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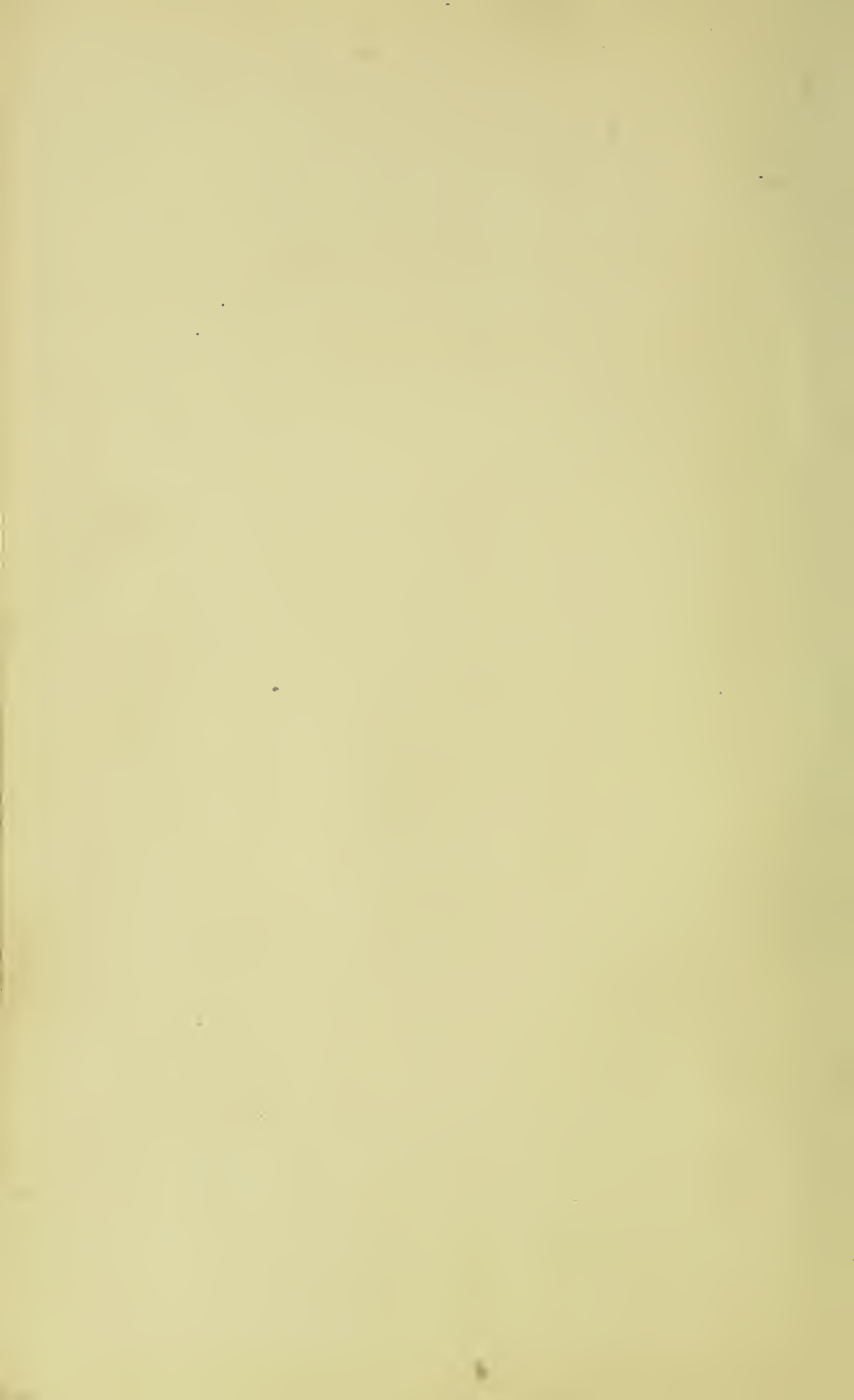
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# Patents, Trademarks and Copyrights

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SECOND EDITION

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*Attorneys-at-Law*  
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Specializing in Patents, Copyrights, Trademarks,  
and Unfair Trade

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## PREFACE

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The reception accorded the first edition of this modest attempt to explain, in an elementary manner the fundamentals of patent practice, met with such success that we have been encouraged to somewhat extent its scope and to publish a second edition.

We have not attempted to write a law book and those who wish to study the law, are referred to Walker, Robinson, Hopkins or other standard text books on this subject.

It is the purpose of this book to present a broad and general explanation of those points in patent practice which the patent attorney is most often called upon to explain. It is thought that such an explanation will be of real service to the inventor and business man and, to a certain degree, to the lawyer in general practice.

The treatment of the subject is, however, both brief and general and it should be borne in

mind that the answer to a specific question in this field can only be determined after a full and complete consideration by a competent patent attorney, of all the facts surrounding the question.

FRANK L. A. GRAHAM.  
FORD W. HARRIS.

*Los Angeles, Cal.,  
October, 1921.*

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## CHAPTER I.

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### PATENTS IN GENERAL

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The United States Government has recognized inventions as an important factor in the industrial development of the nation and for the purpose of promoting the progress of science and the useful arts Congress has by appropriate laws, provided for the granting of patents of invention.

To the individual, patents open a new field for personal endeavor and advancement, whether the patent is used as a nucleus for a business or whether the inventor, by license or sale, derives an income therefrom.

To the business man, patents mean protection and insurance to his business; protection, as the owner of a patent can prevent competition by others; and insurance, as his ownership

of a patent relating to his business prevents this patent from falling into the hands of his competitors who might then prevent him from using the invention covered by the patent.

To the public, patents mean new industries and developments. Under the protection of patents, new business enterprises spring up and invention and progress are fostered. The public shares largely in the fruits of a successful invention, as it must be better or cheaper to supplant what went before, and the public is the great gainer by the introduction of better or cheaper things.

**Purpose of grant.**—It is the purpose of the Patent Laws to grant to the inventor the exclusive right to make, use, and sell his invention for a limited time, provided the inventor will make a full disclosure of the invention accessible to the public. This disclosure of the invention is made by the inventor in his application for a patent and remains confidential between the inventor and the Patent Office until the patent is finally issued. The patent is a public record of the advancement made in the



art by the invention, and, at the same time, it is notice to the public of the exclusive rights of the inventor in his inventions.

**Nature of rights granted.**—The exclusive rights or monopolies granted by a patent comprise the right to exclude others from making, selling or using the invention claimed in the patent during the life thereof. These rights are not collective but separate and distinct, as for instance, devices embodying the invention covered by a patent cannot be made abroad and used or sold in this country, neither can the invention be made in this country for sale or use abroad without the patentee's consent. In the United States the monopoly granted by the patent is absolute during the life of the patent and cannot be lost by the failure of the patentee to work or develop the invention. In some foreign countries the patentee must pay taxes at periodic intervals, and in most foreign countries some effort must be made to put the invention into public use or to "work" it. Failure to pay taxes or to work the patent in such countries causes the patent to lapse. No such rule applies, however, in the United States.

**A patent is not a license.**—A patent is not a license to make anything. It is merely a right to exclude others from making, using or selling the thing claimed in the patent during the life of that patent. As stated by Mr. Chief Justice Taney, "The franchise which the patent grants consists altogether in the right to exclude everyone from making, using or vending the thing patented, without the permission of the patentee." A patentee may have a right to stop others from making, using or selling his claimed invention without having the right himself to make, use or sell the invention disclosed in his patent. This situation frequently arises where an earlier patent has been granted which covers broadly various means for producing the same result. This can only occur where the earlier patentee is a pioneer in the field to which his invention relates. It must be understood that in the case of such a broad patent the claims of the patent may be so worded that the patent not only covers the specified form of the invention disclosed in the patent, but also covers various forms and modifications not directly shown.

**Broad patent no bar to later narrow patents.**—The fact that a broad patent has been granted, however, does not mean that a later narrower patent cannot be granted for an improvement over the forms of the invention disclosed in the broad patent, as the Patent Statute expressly states that patents may be granted for any new or useful invention or any improvement thereon.

If the later applicant can convince the Patent Office that he has invented an improvement on the invention disclosed in the earlier patent, the Patent Office will grant him a patent on his improvement having claims expressing the difference between what the later applicant discloses in his application and what is disclosed in the earlier broad patent. The Patent Office in examining an application does not concern itself with the question of infringement, but merely with the question of whether the invention shown in the application is new and useful. It is the regular practice of the Patent Office to grant improvement patents where there are existing prior broad patents which contain claims which are infringed by the devices shown in the later improvement patents.

**Result of grant of narrow patent.—**

The results of granting the earlier patent containing broad claims and then granting a later patent covering improvements over the invention disclosed in the earlier patent is as follows.

When the first or earlier patent has claims that cover the invention disclosed in the second or later patent, the second patentee cannot make such improvement without infringing the first or earlier patent.

When the second or later patent has claims that cover the specific form of invention disclosed therein, which must be somewhat different from the form shown in the broad patent, to result in a patent, the first patentee cannot make such improvement without infringing the second patent, or in other words, the first patentee cannot make the specific form of the invention claimed in the later patent.

**Ownership of patent no evidence of right to make.—** It is therefore evident that the fact that a patent has been issued is no reason for assuming that the patentee thereunder can make, use or sell the invention shown and

described in such patent. It may be that he has merely an improvement patent, and that the invention shown and described therein infringes one or more prior patents.

The fact that the Patent Office issues narrow patents showing inventions which infringe earlier patents makes the determination of the legal effect of any patent a task for an expert and only a person thoroughly skilled in the art of interpreting patents should undertake to construe one. Patent Attorneys are often called on for opinions in this connection and can furnish such opinions only after an examination of the patent, the circumstances surrounding its grant, and the state of the art at the time it was granted.

Large sums of money have been lost by investors due to accepting patents at their face value or neglecting to consult an expert regarding their validity and scope.

**Disclosure and claims.**—The failure of most people to understand the legal significance of a patent arises from the fact that the distinction between the disclosure and the claims is not understood, or if this distinction is understood,

that the general theory of claims is not understood. We will try to make both of these points plain.

**Patent is a contract.**—The Courts have adopted the view that a patent is a contract and have so construed a patent. As stated in *National Hollow Brake Beam Co. vs. International Brake Beam Co.*, 106 F. 693, “A patent is a contract, and its construction is governed by the same canons of interpretation that control the construction of other grants and agreements.”

