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[PA]TENTS

A HAND-BOOK
of
INFORMATION
FOR
ATTORNEYS
AT LAW

PATENTS

A HAND-BOOK OF INFORMATION

FOR

ATTORNEYS-AT-LAW

ENGAGED IN GENERAL PRACTICE

B. G. FOSTER

ATTORNEY-AT-LAW

Patent and Trade-Mark Causes Exclusively

WASHINGTON LOAN & TRUST BLDG.

WASHINGTON, D. C.

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(Second Edition)

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9 JAN 1913

INTRODUCTION.

Every general practitioner of law is apt to be called upon, now and then, by a client for information and advice on patent law or the securing of a patent. Inasmuch as the practice thereof is a highly specialized branch of the profession, ordinarily, he is not very familiar with the same, so that a concise, accurate compendium which will answer the questions ordinarily presented for consideration, will, it is thought be both convenient and useful. This is the aim of this booklet.

It is of course not intended to be a guide to the actual handling of cases, for the subject is a big one and any attempt to detail the same would defeat the very result aimed at. Moreover, unless an attorney has had actual and thorough training and experience in the conduct of patent cases, he should, by all means, place such matters as are presented to him, in the hands of an associate who has thus specialized.

I will be glad to give any further information at my command on the subject of patents, trademarks, copyrights and the like, and will be glad to personally consider and report on any specific matter submitted to me.

B. G. FOSTER,
Washington, D. C.

THE PATENT MONOPOLY.

Letters Patent are granted in the United States for a term of seventeen years, and the owner thereof, whether the original inventor or a purchaser, has the exclusive right to the invention covered by the patent for that length of time. No one else, without his authority, can manufacture, or use, or sell the same. He may manufacture the invention himself, he may license others to do so, he may let it lie dormant, or he may assign the patent to other parties, so that they will become invested with all the rights he himself held.

While a United States patent will not prevent the free production and use of the invention in other countries, the same cannot be imported into the United States without infringing the patent, and such importation can therefore be prohibited.

WHAT CAN BE PATENTED.

Section 4886 of the Revised Statutes states that "Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereof, not known or used by others in this country, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, and not in public use or on sale for more than two years prior to his application, unless the same is proved to have been abandoned, may upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor."

It will therefore be evident that not only entirely new apparatus, machines, processes, articles and the like can be patented, but also improvements on those already in existence may be made the subject-matter of valid patents.

WHO SHOULD APPLY FOR PATENT.

Only the actual inventor can make application for patent. It cannot be made by another for him, except in case of his death or insanity. Where two or more parties have together worked out the invention, and their ideas and mutual suggestions are so interwoven that it is impossible to separate them into independent inventions, a joint application for patent should be made, and if a patent be secured by one only of the inventors, such patent would be invalid.

On the other hand, if a person secures an interest in the invention of another party, the real inventor only should make the application. An assignment by the inventor to the party in interest can be made and recorded in the Patent Office, and he will then appear as patentee. If in such case the two parties should file an application as joint inventors, the patent thereon would be invalid.

THE FIRST STEP TOWARDS SECURING A PATENT.

A small model, complete drawings or clear sketches of the invention should be prepared, together with a careful description, stating exactly what the device is for, how it is constructed, using reference letters upon the various parts and describing them by the reference letters. The features of importance, the improvements made and the advantages secured, should be carefully pointed out. This information should be sent to a competent patent attorney in order that he may make or have made, an examination of the Patent Office Records to ascertain, as far as possible, whether or not the invention is patentably novel. If the mechanism is complicated, and cannot be properly disclosed by models, drawings and written description, a personal conference with such an attorney is advisable.

PRELIMINARY EXAMINATION OF THE PATENT OFFICE RECORDS.

Such an examination is of real importance, for there are many meritorious inventions that have been patented and never placed upon the market, so that although one may be well acquainted with the commercial field, and know there is nothing in it to anticipate his invention, the Patent Office Records may disclose something very analogous.

Now there are two classes of attorneys, one of which charges a fee (ordinarily $5.00) for the preliminary examination, the other class making no charge. There are undoubtedly conscientious men in both classes and yet it is believed to be wiser to pay the fee.

Those who make a charge for the service, look upon this feature of their business as an important branch of it. They feel that they can, by reason of the fees secured, afford more expert and higher-priced assistance, their searches are apt to be rather more complete, and copies of the closest patents are purchased and forwarded to the client, so that he has before him, prior inventions and patents, and can reach an intelligent decision as to whether he wishes to proceed further.

On the other hand, those who make free examinations ordinarily do not send copies of prior patents with their reports, and, unfortunately, some will advise a client that an invention is patentable, even though the principal features and basic ideas are anticipated, so long as there is some distinction, no matter how unimportant it is, on which a claim can be based. Knowing nothing of the prior art and believing his entire invention patentable, the inventor is thus blindly led into wasting money on something that will be absolutely valueless to him. Therefore, it is believed advisable to send to an attorney who makes a charge for the preliminary examination.

