. A working drawing is usually sufficient. If any part of the invention is not clearly understood by me, the inventor will be notified at once.

The Application.—Section 4888 R. S. provides that: "Before any inventor or discoverer shall receive apatent for his invention or discovery, he * * * shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." The question as to who may be an applicant has been discussed heretofore (p. 5), also as to what may be patented (p. 10).

The specification is for the purpose of completely disclosing the invention to the public, and, by the claims, of defining the extent of the invention. If a mere description of the invention were all that was necessary it would be

a simple task to draw up the specification. Any mechanic skilled in the art could describe in writing the device invented so that its construction and operation could be understood, but this is the smallest part of the work required to compose a properly drafted specification. It should be so expressed that a broad construction will be given to the claims, and the legal pitfalls are so many and so obscure that it should only be entrusted to a person who is well acquainted with the decisions of the United States Courts in patent cases, as well as with the procedure in the Patent Office. Many a patent has been rendered practically worthless, or even declared void, by reason of some expression therein which correctly *described* the invention, but which cut down the scope of the invention because the application writer was not able to foresee the legal effect which such an expression would have when the patent comes before the courts for interpretation. The statement in the body of the specification of what the invention consists is a very frequent cause of a restriction of the patent. A patent is of little value if another person can, in spite of it, by a slight variation of the article patented, in effect make that article, but the courts are continually restricting patents to the precise embodiment shown in the drawings, on account of some apparently innocent clause or even word in the specification. The specification serves to explain the claims, and, in order that the claims shall be as broad, *i. e.*, as comprehensive, as possible, so as to include not only the embodiment shown in the drawings but also as many variations thereof as possible, the specification must explain them broadly. The writer, in the course of his experience in the examining corps in the United States Patent Office was struck with the fact that this phase of patent soliciting is neglected, or not properly understood, by the great majority of patent attorneys.

The specification must disclose every essential element of the invention or the patent will be void. Matter not disclosed in some part of the application as first filed cannot legally be inserted thereafter in any way. This rule is invariable. But matter disclosed, but not completely, may be fully disclosed, if it was invented by the applicant before his application was filed, by amendment with a supplemental oath. If the disclosure is vague or ambiguous it

may render the patent void. If the specification discloses more or less than the patentee's real invention, with intent to mislead the public, the patent is void.

The government fee on filing the application is $15.

Claims.—Section 4888 R. S. specifies that the applicant must "particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery." This requirement is usually complied with by formal "claims" at the end of the specification. These are the backbone of the patent, for the patentee is supposed to have correctly stated in them the exact limits of his invention. He is absolutely bound by them, so long as his patent is alive. He cannot recover for the manufacture, use or sale of an article which does not fall within at least one of them, no matter how much of his actual invention is included in that article, and this too even though he thought he had drawn the claim broad enough to cover that article. As said by Judge Blatchford in an early case. "The rights of the plaintiff depend upon the claim in his patent, according to its proper construction, and not upon what he may erroneously *suppose* it covers." The courts have the power to declare a patent or any of the claims thereof, void, but not to change the claims in any way. A claim is like a glass jar. It cannot be strained to include more than it fairly covers, nor unfairly contracted to avoid being destroyed by an anticipation in the prior art. A patentee is bound absolutely by them. If he has claimed the combination of two "elements," or parts, of his invention, the courts cannot thereafter omit one of those elements in order to make the patent broader so as to cover the real invention, nor will they distort the words of the specification or claim to include an element not named in the claim. Some inventors understand the technical reason for the phraseology used in claims, but the majority do not, probably from not appreciating the importance of exactness in this respect. The broader a claim is, the more modifications of the invention will it include, and, conversely, the narrower it is the less variations will fall within it. A claim is called broad when it contains few elements or necessary parts, and narrow when it includes many elements. To be an infringement of a claim, the alleged in-

fringement must have all the elements enumerated in the claim. It will be obvious, therefore, that a claim reading "A table having a plurality of legs" alone, will describe a table having two, or ten legs, no matter how the rest of the table is constructed, but a claim reading "A table having four curved legs with ball and claw feet and a marble top" will not include a three-legged table, nor one without ball and claw feet, nor one with straight legs, nor one with a wooden top, consequently although all these tables would be infringements of the broad claim they would not infringe the narrow one. The conditions which give a claim a broad or a narrow construction are so numerous and obscure that an inventor should not attempt to decide such questions without the advice of competent counsel.

The courts may declare one or more of the claims of a patent void and uphold the rest, and the patent will be valid to the extent of the remaining claims. A claim must not be vague, ambiguous or functional, nor claim a result merely, nor more than the inventor is entitled to, or it will be absoloutely void. It should not be alternative nor expressed in any but the well-recognized technical terms, although such claims are not necessarily void.

The practice in the Patent Office as to the "joinder of inventions" in one application is now that two or more independent inventions cannot be claimed in one application, such, for example, as a new wheel for a carriage and an improvement in dashboards, as the two do not cooperate to produce a unitary result. But where several distinct inventions are dependent on each other and mutually contribute to produce a single result, they may be claimed in one application. Claims for a process and its product may be presented in the same application, but claims for a machine and its product cannot be joined, nor can a machine and the process in the performance of whieh the machine is used be claimed in the same application. The courts have not uniformly insisted upon such rules. It would seem that the Government has as much right to grant a single patent for two independent inventions as it has to grant a single land patent for two independent strips of its territory. The Patent Office practice in that respect must, however, be followed in taking out patents.

A single claim *may* protect the inventor's rights com-

pletely, but it is usually the better practice to draw several claims, some broad and others more specific. The number and form of the claims, however, depends upon the circumstances of each case, and should be left to the discretion of a competent attorney. There is probably no legal instrument which requires a more thorough knowledge of the technicalities of patent law than the claims of a patent. They are the most important part of the patent, and inventors should, therefore, entrust their cases only to one who is well versed in patent practice in all its phases. The Patent Office, in its book of "Rules and Practice," states that "an applicant, or an assignee of the entire interest, may prosecute his own case; but he is advised, unless familiar with such matters, to employ a competent attorney, as the value of patents depends largely upon the skillful preparation of the specification and claims." A little knowledge is a dangerous thing.

A drawing must be furnished when the invention is capable of illustration, and must show every part of the invention claimed.

The applicant, if the inventor, must make oath or affirmation that he does verily believe himself to be the original and first inventor or discoverer of the art, machine, manufacture, composition, or improvement for which he solicits a patent; that he does not know and does not believe that the same was ever before known or used, and must state of what country he is a citizen, and where he resides. In every original application the applicant must distinctly state under oath that the invention has not been patented to himself or to others with his knowledge or consent in this or any foreign country for more than two years prior to his application, or on an application for a patent filed in any foreign country by himself or his legal representatives or assigns more than seven months prior to his application. If any such application has been filed prior to his application in this country, he must state the country or countries and give the date of the application; the oath must also state that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States, nor described in any printed publication or patent in this or any foreign country for more than two years prior to his application in this country.

If the application is made by an executor or administrator of a deceased person, or the guardian, conservator or representative of an insane person, the form of the oath must be correspondingly changed. The oath may be made before any person within the United States authorized by law to administer oaths; or, when the applicant resides in a foreign country, before any minister, charge d'affaires, consul or commercial agent holding commission under the Government of the United States, or before any notary public of the foreign country who is authorized by law to administer oaths. The officer's official seal must always be affixed.

When the oath is taken before an officer in a country foreign to the United States, all the application papers must be attached together and a ribbon passed one or more times through all the sheets of the application, and the ends of the ribbon brought together under the seal before the latter is affixed or impressed, or each sheet must be impressed with the official seal of such officer; or, if he is not provided with a seal, then each sheet must be initialed by him. An oath is not an absolute prerequisite to the grant of a valid patent, but is always required.

A model need not be filed in each case, unless called for by the examiner.

When the invention or discovery is a composition of matter, the applicant, if required, must furnish specimens of the composition, and of its ingredients, sufficient in quantity for the purpose of experiment. In all cases where the composition is not perishable, a specimen of the composition claimed, put up in proper form to be preserved by the office, must be furnished.

Procedure in the Patent Office.—When the application is filed in the Patent Office, it is referred to one of the examining divisions, and is usually taken up for examination within a month from the date of filing. The examiner reads the application papers and then searches through the proper classes of the patents, publications and other records, both domestic and foreign, in the Patent Office, to see if the claims are allowable. He then writes a letter to the applicant, in care of the attorney, stating the result of said search. Usually some of the claims, possibly all of

them, are rejected at this first action. The examiner cites the patents or other anticipating matter which he has discovered, and gives his reasons why he does not consider the rejected claims are patentable.