A patent is a written contract between the inventor and the public, the Patent Office acting as the representative of the public. It is a record of a bargain. The inventor has disclosed a secret and is given a limited monopoly in return. He has given something and has received something. What he has given, that is, his secret, is set forth in his patent, being shown with great particularity in the drawing, if the invention is subject to illustration, and fully described in the specification. The drawing and specification disclose the inventor's secret to the public. In disclosing and describing

his secret, the inventor must, of necessity, include many things that are old and which really constitute no part of his real invention, that is, his invention may relate only to a part of a machine and to fully describe the operation of the invention it may be necessary to show the entire machine. Having shown the entire machine he is, therefore, required by statute to particularly point out and distinctly claim his invention. This he does by means of his claims. The claims define the part he has invented and define his monopoly or what he receives just as the disclosure of his invention defines what he gives.

**Specification does not define patentee's rights.**—The fundamental mistake made by many people is to read the specification and inspect the drawing of a patent and assume that all that is described or shown is the exclusive property of the patentee. This is not correct as only a very small part of the matter shown in the drawings and described in the specification may be new or covered by the claims. It is in the claims, and in the claims only, that we must look for a definition of the patentee's monopoly.

If the patentee has disclosed something new which he does not claim, he dedicates it to the public. It is, therefore, quite essential that the patentee understand the general theory of claims and this subject will be more fully explained later.

**Two kinds of patents.**—There are two kinds of patents of invention, namely utility patents and design patents. Utility patents are granted for new and useful inventions and design patents are granted for new and ornamental designs.

**Utility patents.**—Utility patents are granted for four general classes of invention, namely, an Art, a Machine, a Manufacture or a Composition of Matter.

Sec. 4886 of the Revised Statutes states, in part, “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 \* \* \* may obtain a patent therefor.”

**Kinds of utility patents.**—The term “Art” as used in patent law covers only a lim-



ited meaning of the word "process" and may be defined as an operation performed by rule to accomplish a result. It is what is commonly called a method, or process, of doing something. While a principle of nature cannot ordinarily be patented, it is often possible to patent the method or process by which this principle is put into use. Care should be taken to discriminate between a method of operation or function of a machine and a true process which can usually be carried on by more than one type of means or machine.

A Machine is a combination of connected elements movable with relation to each other, which when set in motion coact to produce a predetermined result.

A Manufacture is an all inclusive term including every artificial thing resulting from human endeavor not a machine or a composition of matter.

A Composition of Matter is a combination of various substances which, taken together, form a substance having certain new and useful properties. Patents on compositions of matter protect the formulae by which the compositions are produced.

The Patent Office usually refuses to grant in the same patent claims on a machine and a process carried out by this machine so that two applications are usually necessary to protect both.

**Design patents.**—Design patents are provided for in Sec. 4929 of the Revised Statutes which states, in part, “Any person who has invented any new, original and ornamental design for an article of manufacture \* \* \* may \* \* \* obtain a patent therefor.”

Design patents, or patents for ornamental designs, are granted for terms of three and one-half ( $3\frac{1}{2}$ ), seven (7) and fourteen (14) years. Design patents are granted for the purpose of covering the ornamental appearance of articles and relate to the form or surface decoration of such articles. Design patents, in cases where the invention is really not an ornamental design, are comparatively easy to obtain and such patents are often applied for after an applicant has tried to obtain a utility patent and has failed. In such cases the protection obtained is almost negligible, but it allows the patentee to mark the article “patented” and therefore really serves a purpose.

**Field for design patents.**—Design patents, in their proper field, are just as legitimate as utility patents, but their field is limited to cases in which the appearance of the thing is its chief value. In such cases, design patents are quite valuable. Further, the statutes as to infringement of design patents are more drastic than the statutes relating solely to utility patents, there being a fixed initial liability of two hundred and fifty dollars for such infringement. So also it is not necessary that an infringer sell the infringing design, the mere offering of it for sale being an infringing act.

**Who may apply for patent.**—The statutes provide that “any person,” who has invented any new and useful invention or improvement thereon, may apply for a patent.

As stated in *Wende vs. Horine*, 191 F. 620, “Sections 4886, 4888, 4892, 4895 R. S. require an application by the inventor—and this regardless of whether the inventor has parted with title to the invention or not, and notwithstanding he may even have taken steps to have the patent issue to his assignee when granted.” The applicant need not be a citizen, nor need

he be of legal age. Insane persons may apply through a guardian and an executor or administrator may apply for a patent on the invention of a deceased person.

An invention, being a mental conception, can only be produced by a natural person. A corporation, for example, cannot produce an invention. In the United States and in Canada and many other foreign countries the application must be made in the name of and signed by the inventor, although he may at the same time assign it to any person or corporation. In England, and some other countries a corporation may apply for a patent, the theory in those countries being that the patent is granted as a reward for disclosing the invention and not for making it. The actual inventor, or the joint inventors, must sign the application in the United States and execute the oath, which accompanies the application when the same is filed in the Patent Office.

**Joint inventors.**—Two or more persons may be joint inventors. Mere financial assistance to an inventor does not make the one rendering such aid a joint inventor with the true

inventor. To create a joint invention all the parties thereto must participate in its conception. There are no definite lines established by law as to the extent a joint inventor must have participated in the actual conception of an invention, but all persons who have had some part in the conception of the invention are joint inventors, and must join in making the application for patent.

The rule as to what constitutes joint invention has been before the Courts on several occasions and has been adopted as stated in *Warden vs. Fisher* 11 Fed. 505, that it is not necessary that the idea of an invention should occur simultaneously to each of the joint inventors, but it is sufficient that one conceives and the other makes a suggestion essential to its success, and where there is joint invention, it is immaterial in what order the suggestions or conceptions are made so that the inventors work together to the common end of completing a single invention.

**Assigned interests.**—Financial assistance to the inventor is usually rewarded by the inventor making an assignment of an interest in

the patent to the party giving such assistance, which assignment should be recorded in the United States Patent Office, preferable when the application is filed, as all legal titles to United States Letters Patent are dependent upon the records of the Patent Office and all transfers affecting the title are recordable there.

**Mechanical assistant not a joint inventor.**—When an inventor requires the assistance of a skilled mechanic in order to give physical expression to his idea, and instructs the mechanic as to the result which he desires to accomplish through mechanical means, and the mechanic contributes merely the usual skill of his calling, the mechanic does not participate in the invention, and is therefore not a joint inventor with the one who conceived the idea of the invention.

On the other hand, if the mechanic makes a valuable improvement over the original plan suggested by the inventor, sometimes it is a difficult question to decide whether the mechanic has a right to a patent on the improvement or not. In the case of *Agawam Co. vs. Jordan*, 7 Wall. 583, it is stated as follows: “Where a person

has discovered an improved principle in a machine, manufacture, or composition of matter, and employs other persons to assist him in carrying out that principle, and they, in the course of their experiments, make valuable discoveries ancillary to the plan and preconceived design of the employer, such suggested improvements are in general regarded as the property of the party who discovered the original principle, and may be embodied in his patent as a part of his invention. Where the employer has conceived the plan of the invention and is engaged in experiments to perfect it, no suggestions from an employee, not amounting to a new method or arrangement, which in itself is a complete invention, are sufficient to deprive the employer of the exclusive property in the perfected improvement."





## CHAPTER II.

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### PATENTABILITY

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#### **The requirements of patentability.—**

To be patentable, a thing must be new, useful, and an invention. If any of these attributes are lacking, the alleged invention is not properly patentable, and, if patented, the patent is invalid. While in most cases the question of novelty, that is, the statutory requirement of newness, is the most important, the other two requirements are equally important from a legal standpoint.

**Invention.**—While it may be said that to be patentable a thing must be an invention, it is not so easy to define invention nor decide whether a certain alleged invention is really an invention or merely the result of mechanical skill. The early decisions of the Courts, upon

which we now rely, were written in the early days of the Republic before we had attained our present state of industrial perfection. These decisions were written by eminent lawyers who had been elevated to the Bench, and, not having had a mechanical education, many things that were commonplace to the technically skilled seemed to them quite wonderful. It is not surprising, therefore, that in the early cases we find expressed the idea that invention arose from a sort of inspiration. It must be something, as stated by Judge Blatchford in *Tatham vs. Le Roy*, 2 Blatch 474, "over and beyond the skill of the mechanic and embodying the inventive element of the mind." It is recognized by the courts that it is not easy to distinguish between invention and mechanical skill. See *New York Belting & Packing Co. vs. Magowan*, 27 F. 362.

It may be said that there is no positive rule by which the question of invention may be tested and that absence of invention is usually based upon something showing that the alleged invention is merely the result of mechanical skill. The courts, in deciding questions of this kind,

have adopted certain negative rules which have been applied in later cases in a process of exclusion for determining whether or not invention is present. This question is largely a matter of personal opinion, and the dividing line between invention and mechanical skill being so hazy, it is desirable to consider some of these negative rules to illustrate this point.

**Mechanical skill.**—The first and most general rule is that it does not constitute invention to exercise the ordinary skill of a mechanic. A carpenter may produce a flight of stairs that differs in appearance, dimensions, and construction from any that have ever been made before, and which may be quite useful; but, if the carpenter, in producing the stairs, produces nothing substantially different from stairs that any other carpenter might produce under the same conditions, it may be said that the carpenter has exercised ordinary mechanical skill and not invention.

So, also, in the case of more complex engineering problems; in the production of large engineering works and machines, there often result structures or machines that are both new

and useful but which do not rise to the dignity of invention. It may, indeed, be said that good engineering is the very opposite of invention, for the engineer applies recognised engineering principles, and recognised and accepted elements, to produce his results; as long as this is done along the lines that any engineer would follow in attacking the same problem, it is not invention; or, in other words, the result is a good job of construction, and not an invention. It is in this phase of the subject, however, that the personal opinion of the person deciding the question plays so large a part, as what may seem merely good engineering, and quite obvious, to an engineer, may seem to embrace the highest type of invention to a judge. One very eminent engineer has said that there is no such thing as invention as opposed to mechanical skill, that invention is a high order of mechanical skill and mechanical skill is a low order of invention. This is not, however, the view of the courts, who stick closely to the theory that invention and mechanical skill are qualitatively different and not mere differences of degree in the same thing.

**State of the art.**—The fact that an invention appears obvious after its completion, does not negative invention. It must be shown that it was obvious before the invention was disclosed. We are lead, therefore, in such cases to investigate the “state of the art,” or the condition of human knowledge regarding the particular subject at the time the invention was produced. It is the step in advance over the prior art that the inventor is entitled to monopolize, and the magnitude and importance of this step has a very important bearing on the question of whether the result was invention or mere mechanical skill. It is quite conclusive proof of invention, even where the invention seems very obvious, to show that the need for the invention existed for a long period and has never been filled, particularly where there have been repeated attempts to supply such a need without success.