SCOPE OF PRELIMINARY EXAMINATION.

The preliminary examination cannot be absolutely complete. Over one million patents have been granted in the United States, and mistakes in classification and oversights will, of course, occur. Moreover, patents that have been granted in foreign countries, and the various publications, trade magazines, etc., are not included in the examination, but many are searched by the Patent Office when considering an application.

These searches do not take into consideration the question of infringement, but only that of novelty. A device may be patentable and a patent may be secured thereon and still that device may infringe an earlier patent. In other words, the Patent Office considers merely the question of patentable novelty.

ATTORNEY'S REPORT AND PREPARATION OF APPLICATION.

The attorney, having completed the examination, reports the results thereof and expresses an opinion as to the patentability of the invention. If his report is favorable, he usually estimates the cost of the patent and calls for an amount to cover the cost of preparing the application papers and the official drawings. If, in view of this report, the inventor desires to proceed, he remits the amount called for and the necessary papers and drawings are prepared.

As soon as these are completed, the papers are forwarded to the inventor for approval and execution, and upon their return properly signed and accompanied by the attorney's fee, they are filed in the Patent Office.

COST OF A PATENT.

The cost of a patent depends greatly upon the character of the invention and the attorney hand-

ling it. For a simple device, such as a small article of manufacture that can be fully illustrated on one sheet of official drawings, the cost is sometimes as low as $65. Itemized, it is as follows:

First Government fee.............	$15.00
One sheet of official drawings.....	5.00
Attorney's fee.....................	25.00
Final Government fee............	20.00
Total..........................	$65.00

Where the invention is more complicated, requiring more sheets of drawings, each additional sheet costs $5, and the attorney's fee is increased.

TO SAVE TIME.

If the inventor makes a preliminary remittance of $25 instead of $5, with the original description of the invention, then, if a favorable report is sent, the preparation of the papers can be immediately undertaken without the delay incident to awaiting a reply from the report. This is always advisable and nothing is lost thereby, for if an unfavorable report is sent, the amount forwarded, less $5, the cost of the preliminary examination, will be returned.

PROSECUTION OF THE APPLICATION.

Having filed the application, it is placed in the particular division of the Patent Office handling the class of inventions to which it relates. Some of these divisions are months behind in their work, others are fairly up to date. Here the case remains until it is reached in the regular order of business, when it is taken up, carefully considered by the Examiner, and if any errors are found, or if it is discovered, after a careful search of the records, that the claims are drawn too broadly, or if the Examiner regards the application objectionable from any cause, the attorney is notified of the objection by letter.

He has a year within which to reply to the official action. If the attorney considers the Examiner's action correct, he amends the case; if erroneous, he prepares a written argument or has a personal interview with him. These official actions and replies may occur several times until a final conclusion is reached and the application is allowed, or finally rejected, in which latter case, an appeal from the Examiner's decision, can be taken.

The final Government fee of $20 must be paid before the patent actually issues, and the applicant is given six months after the allowance of the application within which to pay the same. If not paid, it can be renewed within two years at additional expense.

PATENT APPLICATIONS NOT OPEN TO INSPECTION.

While all issued patents and their records are open to public investigation, no examination can be made of the applications that are pending in the Patent Office, as they are maintained in secrecy and are not accessible to any one except the applicant, his attorney, or an assignee, or upon their written authority. It is therefore impossible to ascertain if a person has filed an application for patent or if an application has been made along any particular line.

TIME NECESSARY TO SECURE A PATENT.

From what has been stated under *"Prosecution of the application,"* it will be evident that it is impossible to tell the amount of time that will be required to secure a patent with proper protection. The various divisions of the Patent Office are continually varying, sometimes working up to date, at other times, dropping behind. Then it is impossible to foretell how many actions and

amendments will be necessary before adequate claims are secured.

APPEALS.

It sometimes happens that an Examiner refuses to allow claims of importance which an attorney believes to be patenable, and in such cases appeals can be prosecuted from the Examiner to a Board of Examiners-in-Chief, which reviews the matter and reverses or affirms the decision of the Examiner. If the decision of the Board of Examiners-in-Chief is unfavorable, the inventor can then appeal to the Commissioner of Patents in person and from his adverse decision, an appeal can be taken to the Court of Appeals of the District of Columbia. The Government fee in an appeal to the Board of Examiners-in-Chief is $10, and to the Commissioner of Patents, $20.

The attorney's fee for prosecuting an application does not include his charges for prosecuting appeals.

INTERFERENCES.

Where two or more persons have made applications for patent, and have laid claim therein to the same invention, the Patent Office institutes what is known as an interference proceeding, by means of which it determines which applicant is entitled to the interfering claims. An interference may occur between two parties wholly unknown to each other, or, as is sometimes the case, one party may obtain a knowledge of an invention from another and fraudulently file an application.