The applicant's attorney then considers the references cited, and decides for himself whether the rejected claims are in fact anticipated by the matter cited by the examiner. If he decides that they are not, he asks for a reconsideration of the official action, stating why, in his opinion, the references do not meet the claims. If, on the other hand, he decides that the references do in fact show that some of the invention is old, he cancels the claims rejected, amends them to avoid the references, or substitutes new claims therefor. The examiner then acts upon the case in its changed condition, and this action on the part of the examiner and the attorney goes on till the application is allowed or some of the claims are finally rejected. It is nothing against the judgment of the attorney that the claims are rejected in the first action or in subsequent actions. On the contrary it shows that he has presumably claimed at least all that the inventor is entitled to, and if he has claimed more than is patentable, he can cut down the scope of the claims by amendment to the extent of the inventor's rights.

It is in amending the claims, so that they avoid the references and yet protect the inventor to the fullest extent possible, that the attorney shows his skill. He must have the legal knowledge to foresee what will be the legal effect of his actions, for otherwise he may, by his amendments, unconsciously abandon to the public the real invention of the applicant. For example, when an applicant cuts down the scope of, or cancels, rejected claims and allows the patent to issue, he is conclusively supposed to have abandoned the amount so cut out, and the courts cannot and will not reinsert such matter. Such amendments are therefore of vital importance (see p. 25). Anything disclosed in the application, but not claimed therein, or in a co-pending application, is *prima facie* presumed to have been abandoned or not invented by the applicant. In all cases of doubt as to patentability, the doubt should by law be resolved in favor of the applicant. All official correspondence with the Patent Office should, by its rules, be carried

on in writing. Oral interviews with examiners are necessary only in exceptional cases, *e. g.*, when the examiner has repeatedly refused to allow a claim, and can be carried on by the writer's correspondent in Washington or, if desired, the writer can make a trip to Washington for a personal interview.

The failure for one year to properly respond to an action by the Patent Office on an application works a presumptive abandonment of the application. On applications filed *before* Jan. 1, 1898, the period is two years. Usually inventors do not wish to have the issue of their patents delayed, and it is the writer's practice to amend rejected applications as soon as possible after the letter of rejection is received. The law, however, does not require an application to be amended more than once within one year from a rejection. This is often of practical importance where a valuable invention has been made, particularly in a new field. By amending applications only just within the necessary time, such applications have been purposely kept in the Patent Office for years before being allowed, while the art has developed, and when the patent finally issued an enormous number of makers, users and sellers of the invention were put under contribution. The writer has in mind a patent, covering two of the fundamental parts of probably three-fourths of the typewriters at present in use, which was applied for in 1879 but not granted till 1897. A patent has seventeen years to run from the date of grant, and the practical effect of the course stated above is to delay the grant of the patent until the development of the art has made the article a universal necessity, when the issue of the patent puts all makers, users and sellers of the same under contribution. In a case brought finally before the United States Supreme Court to set aside one of Berliner's patents, the patent was not issued till thirteen years after the filing of the application. The court said: "Why should the validity of the grant which that tribunal [the Patent Office] finally makes, depend in any degree upon the number of times he has repeated his application?" and also that the applicant "may insist upon all the advantages and benefits which the statute promises to him."

When the case has been allowed, the Government calls for the payment of the final fee of $20 in order that the patent may issue (p. 38); or, if the case has been finally rejected, the applicant's recourse is by appeal (p. 37.)

INTERFERENCES.

An interference is a proceeding instituted in the Patent Office for the purpose of determining the question of priority of invention, and that question alone, between two or more parties (applicants, or an applicant and a patentee) claiming substantially the same patentable invention. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor, and leave the two patentees to settle their differences before the courts, which may declare either of the patents void in whole or in part.

When the interference has been "declared," that is, instituted, the Patent Office requires each party to file a "preliminary statement" setting forth, under oath, the date of the original conception of the invention claimed, the date upon which a drawing (if any) of the invention was made, the date upon which the model was made, the date of disclosure of the invention to others, the date of reduction to practice, and a statement of the extent to which the invention has been used. When the invention was made abroad, the preliminary statement must set forth other facts. A party is bound by the dates alleged in his preliminary statement, and cannot prove a date earlier than the one set up therein; for example, suppose the date of conception is alleged in the statement as August, 1895. The applicant will not be allowed to prove that he conceived it earlier than that, even though he may have been mistaken in setting up the date of August, 1895. The Patent Office does not allow a change in the preliminary statement except on a very clear showing by affidavits. The importance of keeping a record of experiments, and also the subjects of the experiments, as outlined on page 7,

will now be apparent. The preliminary statements are, kept secret by the Patent Office till all have been filed. The parties can then inspect them. The statements are in effect the "pleadings" of the interference, and, as the dates alleged should obviously be as early as possible, too great care cannot be exercised in their preparation.

The party who has filed his application first is *presumed* to have been the first inventor, and the later applicant (the "junior party") is therefore put in as the plaintiff in the case, the earlier applicant (the "senior party") being in the position of a defendant. In the absence of any other proof the patent would be granted to the one who first filed his application, and the junior party must therefore, to obtain the patent, prove that *he* was the first inventor, and this proof must be beyond a reasonable doubt. This is another reason why an inventor should file his application as soon as possible.

The question of conception and reduction to practice has been discussed heretofore (p. 6). A thorough understanding of the principles underlying each is of the greatest importance in the proper conduct of an interference.

After the preliminary statements have been filed and approved the Patent Office sets the times for taking testimony, the junior party first, then the senior party in defense, and then the junior party in rebuttal. The testimony is usually taken in writing on a typewriter, and each witness is examined and cross-examined as in a court of law. Witnesses may be subpœnaed to attend such examinations. It is here that a record of experiments, such as outlined on page 7, is a great help and perhaps wins the case, for the actual *thing* which was made, together with a written and witnessed record of the making and of the date, is much more convincing to a court than a mere statement of the facts from memory, which latter may or may not be exact.

When the testimony is all in, the case is argued before the Examiner of Interferences in the Patent Office, who renders his decision awarding priority of invention to one or the other of the parties. This decision is not final, as several appeals (see p. 37) may be taken before a final decision is rendered.

APPEALS.

A rule of the Patent Office provides that "every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, upon grounds involving the merits of the invention, such as lack of invention, novelty, or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements * * * may, upon payment of a fee of $10, appeal from the decision of the Primary Examiner to the Examiners in Chief." The Examiners in Chief are a board of three judges who decide questions appealed on the merits from the Primary Examiners. For example, if the Examiner rejects the claims because they are anticipated by certain references, and on the next action rejects them for the same reason, the appeal can be taken. Upon questions not affecting the merits, which have been twice decided by the Examiner adversely to the applicant for the same reason, a petition may be taken to the Commissioner of Patents, whose decision upon such point is final. For such a petition the Patent Office requires no fee. An example of such a petition would be where the Examiner had twice required the applicant to show another figure in his drawings. The applicant's attorney appears before the appellate tribunal, whichever it may be, and argues the case, or the case may be submitted on a brief without argument. From an adverse decision of the Board of Examiners in Chief an applicant may appeal directly to the Commissioner. For this the Patent Office requires a fee of $20.

An appeal from the Commissioner's adverse decision, on a question appealed to him from the Board of Examiners in Chief, may be taken to the Court of Appeals of the District of Columbia within forty days. No oral testimony is taken, but the case is decided on the record as sent up from the Patent Office. The docket fee for this appeal is $15. If the decision of the Court of Appeals of the District of Columbia is adverse, a bill in equity may be filed to compel the grant of a patent. This is the final resort.

Except in an interference case, if the applicant wins any one of his successive appeals the point appealed is decided in his favor, for neither the Examiner nor the Patent Office

has the right to appeal from a decision in favor of the applicant. In the case of an interference there are two parties, each of whom is endeavoring to prove priority of invention and obtain the patent, and a defeated party may therefore appeal from the Examiner of Interferences to the Board, to the Commissioner, and to the Court of Appeals of the District of Columbia, and may bring a bill in equity to compel the grant of a patent to him. Appeals in infringement suits are discussed hereafter (p. 48).

ALLOWANCE AND ISSUE.

After all questions, both formal and on the merits, have been decided, and the Patent Office considers the patent is ready to issue, the application is formally "allowed," and a notice of allowance is sent to the applicant calling for the payment of the "final fee" of $20. This must be paid within six months of the date of the notice, or the application becomes "forfeited," but can be renewed by the payment of a further fee. If, however, the final fee is paid within the six months, the patent is granted—usually about three weeks from the date of payment.

The term of a United States patent is seventeen years. An inventor cannot recover against infringers until his patent is granted, as before that, he has no exclusive "right" to his invention.