**Mere changes in old things.**—It is not invention to enlarge parts of old things, or to use old things for new but analogous purposes. For example, it is not invention to use a chemical commonly used to remove hair from hides

to remove hair from the human face; nor is it invention to duplicate or multiply old parts; nor to substitute for one old part in an old combination, a mechanical equivalent thereof. In most cases, a mere substitution of materials is not invention. The latter rule, however, does not apply when the substitution of the material produces a new improved and unexpected result.

A case on the border line is the case of the tungsten lamp. Here, a known element was substituted for the old carbon filament, it was known that higher efficiencies could be obtained by using higher temperatures and that tungsten stood very high temperatures, yet the patent on the tungsten filament was sustained in the United States, although not sustained in some other countries. Really, the question of substitution of material is one phase of the question of mechanical equivalents.

**Mechanical equivalent.**—It was said in *Carter Machine Co. vs. Hanes*, 70 F. 865, that “as a general definition, a mechanical equivalent that may be properly substituted for an omitted element, device, or agency in a patented ma-

chine, is one that performs the same function by applying the same force to the same object, through the same mode and means of application." See also *Burr vs. Durkee*, 1 Wall. 531. While this decision has to do, as indeed most of the decisions on this point have to do, with the question of infringement, the same rule applies as to the definition of the term "mechanical equivalent" when we are considering anticipation and patentability. The term is, however, often loosely used. Mr. Justice Grier said in *Burr vs. Durkee*, 1 Wall. 531: "The phrases 'substantial identity,' 'equivalent,' 'mode of operations,' etc., are often used in such a vague and equivocal manner that they mystify and lead many to absurd conclusions, who will not distinguish how things differ."

It may be said in general that one thing is not the mechanical equivalent of another unless it operates "in the same manner" or "in the same way" to produce the same result.

**Aggregation.**—It is not invention to associate things which do not co-operate in some measure, one with the other. Such associations of non-co-operating elements are called aggregations.

An excellent example of such an aggregation is described in the case of Grinnell Washing Machine Co. vs. Johnson, 247 U. S. 426; 62 Law Ed. 1197, in which a patent for a washing machine mechanism was held to be invalid as an aggregation. The patent covered a washing machine mechanism which was adapted to drive both a washing mechanism inside a tub and a wringer on top of that tub. Although the wringer was operated in one direction when the washing machine element was idle, and in the other direction when the washing machine element was in operation, the court held the claims invalid as aggregations on the broad ground that there was no co-operation between the wringer and the washing machine element; each operated, when associated, just as they did alone, and neither in any way modified the operation of the other.

This late Supreme Court decision affirms the old doctrine set forth in Hailes vs. Van Wormer, 20 Wall. 353, and Reckendorfer vs. Faber, 92 U. S. 347, and many later cases. The lower courts have of late years shown a somewhat more liberal tendency towards pat-



ents which perhaps are aggregational, and have in some cases upheld patents which, if not aggregations, were very close to it. Such, for example, was the case of Burdett-Rountree Mfg. Co. vs. Standard Plunger Elevator Co., 196 Fed. 43, and particularly Krell Auto Grand Piano Company of America vs. Story & Clark, 207 Fed. 946. In the two cases, just cited, and particularly in the first one, the court upheld a patent which, while open to the objection of aggregation, nevertheless contained elements that co-operated if the operator was considered an essential part of the combination. For example, in the Burdett-Rountree case, the operator received a signal and actuated a mechanism which produced a new and useful result. If the signal, or the operator, or the mechanism, was omitted, no result was obtained. It is, however, hazardous to depend on the courts taking so liberal a view, especially as the question has apparently not been settled by the Supreme Court or, if settled, is squarely against the Burdett-Rountree case and, in a measure, against the Krell case.

In contradistinction to aggregation, we have

the rule that a combination of old elements is invention. A combination being defined by Justice Curtis in the case of *Forbush vs. Cook*, 2 Fisher 669, as "to make a valid claim for a combination, it is not necessary that the several elementary parts of the combination should act simultaneously. If those elementary parts are so arranged that the successive action of each contributed to produce some one practical result, which result, when attained, is a product of the simultaneous or successive action of all the elementary parts, viewed as one entire whole, a valid claim for thus combining those elementary parts may be made."

The above rules are but a few illustrations of the tests which have been applied by the courts a sufficient number of times to have become established rules in determining the presence or absence of invention.

**Novelty.**—The question of patentability most often hinges on the question of whether or not the thing alleged to be an invention is new or not. If it is not new within the definition of the word that has been developed in patent law, it is not patentable. In this connection, it may

be said that it may be old in that it is well known and in use outside the United States, without rendering it unpatentable in the United States to an inventor who invents it independently, and who was ignorant of its existence abroad. If, however, this foreign use has been described fully in a publication published or distributed in the United States, that prior publication is a bar to a patent, as will be described below.

**Prior printed publication.**—A printed description which has had a general circulation in the United States will bar the issue of a patent or invalidate an issued patent if the publication took place before the applicant or patentee made his invention, or if the publication took place more than two years before the application for patent was filed in the United States Patent Office. In the one case, the publication is a bar because the applicant was not the first inventor; and in the other case, assuming that he made the invention prior to the publication, he has lost his rights by abandonment, that is, by sleeping on his rights for more than two years, he has lost them. Such a publication, to

be effective, must be fairly complete; the test of completeness being met when the description is sufficient to enable one skilled in the art, to which the invention pertains, to make and use the invention. It is not necessary that full details should be given, but there must be enough so that a good mechanic in that art can reproduce the invention in workable form. But, every printed description will not serve to anticipate or invalidate, it must be shown that the printed matter was publicly known. In the case of foreign periodicals, the fact that these periodicals are found on file in the Library of Congress is sufficient to show that they were available and therefore public property. Trade publications, however, or privately printed descriptions, must be shown to have had some general public circulation to be effective as anticipations.

**Prior patent.**—Prior patents are the most common forms of printed matter relied upon to anticipate or invalidate a patent. They are most often cited by the Patent Office and they are most often used in court. They are a convenient means of showing the state of the art, as

copies are readily obtained and they are written with the special object of fully disclosing the invention. Foreign patents are quite as effective a bar against the grant of a United States patent as domestic patents are, if these patents were on file in the United States Patent Office prior to the applicant's invention, or more than two years prior to the date of his application for United States patent. A foreign patent taken out by the same inventor or his assigns is a bar to obtaining a patent in the United States after one year.

Mere applications which have not resulted in a patent are not a bar to the grant of a United States patent and abandoned applications are without effect as anticipations. So, also, foreign patents that are not published are no bar, and the date of publication of any foreign or domestic patent is the controlling date from which the bar starts.

**Prior use.**—Public use, if it occurred more than two years before the application for a patent, is a bar to the grant of the patent and an excellent ground for invalidating the patent after issue. This use may or may not have

been with the inventor's knowledge or consent. The public use is in itself a bar whether the use was by the inventor or by others. The use must, however, have been public and it must have been more than an experimental use designed to test out the invention. In the case of *Elizabeth vs. Paving Co.*, 97 U. S. 130, the patentee laid down an experimental pavement in the street and it was in use for more than two years before the patent was applied for. The patent was granted and sustained by the court on the ground that this use was necessary to determine the value of the invention, and that, while the public used and knew of the invention for more than two years, the patent was valid.

So, also, abandoned experiments are not a bar. If a man conceives an invention and tries it out and, after trying it out, he does nothing further with it, this conception and experimental use will not serve to defeat the rights of another who comes forward and develops and perfects the invention and applies for a patent. Such prior attempts are classed as abandoned experiments, and the fact that they did not result in any use of the invention is usually sufficient to raise a presumption that they were unsuccessful.

**Utility.**—This is a question not raised by the Patent Office as often as it should be and, in fact, it is only raised in extreme cases. A thing must, however, be useful to be patentable. The most common class of patents that are void for lack of utility are those in which the disclosure is not sufficient to produce a useful result. Such a patent may be absolutely inoperative, or it may be inoperative to produce the result sought. Even where, by adding well known parts, the device may be made to operate properly, the patent is invalid if there is nothing to indicate in the patent how this is to be accomplished. The rule has been stated as follows: “The patent is void if the machine will not answer the purpose for which it was intended, without some addition, adjustment or alteration which the mechanic who is to construct it must introduce of his own invention, and which had not been invented or discovered by the patentee at the time his patent was issued.” *Burrall vs. Jewett*, 2 Paige 143.

The invention must be capable of some useful result. If it produces a result that is only injurious to the morals, health or the good order

of society, this is not a useful result. For example, machines for facilitating the commission of crime fall within this class. Such inventions are not unpatentable, however, if it can be shown that they also have a useful result.

Some patents have been held to be invalid because the result attained was not broadly useful, as, for example, in the case of a spark arrester for locomotives which arrested the sparks, but was impractical because it tended to greatly interfere with the operation of the locomotive. Such cases are, however, rare and the degree of utility or, indeed, the genuineness of such utility is rarely questioned. Many patents are probably granted which are open to serious questions as to their patentable utility, such patents are rarely important, however, as they result in no use and never come before the courts or have any legal or practical effect.

**Preliminary examination.**—The Patent Office will give no information regarding the patentability of an invention until a complete application has been filed. Rule 14 of the Rules of Practice states as follows: “The office can not respond to inquiries as to the novelty



of an alleged invention in advance of the filing of an application for a patent, nor to inquiries propounded with a view to ascertaining whether any alleged improvements have been patented, and, if so, to whom; nor can it act as an expounder of the patent law, nor as counsellor for individuals, except as to questions arising within the office." After the complete application has been filed, it may be rejected upon any issued United States or foreign patent. Preliminary examinations are made for the purpose of determining in a general way, before filing a formal application, whether or not a patent can probably be obtained for an alleged invention.

**Preliminary examinations are not conclusive.**—Preliminary examinations are usually made by the Washington associate of a local patent attorney and are usually limited to an examination of issued United States patents. Under such circumstances, an examination of this kind is not at all conclusive unless the invention is extremely simple and likely to be found in the issued United States patents. The cost of making a complete examination of both

the United States and foreign patents is as great as the cost of filing the formal application for patent, so that it is often advisable to file the formal application and have the Patent Office pass upon the question authoritatively.

Further, the associates may fail to find a patent which later is relied upon by the examiner in the Patent Office in rejecting the application, such failure being due to defective classification of patents in the Patent Office or to a misapprehension of the associate as to relevancy of other patents.