Often it is possible to dispose of these interferences without great difficulty, and at comparatively small cost. At other times, testimony must be taken and briefs prepared and filed, the same as in a suit in equity. It will be evident therefore, that interferences may be expensive, and that the fees for attending to matters in connection with them must be in addition to that charged for prosecuting the application.

PROSECUTING REJECTED APPLICATIONS.

It often occurs that an inventor files his own application, only to meet with objections and rejections, which he is at a loss to answer. Or very often applications prepared by attorneys, unskilled in the practice, meet the same fate. Such cases can be placed in the hands of a patent attorney, who, for a small charge, usually $5, will investigate the matter fully, and report as to the prospects of securing a patent, at the same time stating what the cost will be for prosecuting the case.

REISSUES.

Sometimes a patent is found to be defective, perhaps in the description or in some other parts of the disclosure, but usually because the invention which it discloses, is not fully protected. Under certain conditions, the patent may be reissued to correct the defect. As the matter of reissue is one fraught with many questions, each particular case must stand on its own footing, and should be made the subject of a report by a skilled attorney.

ASSIGNMENTS AND LICENSES.

If it is desired to transfer a part or the whole interest in an invention before a patent is secured, or in a patent already issued, the same must be done by a written assignment which should be recorded in the Patent Office. If an assignment is made before patent, the person or company that obtains the interest in the same will appear in the patent as owner or part owner as the case may be. The cost of preparing and recording an ordinary assignment is usually $5.

The owner of a patent may, if he desires, license other parties to manufacture, or use, or sell the invention owned by his patent, while retaining the title to the patent. These licenses are made by suitable instruments in writing.

ASSIGNMENT SEARCHES.

For a fee dependent on the amount of work involved, an abstract of title of a patent can be furnished in order that the present ownership of such patent can be determined.

DESIGN PATENTS.

If an inventor has produced a novel, ornamental structure, or has produced an ornamental design that is distinctly different from anything that precedes it, if the same rises to the dignity of invention, it may be protected by design patent. The complete cost of procuring a design patent is approximately as follows:

Patent for 3½ years..............	$30.00
Patent for 7 years..............	35.00
Patent for 14 years..............	50.00

The inventor must determine in advance the term, for after the patent has been obtained it cannot be changed or extended.

TO PROSPECTIVE PURCHASERS OF PATENTS.

Before purchasing an invention or patent, or an interest in the same, it is of the utmost importance that the prospective investor know exactly what he is buying and it is always advisable to consult an attorney before proceeding. Possibly the invention infringes some prior patent ; possibly, in case of a patent, such patent is invalid or does not properly protect the invention. More than likely, it is not nearly as comprehensive in its scope as both the owner and intending purchaser believe it to be. It is much wiser to pay an attorney a fee for an expert and unbiased opinion before purchasing, rather than to buy blindly.

VALUE OF AN INVENTION.

This is something that cannot be foretold. It depends on so many circumstances, whether it is of practical value, whether it is properly brought before the public or those who may be interested. Many inventions that would appear to be of the greatest commercial value are never heard of beyond the confines of the Patent Office. Others, that appeared to be trivial, have made fortunes for their owners. Like everything else, much depends on the ability and energy of the party or parties interested, and an attorney is ordinarily in no position to advise a client as to the commercial value of a patent.

MARKING INVENTIONS.

After an application for a patent has been made, the invention can be marketed and marked "PATENT APPLIED FOR," but this affords no protection, and any one else can still manufacture it until the patent is secured. Therefore it is somewhat dangerous to exploit an invention until the patent is granted. When a patent has been obtained, the patented article should be marked "PATENTED," together with the date of the patent.

INFRINGEMENT.

Any person who places a new machine or article on the market, is running the risk of infringing patents that cover the same. It is therefore often advisable to have an expert search made and an opinion rendered on the question of infringement before proceding with the exploitation of new devices.

If the owner of a patent considers that the same is being infringed, or if a person is threatened with a suit for infringement of a patent, he should seek the advice of a competent attorney. The cost of prosecuting an infringement suit or repre-

senting a defendant in such a suit can hardly be approximated, but is very apt to be considerable.

FOREIGN PATENTS.

Patents granted in the United States do not, of course, extend in their protection to foreign countries. Yet copies of the United States patents and the Official Gazette containing the same are sent abroad immediately on publication. Foreigners therefore are at perfect liberty to adopt and use, in their respective countries, inventions patented in the United States, unless patents are obtained in such foreign countries. Naturally the value of foreign patents depends on whether or not the invention is useful in such countries. Canada, Great Britain, Germany, France, and the other continental countries have many commercial enterprises so similar to our own that often patents are valuable in these countries, as well as in the United States.

While under certain conditions, valid patents can be obtained in many of the foreign countries after the United States patent is issued, it is usually the wiser plan to make application in the foreign countries in which patents are desired, before the United States patent is granted.

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