The Government does not guarantee the validity of a patent, nor that the matter patented in it does not infringe one or more prior patents. From the number of inquiries as to these points which the writer has received, it would appear that a great number of inventors and manufacturers do not understand why such guarantees cannot be given. The Government cannot guarantee the validity of a patent, in the first place because the Examiners in the Patent Office cannot know of many circumstances which might make the patent invalid, for example, a public use in some remote part of the United States or a prior invention, and in the second place the Examiners are not infallible and may not have discovered a prior patent or publication which disclosed the matter patented. It cannot guarantee that the matter claimed in the patent does not infringe one or

more prior patents, because improvements on an invention are patentable, and an improvement upon an existing patented device or process often includes the invention previously patented, and the improved device or process is therefore generally an infringement of the prior patent.

There are no taxes to be paid on the patent, nor must it be "worked" after the grant in order to keep the same alive, as is necessary in most foreign countries (see p. 67).

REISSUES.

Section 4916 R. S. provides in part 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 had 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 and the payment of the duty required by law, cause a new patent for the same invention * * * to be issued * * * for the unexpired part of the term of the original patent." A reissue is in the nature of an amendment of an imperfect existing patent so that it will disclose and protect the subject-matter which the patentee *intended and attempted* to protect, when the imperfection arises from inadvertence, accident or mistake, and without fraud or deceptive intent. It does not, for all purposes, have the effect of a grant of an entirely new patent. Matter not disclosed in the original cannot be included in the reissue application, nor in the case of a machine patent can the model or drawings be amended except each by the other. If the original application did not disclose certain material parts of the invention, it is not a ground for reissue; nor if the patentee merely claimed less than he was entitled to. The defects which can be remedied are principally defects of statement or description of the invention. A claim can seldom be broadened. The record of the original application must show that the applicant attempted to describe and claim it. If this attempt cannot be shown there is no ground for a valid reissue. The mere fact that an applicant showed matter in his original ap-

plication which he might have claimed but did not, is not sufficient. In determining his former purpose all the papers, including the amendments, may be examined. Matter described in the original patent as an essential part of the invention, cannot be omitted in the reissue. A claim may, in some cases, be broadened by reissue, but this is looked upon by the courts with suspicion, but a claim legally abandoned in the original application cannot be reinserted in the reissue. The reissue application must be sworn to by the inventor if living, and must be accompanied by a surrender of the original patent. It will be returned if the reissue is refused.

A reissue should be applied for as soon as the defect in the patent is discovered. Delay may be construed by the courts as abandonment. A delay of over two years has had this effect, and under the present statute (p. 34) one year's delay may be so construed.

DISCLAIMER.

Section 4917 R. S. provides in part that "Whenever through inadvertence, accident or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, * * * any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may * * * make disclaimer of such parts of the thing patented as he shall not choose to claim or hold * * *. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof." Also § 4922 R. S. in part, "But in every such [infringement] case in which a judgment or decree shall be rendered for the plaintiff, no costs shall be recovered unless the proper disclaimer has been entered at the Patent Office before the commencement of the suit."

A disclaimer, when needed, should be filed without delay. The usual purpose of a disclaimer is to cancel a

claim or claims which are anticipated, and therefore rendered void, by the prior act. The subject is not of sufficient importance to discuss here at length.

TRANSFERS OF INTEREST.

An *Assignment* is a transfer of the entire interest in an invention, or an undivided part thereof, as to the entire United States. It may be made before or after the invention has been patented.

A *Grant* is the transfer of the exclusive right to make, use and sell under the patent within some specified part only of the United States, for example, in a single State.

The assignor of the entire interest cannot practice the invention in the United States, nor the grantor within the section granted, without the consent of the assignee or grantee. A patent is personal property. An assignment, grant, license or other transfer of any interest in an invention, should for protection be in writing. A transfer of an interest in a patent need not be sealed or witnessed to be valid. It should, however, be witnessed, as a precaution. A transfer of the right to make alone, or to make and sell only, or to make, or use, or sell, is neither an assignment nor a grant, but is a license (p. 42). An assignment of the entire invention or grant transfers the exclusive interest in the invention,—in case of a grant it is for only a part of the United States, the right to the rest remaining in the grantor. An assignee or grantee can grant licenses, the latter only to the extent of his territory.

A patent may be transferred by will, and is held by the testator's executors or administrators in trust for the heirs. An interest in a patent may be mortgaged. A contract for the transfer of a specified future invention is not an assignment, but is a contract under which the courts will compel the assignment to be made. An assignment transfers the invention referred to therein, but not necessarily any improvements thereon. If the assignment contains an agreement to transfer future improvements which the assignor may make, the assignee takes an equitable title to

such improvements, on that particular invention, when made. But an agreement to transfer "all future inventions" has been held to be too broad and indefinite. An assignment of any undivided part of the patent makes the assignee and assignor joint owners, and either can practice the invention without consent of the other. A single claim of a patent cannot be assigned without the rest. A grant or assignment may be upon conditions either subsequent or precedent.

A *License* has been defined to be any transfer "which does not convey to the assignee the entire and unqualified monopoly which the patentee holds in the territory specified, or an undivided interest in the entire monopoly." If any part of the right in the specified territory remains in the transferor alone, it is a license. Thus the transfer of the right to make and sell is a license, because the right to use was not conveyed. A transfer of the exclusive right to make, use *and* sell, however, conveys the entire interest, and is construed to be an assignment. A license to make does not necessarily also convey the right to sell. A licensee cannot license others, unless specially permitted by the licensor. A license is not revocable by the licensor unless so specified. A license may be verbal, but should be in writing. A license may also be implied from the conduct of the owner. This is often seen in the case of employer and employee. An employer has no right to the inventions of his employee merely because of the relations between the two, but if the employer hires a workman to invent improvements on a machine, he thereby becomes equitably entitled to such inventions. Even if there is no express contract between them as to inventions, if the employee, using the time, tools and materials of the employer, makes and patents an invention and allows the employer to use it practically in his business, the law implies a license to the employer. This question often arises where the employee then leaves the employ, and afterwards strives to restrain his former employer from practicing the invention. A person who purchases of the inventor, or, with his knowledge and consent, constructs any newly invented or discovered machine, or other patentable article, prior to the inventor's application for a patent on the same, or who

sells or uses one so constructed, has the right to use and sell to others to be used, the specific thing so made or purchased, without liability therefor.

Recording.—An assignment or grant of a patent is void, as against any subsequent purchaser or mortgagee who has paid a valuable consideration therefor and who had no notice of the prior conveyance, if said assignment or grant has not been recorded in the Patent Office within three months from the date of execution thereof. Record in the Patent Office within said three months is constructive notice to all the world of the transfer, and no patent or interest should be bought without having the title, as there disclosed, examined by an attorney to find where the title lies. This may also disclose the fact that there are licenses outstanding. The law does not require a license to be recorded, and if recorded it has been held to be not a constructive notice, but it is often wise to record a license, as thereby it may come to the actual notice of a purchaser of the patent.

An assignment or other conveyance of a patent should always be acknowledged before, for convenience, a notary public, or a consular officer if abroad, who should always attach his seal, as the certificate is *prima facie* evidence of execution.

INFRINGEMENTS.

A patent confers upon the patentee the exclusive right to make, use and sell the patented invention throughout the United States and Territories. The manufacture, use or sale of the patented invention within those limits, unauthorized by the owner of the patent right for that locality, is, therefore, an infringement. The intent with which the act was committed does not, in general, affect the question, although it is important in the question of contributory infringement (p. 44) and damages (p. 48). A patent is an entirety, and an infringement of only one claim is an infringement of the patent. An assignor of the entire interest becomes an infringer by the manufacture, use or

sale of the invention by him. A grantor infringes his grantee's rights by the same acts in the territory granted. Similarly the grantee is an infringer of the grantor's rights by such acts outside the territory granted. A licensee, however, cannot, as a rule, sue for infringement without joining his licensor. A licensee may become an infringer by acts not included in the scope of his license, for example, a license to sell does not include the right to make. The United States has no right to infringe a patent, nor has a State or city government. A claim for a combination is not infringed by the making, use or sale of an element alone of that combination, except in the case of a "contributory infringement."

Where part of a patented device is made by one person and part by another, with the *intent* that the two parts shall be joined so as to constitute an infringement, each party contributes to the ultimate infringement, although the particular part which he makes may not by itself be an infringement, and is therefore held to be constructively an infringer of the patent. This contributory infringement often arises where a person makes or sells parts of a patented machine or other article. The intent must be present, to constitute a contributory infringement, for the mere manufacture of an unpatented article, which may in some way be used to contribute to an infringement, but without the legal intent that it shall be so used, is not illegal. The circumstances of each case determine whether or not there is contributory infringement.

If a person has a patented machine which he has the right to use, he also has the right to keep the same in an operative condition by repairs which do not amount to a reconstruction of the machine. If a part becomes worn out or broken, he may, usually, make and replace that part, but he cannot make a substantially new machine. The line dividing legitimate repair and illegal reconstruction cannot be well defined, and each case must be decided in view of its particular circumstances.