The fact that a preliminary examination has been made and the invention not found to have been patented, is no guarantee that a patent on the invention will be granted. Preliminary examinations are not expensive and are usually worth all they cost and but little more. They have the great advantage that they can be quickly made and the inventor at small expense is thus at once given a general idea as to the probability of obtaining a patent. In many instances, could a complete examination and report be made to each prospective application prior to his application, many applicants would

see the futility of attempting to obtain a patent and thereby be saved not only the cost of the application, but also large sums expended in experimental and promotion work.

It should, however, be borne in mind that these examinations cannot be guaranteed to be complete for many reasons, and the fact that the invention is not found to be anticipated as a result of any such examination is far from conclusive; on the other hand, preliminary examinations are of considerable value in the later preparation of a patent application, as they enable the attorney to more accurately word the claims in the application.

A patent attorney of long practice should be able to give a fairly accurate off-hand opinion as to the patentability of inventions submitted to him. Such an off-hand opinion is, however, strengthened if the attorney has at hand available facts which bear on the subject; that is, particularly if similar inventions in the same or analogous arts have previously come to his notice.

An opinion based on a preliminary examination, while better than an off-hand opinion, is

not in any sense conclusive, as has been pointed out under that subject.

Where it is important that a good patent is to be obtained, as for example, where large investments are to be made, and where litigation may result, it is most important that a thorough investigation be made. This investigation is of value in direct proportion to the thoroughness with which the art is searched. All prior patents on the subject should be examined and an investigation into the publications on the subject should be undertaken. Also persons skilled in the art should be interviewed and the standard machines, processes or methods then in common use should be studied. With this data, a good opinion can usually be rendered upon which one can go ahead and base an investment.

## CHAPTER III.

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### PATENT APPLICATIONS

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**Applications made to Patent Office.—** Application for Letters Patent of the United States, both utility and design, are made to the Commissioner of Patents in the United States Patent Office at Washington, D. C. See Rules of Practice, Rule 30, page 11. The applicant may prepare, and file, his own application and thereafter conduct the correspondence usually necessary to secure an allowance, but the Patent Office recommends and prefers to have the inventor employ a registered patent attorney. Attorneys at law in general practice may be admitted to practice before the Patent Office, either for the purpose of filing and prosecuting a single application or for general purposes.

**Canadian and other foreign applications.**—Applications for Canadian patents are made to the Canadian Patent Office at Ottawa.

Applications for other foreign patents must be made, usually through associate counsel located in the respective foreign countries.

**Caveats.**—The Caveat Law was repealed in July, 1910, and it is no longer possible to file a caveat. The only official notice that the United States Government will take of an invention is through the filing of an application for patent in regular form, and no examinations as to the novelty of an invention will be made by the Patent Office until an application is regularly filed thereon.

**Formal parts of U. S. application.**—

A complete application for patent consists of:

(1) A petition to the Commissioner of Patents praying for the grant of the Letters Patent.

(2) A specification fully describing the invention.

(3) A drawing, when the invention admits of illustration, showing the best method or

form of the invention and showing its application.

(4) An oath declaring the applicant to be the first inventor of the invention claimed.

(5) Government filing fee.

**Model.**—A model is no longer required except in rare cases.

It is important that the application be carefully prepared, as a proper presentation of the case before the Patent Office materially assists in an early and successful termination of the prosecution of the application, resulting in the granting of the patent.

The Rules of Practice of the United States Patent Office state 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 patent attorney, as the value of patents depends largely upon the skillful preparation of the specification and claims."

**Specification.**—The specification must consist of a full and detailed description of the invention, which must be described in the appli-

cation so that the public will have full knowledge from the patent itself of how to practice the invention upon the termination of the patent. A patent having a specification which does not fully and completely describe the invention is invalid.

It requires considerable experience to write a good specification. While it is quite essential that the specification fully describe the invention yet this does not mean that every bolt must be mentioned or that wearisome details be indulged in. The specification has two main purposes, one, to fully disclose the invention to the public so that the invention can be put to practical use, and the other, to so present the important points of the invention to the Examiner, so that he can readily understand its value and importance without excessive labor on his part. Both purposes must be kept constantly in mind. The specification must also lead up to and form a valid basis for an explanation of the claims and any technical or special words or phrases used therein.

The statutes not only require the inventor to fully describe his invention in the specification,



but also state that he shall particularly point out and distinctly *claim* the part improvement, or combination which he claims as his invention or discovery. It frequently happens that it is necessary to show in the drawings and describe an entire machine or structure in an application for patent when the invention relates to only a part of such disclosure, under which circumstances the claim or claims point out the particular part which the inventor claims as his invention. The patent is a notice to the public of the monopoly granted and the claims in the patent define the extent of the monopoly.

**Claims.**—The claims should not be confused with the description of the advantages or points of superiority of the invention usually placed at the beginning of the specification. Claims are technical and concise statements of the physical nature of the invented thing, and are placed at the end of the specification which serves as a sort of introduction to them.

The claims of the patent are the very life of the patent, and if the patent has good claims it is a good patent, and if it contains poor claims it is of little value. The inventor is dependent

to a great extent upon his patent attorney to properly present the claims and the main portion of the correspondence with the Patent Office relates to the allowance of the claims.

**Claims cover combinations of elements.**

—A claim is a definite description of an invention, a sort of catalog of the combination of elements that, taken together, make up the new and useful invention which the applicant claims the right to exclude others from making, using or selling during the life of the patent. Anything which the claim accurately describes is an infringement of the claim, but generally speaking, the alleged infringement must have everything called for in the claim and the elements of the claim must be found in the alleged infringing thing and must be associated as described in the claim. If there is anything in the claim not found in the alleged infringing thing, that thing is not an infringement and the patentee cannot prohibit the manufacture, sale, or use of that thing. But the alleged infringement may have other elements besides the elements claimed and still be an infringement.

You cannot avoid a patent by tacking something on the invention claimed in that patent.

**Broad and Narrow claims.**—Those claims are ordinarily the most valuable which contain general expressions which include the greatest number of variations. Such claims are commonly termed “broad” claims. To be broad a claim should not specify elements which may be omitted without destroying the usefulness of the thing nor should they contain words or phrases which limit the invention. Broad claims use general expressions like “means for securing,” rather than narrow expressions such as “a bolt having a castellated nut.” Obviously, a claim specifying “a bolt having a castellated nut” as a means for securing certain of the other elements of the claim together would not describe something fastened together with a rivet. Obviously, also, the expression “means for securing” describes a bolt, rivet, or any means by which the parts may be fastened together. A claim made up of elements broadly and generally described, such for example as “means for securing,” is a broad claim and valuable. A claim having a definite and narrow

wording is usually a valueless claim as it can be easily avoided by substituting something else for such narrowly defined parts.

It is not hard to illustrate and describe a machine. Most inventors can make a drawing and write a description, but it is often a difficult matter to frame proper claims and a harder matter to get the Patent Office to allow them. The drafting of claims and obtaining their allowance is the patent attorney's hardest task and one not often appreciated where the client does not understand the theory and structure of claims .

“The scope of every patent is limited to the invention described in the claims contained in it, read in the light of the specification. These so mark where the progress claimed by the patent begins and where it ends that they have been aptly likened to the description in a deed which sets the bounds to the grant which it contains.” *Motion Picture Patents Co. v. Universal Film Mfg. Co.* 243 U. S. 502.

**Each claim stands or falls alone.**—A patent may have one or several claims and each claim is, in effect, a monopoly in itself. Each

claim stands or falls alone and is really a patent in itself. It is highly desirable to have several claims of varying breadth, but the courts have repeatedly condemned patents having a multiplicity of nebulous claims on the ground that they were not in accordance with the law that requires an inventor to "particularly point out and distinctly claim" his invention. One can, therefore, have too many claims and they may be too broadly written. It is only by experience that an attorney learns the golden mean.

"Under the policy of the patent law, in order to fix the boundaries of a patented invention by distinct and formal claims, it is necessary to make a clear analysis of the subject, and often to use much refinement of speech in pointing out the various utilities affected by the elements described. But where such refinement of language is directed to describing trivial differences existing between possible combinations of the various elements involved, it does not aid the court in an interpretation of the patent, and is of no service to the public, after the patent has expired, in giving information relating to the scope of the invention which has become a

public benefit." *Adt. v. Bay State Optical Co.*,  
226 F. 925, 934.

**Drawings.**—The standards of the Patent Office as to drawings are extremely high and the average mechanical draftsman, unless he has had special experience in making such drawings, will not usually produce work acceptable to the Patent Office. Moreover, the drawings are intended as illustrations, not working drawings, and a highly trained patent draftsman is able to accentuate important features and thus make the true nature of the invention immediately evident.

Patent attorneys usually have in their employ skilled draftsmen who prepare these illustrations working from sketches, drawings, models, or the actual device.

Clear and striking drawings are of the greatest assistance in getting a prompt allowance of the patent with the proper claims as they greatly assist the officials in the Patent Office. These officials appreciate a well written and well illustrated case and show their appreciation by a hearty co-operation with the attorney.

Moreover, clear and convincing drawings are of great value after the patent is issued as they greatly assist both the public and the courts in understanding and interpreting the patent.

**Patent Office fees.**—The Patent Office fees in the ordinary prosecution of an application for patent are: First, a Government Filing Fee, which is paid into the Patent Office when the application is filed and which is not refunded whether patent is granted or not. Second, a Final Fee, which is only payable in the event the Patent Office finds that the invention is patentable.

In the prosecution of applications where unusual proceedings are necessary, such as Interference Proceedings, Appeals to the Board of Examiners-in-Chief or to the Commissioner of Patents, additional fees must be paid into the Patent Office.

For Design Patents, the only fees payable to the Patent Office are Filing Fees, which depend on whether the patent is for three and one-half ( $3\frac{1}{2}$ ) years, seven (7) years, or fourteen (14) years.

**Attorney's fees.**—Attorney's fees are estimated upon the character of the application, the amount of drawing necessary, and time required in preparation, and are payable in addition to the Patent Office fees enumerated above.

**Examination by Patent Office.**—While great care should be exercised in the preparation of the patent application, and while a carefully prepared application is a material factor in obtaining a good patent, it is equally true that a great amount of time and attention must be given to the application by the attorney while the application is pending in the Patent Office if a broad and valid patent is to be obtained. When the complete application is filed in the Patent Office it is given a Serial Number, and then placed, for the purpose of examination, in charge of one of the Examiners who is a specialist in the class of inventions disclosed in the application. After the Examiner has read and considered the description and drawings of the application he then examines the claims for the purpose of ascertaining just what the applicant claims as his invention. To be patentable the matter claimed must be new, useful



and the production of it must amount to invention. The question of usefulness is rarely raised as a bar to an application. To determine if the matter claimed be new the Examiner searches through issued United States and foreign patents, and through printed publications. If he finds either patents, or printed publications, which disclose substantially the subject matter of the claims of the application, or if he believes that to produce the subject matter of the claims did not involve invention, the claims are rejected.

**Amendments by attorney.**—The action taken by the Examiner, stating his reasons for rejection, is communicated to the applicant's attorney by letter, and copies of the patents or printed publications referred to in the Examiner's letter are obtained, by the attorney, from the Patent Office and carefully studied. The claims may be amended, new claims inserted, or claims cancelled, accompanied in each case, however, by arguments embracing the reasons for such amendments. No new matter can be inserted in an application after the same has once been filed, although any manifest errors either

in the description or drawings may be corrected. That is, the construction shown in the drawings cannot be changed nor can a description of anything not found in the application as filed be added. "An applicant in his endeavor to protect his invention may amend the specification and claims so long as he keeps within the requirements of the statutes and the Rules of the Patent Office; but he cannot be permitted at any time to introduce new matter into his application and obtain therefor a date as of the date of the original application." 115 O. G. 1067. For this reason an applicant should present his invention in its complete and best adaptation and if improvements are made after filing the original application, such improvements should form the basis for new applications.

**Reconsideration by Patent Office.—**

After the filing of an amendment or other action by the attorney, the application is again examined and considered by the Examiner in the light of such amendment or action. These alternate actions by the Examiner and the attorney are repeated until the claims cover only patentable subject-matter, the application then

being finally allowed, or until the Examiner and the attorney reach an issue which results in the final rejection of one or more claims.

**Time required to get allowance.**—While in some cases, the patent can be obtained in a few months after filing, it often happens that certain divisions of the Patent Office are somewhat behind with their work, and this necessarily delays the prosecution of the case. The time required for obtaining a patent depends largely on the number of applications for similar inventions which are copending with it in the Patent Office. If the work is properly done and the various important points are thoroughly discussed with the Patent Office, the prosecution of the case must necessarily take some time.

**Careful prosecution by attorneys is necessary.**—Bearing in mind that the claims of a patent are the vital part, the value of the patent finally obtained depends largely on the prosecution of the application, and in order that clients may be fully informed as to the progress of their applications in the Patent Office, attorneys of standing always furnish their clients a

complete copy of the application and drawings as filed, and with a copy of all correspondence had with the Patent Office in relation to their respective applications.

Moreover, to obtain claims which will fully protect the patentee, it is highly desirable that the attorney have frequent consultations with his client and that the client take an active and intelligent interest in the case. Many patents are issued with inadequate claims merely because the attorney did not appreciate fully the importance of certain features of the invention, due to the fact that the inventor never properly explained it.

If an invention is worth patenting, it is worth a carefully prepared specification and claims and worth a careful prosecution in the Patent Office. Speed usually means careless work and patents which are quickly obtained are usually without proper claims. Unless the patent attorney writes good claims and urges their allowance, the patent will be valueless for the Examiner rarely suggests claims.

**Personal visits to Patent Office rarely of value.**—In the ordinary prosecution of patent

applications all of the work in connection therewith is done in the patent attorney's office and under his personal supervision. The rules of the Patent Office require that all communications relating to applications for patent be in writing and personal interviews with Examiners do not ordinarily facilitate the prosecution of the application, and if had, must be supported by a writing duly filed in the case. Interviews with the Examiner in charge of the application are at times desirable, but are only necessary in rare cases, and personal visits to the Examiner should not be made unless absolutely necessary.

It sometimes becomes evident, however, that the Examiner does not understand the construction, method of operation, or merits of the invention. While such matters may be explained by letter it is often profitable to have the attorney, or an associate selected by him to visit the Patent Office and discuss the case in detail with the Examiner. If this discussion is supported by a demonstration of the invention, it generally has great weight with the Examiner and considerably expedites the progress of the case. Oftentimes also, the inventor

himself is able to so explain his invention to the Examiner as to obtain an allowance, but it is desirable for the inventor to be accompanied by his attorney or the attorney's Washington associate on any visits he makes to the Patent Office, unless he fully understands the rules and customs of the Patent Office.

**Divisional applications.**—Only one invention can be covered in a single application. Where two or more independent inventions are claimed in one application, the Patent Office will require that the application be limited to a single invention. The other invention or inventions can then be covered by supplemental applications known as divisional applications. Divisional applications are to all intents and purposes new applications, which are considered, however, as dating back to the date of the original application.

The line between independent and related inventions is not clear and it is not possible to lay down any general rule which would be applicable to all cases, the Patent Office, however, has adopted a rule (see Rule 41, Rules of Practice) which reads as follows: "Two or more

independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result, they may be claimed in one application."

The work and expense of filing and prosecuting a divisional application is the same as in the case of an ordinary application of the same character.

**Appeals.**—When any claim in an application has been twice rejected by the Examiner for the same reason, an appeal may be taken to the Board of Examiners-in-Chief. From an adverse decision of the Examiner-in-Chief an appeal may be taken to the Commissioner of Patents in person, and an appeal from an adverse decision by the Commissioner of Patents may be taken to the Court of Appeals of the District of Columbia. Further appeals and proceedings may be undertaken in other Federal Courts, but such proceedings are quite unusual. In general, appeals are rarely necessary, as a careful and painstaking prosecution of applications before the Primary Examiner is ordinarily effective in securing the allowance

of any claim or claims to which the inventor is fairly entitled.

Patents resulting from applications which have been appealed to the higher tribunals of the Patent Office are usually considered to be stronger than those granted by the Primary Examiners, on the theory that they have been more carefully considered in the Patent Office and hence are most likely to have been properly granted than those granted as a matter of general routine by the Primary Examiners.

While appeals should only be undertaken after an exhaustive effort before the Primary Examiner, they should not be shirked when really necessary. In some cases the Primary Examiner takes an erroneous viewpoint of the invention and it is only by an appeal that an inventor can secure his rights. In cases where the Examiner persists in rejecting claims which the attorney thinks are allowable, the attorney should advise his client to appeal rather than to cancel such claims and thus waive his client's rights thereto.

Every appeal involves the writing of comprehensive briefs and in most cases involves



the personal appearance of the attorney or an associate at the hearing. The Examiners-in-Chief are exceptionally able men and are perfectly competent to thoroughly understand cases brought before them and to act intelligently thereon.

Appeals to the Commissioner are usually decided by an Assistant Commissioner who is selected on account of his fitness for the position.

Appeals to the Federal Courts from the tribunals of the Patent Office are most unusual and quite outside the scope of this book.

**Procedure after allowance.**—Within six months after the date of the formal notice of allowance of an application the final Government fee must be paid. The application is then passed to the issue division of the Patent Office, and Letters Patent, signed by the Commissioner of Patents and sealed with the seal of the Patent Office, are delivered to the attorney.

The time required for the printing, signing and sealing of a patent, after the final Government fee has been paid, usually consumes the better part of six weeks.

Immediately upon receipt of notice of allowance, the applicant should decide whether or not he desires to file patent applications in foreign countries as the issue of the United States patent will sometimes act as a forfeiture of foreign rights.

In the event the final fee is not paid within six months from the date of allowance, the patent becomes forfeited but can be revived as explained under "Forfeited Applications."

## CHAPTER IV.

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### INTERFERENCES

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**Interferences.**— An interference is a proceeding instituted in the Patent Office to determine the question of priority of invention between two or more applicants claiming the same patentable invention, or between an applicant and a patentee of an unexpired patent, when the applicant can show that he made the invention covered by his application prior to the date of the application from which the patent resulted, the invention claimed in the application and the invention covered by the patent being substantially identical.

**Preliminary statement.**—The first step required in interference proceedings is the filing of the preliminary statements of the rival inventors setting forth dates tending to prove

when the invention was actually made. The interference is often decided without the necessity for further procedure, due to one party or the other refusing to contest the interference on account of the facts disclosed in the preliminary statements, in which case the expense is small. If the interference is contested, however, the proceedings partake of the nature of a law-suit requiring the taking of testimony and the preparation of briefs, which involves considerable expense.

**Issues.**—There are usually two main issues in an interference, namely, the date of conception, and the date of reduction to practice. It is often very hard to prove dates of conception, as inventors rarely keep properly dated records of such matters.

Reduction to practice may occur either through an actual making and successful testing of the invention which is a real reduction to practice, or it may occur through the filing of an application for letters patent, which is a constructive reduction to practice.

The general rule is that the inventor first to conceive is entitled to a patent, provided he

has been reasonably diligent in reducing to practice. One cannot expect to conceive an invention and cast it aside and then prevail against someone who independently conceives the invention and proceeds to reduce it to practice.

**Interference with issued patent.—**

Where an interference is declared between a pending application and an issued patent, which cannot occur after two years from the date of the patent, and where the applicant is found to be the first inventor, the Patent Office may issue a patent to the applicant although it has no power to cancel the patent already issued. The first patent being an improperly issued patent may, however, by a suitable procedure, be declared void, inoperative, or invalid by a Federal Court, there being a statute relating to relief in case of such interfering patents.

Success in winning interference proceedings depends in many cases on being prepared to prove the facts involved and this emphasizes the importance of keeping all records concerning the conception and development of the invention.

The importance of keeping a record of the

invention cannot be too strongly emphasized as it is the proof of dates that largely controls the decision of the Patent Office in interference proceedings. For his own protection, an inventor should preserve all sketches, models, bills for material and other data connected with the production of the invention and the disclosure of the invention to other persons.

**Motions.**—After the preliminary statements are opened the Patent Office usually allows thirty days during which it is in order for any party to the interference to make certain motions such as a motion to shift the burden of proof, or motions to dissolve the interference on ground that there has been such an informality in declaring the interference as to preclude a proper determination of the question of priority, or on the ground of non-patentability of the issue, or the ground of a denial of the right of any party to make the claim in interference or the ground that there is no interference in fact. If any such motion is made by any party it is set down for hearing in the Patent Office before the proper official, usually a Law Examiner. At the hearing every party to

the interference may be represented by attorney or may be present in person and briefs are usually filed setting forth the grounds upon which the motion is made or resisted. If the interference is not dissolved the parties then go ahead and take testimony to prove their respective claims.

**Testimony.**—The taking of testimony in interference cases is by deposition. That is, it is taken out of court and without the presence of a supervising judicial officer who can control the nature of the questions asked or the procedure adopted. It is usually taken stenographically before a notary who may conveniently be the stenographer. Such depositions may be taken anywhere upon written and sufficient notice to the other side and all the parties may attend and cross-examine. The taking of such testimony is tedious and expensive and may drag on for days or weeks. After having been taken and reduced to writing and sworn to it is forwarded by the notary or other officer taking it direct to the Patent Office. Any exhibits offered in evidence are also forwarded by the notary or other officer to the Patent Office.