The particular invention claimed must be made, used or sold to constitute an infringement. Every element named in the claim must be present. This does not mean that the identical device illustrated in the patent drawings must be employed. The substitution of equivalents for certain

elements in a combination or process claim may be an infringement—such as a wedge for a screw, a weight for a spring, etc. An equivalent has been defined as an element which "accomplishes substantially the same result in substantially the same way, and was known as a proper substitute at the time the invention was made."

A device which seems to answer every requirement of a claim may not be an infringement thereof. The claim must be construed in the light of the prior act, the wording of the specification, and the actions in the Patent Office before the patent was granted, and may thus be given a narrow interpretation when it seems to be broad. The amendments made in the Patent Office may cut down the scope of a claim (see p. 33).

An "infringement search" is a search through the United States patents in the Patent Office to find whether a certain invention infringes any of said patents. It is oftenest made where a client wishes to manufacture that invention but wants to avoid a suit for infringement. The search may show that the invention does not infringe any prior patent, and the manufacturer may therefore go ahead without the fear of a successful suit against him. If a patent is found which claims the invention, the attorney may be able to instruct the manufacturer how to slightly change his device so that he will not infringe, or, if the patent cannot be avoided, the manufacturer may be able to buy the patent, or obtain a license under the same. In either case the client will probably be saved the expense and annoyance of a suit for infringement. Even if he is compelled to give up the proposed manufacture, on account of the threatening patent, he is saved the expense of installing new machinery, besides the expense of a suit. The writer recently made a validity search on a process of paper manufacture and found three threatening patents. Two of these, on investigation of the prior art and the actions in the Patent Office, were decided to be too narrow to include the process. The third patent had one claim, out of a dozen or more, which might be held to cover the process. An easy way of avoiding the claim was pointed out, and the inventor is now, after having obtained a patent on his process, carrying on the process in comparative security.

The question why the Government grants a patent on

an invention which infringes another patent has been explained on page 38.

No question of infringement should be decided without the advice of competent counsel, as it is one of the most complicated questions in the Patent Law, and the correct answer depends on such a variety of considerations that it cannot be settled with any degree of certainty without expert legal knowledge.

PATENT SUITS.

Jurisdiction in patent and copyright suits is given by the Constitution to the United States Courts. A suit for the recovery of royalties on a license, or for the enforcement of a contract in regard to a patent, is not a patent suit, such as by itself gives jurisdiction to the United States Courts. Such suits may usually be brought in the State courts. The Circuit Courts of the United States have original jurisdiction over patent suits. Suits for infringement may be either at law or in equity. If at law, damages and profits for past infringements can be recovered, but an injunction cannot be granted. As an injunction is usually sought, it is customary to bring the suit on the equity side, as damages and profits can be awarded, besides injunctions. No infringement can be committed before the patent is granted, nor, where suit is brought on a reissue, before the re-issue is granted. As a rule, a suit for infringement cannot be maintained for acts done after the patent has expired, but the sale, after the expiration of a patent, of infringing goods made before that time, is illegal and can be restrained. A single suit cannot be properly brought on two patents, unless the inventions are capable of conjoint use and have been so used.

As soon as the owner of a patent learns that his patent is being infringed, he should notify the infringer in writing to desist. This, and particularly the reply to such a letter, as well as all subsequent actions, should be made only after advice by a competent attorney, as the wording of them is often of the greatest importance. In preparing the defense to an infringement suit, the record of the title and of the actions in the Patent Office are carefully examined, and a "validity search" through the records of patents and

publications, both foreign and domestic, in the Paten Office should be made by the attorney, to find whether the patent has been in fact properly granted. Such a search should always be made before the defense is prepared, as patents or publications are often discovered which anticipate all or some of the claims, or cut down the scope of the claims so that the defendant can escape infringement. Such a search also discloses the "state of the art," that is, what prior inventors have done in that line of invention, and therefore gives the court an opportunity to see just how great or how small an advance over what was old the patentee has made. Such a search should never be omitted, either by the defendant in a suit, or by a person who contemplates purchasing an interest in a patent. In either case the search may show that the patent is invalid, and therefore worthless, or so restricted in scope as to be practically of no value. This is also true where a manufacturer wishes to make a patented invention. A validity search may show that the patent is invalid and that the public has, therefore, the right to practice the invention. The other defenses, such as public use or sale, title, abandonment, estoppel, constructive license, etc., are investigated, and, with the anticipations found by the validity search, set up in the answer, which must be filed generally in about a month after the filing of the bill of complaint.

A "preliminary injunction" is often sought by the complainant. This is for the purpose of restraining the defendant from infringing the patent till the decision of the suit. If obtained, it shuts up the defendant's business to the extent of the patented invention, for he cannot make, use or sell the same while the injunction is in force. The suit may not be decided for months, often for a year or more, and during this time the trade must buy elsewhere, usually of the complainant. A preliminary injunction is an extraordinary relief, and is not granted unless the complainant proves with certainty that he has the title to the patent and that the defendant has infringed, and he must also show that the patent is presumably valid. If there is doubt on any of these points, the injunction should be refused. The decree granting or refusing a preliminary injunction may be appealed from to the Court of Appeals of the proper circuit.

The evidence in a patent suit is not, usually, taken orally before the court, but before a master appointed by the court, and usually in the attorney's office. Witnesses can be subpœnaed to attend. Expert testimony is necessary in most suits. When the testimony has all been taken, it is printed, and the case argued before the court. If the decision is for the complainant, the decree usually sustains the validity of the patent, adjudges that the defendant has infringed, and awards a perpetual injunction against him. If damages or profits, or both, are prayed for in the bill of complaint, an accounting may be had before a master, who reports to the court the amount of damages and profits found. The court then makes a final decree, which may include either or both besides the injunction. The statutes empower the courts to increase the amount of damages found to any sum not exceeding three times the amount of such actual damages, if the circumstances warrant such action. These are called "punitive damages," and are sometimes awarded to punish the defendant in a case of willful and flagrant infringement. If the decision is for the defendant, the bill is dismissed. Costs are awarded in the discretion of the court.

From the final decree the defeated party may appeal to the Court of Appeals of the circuit. Appeals cannot, under the present law, be taken as a right to the Supreme Court, but cases may be taken there under some circumstances.

A patentee should not delay in bringing suit against an infringer. The delay of several years has, in a number of cases, been held to be an abandonment of the patentee's right to sue that infringer. The statutes also provide that in any suit or action brought for the infringement of any patent there shall be no recovery of profits or damages for any infringement committed more than six years before the filing of the bill of complaint or the issuing of the writ in such suit or action. Long delay is almost invariably a cause for refusing to grant a preliminary injunction.

Interfering Patents.—Where two patents interfere, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee by a suit in equity; and the court may adjudge either of the patents void in whole

or in part. A suit of this character should not be confounded with an "interference" in the Patent Office in which at least one application must be involved (see p. 35). This "interference" between to patents has been held to mean the same as in the proceeding in the Patent Office. The cases seem to hold that two patents do not "interfere," with the meaning intended by the statute, merely because one infringes the other. Just what the limits are has not yet been satisfactorily determined by the courts.

MARKING PATENTED ARTICLES.

Section 4900 R. S. provides that: "It shall be the duty of all patentees, and their assigns and legal representatives, and of all persons making or vending any patented article for or under them, to give sufficient notice to the public that the same is patented; either by fixing thereon the word "patented," together with the day and year the patent was granted; or, when from the character of the article this cannot be done, by fixing to it, or to the package wherein one or more of them is enclosed, a label containing the like notice; and in any suit for infringement by the party failing so to mark, no damages shall be recovered by the plaintiff except on proof that the defendant was duly notified of the infringement, and continued, after such notice, to make, use or vend the article so patented."

The failure to give the proper notice that the article is patented may prevent the recovery of damages, but does not, of itself, prevent the grant of a preliminary, nor of a permanent, injunction.

Fraudulent Marking.—"Every person who, in any manner, marks upon anything made, used or sold by him for which he has not obtained a patent, the name or any imitation of the name of any person who has obtained a patent therefor, without the consent of such patentee, or his assigns or legal representatives; or who, in any manner, marks upon or affixes to any such patented article the word 'patent' or 'patentee,' or the words 'letters patent,' or any word of like import, with intent to imitate or counterfeit the mark or device of the patentee, without

having the license or consent of such patentee or his assigns or legal representatives; or who, in any manner, marks upon, or affixes to any unpatented article the word 'patent' or any word importing that the same is patented, for the purpose of deceiving the public, shall be liable, for every such offense, to a penalty of not less than one hundred dollars, with costs; one-half of said penalty to the person who shall sue for the same, and the other to the use of the United States to be recovered by suit in any district court of the United States within whose jurisdiction such offense may have been committed." (Sec. 4901 R. S.) For the requirements as to marking articles made abroad, see p. 62.