The testimony is directed to prove the allegations in the preliminary statements which are in the nature of pleadings by which each party is bound.

Each party has an opportunity to take testimony the last to file his application for patent being given the first opportunity as the burden of proof is on such party. After all the parties have been given an opportunity to take testimony they are then given an opportunity to take rebuttal testimony which they take in reverse order the last to file having the last opportunity to offer rebuttal testimony. The time allowed to take direct testimony is usually a month for each party and the time to take rebuttal is usually fifteen days. These times may be extended by consent or order in complicated cases and the time for taking thereby extended.

**Printing.**—Before the final hearing each party prints his testimony, which is quite expensive, and supplies enough copies so that each party has a printed copy and there are enough in addition for the Patent Office and the higher tribunals therein as well as the court if the case is appealed from the Patent Office.



**Final hearing.**—After the testimony is all in, the case may be argued upon a day set, and briefs filed. The Examiner of Interferences then considers the evidence in view of the argument and the briefs filed and decides the interference. From his decision the usual appeals may be taken.

**In general.**—Interferences are protracted, expensive, and complicated. They are designed to insure that patents are only granted to the first and true inventor, but, in many cases, an interference proceeding is a hardship on the poor inventor due to the additional expense required, especially in protracted cases. Moreover during the time an interference is going on the inventor has no protection unless he has been so fortunate as to have his patent issued prior to the declaration of the interferences.



## CHAPTER V.

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### RENEWALS, REISSUES, EXTENSIONS, ETC.

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**Reissues.**—To obtain a reissue, two important requirements are necessary; first, that the error must have arisen by inadvertence, accident or mistake; and second, that the new or reissue patent must be for the same invention.

Reissue patents may contain narrower or broader claims, but in the latter case, when a reissue patent containing broader claims comes before a Court, it will be scrutinized more carefully than in the case of a reissue containing narrower claims. In *Miller vs. Brass Co.*, 140 West 350, the Court said: "We think it clear that it was not the special purpose of the legislation on the subject to authorize the surrender of patents for the purpose of reissuing them with broader and more comprehensive claims,

although, under the general terms of the law, such a reissue may be made where it clearly appears that an actual mistake has inadvertently been made." The Court in the same case also said: "Reissues for the enlargement of claims should be the exception and not the rule." In *Topliff vs. Topliff*, 145 U. S. 156, with respect to reissue patents having broader claims, the Court said: "Due diligence must be exercised in discovering the mistake in the original patent, and, if it be sought for the purpose of enlarging the claim, the lapse of two years will ordinarily though not always, be treated as evidence of an abandonment of the new matter to the public to the same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the invention to the public." In the case of reissue patents containing broader claims, intervening rights may arise between the issue of the original patent and the date of filing of the application for reissue which may invalidate the reissue patent, even though such reissue patent is allowed by the Patent Office.

For this and other reasons reissues are somewhat hazardous and applicants should assure themselves that their original applications are properly drawn and prosecuted and thus avoid the necessity of reissue. If a patentee has any doubt concerning the claims secured in his patent he should immediately consult a competent attorney and assure himself that he has obtained all that he is entitled to in the way of claims and if he finds his patent defective should at once apply for a reissue.

**Correction of errors in letters patent.—**

Errors in a patent, incurred through the fault of the Patent Office, will, upon demand, be corrected by the issue of a certificate of correction which is attached to the patent and to the printed copies furnished by the Patent Office.

Errors in a patent, incurred through the fault of the Patent Office, which cannot be corrected by certificate of correction, may be corrected upon demand and without charge, by the reissue of the patent.

Such errors must, however, be clearly the fault of the Patent Office and in such cases correction is made without charge. Immediately

upon receipt of a patent it should be carefully checked to see no such error has been committed.

**Disclaimers.**—If a patentee find himself in possession of a patent having several claims some of which he is certain are invalid as claiming more than that of which he was the inventor he should at once file a disclaimer of the invalid claims as failure so to do will defeat his rights to costs in any subsequent suit for infringement; or in case he unreasonably neglect to file such a disclaimer he may be barred from maintaining such suit.

It is required that such disclaimers shall be in writing and filed in the Patent Office. The disclaimer is then considered as a part of the original specification. “Matters properly disclaimed cease to be a part of the invention; and it follows that the construction of the patent must be the same as it would be if such matters had never been included in the description of the invention or the claims of the specification.” Dunbar vs. Mayers, 94 U. S. 187.

**Revival of abandoned applications.**—The rules of practice provide that after a re-

jection of the claims the applicant is given one year to amend his application. If he fails to do this his application becomes abandoned and can only be revived by filing a new application, in which case the drawings of the original application may be used. Such an abandonment may prove a serious matter where other inventors have entered the field.

**Revival of forfeited applications.—**

If after a patent is allowed the final fee is not paid within six months from the date of allowance the application becomes forfeited. To revive a forfeited application one must pay a new filing fee within two years from the date of allowance and also file a petition for renewal. If an application is forfeited more than once it can only be renewed in the event that a petition of renewal is filed within two years from the date of first allowance.

Forfeiture is not as serious as abandonment but conditions may arise where serious losses may occur due to such forfeiture.

**Extensions.—**Utility patents are granted for a term of seventeen years and can only be extended by special act of Congress.





## CHAPTER VI.

### RELATIONSHIP OF PATENTEE WITH OTHERS

**Marking patented.**—Articles covered by Letters Patent should be marked “PATENTED,” followed by the date or number of the patent. Unless this is done it is necessary to personally warn each infringer, and in such cases where the patentee has failed to mark, damages can only be recovered from the date of such warning. There is a heavy penalty for wilfully marking articles “Patented,” or words to that effect for the purpose of deceiving the public, when the person so marking the article is not the patentee, or has not been authorized so to do by the patentee or someone holding under him.

**Patent applied for.**—The words “PATENT APPLIED FOR,” or “PATENT

PENDING," are ordinarily placed on articles which are covered by an application pending in the United States Patent Office. While an inventor has no rights which he can enforce until his patent has been issued, the use of the term "PATENT APPLIED FOR" is often of very real practical value, inasmuch as it indicates to other manufacturers that the inventor is seeking protection and that he expects a patent to issue which will adequately protect him. All applications filed in the Patent Office are confidential, and it is impossible for parties, other than the inventor and his attorneys, to find out the status of any application pending before the Patent Office. For this reason manufacturers hesitate to manufacture an article marked "PATENT APPLIED FOR" unless authorized by the inventor.

**Abandoned inventions.**—The first inventor has presumptively a right to the entire invention and to any patent which may issue thereon. The inventor's title may, however, pass from him either before or after he makes his application either by his voluntary act or due to his failure to perform some necessary

act. He may, for example, neglect to reduce the invention to practice and thus abandon it, or he may neglect to file an application within two years from the first public use or neglect to prosecute his application for more than a year after it has been acted on by the Patent Office or to pay the final fee within two years from the date of allowance, and thus abandon it.

**Shop right.**—The inventor may by his use of his employer's materials and tools in the production of his invention grant to that employer a shop right.

**Undivided interest.**—The most common right in a patent is an undivided right to some portion thereof. Where two or more persons have such undivided rights in any patent they are not, in the absence of an agreement to that effect, partners. One is not accountable to the other in any way for his acts under the patent. He may make, use and sell the patented invention without responsibility to his co-owners and may grant licenses to others to do the same. He cannot, however, grant an exclusive license or an entire assignment of the patent nor main-

tain a suit under the patent without the cooperation and consent of all his co-owners.

In the case of *Blackledge vs. Weir & Craig Mfg. Co.*, 108 F. 71, the Court said: "On principle, therefore, there can be no accountability on the part of a part owner of an invention to other owners for profits made by the exercise of his individual right, whether it be by engaging in the manufacture and sale, or by granting to others licenses or by assigning interests in the patent. His use of the invention in any lawful way is not an appropriation of anything which belongs to another. The separate rights of the other owners remain unaffected. They are equally free to use the invention in all legitimate ways for their individual profit. Each is entitled to the fruits of his endeavors, taking no risk and expecting no reward from enterprises in which he does not choose to **join.**"

**Patent rights.**—It is possible for a patentee to grant to others rights under the patent which are of varying scope. He may, for example, assign all of his rights to another or he may grant a limited right. This right may be

limited in various ways. He may grant the right to sell and use but not to make, or he may grant the right to make and use but not to sell. The right may be for the entire term of the patent or for any lesser times and may be co-extensive with the United States or limited to any portion thereof. Various considerations may be exacted. The patentee may sell for a gross sum or he may take a royalty. In the latter case he may or may not exact a yearly or monthly minimum, and he may or may not add certain requirements as to serially numbering the articles sold or affixing name plates or seals furnished by the patentee.

**Interest in invention only.**—The patentee may also sell undivided interests in the patent or in a pending application or in an invention for which no application has been made. Or he may sell a portion of his expected profits.

**Forms.**—The forms which rights under patents may take are extremely varied. Attorneys having an extensive experience in patent law usually have a full understanding of the best methods of handling such matters and can

often offer very valuable suggestions as to the form the grant or license should take. They are also familiar with the necessary precautions needed to make any such a grant or license fair, legal and operative and can draw contracts which are operative and enforceable in both the state and federal courts.

**Assignments.**—Patent rights are peculiar in their nature, and any assignment of a patent or interest therein, or any contract relating to the manufacture, sale or use of inventions, whether patented or not, should be carefully prepared. All such instruments should be in writing and due proceedings taken for the proper recording of such of these instruments as may be recorded under the law.

Sec. 4898 R. S. reads in part as follows: “Every patent or any interest therein shall be assignable in law by an instrument in writing, and the patentee or his assigns or legal representatives may in like manner grant and convey an exclusive right under his patent to the whole or any specified part of the United States. An assignment, grant, or conveyance shall be void as against any subsequent purchaser or

mortgagee for a valuable consideration, without notice, unless it is recorded in the Patent Office within three months from the date thereof." The preparation of such instruments requires a special knowledge of patent law as well as general law relating to such matters and should be prepared by an attorney familiar with patent law.

**Employer and employee.**—The question often arises as to the rights of an employer in inventions made by his employees. This question may be divided into two inquiries: First, under what circumstances is the employer entitled to the patent itself; and, second, when is the employer entitled to use the invention made by an employee?

The employer is not entitled to the patent of an employee unless an express contract has been entered into with the employee in which the employee has agreed to transfer such patent to the employer. In case of *Pressed Steel Car Co. vs. Hansen*, 137, Fed. 403, the Court after considering this question, said: "We have been referred to no case, nor have we been able to discover one in which, apart from express

contract or agreement, and upon the mere general relation of employer and employee and of the facts and circumstances attending it, the employer has been vested with the entire property right in the invention and patent monopoly of the employee, or with anything other than a shop right, or irrevocable license, to use the patented invention.”

On the other hand, when an employee, who has not entered into any such specific contract, uses the tools or material belonging to the employer, and, performing the work on the time of the employer, produces an invention, to the use of which by the employer the employee assents, the employee is entitled to the patent but the employer is vested with an implied license, or “shop right,” to use the invention, the extent of such “shop right” depending upon the particular circumstances and the nature of the invention. This implied license or “shop right” usually occurs when the employee designs improvements on the shop machinery or on the product manufactured by the shop. The Court in the case of *Gill vs. United States*, 160 U. S. 426, stated: “This case raises the question,



which has been several times presented to this court, whether an employee paid by salary or wages, who devises an improved method of doing his work, using the property or labor of his employer to put his invention into practical form, and assenting to the use of such improvements by the employer, may, by taking out a patent upon his invention, recover a royalty or other compensation for such use. In a series of cases, to which fuller reference will be made hereafter, we have held that this cannot be done." The patent in both cases must be applied for in the name of the inventor, but may, of course, be assigned to the employer at the time the application is signed or later.

**Building a monopoly.**—Few concerns ever obtain a practical monopoly in any line of business, and when such a monopoly is obtained it is usually the result of much thought and effort. A single patent is rarely sufficient, it being necessary to plan patent protection along broad and comprehensive lines. Even where a broad patent forms the basis of the business it is wise to buy or devise improvement or companion inventions and to protect them by pat-

ents. The trend of the industry should be studied and likely lines of development should be investigated. Where development seems likely or, in some cases possible, patents should be obtained which will govern and control these developments. By careful management monopolies can often be extended long after the broad patents have expired, due to the ownership of important detail patents. This requires careful and thorough work on the part of the patent attorney and close co-operation between the attorney and the client or his employees.

## CHAPTER VII.

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### INFRINGEMENT AND LITIGATION

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**Avoiding infringement.**—A person wishing to proceed in a certain line of business often finds that others have one or more patents that apparently bar him from that business. Very often these patents may be avoided. The first step is, of course, to determine just what such patents mean; that is, to determine the scope of the patents. This is ordinarily done by a patent attorney, who carefully examines the patent, the history of the application in the Patent Office and the state of the art at the time the invention was made. Very often the patent attorney can suggest a plan whereby the client can proceed without infringing any such patents.

If there is no method apparent by which infringement of the patent or patents can be commercially avoided the only hope of the client

lies in attacking the validity of the patent if he is sued. The probability of the success of such an attack can generally be forecasted if proper investigations are made.

**Validity.**—The issue of a patent is not conclusive proof that the patentee is entitled to the claims allowed. The fees paid the Patent Office are small and for these fees the Patent Office cannot hope to finally and completely settle the inventor's status. For an example, the Patent Office cannot make an investigation of the circumstances surrounding the making of an invention sufficient to guarantee that some associate of the alleged inventor was not the real inventor, nor can it assure itself that the invention was not in public use somewhere in this country for more than two years prior to the date of application.

The Patent Office merely examines the most accessible sources of information, namely, its own files and library, and if no anticipation is found, issues a patent. There is a presumption that every patent was properly issued, but this presumption is not very strong and the validity of the patent may be attacked by the presentation of suitable evidence.

This evidence may be presented in any suit for infringement and a decision in any such suit is not final as against other infringers who may present new evidence of invalidity. A patent may be declared valid in several courts, only to be declared invalid by another upon the presentation of suitable evidence of invalidity. The presumption of validity arising from the original grant by the Patent Office is, of course, strengthened by subsequent court decisions.

If a patent has ever been in litigation and there is a reported decision thereon, such decisions can be readily found. There are no available records in the Patent Office showing whether or not a patent has been invalidated by the courts, and it well before investing in any patent to find out if the patent has ever been in litigation, and the result thereof.

**Opinions on patents.**—Where investors are contemplating purchasing patent rights, or investing in enterprises largely based on patents, it is desirable that the validity of these rights be passed upon by a competent patent attorney. This ordinarily involves an examination of the title to the patent and a careful study

of the patent itself. It is also necessary to go into the history of the patent and to examine the prior art relating to the same. By such an examination it can be determined whether the invention is covered by the patent and whether or not the device infringes upon any prior patent.

This work may be considerable in complex cases but will be found to be of great value in avoiding litigation or unwise investment.

**Opinions on commercial value.**—Attorneys are often asked to give an off-hand opinion as to the chances of making money on a given invention. Few persons are competent to give such opinions, unless they are engaged in the business to which the invention relates and thus familiar with commercial conditions in that business. The financial returns from an invention depend upon so many variable quantities that conscientious attorneys always hesitate to advise an inventor. Patents that seem to be of little merit have often sold for large sums, and many promising patents have proven entirely unprofitable. The inventor must appreciate, while the getting of a good patent is a matter

of prime necessity, that even where such a patent is granted, profitable returns will only result where the invention is properly exploited.

The exploitation of patent rights is a business and is subject to all the usual hazards of business, as well as certain special hazards of its own. It may be said, however, that many patents are unprofitable due either to the character of the invention or lack of ability to promote it on the part of the patentee. Many patents are taken out on trivial improvements with the result that the narrow claims allowed do not appeal to investors and the patentee reaps nothing but expense and disappointment.

**Infringement.**—A patent is not infringed by any acts performed prior to the date of grant of the patent nor after the date upon which the patent expires. Filing an application for patent confers no right upon the applicant to bring suit against any one nor can such suit be brought until the issuance or grant of the patent.

Infringement is the unauthorized manufacture, use, or sale of a patented invention, and such infringement is determined primarily by the claims of the patent. That is to say, if the

alleged infringement comes within the invention as set forth in any one, or more, of the claims of the patent, the charge of infringement is sustained. It is not essential that the defendant shall have both made, used and sold the infringing article to be guilty of infringement; either one or all of these acts may constitute infringement. That is, the manufacturer of the infringing article, the seller, or the user may be sued separately.

It may happen that a manufacturer may be sued for infringement even before he has had an opportunity to sell the infringing articles made by him, and this condition may arise after he has expended large sums of money in equipping his shop for the manufacture of the particular goods in controversy. This situation may be avoided as stated elsewhere in this book had the manufacturer properly investigated the patent situation before embarking on the enterprise. The fact that the infringer did not know of the existence of the patent sued on is no defense as a patent is a public record and the infringer is presumed to know of its existence.

**Scope of patent.**—When a patent comes



before a court as the basis of a suit for infringement, assuming the patent to be valid, the first consideration for determination is the scope of the patent and the proper interpretation to be placed upon the claims of the patent. The status of the claims is fixed by the specification and the prior art, that is, the advance in the art made by the inventor is the invention covered by the patent. The patentee may have made a distinct advance in the art of such a character that the patent rises to the dignity of a pioneer patent, on the other hand, the patent may only embrace an improvement of limited character. In the first instance, a more liberal interpretation is placed upon the patent than in the latter case.

In the case of *Railway Co. vs. Sayles*, 97 U. S. 554, the Court said: "If one inventor precedes all the rest, and strikes out something which includes and underlies all they produce, he acquires a monopoly and subjects them to tribute. But if the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete whole, then each is entitled only to the specific form of

device which he produces, and every other inventor is entitled to his own specific form, so long as it differs from those of his competitors and does not include theirs. These general principles are so obvious, that they need no argument or illustration to support them."

The second consideration is—does the defendant's process or machine come within the claims of the patent.

A patent for a process is infringed by him who, without right from the patentee, uses substantially the process described in the patent, whether he uses the same apparatus or not, and whether he uses the same materials or their equivalents. In the case of *Moore Filter Co. vs. Tonopah-Belmont Development Co.*, 201 Fed. 532, the Court said: "As the apparatus shown in a process patent is only to show that the process may be practically applied, it follows that such illustrative apparatus does not limit the process patentee to that type of machine alone; but the test of infringement of a process patent is whether the apparatus used, no matter what its form, utilizes the process."

A patent for a machine is infringed by him

who, without right from the patentee, makes, uses or sells a machine covered by any claim in the patent. In the case of *Machine Co. vs. Murphy*, 97 U. S. 120, the Court stated the following rule: "In determining the question of infringement, the court or jury as the case may be, are not to judge about similarities or differences by the name of things, but are to look at the machines or their several devices or elements in the light of what they do, or what office or function they perform, and how they perform it, and to find that one thing is substantially the same as another, if it performs the same function in substantially the same way to obtain the same result; always bearing in mind that devices in a patented machine are different in the sense of the patent law where they perform different functions or in a different way, or produce a substantially different result."

**Suits, where brought.**—Suits for infringement of patents are brought in the Federal courts, and may be either in the nature of an action for damages for past infringement, or an action to restrain the continuance of such infringement and the collection of profits which

the infringer has made, and damages, if any, in excess of the amount of these profits which the patentee may have suffered from the infringement.

**Technical nature of suits.**—The prosecution or defense of infringement suits is of a highly technical nature and requires not only a technical knowledge of the subject matter of the invention, but also a knowledge of that portion of the law peculiar to patents. Such litigation is expensive and protracted and should not be entered without exhaustive searches and investigation into the patent involved and the effects and consequences of the litigation.

**Courts.**—The Federal Courts have exclusive jurisdiction of patent and copyright cases prosecuted under the Federal Statutes. Sec. 24 of the Judicial Code of the United States provides: "The District Courts shall have original jurisdiction as follows: Seventh. Of all suits at law or in equity arising under the patent, the copyright, and the trade-mark laws." All actions respecting contracts relating to patent rights are not actions arising under the patent laws of the United States and are properly

brought in the State Courts. Federal Courts also have jurisdiction of trade-mark cases arising from infringement of trade-marks registered in the United States Patent Office. Many matters may arise in connection with contracts relating to patents, trade-marks, or copyrights which may be tried in the State Courts.

Suits are primarily filed in any District Court of the United States and may be appealed therefrom to the Circuit Court of Appeals having jurisdiction over that district. It is rarely possible to carry patent litigation from a Circuit Court into the Supreme Court of the United States as this can ordinarily be done only where the interpretation of some new point of law is involved. Since the law of patents is quite well settled it is only rarely that a new question arises which necessitates action by the Supreme Court.