DESIGNS.

Section 4929 R. S. provides in part that: "Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design * * * or any new, useful and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may * * * obtain a patent therefor." Nearly all the prerequisites as to the patentability of inventions, such as absence of two years public use, prior invention, or abandonment, etc., apply also to designs. A reissue (p. 39) of a design patent may be had, and a caveat (p. 25) and disclaimer (p. 40) can be filed.

A design is intended to please the eye of the observer, instead of being a shape which is merely better mechanically. It may consist of an entire article, as a new design for a stove, or of a part thereof, as a design for a handle, or it may be purely for decorative effect, as a peculiar ornamentation of the door of the stove. It must be useful in the sense that it is not immoral or necessarily harmful. The Supreme Court has said that "The Acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance." There must be invention displayed in the production of the design; mere mechanical skill is insufficient.

A prior mechanical patent on a device does not necessarily prevent the grant to the same person of a patent on a design shown therein.

To constitute a new design, it must appear to be such to the eye of the *ordinary* observer, not necessarily to the eye of the expert. The mechanical effects are to be disregarded entirely in judging of the similarity or difference between designs. It is the appearance to the eye of the ordinary observer which is the criterion. So, too, in the case of an alleged infringement of a design, patent, the mechanical results which two devices produce may be precisely the same and they may operate in precisely the same way, and yet be different designs, but if an ordinary observer, using ordinary care, would not mistake one design for the other by their appearance, they are different designs in the eye of the Patent Law.

Any person who unlawfully and knowingly manufactures for sale, or sells or exposes for sale, any article of the patented design, is liable to the extent of $250; and in case the total profit to him from the infringement exceeded that amount, he is liable for the excess also, which may be recovered by the owner of the patent. Damages and injunctions may also be awarded.

Design patents are granted for 3½, 7 or 14 years, at the option of the applicant, the Government fee being $10, $15 or $30, respectively.

In general, the practice as to design patents follows that as to mechanical patents, and nearly all the regulations and provisions which apply to obtaining or protecting patents for inventions apply also to patents for designs.

COPYRIGHTS.

An author, resident in this country, has a property in his intellectual production before it has been published, independent of any right conferred by statute. It is, in effect, not the right to make copies, but the right to first *publish*; and he can, without obtaining a copyright, restrain others from, and obtain damages for, copying or publishing his work before he himself publishes it, without his permission. This right continues until the work is published by

him, and then ceases. The necessity for enforcing this non-statutory right seldom arises, but may be invoked to prevent the unlawful piracy of his work before he obtains a copyright. Suits on this right must, usually, be brought in the State courts. The right of copying, *i. e.*, the "copyright," conferred by statute is of more practical importance.

STATUTORY COPYRIGHT.—The grant of copyright is authorized by the same section of the Constitution as authorizes the grant of a patent for an invention, namely Art. I, § 8, which says that "The Congress shall have power * * * to promote the progress of science and useful arts by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Congress has delegated the power to grant copyrights to the Librarian of Congress.

What may be copyrighted.—The author, inventor, designer or proprietor of any book, map, chart or musical composition, engraving, cut, print or photograph or negative thereof, or of a painting, drawing, chromo, statute, statuary, and of models or designs intended to be perfected as works of the fine arts, and the executors, administrators, or assigns of any such person, may obtain a copyright giving him the sole liberty of printing, reprinting, publishing, completing, copying, executing, finishing and vending the same; and, in the case of a musical composition, of publicly performing or representing it, or causing it to be performed or represented by others. And authors or their assigns may obtain the exclusive right to dramatize or translate any of their works, for which copyright has been obtained under the laws of the United States. A foreigner may obtain a copyright when his foreign state or nation permits reciprocal rights to citizens of the United States. A citizen of the United States may obtain a copyright in nearly all of the European countries on substantially the same footing as citizens of those countries. In many other countries he may also obtain a copyright, but under restrictions. A pamphlet, or even a single page or article, has been held to be a "book." A circus poster has been decided to be not a "work of the fine arts" such as entitles the designer or owner to a copyright.

The above words "engraving," "cut" and "print" are applied only to pictorial illustrations or works connected with the fine arts. There must be some intellectual effort spent on the subject to make it copyrightable. Prints or labels designed to be used for any other articles of manufacture cannot be entered under the copyright law, but may be registered in the Patent Office (see p. 82).

Term.—Copyrights are granted for the term of twenty-eight years. The author, inventor or designer, if living, or his widow or children, if he is dead, may have the copyright continued for a further period of fourteen years.

Procedure.—To obtain a valid copyright under the statutes a person must, on or before the day of publication, in this or in any foreign country, deliver at the office of the Librarian of Congress, or deposit in the mail within the United States, addressed to the Librarian of Congress at Washington, a printed copy of the title of the book, map, chart, dramatic or musical composition, engraving, cut, print, photograph or chromo, or a description of the painting, drawing, statue, statuary, or a model or design for a work of the fine arts for which he desires a copyright. He must also, not later than the day of the publication thereof in this or in any foreign country, deliver at the office of the said Librarian, or similarly deposit in the mail, two copies of such book, map, chart, dramatic or musical composition, engraving, chromo, print or photograph, or, in case of a painting, drawing, statue, statuary, model or design for a work of the fine arts, a photograph of the same. In the case of a book, photograph, chromo or lithograph, the two copies required as above must have been printed from type set within the limits of the United States, or from plates made therefrom, or from negatives or drawings on stone made within the limits of the United States, or from transfers therefrom. The importation of any book, chromo, lithograph or photograph, so copyrighted and not produced as above specified, is forbidden while the copyright is in force, except in a few cases.

A copyright of a book secures its contents, including prints, engravings, etc. A "publication," in the sense above meant, need not necessarily be a distribution or sale

of copies. It has been held that an offering of the book to public notice, or rendering it accessible to public scrutiny, is a publication. It has also been decided that an exhibition of a painting to which the public could come was a publication of the painting. It would still be so, even though an admission fee were charged. It has been held that a mere advertisement, having no intellectual quality, is not copyrightable. It has been held by a Court of Appeals that the "description" which must be filed in certain cases, as above specified, is not contained in the "photograph" which must also be filed. A verbal description of the subject is required. A copy of each subsequent edition of a book must also be filed, when substantial changes are made. Each volume, of a book in two or more volumes, and each number of a periodical, is an independent publication, and subject to copyright as such. Sending the printed title of a book or magazine does not copyright the title. It is the book or magazine itself which is copyrighted, and sending the title merely is not sufficient. A failure on the part of the proprietor of a copyright to deliver, or deposit in the mail, either of the published copies, or description or photograph above required, makes the proprietor liable to a penalty of $25.

No person can maintain an action for infringement of his copyright unless he gives notice thereof by inserting in in the several copies on the title page, or the page immediately following, if it is a book; or, if a map, chart, musical composition, print, cut, engraving, photograph, painting, drawing, chromo, statue, statuary, or model or design intended to be perfected and completed as a work of the fine arts, by inscribing upon some visible portion thereof, or of the substance on which the same is mounted "Entered according to Act of Congress in the year——by A. B., in the Office of the Librarian of Congress at Washington"; or, if preferred, the word "Copyright," with the year of entry of the copyright and the name of the party by whom the copyright was obtained, thus "Copyright, 1900, by John Smith." The Supreme Court has held this to be a condition precedent to a valid copyright. The "several" copies includes the original. The purpose of this requirement of marking is to give notice of the copyright to the public, and the courts have not required

the words of the statute to be strictly followed, providing the essential information is given. For example, "Copyright '93 by Bolles, Brooklyn," was decided by the Supreme Court to be a sufficient compliance. It has also been held that additional statements are mere surplusage so long as the essentials of the notice are given. In the case of moulded decorative articles, tiles, placques, or articles of pottery or metal, the above notice may be placed on the back or bottom.

A person who impresses such notice falsely upon an article for which he has no copyright, or knowingly issues or sells or imports the same, is liable to a penalty of $100.

Infringement.—If, after the title of a *book* has been recorded, and the two copies deposited as heretofore provided, a person unlawfully prints, publishes, dramatizes, translates or imports, or, knowing the same to be so printed, published, dramatized, translated or imported, sells or exposes for sale any copy of such book, he is liable to forfeit every copy to the proprietor of the copyright, besides damages. If the consent of the proprietor is first obtained in writing, signed in the presence of two witnesses, the liability does not attach. A cut in a book may be a subject of copyright distinct from the book itself.