**Jurisdiction.**—An infringer must be sued in the district in which he is an inhabitant or he may be sued in any district in which he may have committed acts of infringement and in which he has a regular and established place of business.

The Judicial Code provides as follows: "Sec. 48. In suits brought for the infringement of letters patent the district courts of the United States shall have jurisdiction, in law or in equity, in the district of which the defendant is an inhabitant, or in any district in which the defendant, whether a person, partnership, or corporation, shall have committed acts of infringement and have a regular and established place of business." By district is meant that portion of the United States within the judicial district of any District Court of the United States. Nearly every state is divided into two or more districts. If the defendant is not an inhabitant in the district where the suit is brought he must, whether a person, firm or corporation, have a regular and established place of business in that district to give the court of that district proper jurisdiction over him. It is not sufficient that he sell goods by travelling salesmen or by mail within the district. In many cases a manufacturer outside a district sells goods to a merchant who sells them within the district. In this case the merchant can be sued in the district but not the manufacturer,

unless the manufacturer maintains an office and has a representative therein within the district.

**Defenses.**—There are numerous defenses which may be available in an infringement suit. Walker on Patents enumerates twenty-seven defenses. Some of the defenses attack the validity of the patent on the grounds that the subject matter of the patent is neither an art, machine, manufacture nor composition of matter, that the alleged invention was not new or useful or that the exercise of inventive skill was not required to produce it, that the invention was in fact the invention of another or that the alleged sole invention was in fact a joint invention; on the other hand, the defendant may set up the defenses that his process or machine does not infringe the patent sued on or that the defendant has a license.

Of those defenses enumerated above, the most important is the defense of non-infringement and is proven by showing the claims of the patent sued on do not cover the process used or the thing made, sold or used by defendant. The defense of want of novelty of the subject matter of the patent is also a defense frequently

used and is proven by showing that the same was not new at the time of the alleged invention, or that it was in public use or on sale more than two years prior to the application for patent or that it was patented or described in some printed publication before the alleged invention or more than two years before the date of application for patent.

If the patent is not infringed or if proper proof is offered to show that the patent is invalid, the suit is dismissed and the defendant is entitled to recover court costs from the plaintiff, such costs however not including attorneys' fees.

If the patent is found to be valid and infringed, the defendant, if the suit is brought at law, will be required to pay damages suffered by the plaintiff. On the other hand, if the suit is brought in equity and the patent found valid and infringed, the matter will be referred to a Master for the purpose of determining the profits made by the defendant by use of the infringing process or machine. Damages may also be had in an Equity suit under certain circumstances. In addition to the profits or dam-



ages collected by a successful plaintiff in a suit in equity, the Court will issue an injunction against further use by the defendant of the infringing thing.

**Injunctions.**—Injunctions are issued in suits in equity by the Federal Courts to prevent further infringement of patents, trade-marks, or copyrights. They are formidable weapons backed by the full weight of the United States Government and are very rarely disregarded. The Federal judges, having in mind the consequences of such injunctions, will never grant them except in cases where the infringement is plain and the ownership and validity of the right sued on is certain. Usually injunctions cannot be obtained until after final hearing of the litigation, but in certain cases preliminary injunctions will be granted shortly after the suit is filed. Preliminary injunctions are rarely granted except where the infringement is certain and where there has been a previous full and complete adjudication of the patent by a Federal Court.

Permanent injunctions are issued in equity suits after a full hearing of the case and the

patent adjudged valid and infringed, such injunctions being usually the main things sought in such suits, as they effectually stop further infringement.

**Damages.**—Damages in suits on patents, copyrights, and trade-marks may be obtained in either actions at law or suits in equity. In the latter decrees for accounting may be had which assist in determining the damages. The plaintiff is entitled to recover either his actual damage caused by defendant's infringement or the defendant's profits in patent cases, if these profits are greater than the proved damages.

Sec. 4921 of the Revised Statutes provides in part as follows: "But 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."

In suits on design patents minimum damages of two hundred and fifty dollars are fixed by statute and in copyright cases certain damages are also fixed by statute.

Triple damages are sometimes awarded in cases of wilful infringement.

**Unfair competition.**—Unfair competition consists essentially in the conduct of a trade or business in such a manner that there is an express or implied representation that the goods or business of one person are the goods or business of another. It is unfair to pass off one's goods as those of another person; to imitate a rival's trade-name or label; or to copy or imitate the actual goods made or sold by a competitor, etc. Suits for the protection of a business against unfair competition are usually local in character and are frequently brought in the state courts. While the Law of Unfair Competition is of recent growth, the boundaries for fairly conducting a business are quite well defined, and in many instances advice as to the style or get-up of goods before placing the same on the market will prevent later loss and defense of suits which might be avoided.



## CHAPTER VIII.

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### MISCELLANEOUS INFORMATION

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**Foreign patents.**—There are at the present time about a hundred countries which have patent laws and in which patent protection can be obtained. The laws of these various countries differ widely as to requirements, and to enumerate such requirements of the respective countries would require an explanation too long for a book of this kind. The foreign patent laws differ from the United States laws in many ways. Most of the foreign countries have special regulations requiring the payment of taxes on patents at regular intervals to keep the patents alive, these taxes varying in amount according to the laws of the different countries. In some of the foreign countries it is also necessary that the public derive some benefit from the

patent during the life of the same. In other words, it is necessary that the invention be worked within a given time. Such working may consist of the actual use of the invention, upon reasonable terms made by the inventor, or it may consist merely in an advertising of the invention for the purpose of inducing some person to use it. No taxes are levied nor is working necessary in connection with United States patents. Foreign patents are ordinarily obtained through associates located in the respective foreign countries.

The cost of foreign applications is generally slightly higher per country than in the United States. Complete protection in all foreign countries is quite expensive.

It is undoubtedly a fact that most foreign patents are unprofitable to the patentees and money should not be expended on such patents without a clear idea of the manner in which the patents can be made profitable.

**Trade-marks.**—A trademark is an arbitrary word, symbol or mark affixed to goods or to the packages containing the same, by which a manufacturer distinguishes his goods on the

market from the goods of the same kind placed upon the market by others. The average manufacturer does not appreciate the great value of registering a trade-mark under our Federal and state laws. Trade-marks are vested in the owner as long as they are used and not abandoned. The registration thereof may be renewed at expiration of twenty (20) years, provided the same is still in use. The more extensive the use of a trade-mark, and the longer it is in use, the more value it possesses.

Federal trade-marks, which cover the United States and its possessions, are, of course, of the greatest value, and the requirements for registration are much more strict than in the case of state trade-marks.

Where it is the intention to confine the business to a single state, a state trade-mark registration in that particular state is often sufficient, and in many cases is the only registration that can be obtained.

To register a trade-mark under the laws of the United States, the mark must have been used by the applicant in interstate or foreign commerce, and it must be free from certain

objections, which have become well defined by statute and the decisions of the courts. In a general way it may be stated that to secure registration of a trade-mark it must not be descriptive of the character or quality of the goods upon which it is used, it must not ordinarily consist of the name of an individual, firm or corporation, nor of a geographical term.

Federal registration is valuable because it gives notice to the world and is *prima facie* evidence of ownership, it gives the owner the right to bring suit for infringement in the Federal courts and is also record proof of the date of use which otherwise might be lost or difficult of proof.

**Foreign trade-marks.**—In the United States, ownership of a trade-mark is acquired by the use of the mark. In South American countries and many other foreign countries, ownership is based entirely upon registration, the result being that in such South American and foreign countries any person may register a trade-mark whether he has used the same or not, even though such mark has been used by someone else. In such countries, the law grants



the trade-mark to the first applicant, therefore exporters find that the best and safest policy to follow upon deciding to enter the foreign field; is to first register their trade-mark in the chosen country, thus avoiding the probability that some foreign concern registers the trade-mark, making it impossible to sell or exploit the goods of the exporter under his own trade-mark. Further, it is advisable that the exporter himself obtain the trade-mark rather than to apply for it through a foreign agent.

**Copyrights.**—Copyrights may be registered for a term of twenty-eight (28) years, subject in some cases to a renewal for a further term of twenty-eight (28) years. The following general classes of works may be copyrighted: Books, periodicals, lectures, sermons, addresses, dramatic, dramatico-musical compositions, musical compositions, maps, works of art, reproduction of works of art, drawings and plastic works of a scientific or technical character, photographs, prints, and pictorial illustrations, motion picture photoplays, and motion pictures other than photoplays.

The proper procedure for obtaining copy-

rights on books and similar articles is to place on sale, sell, or publicly distribute copies of the thing copyrighted with a notice of copyright consisting of the word "Copyright," followed by the year when first published, together with the name of the copyright proprietor. This act should be followed by a formal application for registration of copyright addressed to the Register of Copyrights and accompanied in the case of a printed work by two copies of the best edition of the work. In the case of unpublished works, one manuscript copy must be sent. In the case of photographs not intended for general circulation, or in the case of paintings, drawings or sculpture, one photographic print is sufficient. In the case of registering claims to copyright on books it is necessary to also file an affidavit as to the manufacture.

**Prints and labels.**—The law provides for the registration of prints and labels and has defined a PRINT to be any artistic and intellectual production designed to be used for an article of manufacture and in some fashion directly pertaining thereto, but not borne by it, such, for instance, as an advertisement; and the

word LABEL is defined as an artistic and intellectual production impressed or stamped directly upon the article of manufacture or upon a slip or piece of paper or other material to be attached in any manner to manufactured articles or to boxes and packages containing them to indicate the article of manufacture.

A certificate of registration of a print or label remains in force for twenty-eight (28) years from the date of the first publication, and may be continued for a further terms of twenty-eight years upon filing a proper application for such extension.



## CHAPTER IX.

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### PUBLICATIONS

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The Patent Office issues a book, Rules of Practice, which is sent free upon request. It contains the regulations of the office relating to the preparation and prosecution of applications, appeals, interferences, reissues, etc.

The Patent Office also issues a Weekly Gazette, in which are listed all patents issued, a portion of the drawing and one of the claims being usually printed. Individual copies of the Gazette may be purchased or one may subscribe for it by the year. Bound copies of the Gazette are usually found in every public library and as they are indexed both as to patentees and as to inventions it is possible to obtain therefrom information as to any particular patent if the number or date is known.

Printed copies of an issued patent may be obtained direct from the Patent Office for ten cents each, Congress having increased the price from five cents on November 4, 1919. Books containing coupons which can be exchanged for patents may be purchased from the Patent Office and form a convenient method of ordering patents as the Patent Office will not accept postage stamps.

The Patent Office also sells a Manual of Classification.









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