If, after the record of the title of a map, chart, dramatic or musical composition, print, cut, engraving or photograph or chromo, or the description of a painting, drawing, statue, statuary, or model or design intended to be perfected and executed as a work of the fine arts, a person, without the consent of the proprietor of the copyright first obtained in writing, signed as above stated, engraves, etches, works, copies, prints, publishes, dramatizes, translates or imports, either in whole or in part, or by varying the main design, with intent to evade the law, or knowing the same to be so printed, published, dramatized, translated or imported, sells or exposes for sale any copy of any of the above articles, he is liable to forfeit to the proprietor all the plates on which the same are copied, and every sheet thereof, either copied or printed, besides one dollar for every sheet found actually in the possession of the infringer, whether those sheets are printing, printed, copied, published, imported or exposed for sale. A corporation is a "person."

It has been held that a book is not included in the above. In case of the infringement, by any of the above acts, of a copyright for a painting, statue or statuary, the infringer is liable to the forfeiture of ten dollars for every copy in his possession, or by him sold or exposed for sale; provided that in case of any such infringement of the copyright of a photograph made from any object not a work of the fine arts the sum recovered shall be not less than $100, nor more than $5,000; and provided, further, that in case of any such infringement of the copyright of a painting, drawing, statue, engraving, etching, print or model or design for a work of the fine arts, the sum to be recovered shall be not less than $250, and not more than $10,000. One half the above penalties goes to the proprietor and the other half to the United States.

Any person publicly performing or representing any copyrighted dramatic or musical composition without permission is liable in damages, and such damages are to be in every case not less than $100 for the first, and $50 for every subsequent, performance. The performance of only a part of the copyrighted matter may constitute an infringement. When the unlawful performance is willful and for profit, the infringer is guilty of a misdemeanor, and may be imprisoned for not more than a year.

Any person who prints or publishes any manuscript whatever, without the consent of the author or proprietor first obtained, is by statute liable to the author or proprietor for all damages therefor (see also p. 51).

Suits for infringement are, like patent suits, usually brought in the United States Circuit Courts, and the procedure is about the same (see p. 46). A suit on the non-statutory right is, however, usually brought in the State courts (p. 52). Injunctions restraining infringement may be granted. Actions for forfeiture or penalty must be brought within two years of the infringement complained of.

The assignment of a copyright should in all cases be in writing attested by two witnesses, and must be recorded in the office of the Librarian of Congress within sixty days, or it will be void as against any subsequent purchaser or mortgagee who paid a valuable consideration therefor and who had no notice of the prior transfer.

TRADE-MARKS.

The purpose of a trade-mark is to denote the origin, as the maker or seller, or the ownership, of the article to which it is applied. The courts have for years protected trade-marks on the broad ground that he who by honest dealing has built up a reputation with the public for excellence of quality in his goods should be able to prevent another person from damaging his trade by deceiving the public into buying the goods of the same kind of the latter person when they supposed they were buying the goods of the former. It often happens that where the goods sold by a person have for years been designated by a particular mark, the public have become accustomed to distinguish those goods by the mark alone and to consider that goods of the same kind, bearing that mark, all came from the same person, and they would be deceived into taking the goods of another person if a similar mark was applied to them. The trade-mark protection is given by the law in order to prevent this unfair competition in trade. It is on this broad ground that courts will often restrain, or give damages against, a person who has apparently not copied the trade *device* of another, but has put up his merchandise in packages having a shape and coloring similar to those of the plaintiffs, so that the public would probably mistake the one for the other.

Who may own a Trade-mark.—Under the non-statutory right a person who makes or selects articles of merchandise, and places them on the market, may adopt a trade-mark for such merchandise and be protected therein. Under the statutory registration of a trade-mark an "owner" may be almost any one who makes, carries, sells or handles the merchandise.

In What a Trade-mark Consists.—A valid trade-mark must be some arbitrarily selected designation. A device or symbol is the usual mark, but other means to denote origin or ownership may be selected. A word may be a trade-mark, but it must not be descriptive of the goods to which it is applied, as any person has the right to use any words

which properly describe his merchandise. The word "Star" applied to shirts, underwear, etc., has been upheld as a trade-mark, as it is not descriptive of the goods. The following have been held to be descriptive, and therefore not valid trade-marks: "Liquid" Glue, "Best" Tobacco, "Aromatic" Schiedam Schnapps, "Croup Tincture," "Iron Bitters," "American" Sardines, "Straight Cut" Cigarettes, "Durham" Tobacco, "Microbe Killer," for a vermin exterminator, "Lackawanna" Coal, and "St. Louis" Beer, the last two being mere geographical adjectives describing where the articles were produced. The word "Uneeda" applied to biscuits, and "Asepsin" applied to an antiseptic composition, have been upheld, and are good illustrations of valid trade-marks which might convey some meaning when applied to the article, but which are not, in fact, descriptive of the article. A single letter or a numeral may, usually, be a trade-mark. The *mere* name of the inventor or maker is usually not a good trade-mark, as another person of the same name might make the same article, but, in some cases of deliberate fraudulent imitation, a maker has been protected in the use of his name. A name written or printed in a peculiar way, such as a running signature, may be a valid trade-mark. A business sign may, in some cases, be protected as a quasi trade-mark. The size, shape, color, decoration of, and wording upon, the two packages, are often taken into consideration in ascertaining whether there has been an intent to imitate the appearance of the other goods, although the intent to infringe need not, in most cases, be proven.

A trade-mark is not universal for all classes of manufactures; for example, a person who manufactured axes and applied his trade-mark to them only could probably not prevent a baker from using the same mark on his bread alone. The trade-mark, to entitle the owner to the exclusive right to designate a class of manufacture thereby, must have been used by him on the articles in such class. A trade-mark need not in all cases be actually applied to the article. It may in most cases be on the packages containing it. The use of a word which sounds, but does not look, the same as another word used as a trade-mark, has several times been held to be illegal. Similarly the word

"Bouquet," applied to an article, has been held to be an infringement of a trade-mark consisting of the picture of a bouquet.

The Non-Statutory Right.—The law within the United States affords substantial protection to owners of trade-marks independently of any statutory provisions. The statutes as to trade-marks do not "prevent, lessen, impeach, or avoid any remedy at law or in equity which any party aggrieved by any wrongful use of any trade-mark might have had" if the statutes had not been passed. In actions under the non-statutory right, the exclusive ownership of the trade-mark must be *proved* by the plaintiff, and the suit must, usually, be in a State court, while the registration of a trade-mark, being *prima facie* proof of ownership, shifts the burden of proof onto the defendant, and suit may be brought in the United States courts.

Under the Statutes.—Section 1 of the Trade-mark Act of 1881 provides that "owners of trade-marks used in commerce with foreign nations, or with the Indian tribes, provided such owners shall be domiciled in the United States or located in any foreign country or tribes which by treaty, convention or law affords similar privileges to citizens of the United States, may obtain registration of such trade-marks * * * ." Registration is not the *grant* of an exclusive right to the trade-mark, as in the case of the grant of a patent. In the case of a trade-mark the owner, by his non-statutory right, had the exclusive right to it before registration, perhaps years before, but the exclusive right to an invention is not conferred till the patent is granted. An examination for novelty is made by the Patent Office. Registration of a trade mark is, as heretofore stated, *prima facie* proof of ownership. An owner of a trade-mark which is used on articles sold only in the United States may, independent of statute, have protection of his right, but before he can register his trade-mark under the statutes, he must have actually used that trade-mark on the article in commerce with a foreign nation or with some Indian tribe. This provision is usually complied with, in case the owner has not so used the trade-mark in commerce, by sending one or more of the articles,

with the trade-mark thereon, to a foreign country. The United States has entered into treaties or relations with most of the principal countries of the world, so that citizens of the United States may obtain protection there and citizens of such foreign countries may register their trade-marks here.

Registration.—In obtaining registry of a trade-mark there must be recorded in the Patent Office a statement specifying the name, domicile, location, and citizenship of the party applying, the class of merchandise and the particular description of goods comprised in such class to which the trade-mark has been appropriated, a description of the trade-mark, with *fac-similes* thereof, and a statement of the mode in which the same is applied and affixed to goods, and the length of time it has been used. The Government fee required is $25. A written declaration under oath by the person, or member of the firm, or officer of the corporation applying, must be filed, stating in effect that all the prerequisites of the statute have been complied with. This "declaration" must be carefully drawn, as the statute expressly states that the application "must, in order to create any right whatever in favor of the party filing it," be accompanied by a declaration setting forth in detail the matter specified. Interferences are conducted by substantially the same procedure as in the case of an interference in an application for a patent (see p. 35). It has been held, however, that an appeal will not lie from the Commissioner in such a case to the Court of Appeals of the District of Columbia.

Term.—The right under the registration remains in force for thirty years, except in cases where the trade-mark is claimed for, and applied to, articles not manufactured in this country, and in which it receives protection under the laws of a foreign country for a shorter period, in which case it expires at the same time as that in the foreign country. It can be renewed for another thirty years at any time during the six months prior to the expiration of the first thirty years. The public has not the right to use a registered trade-mark merely because the term has expired, but the owner still retains his non-statutory rights (see p. 59).

Infringement and Suits.—Any person who reproduces, counterfeits, copies or colorably imitates any trade-mark registered under the act now in force, and affixes the same to merchandise of substantially the same descriptive properties as those described in the registration, is liable in damages to the owner of the trade-mark, "for the wrongful use of said trade-mark," and the owner can also enjoin the wrongful use of his trade-mark when it has been used by the defendant in commerce with foreign nations or with Indian tribes, and can also recover compensation therefor.

The judgment of an expert is not the test as to whether one trade-mark infringes another. If the ordinary purchaser, using ordinary care, and judging from the two marks, would mistake the one for the other and buy one article thinking he was buying the other, there is an infringement. From the authoritative cases it seems that the present statute is to be narrowly construed, and in fact more than one court has cast doubts upon its constitutionality. The statutes apparently require, and, in a recent case, a United States Court of Appeals seemed to infer, that, to entitle a plaintiff to recover under this statute, a defendant *must* have used the trade-mark in commerce with a foreign nation or an Indian tribe. Whether this will be held hereafter to be a prerequisite or not, an owner of a trade-mark, registered or not, can obtain damages from, and can also restrain, a person who has wrongfully applied the trade-mark to merchandise of the same class and sold the same, either in the United States or in foreign commerce. Registration of the trade-mark takes away no right which the owner would have if it were not registered, and prevents the necessity of *proving* ownership when suit is brought under the statutes of the United States. It is also important in the introduction of evidence in some cases. A trade-mark should, therefore, always be registered. The courts of the United States have jurisdiction of cases arising under the statute. A person who fraudulently registers a trade-mark as his own is liable for any damages sustained thereby.

The United States statutes do not make the infringement of a trade-mark a crime, but some States have passed laws making it a criminal offence. It is a misdemeanor in New York.

Assignments.—The right to use a trade-mark on the same classes of goods may, in most cases, be assigned. In some instances, however, the trade-mark is purely personal and cannot be transferred. The sale of a business and the good-will thereof usually passes the right to the trade-marks also. Each case depends on its own circumstances. Assignments of registered trade-marks may be recorded in the Patent Office, but the statutes do not impose a forfeiture of any right by delay in recording.

Articles made Abroad.—Section 11 of the Tariff Law of 1897 provides in part "That no article of imported merchandise which shall copy or simulate the name or trade-mark of any domestic manufacture or manufacturer, or which shall bear a name or mark which is calculated to induce the public to believe that the article is manufactured in the United States, shall be admitted to entry at any custom house of the United States." A domestic owner of a trade-mark can have it recorded in the Treasury Depart, ment at Washington for the guidance of customs officials in reference to the above section.

Section 8 of the same act provides in part "That all articles of foreign manufacture, such as are ordinarily marked, stamped, branded or labeled, *and all packages containing such or other imported articles*, shall, respectively, be plainly marked, stamped, branded or labeled in legible English words in a conspicuous place, so as to indicate the country of their origin, and the quantity of their contents; and, until so marked, stamped, branded or labeled, they shall not be delivered to the importer." The expression "quantity of their contents" has been interpreted by the Treasury Department to mean the number of articles contained in the package.

LABELS AND PRINTS.

A section of the act relating to copyrights provides that "in the construction of this act the words 'engraving,' 'cut,' and 'print' (see p. 52) shall be applied only to pictorial illustrations or works connected with the fine arts, and no prints or labels designed to be used for any other

articles of manufacture shall be entered under the copyright law, but may be registered in the Patent Office." The Government fee is $6. No examination is now made as to novelty. Appeal may be taken to the Commissioner. The word "print" is construed by the Patent Office to be an "artistic representation or intellectual production" not borne by an article of manufacture or vendible commodity, but in some fashion pertaining thereto—such, for instance, as an advertisement thereof; and a label as "an artistic representation or intellectual production" impressed or stamped directly upon the articles of manufacture, or upon a slip or piece of paper or other material, to be attached in any manner to manufactured articles, or to bottles, boxes and packages containing them, to indicate the contents of the package, the name of the manufacturer, or the place of manufacture, the quality of goods, directions for use, etc. By "articles of manufacture" is meant all vendible commodities produced by hand, machinery or art.

The certificate remains in force for twenty-eight years and can be extended for fourteen years more on application within six months before the expiration of the first term.

A notice must be placed on the print or label, substantially as in the case of a copyright (see p. 54), for the registration is allowed under the copyright statutes.

PATENT PROTECTION IN OUR COLONIES.

An order of the War Department dated April 11, 1899, provides that "In territory subject to military government by the military forces of the United States, owners of patents, including design patents, which have been issued or which may hereafter be issued, and owners of trade-marks, prints and labels, duly registered in the United States Patent Office under the laws of the United States relating to the grant of patents and to the registration of trade-marks, prints and labels, shall receive the protection accorded them in the United States under said laws; and an infringement of the rights secured by lawful issue of a patent, or by registration of a trade-mark, or label, shall subject the person or party guilty of such infringement to the liabilities created and imposed by the laws of the

United States relating to said matters: *Provided*, that a duly certified copy of the patent, or of the certificate of registration of the trade-mark, print or label, shall be filed in the office of the Governor-General of the island wherein such protection is desired; and *provided further*, that the rights of property in patents and trade-marks secured in the islands of Cuba, Porto Rico and the Philippines, and other ceded territory, to persons under the Spanish laws, shall be respected in said territory, the same as if such laws were in full force and effect."

The following order dated May 26, 1900, has also been issued:

"1. Notice is hereby given to all persons in legal possession of Letters Patent registered in Madrid, Spain, and extended to the island of Cuba to exhibit the duplicates of models, plans and specifications of their patents, or an authenticated copy of the same, together with a certificate that they are in force in Spain, in accordance with Section 5 of the Royal Decree of May 14, 1880, within six months from the date of this order, in order to protect them from pending infringements.

"2. American patents already forwarded for registration, and those that may hereafter be forwarded, will at once be entered in the special register in the office of the Secretary of Agriculture, Commerce and Industries conditionally, reserving the decision in regard to the definite inscription or absolute rejection of such as are determined to be infringements in accordance with the proofs obtained within the period of six months, as provided in paragraph 1 of this order, upon the expiration of which period the inscription will be made in full, leaving to the parties concerned after that date the right of settling their differences before courts of justice."

PRACTICAL SUGGESTIONS.

Put your invention on paper at once—if possible, make complete drawings, and have them witnessed and dated (p. 8). Keep a witnessed and dated record of your experiments, whether successes or failures (p. 7). Don't think that because an invention is simple it is not valuable.

Don't disclose your invention to every one, even your friends. On the other hand, don't tell no-one, for your uncorroborated statement will probably not be sufficient *proof* of what was done (p. 36). Don't delay in accomplishing reduction to practice of the invention (p. 6). Make your application as soon as possible (pp. 21, 36).

When you engage a workman, have it definitely understood whether any or all inventions are to be assigned to you, and, if so, have them so assigned when the application is executed (p. 42). Don't apply in your own name for a patent unless you are actually the inventor, nor, in case of a joint invention, unless you are a *bona fide* joint inventor. Let the actual inventor apply and have the application assigned to you (p. 9). Remember that he who originates the *means* for accomplishing the results is the inventor (p. 9).

Don't lay out money in manufacturing an article until you know whether that article will infringe some other person's patent. A few dollars spent in an infringement search (p. 45) will probably save you money, time and trouble in the future. On the other hand, don't think that because an article is patented you cannot make it. A validity search (p. 46), may show that the patent is invalid, or your counsel can often instruct you how to avoid it (p. 45).

Don't buy any patent, nor any interest in one, without having a validity and title search (p. 43) made, at least the latter. The patent may be void, and therefore worthless, or the title may be defective. The claims of a patent do not necessarily cover everything shown in the drawing.

Don't be frightened if you receive a letter notifying you that you are infringing some patent. It is meant to frighten you, and may be a bluff. Don't answer it without consulting your patent attorney and submitting to him the article as manufactured by you. The wording of such an answer is often of great importance on the question of damages, if you are defeated in the suit.

Don't decide legal questions without consulting competent counsel.

CHARGES.

The writer has practically no fixed charges for either the prosecution of cases before the Patent Office or before the Courts. An "average fee" would probably be too great for a simple case and too small for a complicated one. Each case depends on its own circumstances, but what is aimed at is a reasonable charge for the time and labor involved. Prices upon any particular work will be gladly furnished at any time.

FOREIGN PATENTS.

It will not be attempted, under this heading, to give in detail the laws or procedure in all the different countries. Only the principal countries will be selected, and only the fundamental rules in force in each will be mentioned.

In nearly all foreign countries the invention must be new "within the realm" at the date of application, as public use or a description in a printed publication, at least in that county, will usually prevent the grant of a patent. The patent laws of some of the countries are modeled in part on those of the United States, notably Canada and Germany, and in such countries an examination for novelty is made. Many foreign powers, Great Britain for example, grant patents without such an examination, and allow practically any claims presented, even if broad enough to include matter old in the prior art. Such patents, therefore, have not the presumption of validity which attaches to United States patents. In order to find out the "state of the art" (see p. 47), and to learn what are the probable limits of his rights, an application can, if desired, be filed in the United States and prosecuted to an "allowance" (p. 38) before the foreign patent is filed. The foreign applications, having so far as possible the claims allowed by the United States Patent Office, can then be filed within the six months before the final fee here must be paid (see p. 38). The applications for the foreign patents can be filed at the same time as the domestic application, and, in most cases, should be so filed, in order to get as early a date of application as possible in each country to avoid the bar of publica-

tion or use in that country. In most foreign countries the application there must have been filed before the grant of the United States patent. The United States application should be filed, if not before, then within seven months after, the first *application* in any foreign country (see p. 21).

In the majority of foreign countries taxes must be paid at stated periods, and the invention must also be "worked," that is practiced, in the foreign country, or the patent becomes absolutely void. The theory of this is that if the patentee does nothing with his invention he practically abandons it, and the public is not benefited thereby and should be entitled to use it. If it is a valuable invention, the patentee can afford to pay a yearly tax on it. The laws of the United States do not require that a patent be "worked," nor that a tax be paid after the grant of the patent. It is a question whether it would not be a good plan to engraft such a provision on our patent system.

Patentees do not wish to be troubled by having to keep track of the times for payment of taxes on, or the workings of, their foreign patents, with the danger that any mistake may result in the forfeiture of their patents. The writer has therefore arranged to notify clients, without charge, whenever such taxes or workings fall due on patents taken out by him, usually about three months beforehand, in order that they may instruct him to attend to the matter. The patent can be legally "worked" for a small fee, depending on the particular invention.

The writer has correspondents, practicing patent attorneys, in the different countries, in whom he has confidence and who, by their past work, have proved their ability to transact any necessary patent business. These correspondents attend to the prosecution of the applications before the foreign patent offices, *under instructions from the writer as to amendments*. Canadian applications and amendments, like those in the United States, are made by the writer, and not through correspondents.

Advice as to the laws in the countries mentioned hereafter, or other countries, can be had from the writer.

Canada.—Any person may obtain a patent who has invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improve-

ment thereof, which was not known or used in Canada by any other person before the invention thereof and which has not been in public use or on sale in Canada, with the consent or allowance of the inventor, for more than one year before the application in Canada. A patent may be had if applied for within one year of the issue of a patent for the same invention in another country. A caveat may be filed, substantially as in this country (see p. 25). The Commissioner may object to the grant of a patent when the invention has been described in a book or other printed publication before the date of the application. Appeal may be had, and interferences (p. 35) may be declared.

The term of a Canadian patent is either six, twelve or eighteen years at the option of the applicant. The fee for six years is $20 and can be extended to twelve years by payment of $20 additional before the end of the first six years. It may be extended to eighteen years by payment of a similar amount before the expiration of the twelfth year. If a foreign patent for the same invention exists, the Canadian patent will expire at the same time with the one having the shortest term.

Reissues are granted on substantially the same grounds as in the case of United States patents (see p. 39). So also as to a disclaimer (p. 40).

A patent, or any interest therein, may be assigned, and the assignment must be recorded, to be valid, before any subsequent assignment thereof is recorded.

Damages for infringement, as well as injunctions, may be obtained by suit.

The patent must be worked within two years of the date thereof, or the patent will become void. Yearly extensions of this time can be obtained for a small fee. There are no taxes necessary to be paid, except the fees above mentioned. The patentee, or his legal representatives or assignee, cannot import the invention into Canada after one year from the grant thereof without forfeiting the interest of the party so importing. An extension for one year of this time for importation can be had for a small fee.

Patented articles or the packages containing them must be marked "Patented" with the year the patent was granted.

France.—Theoretically the inventor only should obtain the patent. It has been decided, however, that a person can dispose of his interest in an invention and the purchaser can then apply. If a purchaser is to apply, he should obtain and keep the written consent of the inventor.

The term of the patent is 15 years, providing the taxes (p. 67) are paid and the "working" (p. 67) accomplished. The Government requires a fee of 100 francs on application.

A "patent of addition," for the unexpired term of the original patent, on an improvement on the invention covered by the original patent, may be obtained. Application must be made by owner of original patent. The Government fee is 100 francs.

Application must be made in France before the invention has been disclosed by public use in France, or, usually, in a printed publication in France or elsewhere. Public use abroad will not be an anticipation.

The taxes (p. 67) required are 100 francs yearly in advance from date of application. No extension of time for payment can be obtained. No taxes are required on a "patent of addition." No assignment will be recorded till all the taxes for the entire term of the patent have been paid. To avoid the necessity of paying these taxes it is usual to have the assignor execute a proper "notarial power" which can be retained by the purchaser and enables him to have the assignment made and recorded at some later time, if necessary.

The patent must be "worked" within two years of the grant, and the working must not cease for any two consecutive years. This can be attended to for a small fee depending on the particular invention.

A citizen of the United States can import into France articles patented there by him without risk of forfeiture of his patent.

Germany.—The patent may be granted to the first applicant, whether the inventor or not. If the applicant is not the inventor he should obtain and keep the written consent of the inventor to file the application, or the patent is liable to be declared void.

If the invention has been disclosed in a printed publication, either in Germany or abroad, within the last century,

or has been in sufficient public use in Germany before the date of application, no patent will be granted. Application should of course be made before the grant of a patent in any other country, and can be made at the same time with the application in the United States. A rigid examination for novelty is made. The grant of a German patent is very largely dependent upon the manner in which the invention is presented in the specification as first filed, and the specification as filed in the United States is almost never sufficient. It must conform to the extremely technical requirements of the German Patent Office or the patent will be refused. Before the patent is granted it is open for opposition by other parties. This very seldom arises.

The Government requires a fee of 30 marks for the grant of the patent. The term is 15 years from the day after filing the application, subject to the payment of the taxes (p. 67) and the proper working (p. 67) of the invention. A tax of 50 marks is payable before the expiration of the first year, 100 marks before the expiration of the second, and so on, increasing 50 marks each year. Two extensions of six weeks each for payment of a tax can be had for a small fee.

The invention must be "worked" within three years of the grant of the patent or it will become void. What constitutes a sufficient working depends upon the particular invention. Importation of the patented articles into Germany is in some cases sufficient, in others the offering of licenses, and in some the invention must be manufactured there. The working can usually be attended to for a small fee.

German patents have usually a broad scope, as the courts do not hesitate to construe it to cover the real invention no matter in what form it appears. A process patent is infringed by a product made by that process. Infringement is punished by fine or imprisonment, and the owner of the patent may also obtain damages therefor.

An assignment, to be valid, must be recorded in the German Patent Office.

A "Gebrauchmuster" or "model patent" is often of great value where the article is not of sufficient importance to take out a mechanical patent thereon, or where a patent has been refused. It is often likened to a design patent in

the United States, but the "Gebrauchmuster" is the broader. It is particularly useful in protecting tools and other small articles. The patent is granted without examination. The Government fee is 15 marks. The term is three years, and a renewal for three years further can be had on payment of a fee of 60 marks. No other taxes are required.

Great Britain.—The actual inventor may obtain the patent, or it may be obtained by an agent on "communication" from the inventor *or other party*. If the inventor does not apply, the applicant should, before he applies, obtain from the former an assignment of the invention as to Great Britain, or a written consent to the application. A firm or corporation can apply for and obtain a patent by such "communication from abroad."

Publication or use of the invention in Great Britain before the date of application there will prevent the grant of, or defeat, a patent. It must have been sufficient to communicate the invention to the public so that it can make, construct and use the same. Publication or use in some other country is immaterial. In this connection it has been held that one of the British colonies which had a separate government and patent system was a country foreign to Great Britain in the sense meant in the statute. When a person has applied in the United States for a patent, and within seven months of that date makes application in Great Britain, his patent will not be refused because of the publication or use of the device in Great Britain in the meantime. This is in consequence of a treaty.

The patent is granted for fourteen years, usually from the date of application, subject to the payment of the prescribed taxes. No working (p. 67) is required. The patent covers England, Scotland, Ireland, Wales and the Isle of Man.

The Government taxes (p. 67) are £5 before the end of the fourth year, and increase £1 a year thereafter. Extensions of time for payment can be obtained for one month for £1, two months for £3, and three months for £5.

Assignments can be made and registered in the Patent Office for a small fee. They should always be so registered.